



Sharayu Khot.

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

INTERIM APPLICATION (L) NO. 27493 OF 2023  
IN  
COMMERCIAL IPR SUIT (L) NO. 27330 OF 2023

Prince Pipes and Fittings Ltd.

...Applicant/  
Plaintiff

*Versus*

Shree Sai Plast Pvt. Ltd.

...Defendant

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Mr. Rashmin Khandekar a/w Mr. Pranav Nair, Mr. Madhu Gododia, Ms. Anisha Nair and Prajjwal Khushwaha (through V.C.) i/b Anand & Naik for the Plaintiff.

Mr. Alankar Kirpekar a/w Mr. Shekhar Bhagat, Mr. Amit Kukreja, Mr. Ayush Tiwari, Mr. Chinmay Pagedar, Mr. Rajas Panandikar and Ms. Gauri Sansare i/b Shekhar Bhagat for the Defendant.

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CORAM : R.I. CHAGLA J

Reserved on : 9 August 2024

Pronounced on : 6 December 2024

ORDER :

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PANDURANG  
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1. By this Interim Application, the Plaintiff is seeking injunction order restraining the Defendant from infringing the Plaintiff's registered "PRINCE" trade marks as well as infringing the

Plaintiff's registered "crown device" marks. Further, injunction order is sought restraining the Defendant from infringing the copyright contained in the Plaintiff's "crown device" registrations. Also an injunction order is sought restraining the Defendant from Passing off the Plaintiff's registered "PRINCE" trade marks and "crown device" marks by using an identical or similar mark causing dilution or tarnishment of the Plaintiff's marks.


2. The Plaintiff states that it is a Mumbai based company using the mark "PRINCE" since 1987 for manufacturing and selling its PVC pipes. Since its inception, the Plaintiff claims to have been continuously and extensively using the "PRINCE" mark along with "crown devices" as its trade mark, and members of the trade associate the mark "PRINCE" and the "crown devices", only with the Plaintiff and no one else.

3. Over the years, the Plaintiff claims that it has garnered tremendous goodwill and reputation, resulting in the "PRINCE" mark and "crown device" (which was slightly modifies over time) being associated exclusively with it and its PVC pipes. This is demonstrated by:

- (i) The Plaintiff's large sales base in India with annual sales of Rs. 2703.4 Crores and annual sales promotional expenses of Rs. 41.3 Crores for the year 2022-2023. A table showing annual sales and promotional expenses from 2012 onwards as duly certified by a Chartered Accountant is set out in paragraph 16 of the Complaint, as under:

<b>YEAR</b>	<b>Annual Sale of Products &amp; Services (Rs. in millions)</b>	<b>Annual Sales Promotional Expenses (Rs. in millions)</b>
2022-2023	27,034.42	413.86
2021-2022	26,497.71	415.21
2020-2021	20,683.33	657.17
2019-2020	16,313.65	321.17
2018-2019	15,605.91	432.79
2017-2018	13,154.19	201.95
2016-2017	13,261.71	150.24
2015-2016	10,812.38	139.96
2014-2015	10,312.41	161.05
2013-2014	10,803.57	56.96
2012-2013	8,530.74	80.67

- (ii) Extensive advertisement in print and digital media by the Plaintiff ever since the Plaintiff has been in business.
- (iii) Bills and invoices of goods sold by the Plaintiff under the "PRINCE" mark. The invoices showing the use of mark "PRINCE" since at least from March 2010.

- (iv) Since 26<sup>th</sup> February 2000, the Plaintiff has owned, operated and registered a domain name, viz. “www.princepipes.com”, through which it advertises, promotes and conducts its business in relation to PVC pipes.
- (v) Since 2019 the Plaintiff is publicly listed on the Bombay Stock Exchange and National Stock Exchange under the name “Prince Pipes and Fittings” with the “crown device”  being displayed next to its name by stock broking platforms.
- (vi) The Plaintiff has been awarded various awards and accreditations including being recognized as a ‘Fortune India the Next 500’ company. The Plaintiff has enforced its mark, “PRINCE” as also the “crown” marks in courts as well as before the trade mark registry so that the distinctiveness of “PRINCE” and “crown device” in respect of PVC pipes is maintained.
- (vii) Several successful enforcement actions for the “PRINCE” mark and “crown device” by the Plaintiff including by way of suits before this Court and oppositions against third party applicants of similar trade marks before the Trade Marks Registry.

4. The Plaintiff states that there is as such absolutely no quarrel with the fact that the Plaintiff has used “Prince” and a “crown device” in respect of its business of “PVC Pipes” nearly for the last 4 decades. “Prince” is a part of the Plaintiff’s trading name as well. As such both, “Prince” and the “crown device” have acquired substantial goodwill and reputation, and are associated and identified directly with the Plaintiff, in relation to “PVC Pipes”.

The Plaintiffs’ statutory entitlement in respect of its distinctive “PRINCE” and “crown device” range of marks. The Plaintiff has secured registrations in respect of such marks not only in India but also in other parts of the world.

5. In 1992, the Plaintiff first obtained a registration for the

mark “PRINCE” with a crown device depicted as



*vide*

application no. 579413 [Para 2, Pg. 26 Plaintiff; Ex. B, Pg. 152, Vol I Plaintiff]. While this registration has since lapsed for non-renewal its grant demonstrates the user of the Plaintiff of the said mark as on the date claimed.

6. Since then, the Plaintiff has applied for and been granted registration of several marks, the essential feature whereof is “PRINCE” and the “crown device”. In fact, the Plaintiff also has a separate registration for the “crown device” on its own. The mark “PRINCE” and “crown device” are distinctive of the Plaintiff so far as the goods in question are concerned, viz. PVC pipes. A list of the Plaintiff’s trade marks material for the present Suit are set out in paragraph 7, Pg. 30 Plaintiff; Exh. E, Pg. 264-333, Vol II Plaintiff.

7. As the Plaintiff’s goods are also exported to various foreign countries, it claims to have also secured protection for its trade marks in Bhutan, Kenya, Pakistan, and Sri Lanka. The Plaintiff has also issued a caution notice in Maldives.

8. Insofar as Plaintiff’s trade mark Application no. 1013152





for the mark is concerned, it is submitted that while the application was pending, the Examination report issued by the registry contained a condition that the words “AQUA SYSTEMS” should be disclaimed to which the Plaintiff agreed. However, in the eventual registration, the disclaimer was wrongly entered for the

word “PRINCE” instead of “AQUA SYSTEMS”.

9. The Plaintiff’s attorneys were unable to cancel this obviously wrong and erroneously recorded disclaimer for “PRINCE” and the Plaintiff is taking all the steps available to have the same corrected. In any case, as this one disclaimer is in relation to only one registration, the Plaintiff states that it continues to possess both statutory and common law rights in respect of all other registrations which have been secured by the Plaintiff. Therefore, it is stated that the fact that one of the Plaintiff’s registrations has a disclaimer is **absolutely irrelevant** for the adjudication of the present dispute.

10. The Plaintiff states that the crown devices depicted

in  and as  forming the essential and dominant feature of the Plaintiff’s various trade marks were created in-house together by a team of the Plaintiff company and its founder. There are specific pleadings contained in the Plaint to this effect. Therefore, by virtue of its creation, the Plaintiff claims that its crown device is protected as an artistic work under Section 2(c) and Section 14 of the Copyright Act, 1957 (“**Copyright Act**”). The Plaintiff thus claims to be the first

owner of the copyright in the crown device under Section 17(c) of the Copyright Act.




11. The Defendant is a private limited company based in Patna, Bihar engaged in the identical business of selling PVC pipes across India.

12. On 7<sup>th</sup> January 2021, the Plaintiff was served with a Caveat filed by the Defendant before the Patna High Court.

13. Thereafter in February and March 2021, the Plaintiff found that the Defendant had applied for the registration of identical and/or deceptively similar marks containing the essential features of the Plaintiff's registered marks "PRINCE" and the "crown device". Accordingly, the Plaintiff initiated proceedings before the TM Registry against the said marks. The first opposition by the Plaintiff was against impugned mark No. 5 in March 2021. The table below sets out the particulars in this regard, with details of Defendant's Applications and their oppositions by the Plaintiff:




Impugned Mark No.	Application No.	Application Date	Class User	Exhibit to the Plaint	Date of Opposition by the Plaintiff
1. 	3981950	24.10.2018	35  (User claimed since 17.02.201 6)	Exh. W  (Pg. 488541)	20.01.2022
2. 	4343663	11.11.2019	17  (Propose d to be used)	Exh. X  (Pg. 542559)	20.01.2022
3. 	4343664	11.11.2019	17  (Propose d to be used)	Exh. Y  (Pg. 560577)	20.01.2022
4.	4343665	11.11.2019	17  (Propose d to be used)	Exh. Z  (Pg. 578595)	20.01.2022

					
5. 	4827338	20.01.2021	17  (Proposed to be used)	Exh.  AA  (Pg. 596610)	04.03.2021
6. 	5120837	07.09.2021	17  (Proposed to be used)	Exh.  AB  (Pg. 611625)	20.05.2022

14. As the Defendant failed to file its counter statements to the Plaintiff's oppositions to impugned mark Nos. 4 and 6, they have since been deemed to be abandoned.

15. The Plaintiff states that while preparing the present action, it also discovered that the Defendant had **fraudulently** and **ex facie dishonestly** registered the following trade marks, which

utilized the essential feature of the Plaintiff's registered marks, viz.  
the "crown device" as under:

Impugned Mark No.	Application No.	Application Date	Class	Exhibit to the Plaintiff
7. 	3179529	08.02.2016	17	Exh. AE (Vol. V) (Pg.894-898)
8. 	3981918	24.10.2018	17	Exh. AF (Vol. V) (Pg.899-952)
9. 	3981919	24.10.2018	17	Exh. AG (Vol. V) (Pg.953-1003)
10. 	3981927	24.10.2018	17	Exh. AH (Vol. VI) (Pg.1004-1057)
11. 	3981940	24.10.2018	35	Exh. AI (Vol. VI) (Pg. 1058-1151)

12.	3981949	24.10.2018	35	Exh. AJ (Vol. VI) (Pg.1152- 1206)
				

The various impugned marks registered and applied for by the Defendant are hereinafter referred to as “**Impugned Marks**”.

16. In May 2023, the Plaintiff claims that it first became aware that the Defendant through its website [www.shreesaiplast.in](http://www.shreesaiplast.in), has been advertising its goods bearing the Impugned Marks.

17. From the images of the Defendant’s products on its website, it was clear that the Defendant was using the Impugned Marks in a *mala fide* manner to cause confusion in the minds of the public.

18. The Plaintiff states that the Defendant used of the word “PRINCE” as the most prominent feature of its marks by making it much bigger and bolder alongside a “crown device” similar to that of the Plaintiff. Such use by the Defendant is also in derogation of

what it originally applied for. Representations of the Defendant's products as visible on its website are as follows:

Sr. No.	Use of Impugned Marks on the Defendant's products	Reference
1.		Para. 36 Pg. 73 Plaintiff; Exh. AP, Pg.1260, Vol VII Plaintiff
2.		Para. 36 Pg. 73 Plaintiff; Exh. AP, Pg.1260, Vol VII Plaintiff
3.		Para 26, Pg. 172 Rejoinder

19. The Plaintiff states that there is absolutely no manner of doubt whatsoever that when the Defendant adopted the impugned marks, such adoption was tainted and fraud and deceit. The manner of adoption itself makes this abundantly clear.

20. During the course of the present proceedings, the Plaintiff claims to have discovered further material which make it clear that the Defendant, through persons who managed it, always wanted to piggyback upon the goodwill and reputation of the Plaintiff by copying, imitating and pirating its mark.

21. The Plaintiff states that while perusing the examination reports of the Defendant's Impugned Marks for preparing its Limited Affidavit in Reply ("**Limited Affidavit**") (and in an answer to the Defendant's case sought to be put up in its Additional Reply), the Plaintiff has discovered that Mr. Sanjeet Prakash, a Director of the Defendant, the deponent in its affidavits and the person credited with the authorship of the impugned marks had on:

(i) 10<sup>th</sup> December 2013, *vide* application No. 2640339


applied for and later obtained a registration for the

device mark  **SHARDA POLLYTUBE** under  
class 17 for PVC pipes.


(ii) 5<sup>th</sup> March 2014, *vide* application No. 2691907 applied  
for and later obtained a registration for the device

mark  **SHAKTI** under class 17 for PVC  
pipes; and

(iii) 5<sup>th</sup> March 2014, *vide* application No. 2691908 applied  
for but later abandoned the device mark

 **INTEX** under class 17 for PVC pipes.

22. The Plaintiff states at the time when these  
applications were made by Mr. Prakash in the financial year 2013-

2014, the Plaintiff's mark  "PRINCE  
AQUA  
SYSTEMS" was already in the market for  
years and generating sales of approx. Rs. 10,803.57 Million as well as

incurring promotional expenses of Rs. 56.96 Million. Thus, Mr. Prakash ought to have been and was in fact aware of the Plaintiff's mark at the time of filing its applications.

23. The Plaintiff contends that Mr. Prakash blatantly copied the Plaintiff's mark and applied for its registration. A comparison of the Plaintiff's mark and Mr. Prakash's applied for marks are as follows:

Plaintiff's Mark	Defendant's marks
	  



24. It is stated that the Defendant knowingly suppressed these applications in their reply wherein they otherwise highlight various other marks with crown devices. The Defendant/ Mr. Prakash ought to have disclosed that Mr. Prakash had also applied for/registered a mark near identical to that of the Plaintiff's. They have omitted to do so only to conceal the fact that they always intended to copy the Plaintiff's mark and the suppressed applications would have made this evident. The said registrations obtained by the Defendant are *ex facie* fraudulent, illegal and such that shock the conscience of this Court. The said registrations can be ignored even at this interlocutory stage. On account of the prayers already sought, an order against the said registered marks is also covered.

25. It is stated that the manner of use of the impugned marks by the Defendant, as also the suppressed applications make it clear that the Defendant / Mr. Prakash have always attempted to copy, infringe and pass off their goods as that of the Plaintiff's, and it is only their approach to it which has become more nuanced with the passage of time. Mr. Prakash's actions as the Director of the Defendant and the admitted author of the mark also makes the Defendant's adoption of the Impugned Marks *ex facie* fraudulent,

dishonest and *mala fide*. As the newly discovered marks also fall within the ambit of the Plaintiff's prayers in the Suit and the present Interim Application, the Plaintiff prays that appropriate relief may be granted in relation to these marks as well.

26. The Plaintiff submits that the fact that the Defendant copied the "crown device" of the Plaintiff also shows that the crown device is an essential and prominent feature of the Plaintiff's marks, and that it is directly associated with the goods and services of the Plaintiff, that are sought to be enforced in the present proceedings. Therefore, the intent of the Defendant to copy the "crown device" of the Plaintiff is clear. The Defendant has therefore copied the "crown device", as also the mark "Prince", in relation to identical goods and/or services. The Defendant has made every attempt to sail as close as possible to the Plaintiff's marks. This is also a complete answer to the Defendant's contention of its crown device being adopted in a *bona fide* manner. The Defendant's conduct is in fact a calculated attack on the Plaintiff's business by copying and imitating its marks and its essential feature. Once the dishonest conduct of the Defendant is apparent, it is trite that an injunction ought to follow.

27. It is further submitted that most importantly the Defendant has not disputed the aforesaid facts either on Affidavit or even during the oral arguments despite them being specifically pleaded by the Plaintiff. Therefore, this Court is required to view the conduct of the Defendant through this prism, where it is now an admitted position that the Defendant and the persons managing the day to day affairs of the Defendant had strained every possible nerve to copy the Plaintiff's distinctive marks, "PRINCE" as also the "crown device" in respect of identical goods and services, viz. PVC pipes in an ungainly manner so as to piggyback upon the goodwill and reputation of the Plaintiff as also its distinctive marks. This aspect is material because it is trite law that once it is found that the conduct of the Defendant is ex facie dishonest, the same is a relevant factor in consideration of grant of an injunction against the Defendant. ordinarily in such cases injunction is granted as a matter of course.

28. Mr. Rashmin Khandekar, the learned Counsel appearing for the Plaintiff has submitted that the Defendant's reliance on the disclaimer in relation to "PRINCE" is misconceived. This does not hinder the Plaintiff's enforcement of the same mark or its other marks. He has submitted that the disclaimer on Plaintiff's

mark “PRINCE” is with respect to the Plaintiff’s registration bearing No. 1013152. There is no disclaimer on any other of the Plaintiff’s registered marks in relation to “PRINCE” and/or “crown device”, that are sought to be enforced in the present action. He has further submitted that there is no impediment whatsoever with respect to the registrations of the mark “PRINCE” and/or “crown device”, which do not contain any disclaimer. He has submitted that the disclaimer has wrongly been applied to the Plaintiff’s registration bearing No. 1013152, as the disclaimer was meant for the words “AQUA SYSTEMS” and not with respect to “PRINCE”.

29. Mr. Khandekar has placed reliance upon the decisions of this Court in **Prince Pipes & Fittings Ltd. Vs. Prince Platinum Pipes And Fittings**, order dated 10th March 2021 in Interim Application (L) No. 5290 of 2021. In the said decision, the learned Single Judge of this Court has noted that *“I do not even pretend to understand the purport of that disclaimer because ex facie the word PRINCE in relation to something as plebian as PVC Pipes is surely deserving a recognition of distinctiveness. Over time, the goods have been described by the Plaintiff as “Piping Systems”. The PRINCE mark is prominently displayed on every unit or segment of the*

*supplied products.”.*

30. Mr. Khandekar has submitted that it is trite law that a disclaimer in relation to one mark does not “travel” to other registrations obtained by the Plaintiff where there is no specific disclaimer and/or condition and/or limitation. He has in this context, placed reliance upon the following decisions :-

- (i) **Pidilite Industries Ltd. Vs. Dubond Products India (P) Ltd., 2024 SCC OnLine Bom 1390** at paragraph 96;
- (ii) **Skol Breweries Ltd. Vs. Sol Distilleries, 2012 (49) PTC 231 (Bom)** at paragraphs 8, 10 and 11;
- (iii) **Pidilite Industries Ltd. Vs. Pom a-Ex Products, 2017 SCC OnLine Bom 7237** at paragraphs 98, 99 and 100.
- (iv) **Foodlink F & B Holdings India Private Limited Vs. WOW Momos Foods Private Limited, CS (Comm) 848/2022 dated 3<sup>rd</sup> August 2022** (Delhi High Court; Single Judge) at paragraphs 28, 29 and 30.

31. Mr. Khandekar has submitted that it is abundantly clear from the aforementioned judgments that a disclaimer in

relation to one registered mark can never travel to another registered mark, where there is no specific disclaimer. He has submitted that the Courts have time and again held that even for the purposes of comparison for rival marks the disclaimed portion of the mark is also required to be compared while comparing the mark as a whole, because a disclaimer does not “travel to the market”. He has in this context, placed reliance upon **Pidilite Industries Ltd. Vs. S.M. Associates, 2003 SCC OnLine Bom 143 (Single Judge)** at paragraphs 70 and 71 and **Shree Nath Heritage Liquor Pvt. Ltd. Vs. Allied Blender & Distillers Pvt. Ltd., 2015 SCC OnLine Del 10164** at paragraph 17.

32. Mr. Khandekar has submitted that the Plaintiff has several other marks with “PRINCE” and the “crown device” as a part of its essential feature and where there is no disclaimer. He has submitted that the aforesaid judgments are placed before this Court only for the sake of completeness because a contrary proposition was argued by the Defendant during the oral arguments.

33. Mr. Khandekar has submitted that mere existence of other marks without demonstrating extensive use cannot assist the

Defendant, so also, a mere entry in the register of Trade Marks is of no consequence for the defence common to the trade because it is trite that registration per se does not prove “use” of the mark.

34. In the context of the compilation of documents tendered by the Defendant during the oral arguments, which comprised of printouts of various registered marks on the website of the TM Registry using the word “PRINCE”, he has submitted that the material referred to by the Defendant in relation to the use of “PRINCE” is not even in relation to PVC pipes, which are the subject goods in question and are in relation to wholly unconnected goods and/or services.

35. Mr. Khandekar has submitted that mere presence of marks on the register does not evidence their use. In support of his submission, he has placed reliance on **Corn Products Refining Co. Vs. Shangrila Food Products Ltd.**<sup>1</sup>. The Supreme Court has held that for a mark to become “common to the trade” it must be demonstrated that the common element is extensively used.

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<sup>1</sup> AIR 1960 SC 142 (Supreme Court; Full Bench) at paragraphs 15 and 16

36. Mr. Khandekar has submitted that in fact the Defendant is estopped from contending either that “PRINCE” and/or the “crown device” to a PVC pipes are common to the trade, because the Defendant has itself applied for and in fact, even secured registration of marks, the essential feature whereof is “PRINCE” and/or “crown device”. He has in support of his submission placed reliance upon the decisions as follows :-

- (i) **Pidilite Industries Ltd. Vs. Jubilant Agri & Consumer Products Ltd.**, 2014 SCC OnLine Bom 50 at paragraphs 11, 11.1 and 11.2;
- (ii) **Jagdish Gopal Kamath Vs. Lime & Chilli Hospitality Services**, 2015 SCC OnLine Bom 531 at paragraph 29;
- (iii) **Brihan Karan Sugar Syndicate (P) Ltd. Vs. Lokranjan Breweries (P) Ltd.**, 2014 SCC OnLine Bom 1063 at paragraph 33.

37. Mr. Khandekar has submitted that the Plaintiff’s marks are specifically enforceable under Section 17(1) of the Trade Marks Act, 1999. Further, Section 17(2) of the Act in fact is not even applicable in the facts of the present case. He has submitted that the



Defendant has attempted to completely misconstrue the provisions of the Section. The Defendant has during the oral arguments contended the Plaintiff has not separately applied for registration of “PRINCE” or secured a separate registration in that regard, and thus, the bar contained in Section 17(2) comes into force and the Plaintiff is not entitled to enforce “PRINCE” as a part of its registration. It is contended that while Section 17(1) of the Act grants registration of a mark as a whole, if a part of the said mark is not separately applied for, the Plaintiff cannot claim a monopoly on the same.

38. Mr. Khandekar has submitted that this contention of the Defendant is misplaced on multiple counts. Not only is it based on an entirely incorrect reading of Section 17 of the Act and the Statement of Objects and Reasons (SOR), which were pressed into force even by the Defendant, it is also incorrect on the part of the Defendant to contend that the said contention is in fact not considered by judgments of this Court. He has submitted that the contention as sought to be raised is no more *res integra* and has been authoritatively decided by multiple judgments of this Court.

39. Mr. Khandekar has referred to Section 17 and

submitted that it is in two parts, viz. Section 17(1) and 17(2). He has submitted that if the registered marks contained any “distinctive” feature, the use of the same is saved and protected under Section 17(1) of the Act and 17(2) in fact does not even come into play. The moment the mark is held to be distinctive, which analysis is required to be made on an ocular evaluation as also on the basis of the goods and services in respect of which it is sought to be used, the same is covered under Section 17(1) of the Act and the fetters qua Section 17(2) will not apply to such a “distinctive” mark.

40. Mr. Khandekar has submitted that from the Statement of Objects and Reasons, it is clear that the clause deals with the effect of registration of parts of the mark seeking to omit the provisions relating to requirement of disclaimer and to explicitly state the general proposition that the registration of trade mark confers exclusive right to use of the trade mark taken as a whole and not separately of each of its constituents if any. He has submitted that this does not make any departure as sought to be contended by the Defendant from the earlier regime, but merely makes explicit what was always a general proposition. He has submitted that as such the contention of the Defendant that the regime of the “essential feature”

and “prominent feature” as was applied and considered by a catena of judgments of the Supreme Court and this Court is absolutely incorrect. He has further submitted the Defendant is also incorrect in seeking to contend before this Court that the aforesaid contention is in fact *res integra*. He has submitted that the exact arguments sought to be raised by the Defendant including the effect of the deletion of the provisions with respect to the disclaimer as also the reference to the Statement of Objects and Reasons has squarely been considered by this Court in multiple judgments. In this context, he has placed reliance upon the following judgments :-

- (i) ***Pidilite Industries Ltd. Vs. Jubilant Agri & Consumer Products Ltd.***, 2014 SCC OnLine Bom 50 at paragraphs 16, 16.1, 16.2, 16.3 and 16.4;
- (ii) ***Ultra Tech Cement Ltd. Vs. Alaknanda Cement (P) Ltd.***, 2011 SCC OnLine Bom 783 at paragraphs 32, 33 and 34;
- (iii) ***Brihan Karan Sugar Syndicate (P) Ltd. Vs. Lokranjan Breweries (P) Ltd.***, 2014 SCC OnLine Bom 1063 at paragraphs 22, 24 to 29;
- (iv) ***Alaknanda Cement (P) Ltd. Vs. Ultratech Cement***

*Ltd.*, 2011 SCC OnLine Bom 1487 paragraphs 11, 12, 14 to 16;

(v) *United Biotech (P) Ltd. Vs. Orchid Chemicals & Pharmaceuticals Ltd.*, ILR (2012) 5 Del 325 paragraphs 21 to 23 and 25;

(vi) *Shree Nath Heritage Liquor Pvt. Ltd. Vs. Allied Blender & Distillers Pvt. Ltd.*, 2015 SCC OnLine Del 10164 paragraphs 84, 85 and 86.

41. Mr. Khandekar has submitted that the decision relied upon by the Defendant, namely *Ultratech Cement Limited Vs. Dalmia Cement Bharat Limited* <sup>2</sup>, reads entirely in favour of the Plaintiff and against the Defendant. In paragraph 6 of the said judgment, the arguments of the Plaintiff have been recorded. Paragraph 16(c) of the said judgment is relevant to the dispute at hand. The argument was that “Ultra” in respect of cement was distinctive. However, this Court found to the contrary and held that “Ultra” was in fact an ordinary, laudatory and descriptive word commonly used in the English language and could not be distinctive of goods in question, viz. Cement. He has in particular, placed reliance upon the findings in paragraph 8 of the said judgment in this

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<sup>2</sup> Judgment dt. 10.06.2016 in Notice of Motion No. 76 of 2014 in Suit No. 42 of 2014

context. In paragraph 12 of the said judgment, this Court held that the word “Ultra” which is part of the whole of the Plaintiff’s registered trade marks is of a non distinctive character. The registration of the mark as a whole does not, by reason of Sub-Section (2) of Section 17, confer any exclusive right on the proprietor to the use of the the word 'Ultra'.”

42. Mr. Khandekar has submitted that there can be no doubt that in the present case, “PRINCE” in relation to PVC pipe is distinctive. He has submitted that “PRINCE” is used in the prominent and distinct fashion as a mark in relation to the Plaintiff’s goods i.e. PVC pipes. The word “PRINCE” has absolutely no relation whatsoever with the goods in question. It is thus, not a laudatory word. Therefore, “PRINCE” in relation to PVC pipes is entirely arbitrary and/or distinctive. It is not even descriptive or suggestive and is therefore, capable of strongest trade mark protection. The said mark has been used expensively from 1987, and thus, *in fact* associated only with the Plaintiff alone. The sales of the Plaintiff under this mark are to say the least, very substantial. There is no doubt about the goodwill and reputation accrued in the said mark, and material in that regard is placed on record.

43. Mr. Khandekar has submitted that on an independent ocular evaluation of the Plaintiff's "PRINCE" marks coupled with the fact that it is used in relation to PVC pipes for a long length of user, and having acquired extensive goodwill and reputation, makes it clear that "PRINCE" is distinctive of the Plaintiff qua PVC pipes.

44. Mr. Khandekar has submitted that this Court has examined this aspect and found "PRINCE" entirely distinctive in relation to PVC pipes. He has in this context, placed reliance on the judgment of this Court in *Prince Pipes And Fittings Ltd. Vs. Prince Platinum Pipes And Fittings*<sup>3</sup> at paragraphs 3, 5, 9, 15, 20 to 22. He has submitted that the ratio of the judgment applies to the present case on all fours. The said judgment unequivocally held "PRINCE" to PVC distinctive of the Plaintiff in relation to PVC pipes.

45. It has been held that the essential feature of the Plaintiff's mark "PRINCE" is distinctive and has been copied by the Defendant. Therefore, it is held there is a clear case of infringement and passing off is made out.

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<sup>3</sup> Order dt. 10<sup>th</sup> March 2021 in IA(L) No. 5290/2021

46. Mr. Khandekar has submitted that there can be no manner of doubt that “PRINCE” in relation to PVC pipe is entirely arbitrary and distinctive and once it is so, the case is covered by Section 17(1) of the Act and the Plaintiff is entitled to a ruling that the Defendant’s mark which contains “PRINCE” as a part of the impugned mark is liable to be restrained on account of infringement and also passing off.

47. Mr. Khandekar has submitted that no case of estoppel is made out insofar as the Plaintiff’s statements in relation to Plaintiff’s trade mark applications. He has submitted that the Plaintiff’s statements can clearly be explained. The statements made in relation to other goods cannot affect the Plaintiff’s enforcement for PVC pipes. Moreover, the Defendant is dis-entitled from relying upon the plea of estoppel as it has come to the Court with unclean hands.

48. Mr. Khandekar has referred to the applications for registration which have been relied upon by the Defendant to contend that the Plaintiff has taken a contrary stand with respect to these applications as that taken in the present proceedings. The Defendant has accordingly, relied upon prosecution history estoppel.

He has submitted that the applications which have been relied upon by the Defendant are in relation to different goods and any statement made by the Plaintiff in respect of these goods cannot be used against them, in the present proceedings, particularly, as the subject goods in the present proceedings are PVC pipes which were not in consideration in those applications for registration.

49. Mr. Khandekar has submitted that it has been consistently the case of the Plaintiff that it is the use of the “crown device” and/or use of the word “PRINCE” in relation to similar goods which makes the Defendant’s use deceptively similar and causes confusion. Therefore, firstly there is no admission on the part of the Plaintiff as sought to be contended by the Defendant. In any event, without prejudice thereto assuming that there is any case which is required to be dealt with by the Plaintiff, the same has been sufficiently explained.

50. Mr. Khandekar has placed reliance upon the judgment of the Supreme Court in **Govindammal Vs. Vaidiyanathan**<sup>4</sup>, wherein the Supreme Court has held that an admission can always be

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<sup>4</sup> (2019) 17 SCC 433



explained, unless such an admission gives rise to the principle of estoppel. The basic requirement for attracting the principle of estoppel, is that the person to whom the representation has been made must have acted on the basis of such representation, and particularly to his own detriment. Further, in **Nagubai Ammal and Others Vs. B. Shama Rao and Others**<sup>5</sup>, the Full Bench of the Supreme Court has held that an admission is not conclusive as to the truth of the matters stated therein. It is only a piece of evidence, the weight to be attached to which must depend on the circumstances under which it is made. It can be shown to be erroneous or untrue, so long as the person to whom it was made has not acted upon it to his detriment, when it might become conclusive by way of estoppel.

51. Mr. Khandekar has submitted that the Defendant's contentions on "prosecution history estoppel" can also be faulted on another ground. The statement of the Plaintiff referenced were made in relation to other goods i.e. not PVC pipes. They bear no relevance to the Plaintiff's registration in relation to PVC pipes. He has submitted that the registration is always goods specific and which has been expressly recognized by the Supreme Court in the case of

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<sup>5</sup> (1956) SCC OnLine SC 14

**Nandhini Deluxe Vs. Karnataka Coop. Milk Producers Federation Ltd.**<sup>6</sup>.

52. Mr. Khandekar has submitted that it is an admitted case that the Defendant has sought to pirate marks of the Plaintiff. There is no question of any equity arising in favor of the Defendant. In fact, the Defendant has suppressed material facts including that the Defendant had applied for identical “crown devices” as that of the Plaintiff. Therefore, it is not open for the Defendant to raise a plea of estoppel. He has in this context placed reliance on the decisions of the Supreme Court in **Madhuri Patil Vs. Commr., Tribal Development**<sup>7</sup> and judgment of Madhya Pradesh High Court in **Israk Ahmad Mansuri (Bahana) Vs. State of M.P.**<sup>8</sup>. He has submitted that as such no estoppel can be invoked against the Plaintiff considering the Defendant’s demonstrated suppression of its previous attempts to register infringing marks as well as its continued attempt to come as close to the Plaintiff’s Marks as possible.

53. Mr. Khandekar has submitted that the impugned

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<sup>6</sup> (2018) 9 SCC 183, paragraph 32

<sup>7</sup> (1994) 6 SCC 24 paragraph 16

<sup>8</sup> 1981 SCC OnLine MP 71 paragraph 5

marks are similar to the Plaintiff's marks thereby infringing the Plaintiff's trade marks and passing off its goods. The Defendant has not only copied the essential features of the Plaintiff's marks, but the "idea" conveyed by the rival marks is also identical. He has referred to the comparison of rival marks, which makes it clear that the use by the Defendant of the Impugned Marks is likely to cause confusion within the meaning of Section 29 of the Act so as to make out a case for infringement of trade mark.

54. Mr. Khandekar has submitted that the comparison between the Plaintiff's marks and the Defendant's impugned marks makes it clear that the Defendant has in fact made every attempt possible to copy the essential features of the Plaintiff's marks. Firstly, the Defendant copied a nearly identical "crown device". Secondly, the Defendant started utilizing the Plaintiff's "PRINCE" as a part of various marks such as "HI-POWER PRINCE", "TOPONE PRINCE" and "PERFECT PRINCE", etc. making it abundantly clear that the entire idea was to sail as close as possible to the Plaintiff and its marks.

55. Mr. Khandekar has submitted that a cursory evaluation of the rival marks also makes it abundantly clear that the

idea is also same. The idea is that of a “PRINCE” and/or “crown” in relation to arbitrary goods, i.e. PVC pipes. He has submitted that it is the Plaintiff’s case that such marks as obviously considered to be identical and/or deceptively similar, so as to cause confusion and/or deception within the meaning of the Trade Marks Act, and for which, he has placed reliance on the following judgments:-

- (i) **Indchemie Health Specialities Pvt. Ltd. Vs. Naxpar Labs Pvt. Ltd.**, (2002) 2 Mah LJ 513 (Bombay High Court; Division Bench) at paragraph 8;
- (ii) **Ruston & Hornsby Ltd. Vs. Zamindara Engineering Co.**, (1969) 2 SCC 727 (Division Bench; Supreme Court) at paragraphs 7 and 8;
- (iii) **Rahul Uttam Suryavanshi Vs. Sunil Manikchand Kasliwal**, judgment dt. 30<sup>th</sup> September 2016 in AO 761/2016 (Bombay High Court; Single Judge) at paragraphs 24, 27 to 29.
- (iv) **Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.**, (2001) 5 SCC 73 at paragraph 33;
- (v) **Corn Products Refining Co. Vs. Shangrila Food Products Ltd.**, AIR 1960 SC 142 at paragraph 18;
- (vi) **James Chadwick & Bros., Ltd. Vs. National Sewing Thread Co., Ltd.**, AIR 1951 Bom 147 at page 356

and 357;

- (vii) *National Sewing Thread Co. Ltd. Vs. James Chadwick & Bros. Ltd.*, AIR 1953 SC 357 at paragraphs 28 and 29;
- (viii) *Parle Products (P) Ltd. Vs. J.P. and Co.*, (1972) 1 SCC 618 at paragraphs 8 and 9
- (ix) *Hiralal Parbhudas Vs. Ganesh Trading Company*, AIR 1984 Bom 218 at paragraphs 5 to 10.

56. Mr. Khandekar has submitted that on both, similarity of marks, as also the “idea” conveyed by the mark, the Plaintiff is liable to succeed.

57. Mr. Khandekar has submitted that the products in question are PVC pipes. These are generally to be purchased by plumbers and carpenters, construction workers and such other labourers. The class of consumers need not be literate or educated. Structurally, phonetically and visually the rival marks are clearly identical and/or deceptively similar. The phonetic similarity is so strong that any variation of “PRINCE” in relation to PVC pipes will be associated with the Plaintiff. The consumers are bound to presume that the impugned marks which add an irrelevant prefix to “PRINCE”

such as “HI-Power” or “TOPONE” or “PERFECT” are only different types of PVC pipes of the Plaintiff. Same is the case with trivial alterations of the “crown device”. The idea of the Defendant is to ensure confusion and deception. Such acts are liable to be judicially restrained. It is settled law that the “relevant class of consumers” is a factor to be considered with the meaning of “surrounding circumstances” which has been laid down in *Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.* (supra). He has also placed reliance upon the judgment of this Court in *7 Stars Distilleries Vs. The Brihan Maharashtra Sugar Syndicate*<sup>9</sup>.

58. Mr. Khandekar has submitted that the Defendant has admitted to rely upon the NOCs granted by the TM Registry while obtaining its copyright registration to contend that the impugned marks are not similar to that of the Plaintiff’s. He has submitted that the Defendant’s copyright Applications (of which the NOCs formed a part) itself being under challenge no reliance can be placed on it. He has submitted that it is settled law that the TM Registry’s opinion on the similarity of marks is irrelevant and it is only for the Court to decide this question. He has relied on the

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<sup>9</sup> Judgment dt. 13<sup>th</sup> August 2007 in Appeal from Order No. 38/2007 at paragraph 12

judgment in this context in *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.* (supra) at paragraphs 17 and 18.

59. Mr. Khandekar has submitted that it is not this Court's domain to examine and/or rule upon and/or advice the Defendant with respect to the Defendant's hypothetical case for modifying the use of the impugned marks. This particularly so, when the conduct of the Defendant is *ex facie* fraudulent and dishonest. He has submitted that this is in relation to the Defendant's statement made across the bar that he will be willing to modify its use of the impugned marks and that this Court may permit the Defendant to use the impugned marks in the modified manner approved by the Court. No particulars in this regard were furnished and only oral arguments were canvassed as a last-ditch effort. However, the Defendant made it clear that it wished to continue the use of the word "PRINCE". He has submitted that this request is untenable. He has placed reliance upon the decision of the Division Bench of this Court in *R.R. Oomerbhoy Pvt. Ltd. Vs. Court Receiver*<sup>10</sup> in this context.

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<sup>10</sup> (2003) 27 PTC 580 (DB) paragraph 26

60. Mr. Khandekar has submitted that the Judgments relied upon by the Defendant where this Court has allowed the Defendant to modify its use of the mark and that this modified mark was no longer infringing only acknowledge that such a modification did take place, and they are inapplicable to the present case. He has submitted in any event, contrary to the judgments relied upon by the Defendant, the Defendant request in the present case is not supported by a sworn Affidavit.

61. Mr. Khandekar has submitted that in view of dishonesty of adoption, similarity of marks and identity of goods and service, a clear case of passing off is also made out. He has submitted that the Plaintiff has clearly made out a case that the marks of the Plaintiff and the essential feature thereof i.e. “PRINCE” as also the “crown device” mark have garnered substantial goodwill and reputation. The rival marks used by the Defendant are *ex facie* identical and/or deceptively similar and are liable to cause confusion and deception. He has submitted that therefore, a case for passing off is made out. He has place reliance on the judgment of the Supreme Court in ***Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.***



(supra), wherein the factors for deciding deceptively similarity in passing off have been laid down at paragraph 35 of the said decision.

62. Mr. Khandekar has submitted that in the present case passing off is clearly made out as the conduct of the Defendant makes it clear that there is a calculated attempt on the part of the Defendant to pirate the entire range of the Plaintiff's marks. He has placed reliance upon *Pidilite Industries Ltd. Vs Platinum Waltech Ltd.*<sup>11</sup> in this context.

63. Mr. Khandekar has submitted that the Defendant has admittedly adopted the impugned marks dishonestly and hence, it is trite that an injunction must follow. In this context, he has placed reliance on the judgment of the Supreme Court in *Midas Hygiene Industries (P) Ltd. Vs. Sudhir Bhatia*<sup>12</sup>.

64. Mr. Khandekar has submitted that there is no requirement in law that the relief for copying infringement cannot be claimed by a corporation for want of naming a specific person as the

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<sup>11</sup> Order dt. 24<sup>th</sup> August 2021 in IA (L) No. 10582 of 2021 paragraphs 19 and 20.

<sup>12</sup> (2004) 3 SCC 90 at paragraph 5

author of the work in question. He has referred to paragraph 8 of the Plaintiff, wherein the Plaintiff has stated that the artistic works therein, i.e., the crown device, which forms the essential feature of the said marks, were created in-house together by a team of the Plaintiff company and its founder. Reference has been made to Section 2(c) of the Copyright Act, 1957 as well as Sections 14 and 17 of the Copyright Act, 1957 to contend that the original creation of the said logos/device marks, are protected as artistic works and exclusive rights to which emanate therefrom and the Plaintiff is the first owner of the Copyright subsisting in the said artistic works.

65. Mr. Khandekar has submitted that it is not a case of the Defendant that the Defendant is the owner of copyright or that a third party is the owner of the copyright, in the work which the Plaintiff claims ownership. That being the case it is not open to the Defendant to merely attempt to poke holes in what otherwise is an inconsequential contention. He has placed reliance upon the judgment of this Court in *Sanjay Soya (P) Ltd. v. Narayani Trading Co.*<sup>13</sup>, which supports this submission of the Plaintiff.

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<sup>13</sup> 2021 SCC OnLine Bom 407 at paragraphs 8, 10, 13, 20 and 23

66. Mr. Khandekar has submitted that the above proposition of the Plaintiff has also been considered in other judgments of this Court, namely **Pidilite Industries Ltd. Vs. Pom a-Ex Products** (supra) at paragraphs 109 to 113 and **Zee Entertainment Enterprises Ltd. Vs. Gajendra Singh**<sup>14</sup> and **Zee Telefilms Ltd. Vs. Sundial Communications Pvt. Ltd.**<sup>15</sup>.

67. Mr. Khandekar has submitted that there has been a consistent view taken by this Court that the pleading as is made in the present case is absolutely sufficient to sustain an action for infringement of copyright. Surely, a third party, who is otherwise entirely dishonest in its conduct is not allowed to merely contend that a specific person should in fact be named as the author of the work to maintain an infringement of a copyright.

68. Mr. Khandekar has submitted that it is the Defendant's own pleaded case that its marks are "fluid" in nature and "keep on changing". This admission is fatal qua the Defendant's case on balance of convenience and firmly establishes that no substantial

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<sup>14</sup> 2007 SCC OnLine Bom 920 at paragraph 161 to 164

<sup>15</sup> 2003 SCC OnLine Bom 344 at paragraph 21

harm would befall the Defendant, if the reliefs as prayed for in the Interim Application are allowed.

69. Mr. Khandekar has submitted that if reliefs as prayed for are denied and the Defendant is permitted to continue its use of the Impugned Marks, irreparable harm, loss and injury would be inflicted on the Plaintiff. A clear case is made out for infringement of registered trade mark, infringement of copyright and passing off.

70. Mr. Kirpekar, learned Counsel appearing for the Defendant has submitted that it is an admitted position that the Plaintiff does not have any word mark registration for the word “PRINCE” in any class or in respect of any goods including PVC pipes. It is further an admitted position that the Plaintiff has not even applied for registration of the word “PRINCE” in respect of PVC pipes or any other goods. In such scenario it is necessary to ascertain the applicability of Section 17 of the Trade Marks Act, 1999, which has been interpreted by the Division Bench of this Court in *Alaknanda Cement Private Limited Vs. Ultratech Cement Limited* (supra).

71. Mr. Kirpekar has referred to Section 13 of the

Trade Marks Act, 1940, which contains provisions for disclaimer as well as Section 17 of Trade Marks Act, 1957, which also contains provision for disclaimer. He has submitted that when the Trade Marks Act, 1999 was enacted the provision enabling the Registrar to put a disclaimer condition was removed from Section 17. The effect of the same is that neither the Registrar can put disclaimer condition nor the registered proprietor has a right to claim rights in respect of disclaimed part in passing off under the Trade Marks Act, 1999.

72. Mr. Kirpekar has referred to Section 17 of the Trade Marks Act, 1999. He has submitted that the title of Section 17 is “Effect of registration of parts of the registered mark”. The title of earlier aforementioned provisions of 1940 and 1957 Act was “Registration subject to Disclaimer”. He has submitted that the power to grant registration with disclaimer has been taken away by virtue of completely revamping the Section and removal of Section 17 (b) of Trade and Merchandise Marks Act, 1958. Now in order to claim the exclusive right on the part of registered device or composite mark the registered proprietor is required to make compliance of Section 17(2) (a)(i) or Section 17(2)(a)(ii).

73. Mr. Kirpekar has submitted that in the present case, the Plaintiff has failed to show any compliance of Section 17(a)(i) or Section 17(a)(ii) and hence, it is not open for the Plaintiff to contend that the marks are similar just because rival marks are comprising the disclaimed and non-distinctive word “PRINCE”.

74. Mr. Kirpekar has submitted that just because the words non-distinctive does not make that word *ipso facto* distinctive. It is always necessary to protect the world at large from wealthy traders from claiming exclusive rights over the commonly used words in the course of trade or otherwise words commonly used in day-to-day language.

75. Mr. Kirpekar has submitted that the compilation of documents showing search results for classes 1 to 45, clearly demonstrates that not only in class 11, 17 and 19, but also in all classes the word “PRINCE” and “PRINCESS” are commonly used and different device marks comprising word “PRINCE” and “PRINCESS” are co-existing with each other which means that the word “PRINCE” and “PRINCESS” are common non-distinctive words.

76. Mr. Kirpekar has submitted that the decision of the Division Bench of this Court in **Alaknanda Cement Private Limited Vs. Ultratech Cement Limited** (supra) and its observations on Section 17 are binding on this Court. Hence, there is no need to separately deal with other judgments of single Judges of this Court. He has placed specific reliance on paragraphs 2, 3, 4, 5, 8, 14, 15, 18 and 20 of the said decision.

77. Mr. Kirpekar has submitted that the Division Bench while considering rival marks as a whole came to the independent conclusion that the rival marks are visually similar and rival words ULTRATECH CEMENT and ULTRATUFF CEMENT, when compared as a whole under Section 17(1) are similar as both words start with the word ULTRA and end with the word CEMENT.

78. The Division Bench while comparing the rival marks did not ignore descriptive word CEMENT from comparison. Thus the test applied is not of essential feature but of entirety of marks including descriptive words. This can be seen from paragraph 15 of the said decision.

79. Mr. Kirpekar has submitted that the test under Section 17(1) of the Act, according to the Division Bench in **Alaknanda Cement Private Limited Vs. Ultratech Cement Limited** (supra) is equivalent to test of passing off. The Division Bench while comparing the marks did not compare the marks “ULTRATECH” versus “ULTRATUFF” but the entire mark “ULTRATECH CEMENT” versus “ULTRATUFF CEMENT” including the visual similarity such as colour combinations and get-ups were considered in compliance of Statement of Objects and Reasons to Section 17. He has submitted that to consider one word or part of one trade mark vivisecting it from the registered label mark is contrary to Statement of Objects and Reasons. The only exception has been carved out in Section 17(2)(a)(i) and 17(2)(a)(ii).

80. Mr. Kirpekar has submitted that the test followed by the learned Single Judge of this Court in **Alaknanda Cement Private Limited Vs. Ultratech Cement Limited** (supra) was not followed by the Division Bench as the learned Single Judge had compared single words ULTRATECH vs ULTRATUFF, whereas the Division Bench has compared the mark as a whole in compliance of objects and reasons of Section 17. He has submitted under the



provisions of Trade Marks Act, 1999 it is impermissible to separate a word from the device mark and compare it with a word from another device mark, if the conditions under Section 17 (2) (a) (i) and (ii) are not complied. He has placed reliance upon the decision of the Supreme Court in **M/s. Nandhini Deluxe Vs M/s Karnataka Cooperative Milk Producers Federation Ltd.**<sup>16</sup>, which has been referred and quoted with approval in the judgment of **FDC Limited Vs Faraway Foods Pvt. Ltd.**<sup>17</sup> by the Delhi High Court. He has submitted that this is the test to be applied when marks are to be compared as whole under Section 17 (1) of the Act. In the present case on perusing of rival marks, it is crystal clear that the marks are structurally and visually different. The colour combinations, get-up, representation of the crown and placement of respective words are entirely different. Hence, there is no visual or structural similarity. In any case, it is admitted by the Plaintiff that the rival devices of crown are different.

81. Mr. Kirpekar has submitted that as regards the device of crown which is forming part of the multiple registrations,

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<sup>16</sup> (2018) 9 SCC 183

<sup>17</sup> (MANU/DE/0230/2021)

the Defendant is protected by virtue of provisions of Section 28(3) and Section 30(2)(e) of the Trade marks Act, 1999, as the Defendant's Trade mark is also registered.

82. Mr. Kirpekar has submitted that non-compliance of Section 17 (a) (i) and Section 17 (a)(ii) of Trade Marks Act, 1999, by either filing application for word "PRINCE" or obtaining registration for the said word, takes away from the scope of present judicial *prima facie* inquiry the word "PRINCE". The rival marks are required to be compared as a WHOLE as registered by keeping in mind that the Plaintiff and the Defendant both have fluid marks and their marks have changed many times in past. He has submitted that microscopic examination is not permissible and the Plaintiff's attempt to compare the marks microscopically itself demonstrates that the rival marks are not similar.

83. Mr. Kirpekar has submitted that for Section 17 (1) and passing off the Plaintiff has failed to demonstrate that the Plaintiff has acquired distinctiveness to aliunde claim the word "PRINCE" as the essential or memorable feature. The Plaintiff has not separately applied for word mark "PRINCE" and hence, a very limited

enquiry is possible contrary to the provisions of Section 17 (2) (a) and (b) and the purpose of Trade Marks Act as stated in the objects and reasons. The Plaintiff has to demonstrate a very strong case for *aliunde* claiming distinctiveness in complete contradiction to the mandate of the statute under Section 17 (2). None of the Plaintiff's documents demonstrate the use of the standalone word "PRINCE" as a mark. In view of the above, it is not possible at the *ad-interim* or *interim* stage in the absence of any evidence to presume under the law of evidence on the basis of documents that the said word "PRINCE" per se as a standalone mark and not the device comprising the word "PRINCE" has acquired any distinctiveness much less to claim it *aliunde* to take the benefit of interpretation of provisions of Section 17 (1) of the Trade Marks Act.

84. Mr. Kirpekar has submitted that the Plaintiff has failed to disclose that it is a common practice in the trade mark registry to put a disclaimer/condition on the word "PRINCE" and "PRINCESS". He has referred to the Applications by third parties in which the trade mark registry had put disclaimer condition on the word "PRINCE" and "PRINCESS" across all classes irrespective of the goods/services. This fact demonstrates that as per the trade mark

registry the words “PRINCE” or “PRINCESS” per se are of non-distinctive character and hence, can’t be appropriated or exclusively claimed by the Plaintiff or any third-party including the Defendant.

85. Mr. Kirpekar has placed reliance upon Section 9(1) (a) which specifically deals with non-distinctive character words while Section 9(1)(b) and 9(1)(c) deals with descriptive and common to trade words respectively.

86. Mr. Kirpekar has submitted that during the search on the official website of the trade marks registry, the Defendant recently discovered that the Plaintiff has not disclosed most important and material fact that shows that the word “PRINCE” is a laudatory and non-distinctive word incapable of registration under Section 9(1) (a) of the Trade Marks Act, 1999 and this fact has been admitted by the Plaintiff through its conduct in last 26 years. He has in this context referred to Application No. 718754 in class 17 for PVC pipes. He has submitted that when this objection was raised by the Defendant, the Plaintiff filed Affidavit and stated that withdrawal of the said application is of no consequence, as subsequently, the Plaintiff obtained registration of the device marks.

87. Mr. Kirpekar has submitted that it is a settled position of law that if a party accepts a particular state of fact by admission or voluntary act, then it cannot approbate and reprobate simultaneously.

88. Mr. Kirpekar has submitted that the effect of non-compliance of Order XI Rule 1 as amended by Commercial Courts Act, disentitles the Plaintiff from claiming right on the word “PRINCE” per se even in respect of PVC pipes.

89. Mr. Kirpekar has submitted that the statement of the Plaintiff with respect to Application No. 2268630 in Class 19 and Application Nos. 813263 and 1118544 in Class 19, where the Plaintiff has stated that the opponents to these Applications do not enjoy any right to the exclusive use of the word ‘PRINCE’, though made in respect of plywood and not PVC pipes would be binding on the Plaintiff. The said statement of the Plaintiff purely on the basis of it’s own understanding and admission that word “PRINCE” cannot be monopolized in respect of any goods as it is inherently non-distinctive word. He has submitted that since the Plaintiff could not obtain any registration for the word mark “PRINCE” and there being

a disclaimer on the Plaintiff's word, "PRINCE", the Plaintiff has made the said statement before the Trade Marks Registry and raised the ground that word "PRINCE" cannot be monopolized.

90. Mr. Kirpekar has submitted that the word "PRINCE" is neither descriptive of PVC pipes nor descriptive of plywood. He has submitted that the word "PRINCE" is common to trade and also a word of non-distinctive character irrespective of goods or services for which it is used. Even according to the trade mark registry, the word "PRINCE" is of non-distinctive character and common to trade irrespective of the goods which can be seen from the fact that there are many users and registered proprietors of the device marks comprising of the word PRINCE or PRINCESS across class 1 to 45.

91. Mr. Kirpekar has submitted that there has been concealment of admissions in Trade Mark Application Nos. 2731072 and 85070 in Class 11 that marks are to be compared except the word PRINCE. The aforesaid concealment of material facts and admissions disentitles the Plaintiff from claiming right over the word PRINCE per se. As per the Plaintiff, the word PRINCE is commonly

used as a part of Device marks and Plaintiff has never ever disputed use of other cited marks in reply before Trade Mark registry.

92. Mr. Kirpekar has submitted that the effect of disclaimer condition on the mark examined under the Trade Marks Act, 1940 or Trade and Merchandise Act, 1958 is a relevant consideration. He has submitted that in respect of disclaimer on the word “PRINCE” in respect of Trade mark registration No. 1013152 in Class 17 would show that the Plaintiff never intended to claim any exclusive right to use the non-distinctive word “PRINCE” subsequent to obtaining registration. The entire pleadings of wrongful disclaimer condition in paragraphs 9 and 10 of the Complaint are nothing but afterthought. He has placed reliance upon the decision of the Supreme Court in **The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Limited**<sup>18</sup> in support of his submission that disclaimed parts or matters are not within the protection of the statute. He has also placed reliance upon the decision of this Court in **Kuber Khaini Private Limited Vs. Sopariwala Exports and Anr.**<sup>19</sup>, wherein this Court at paragraph 8 has examined the disclaimer to the effect that the

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<sup>18</sup> AIR 1955 SC 558 at paragraphs 9

<sup>19</sup> Appeal 725/12 in Notice of Motion (L) 1441/12 in Suit 2384/12 paragraph 8

registration of the mark shall not give a right to the exclusive use of the words and the descriptive matter appearing on the label. It has been held that in an action for infringement of a registered trademark, a Plaintiff cannot found a cause of action on the use of descriptive words in respect of which a disclaimer has been granted. He has submitted that based upon these submissions, the Plaintiff is not entitled to claim any right over the non-distinctive word "Prince" under the Trade Marks Act, 1999 by virtue of registration No. 1013152.

93. Mr. Kirpekar has referred to the registration of the Defendant's mark in relation to device of crown along with the word "SHARDA INDIA" and has submitted that by virtue of which, the Defendant enjoys protection under Section 28(3) read with Section 30(2)(e) of the Trade Marks Act, 1999. These provisions provide that if the said mark is used by the registered proprietor it does not amount to dishonesty as it permits the two registered proprietors of the identical or similar mark to co-exist.

94. Mr. Kirpekar has submitted that only common feature in one of the mark of the Defendant is the use of the word



“PRINCE” as a part of entire trade mark “HI-POWER PRINCE”. He has submitted that the Defendant never applied for the word “PRINCE”. The Defendant’s device mark is entirely distinct if compared using the test propounded by the Plaintiff, which is that the rival device marks are required to be compared as a whole without considering the word “PRINCE”. He has submitted that entire conduct of the Plaintiff in the last 26 years is against its afterthought claim on word PRINCE. He has placed reliance upon the decision of the Supreme Court **Kaviraj Pandit Durga Dutta Sharma Vs. Navratna Phamaceutical Laboratories**<sup>20</sup>. In the said decision, the Supreme Court has held that when marks are compared as a whole, if *prima facie* demonstrate distinction, then it is possible to hold that marks are dissimilar. In **Ruston & Hornsby Ltd. Vs. The Zamindara Engineering Co.**<sup>21</sup>, the Supreme Court held that when the registered mark and impugned marks are not identical the test has been applied in infringement suit and passing off Suit is same. He has submitted that in view of such peculiar circumstances, the balance of convenience is in favour of Defendant. The Defendant will suffer irreparable loss, if the Defendant is precluded from using its

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<sup>20</sup> MANU/SC/0197/1964

<sup>21</sup> MANU/SC/0304/1969

registered trade mark which have been granted after due scrutiny and ignoring the disclaimed word “PRINCE” as it is of non- distinctive character.

95. Mr. Kirpekar has submitted that during the oral arguments a without prejudice proposal was made by the Defendant for amicable settlement of the Suit. He has submitted that this course of action has been accepted by the Calcutta High Court and the decision of Single Judge has been upheld till the Supreme Court viz. in **Parakh Vanijya Private Limited Vs. Baroma Agro Product and Ors.**<sup>22</sup> High Court of Calcutta, upheld in **Parakh Vanijya Private Limited Vs. Baroma Agro Product and Ors.**<sup>23</sup> by the Supreme Court of India. He has submitted that without prejudice to the rights and contentions of the Defendant, the Defendant will not use the device of the crown and trade mark “HI-POWER PRINCE” or “TOPONE PRINCE” in conjunction with each other.

96. Mr. Kirpekar has submitted that with respect to copyright infringement alleged, the Defendant’s artistic works are

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<sup>22</sup> MANU/WB/0284/2017

<sup>23</sup> MANU/SC/0722/2018

registered under the Copyright Act after obtaining NOC under Section 45 of the Copyright Act from the Trade Marks Registry. He has submitted that in comparison with the registration obtained by the Defendant in respect of its artistic work, the Plaintiff has failed to obtain any registration for its purported artistic works under the Copyright Act.

97. Mr. Kirpekar has submitted that there is non-disclosure of the name of the artist and lack of pleadings pertaining to employee-employer relationship or ownership of copyright in the Plaintiff. He has referred to Section 2(d)(iii) of the Copyright Act, which defines 'author' to mean in relation to an artistic work other than a photograph, the artist. He has also referred to Section 17 of the Copyright Act, which provides that the author of the work shall be the first owner of the Copyright. He has referred to the manual of the copyright office wherein in Column 7, the details of the author is required to be provided. Further, under Section 16 of the Copyright Act, there is no copyright except as provided under the Copyright Act, 1957. It is the requirement under the statute to show that the Plaintiff is either the artist or owner by virtue of Section 17 (c) or by virtue of Deed of Assignment as per Section 19 of the Act which is a

must and sine-qua-non.

98. Mr. Kirpekar has submitted that the Plaintiff neither discloses the name of the artists/authors of the purported artistic works of Plaintiff nor discloses any employee-employer relationship with the artists/authors by providing details. There is a mere bald statement that the artistic works have been created in house without giving any further details. The Defendant has denied that the “**TEAM**” per-se cannot claim any copyright. Under the Copyright Act, there can be only two categories “authors” or “co-authors”. The name of each author, his nationality, domicile and place of publication are all necessary and must for establishing the authorship and/or ownership of the copyright as per Section 13 (2) read with Section 14 of the Copyright Act, 1957. He has submitted that the Defendant has specifically denied the claim of authorship and ownership, but despite the denial the Plaintiff has not produced any material document to show the authorship and ownership in the subsequent pleadings.

99. Mr. Kirpekar has submitted that it has been admitted by the Plaintiff in the Affidavit in Rejoinder that the crown

device as used by the Defendant in the trade is different. This can be seen from paragraph 12 of the Rejoinder Affidavit which is in response to paragraph 22 of the Reply Affidavit. He has submitted that the use of crown device is common across all trades and no one can claim monopoly in the device of crown per se. The crown device is used for the mark of “ROLEX”, “Hallmark”, “HENRI LLOYD” and “LOUIS PHILIPPE”.

100. Mr. Kirpekar has submitted that the reliance by the Plaintiff upon **Sanjay Soya Private Limited Vs. Narayani Trading Company** (supra) in support of its contention that the Plaintiff is not required to disclose the name of the artist though the Plaintiff is a company is misplaced. The Defendant therein had never contended that the name of artist is not disclosed by the Plaintiff in the Plaint. The contention, which arises in the present case viz. that disclosure of the name of artist is a *sine-qua-non* for claiming authorship or ownership did not arise in that case. Accordingly, the said decision can be distinguished by virtue of this specific contention which has been raised by the Defendant in the present case.

101. Mr. Kirpekar has submitted that the Delhi High

Court in **Navigators Logistics Limited Vs. Kashif Qureshi and Ors.**<sup>24</sup>

has held that the Plaintiff is required to disclose the identity of the author who was employed with the plaintiff, as the plaintiff being a company cannot be the author. This decision has been quoted in the subsequent judgments of the Delhi High Court and Madras High Court with approval.

102. Mr. Kirpekar has referred to the Order XI Rule 1 of the Code of Civil Procedure, 1908 as amended by the Commercial Courts Act and which makes it mandatory to the Plaintiff to file on record all the documents pertaining to the claim of ownership at the time of filing of the Suit. He has submitted that in view of lack of pleadings in respect of the natural person who has created the natural artistic works and the Plaintiff having failed to establish through the documents that a person who is the artist of those artistic work has been or is the employee of the Plaintiff Company, the case for infringement of copyright failed.

103. Mr. Kirpekar has submitted that the Plaintiff has failed to make out any *prima facie* case for infringement of copyright

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<sup>24</sup> MANU/DE/3355/2018

on the aforementioned submissions. The Defendant is *prima facie* owner of the copyright in the artistic works having been obtained in the copyright registration. The Defendant is statutorily protected in respect of the crown device under the Trade Marks Act, 1999. Further, the Defendant being registered owner of the copyrighted artistic works along with the names of artists and date of first publication is entitled to use the registered copyrights and registered trade marks.

104. Mr. Kirpekar has submitted that the Defendant had followed the due process of law by first applying for No Objection Certificate from the Trade mark registry. Upon obtaining the said NOC, the Defendant is entitled to use the devices as registered under the statute. The Defendant being *bona fide* adopter and registered proprietor and owner, the balance of convenience is in favour of the Defendant and it is the Defendant, who would suffer irreparable losses, if Defendant is deprived of his statutorily granted protections under the Trade Marks Act and Copyright Act without the Plaintiff having disclosed the necessary information for maintaining the legal action for infringement of copyright.

105. Mr. Kirpekar has submitted that the judgments relied upon by the Plaintiff are not applicable, particularly, as they do not address the issue on the effect of removal of the proviso under Section 17 by the 1999 Act on the ability of the Plaintiff to raise a claim on part of registered device mark. He has placed reliance upon the decision of the Supreme Court in **The Regional Manager and Ors. vs. Pawan Kumar Dubey**<sup>25</sup>, where the Supreme Court has held that it is the rule deducible from the application of law to the facts and circumstances of a case which constitutes its ratio *decidendi* and not some conclusion based upon facts which may appear to be similar. One additional or different fact can make a world of difference between conclusions in two cases even, when the same principles are applied in each case to similar facts. Further, the Supreme Court in **Shin-Etsu Chemical Co. Ltd. Vs. Aksh Optifibre Ltd.**<sup>26</sup> held that if the Court thinks that an issue does not arise, then any observation made with regard to such an issue would be purely *obiter dictum*. It is a well settled proposition that the ratio *decidendi* of a case is the principle of law that decided the dispute in the facts of the case and, therefore, a decision cannot be relied upon in support of a

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<sup>25</sup> MANU/SC/0464/1976

<sup>26</sup> MANU/SC/0488/2005



proposition that it did not decide.

106. Mr. Kripekar has accordingly, submitted that the Plaintiff has failed to make out a case of infringement of Trade Mark and/or copyright and/or passing off. He has accordingly, submitted that the present Application requires to be rejected.

107. Having considered the submissions, it would be necessary to consider the respective interpretation placed on Section 17 of the Trade Marks Act, 1999. The interpretation of Section 17 placed by the Defendant is that monopoly on part of the mark can be claimed only where an Application for registration has been made in respect of that part. Thus, emphasis has been placed on Section 17(2) of the Act, which provides that when a trade mark “(a) contains any part : (i) which is not the subject of a separate application by the proprietor for registration as a Trade mark or (ii) which is not separately registered by the proprietor as a trade mark, or (b) contains any matter which is common to the trade or otherwise of a non-distinctive character; the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.”

108. In my view, such interpretation cannot be accepted as Sub-Section (b) of Section 17(2) provides that the Trade mark contains any matter which is common to the trade or otherwise of a non-distinctive character would require to be read with Sub-Section (a) of Section 17(2) of the Act. Thus, where the part of the trade mark is of a distinctive character, and which part is the prominent and/or essential feature of the registered trade mark (considered as a whole), that part of the registered trade mark is required to be protected and the registration of the entire trade mark will confer exclusive right in the part of the whole of the trade mark so registered. Accordingly, the Defendant must establish that the part of the registered trade mark as in the present case “PRINCE” is “common to the trade” and/or is otherwise “of a nondistinctive character” in order to claim that it falls under Section 17(2) of the Act.

109. This Court had the occasion to consider the interpretation of Section 17 of the Act as placed by the Defendant in **Pidilite Industries Ltd. Vs. Jubilant Agri & Consumer Products Ltd.** (supra). It is relevant to reproduce paragraphs 16.2 and 16.3 of the said decision, which read 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.*

16.3 *Again, in my view, nothing in Section 17(2) of the Act bars the Plaintiff's entitlement to the relief as claimed. Section 17(2)(a) is plainly not applicable. The defendant does not even claim so. The Defendant's only claim that Section 17(2)(b) of the Act bars the grant of relief in the Plaintiff's favour. The Defendant's claim in this behalf is premised on the assumption that the word 'MARINE' is 'common to the trade' and/or 'of a non-distinctive character'. For this plea to succeed, the Defendant must establish that the word 'MARINE' is either 'common to the trade' or 'of a non-distinctive character'. The onus to do so is entirely on the Defendant. As set out herein, the Defendant has failed to discharge the burden or onus upon them."*

110. Thus, I am in agreement with the view expressed by this Court in the aforementioned decision. This view has also been taken by the learned Single Judge of this Court in ***Ultra Tech Cement Ltd. Vs. Alaknanda Cement (P) Ltd.*** (supra).

111. Mr. Kirpekar on behalf of the Defendant has relied upon the decision of the Division Bench of this Court in ***Alaknanda***

***Cement Private Limited Vs. Ultratech Cement Limited*** (supra) to contend that an independent conclusion had been arrived at by the Division Bench from that arrived at by the Single Judge viz. that the rival marks are visually similar by considering the rival marks as a whole i.e. not ignoring the descriptive word CEMENT from comparison. I am of the view that such distinction drawn is not warranted. Further, the contention of the Defendant drawn from the said decision viz. that Section 17(1) provides for marks to be compared as a whole without vivisectioning a part thereof is not acceptable, considering the interpretation of Section 17 of the Trademarks Act, 1999 placed by this Court. The decisions relied upon by Mr. Kirpekar in support of the Defendant's contention, viz. **Nandhini Deluxe Vs. Karnataka Coop. Milk Producers Federation Ltd.** (supra) and **FDC Limited Vs Faraway Foods Pvt. Ltd.** (supra) are to be read in the context of the issues decided therein which is vastly different to the issue which arise herein and which had also fallen for consideration in **Pidilite Industries Ltd. Vs. Jubilant Agri & Consumer Products Ltd.** (supra), namely the interpretation of Section 17 of the Act.

112. I accordingly, find that the Defendant by using as

part of its mark the word “PRINCE” which is identical to the Plaintiff’s registered mark “PRINCE” *prima facie* has infringed the Plaintiff’s registered mark.

113. The contention of the Defendant that the Plaintiff’s registered mark bearing No. 1013152 contained a disclaimer in relation to “PRINCE” and which disclaimer is required to be read into the other registrations, is contrary to the settled law. It is settled law that the disclaimer of one registration cannot be read into other registrations of the Plaintiff where there is no such disclaimer and particularly, where as in the present case, this Court has come to a *prima facie* view that the word “PRINCE” is distinctive, as it is in relation to PVC pipes. This has also been held in **Prince Pipes & Fittings Ltd. Vs. Prince Platinum Pipes And Fittings** (supra), where the learned Single Judge of this Court in paragraph 3 came to the view as under :-

“3. *The Suit seeks reliefs in trade mark infringement and passing off. The Plaintiff uses the mark **PRINCE** in conjunction with a crown device as a registered trade mark in relation to its PVC pipe products. The adoption of the mark itself goes back to 1996. The*

*Plaintiff has obtained a series of registrations from 2014 onwards of the PRINCE mark and logo. There can be no doubt that in the registered marks, the word PRINCE is the central, memorable, striking and most notable feature. The amendment permitted today shows that there is a disclaimer in regard to the word PRINCE of only one of those registrations. There is no such disclaimer for the others. I do not even pretend to understand the purport of that disclaimer because ex facie the word PRINCE in relation to something as plebian as PVC Pipes is surely deserving a recognition of distinctiveness. Over time, the goods have been described by the Plaintiff as “Piping Systems”. The PRINCE mark is prominently displayed on every unit or segment of the supplied products. The necessary documents in relation to the registrations are annexed.” (Emphasis Supplied)*

114. From the above decision, it is apparent that the learned Single Judge of this Court had considered the disclaimer as not being applicable to the other registrations as well as being unable to understand the purport of the disclaimer as to the word “PRINCE” in relation to something as plebian as PVC Pipes which is surely deserving a recognition of distinctiveness. Further, the goods have

been described by the Plaintiff as “Piping Systems”. The PRINCE mark is prominently displayed on every unit or segment of the supplied products. Thus, the view taken by this Court is that there is no merit in the submission of the Defendant that the Plaintiff is bound by the disclaimer as to the word “PRINCE”.

115. Having arrived at the above finding, it is not relevant to consider whether Section 17 of Trade Marks Act, 1999 has taken away the power to grant registration with disclaimer and/or that the subsequent registrations of the Plaintiff do not contain such disclaimer as the registrations were granted after the Trademarks Act, 1999 came into force.

116. I find merit in the submission on behalf of the Plaintiff that the Defendant is estopped from contending that either “PRINCE” and/or the “crown device” qua PVC pipes are common to the trade, as the Defendant has itself applied for and even secured registration of its marks, the essential feature whereof is “PRINCE” and “crown device”. The judgments relied upon by the Plaintiff namely, **Pidilite Industries Ltd. Vs. Jubilant Agri & Consumer Products Ltd.** (supra); **Jagdish Gopal Kamath Vs. Lime & Chilli**



**Hospitality Services** (supra) and **Brihan Karan Sugar Syndicate (P) Ltd.** (supra) are apposite.

117. The reliance on behalf of the Defendant on the Plaintiff's statements in relation to Applications for registration of its marks is misplaced. The statements made by the Plaintiff in the Application for registration of its marks were in respect of different goods/services and not PVC pipes. Thus, prosecution history estoppel does not apply in the present case. The Plaintiff's statement which pertains to different goods/services have been relied entirely out of context. These statements cannot affect the Plaintiff's protection of its marks in relation to PVC pipes. It is clear from the provision of the Trademarks Act that the registration of a mark is "goods specific". The judgment of the Supreme Court relied upon by the Plaintiff, namely **Nandhini Deluxe Vs. Karnataka Coop. Milk Producers Federation Ltd.** (supra) is apposite.

118. The Defendant's contention on "prosecution history estoppel" is misconceived. It is settled law that there can be no estoppel against the statute. This is apart from the fact that the statements made by the Plaintiff in Trade Mark Applications referred

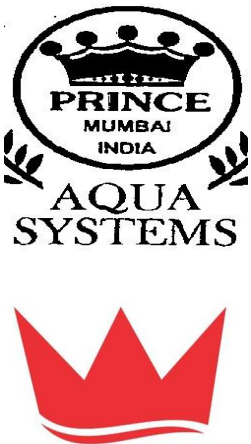






to by the Defendant were made in relation to other goods i.e. not PVC pipes. The Defendant is not entitled to raise the contention of estoppel as sought to be raised as in my *prima facie* view, the Defendant has not come to the Court with clean hands. The Defendant has sought to pirate the marks of the Plaintiff and hence, there is no question of any equity arising in favour of the Defendant. The Defendant has also applied for identical “crown devices” as that of the Plaintiff and which material fact has been suppressed. Thus, estoppel cannot be invoked against the Plaintiff in any circumstance of the case.

119.               Insofar as the Defendant’s contention with regard to the Plaintiff’s claim for infringement of copyright is concerned, namely that the Plaintiff has not identified a specific person who authored the Plaintiff’s mark and by virtue of which the Plaintiff cannot enforce its claim under copyright law is misconceived. This is particularly, since the Plaintiff in support, has clearly contended that the work in question was created by the Plaintiff’s team under the supervision of the Plaintiff. The Defendant does not claim to be the owner of the copyright or that a third party is the owner of the copyright, in the work which the Plaintiff claims ownership. The

decision relied upon by the Defendant in **Sanjay Soya Private Limited Vs. Narayani Trading Company** (supra) has considered a similar case where the label has been designed by the employee during the course of employment and it was held that there is no requirement that the person who actually sketched or drew the artwork must be identified. Similar view has been expressed in **Pidilite Industries Ltd. Vs. Pom a-Ex Products** (supra), **Zee Entertainment Enterprises Ltd. Vs. Gajendra Singh** (supra) and **Zee Telefilms Ltd. Vs. Sundial Communications Pvt. Ltd.** (supra). The Delhi High Court judgment relied upon by the Defendant in **Navigators Logistics Limited Vs. Kashif Qureshi and Ors.** (supra) which is contrary to the binding ratio of the aforementioned judgments of this Court, cannot be taken into consideration. The contention on behalf of the Defendant that the Defendant's artistic work is registered, whereas the Plaintiff's artistic work is not registered under the Copyright Act, would make no difference as the Plaintiff has established that it is the owner of the Copyright. The registration of artistic work of the Defendant under the Copyright Act would only mean that there is *prima facie* validity in the entries made in the Copyright Register. However, it is not the case of the Defendant that they are the owners of the artistic work registered under the Copyright Act.

120. The Defendant's reliance on the NoC's granted by the Trademarks Registry whilst obtaining Copyright registration to contend that the impugned marks are not similar to that of the Plaintiff, is required to be viewed from the settled law that the Trademark Registry's opinion on the similarity of marks is irrelevant and it is only for the Court to decide this question. This has been held in *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.* (supra). Further, the Defendant's Copyright Applications (of the NoC form a part) itself is under challenged and hence, no reliance can be placed upon it.

121. A comparison of the rival marks makes it clear that the Defendant has copied the essential features of the Plaintiff's marks. The Comparison of rival marks is reproduced as under :-

Plaintiff's Marks	Defendant's Impugned Marks
	
 	
	
	

Comparison of marks as in use

 <p>[Ex. M, Pg. 382, Plaintiff]</p>	
 <p>[Ex. M, Pg. 382, Plaintiff]</p>	

122. From the comparison of the rival marks, I am of the *prima facie* view that the use by the Defendant of the impugned marks is likely to cause confusion within the meaning of Section 29 of the Trademarks Act. The Defendant has made every attempt possible to copy the essential features of the Plaintiff's marks. Firstly, the Defendant has copied a nearly identical "crown device" and secondly, the Defendant has started utilizing the Plaintiff's "PRINCE", as parts of its marks "HI-POWER PRINCE", "TOPONE PRINCE" and "PERFECT PRINCE", etc. making it abundantly clear that the entire

idea was to sail as close as possible to the Plaintiff's marks.

123. The Judgments relied upon by the Plaintiff on passing off in particular, ***Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*** (supra), is apposite.

124. I am of the considered *prima facie* view that on both the similarity of marks, as also the “idea” conveyed by the marks, the Plaintiff is entitled to succeed.


125. Given that the Plaintiff has made out a strong *prima facie* case for grant of injunction as sought for, the voluntary statement made on behalf of the Defendant during oral arguments viz. to modify the use of the impugned marks by not using the trade mark “HI-POWER PRINCE” or “TOPONE PRINCE” with the device “crown” in conjunction with each other is not required to be accepted. Particularly, since the Defendant continues to insist on using the word “PRINCE” which has been found to be deceptively similar to the Plaintiff's mark.

126. The balance of convenience is also in favour of the

plaintiff, since it is the Defendant's own pleaded case that its marks are "fluid" in nature and "keep on changing". Further, irreparable harm, loss and injury would be inflicted on the Plaintiff, if the reliefs sought are not granted in favour of the Plaintiff.

127. Accordingly, interim relief is granted in terms of prayer clauses (a) to (f), which read as under :-

- a) An order for permanent injunction of this Hon'ble Court restraining the Defendant by itself, its proprietors, partners, directors, servants, agents, stockists, dealers, distributors and all persons acting on its behalf from infringing the Plaintiff's registered 'PRINCE' trade marks bearing nos. ,


1013152 (  in class 17), 2731071 (






in class 17) and 2731072 (





in class 11) by the use of the

copyright registration no. A-133962 , and




impugned mark no. 3 (  app. no. 4343664 in class 17), impugned mark no. 5 (  app. no. 4827338 in class 17), and impugned mark no. 6 (  app. no. 5120837 in class 17) at Exhibits AM, Y, AA and AB, or any other mark identical and/or deceptively similar to the aforementioned registered marks of the Plaintiff or from any other act amounting infringement of trade mark.

- b) An order for permanent injunction of this Hon'ble Court restraining the Defendant by itself, its proprietors, partners, directors, servants, agents, stockists, dealers, distributors and all persons acting on its behalf from infringing the Plaintiff's registered crown device trade marks bearing

nos., 1013152 (  in class 17) , 4728084 (  in

class 17), 4728085 (  in class 19) by the use of the

copyright registration nos. A-118764/2017 ,

and A-11818/2020  and impugned mark no. 1 (



app no. 3981950 in class 35) , impugned



mark no. 2 ( app no. 4343663 in class 17),



impugned mark no. 4 ( app. no. 4343665 in



class 17), impugned mark no. 7 ( app. no.



3179529 in class 17), impugned mark no. 8 (

app. no. 3981918 in class 17), impugned mark no. 9 (



app no. 3981919 in class 17), impugned mark



no. 10 ( app no. 3981927), impugned mark



no. 11 ( app. no. 3981940 in Class 35),



impugned mark no. 12 ( app. no. 3981949 in Class 35) at Exhibits AL, AN, W, X, Z, AE, AF, AG, AH, AI and AK, or any other mark identical and/or deceptively similar to the aforementioned registered marks of the Plaintiff or from any other act amounting infringement of trade mark.

- c) An order of permanent injunction of this Hon'ble Court restraining the Defendant by itself, its proprietors, partners, directors, servants, agents, stockists, dealers, distributors and all persons acting on its behalf from infringing the Plaintiff's copyright contained in the Plaintiff's crown




device registrations as artistic works in 'SYSTEMS'




including other marks depicted in Exhibit – E, or any other artistic work which is a substantial reproduction of the Plaintiff's artistic works depicted in Exhibit – E ;

- d) An order for permanent injunction of this Hon'ble Court restraining the Defendant by itself, its proprietors, partners,




directors, servants, agents, stockists, dealers, distributors and all persons acting on its behalf from passing off the Plaintiff's registered 'PRINCE' trade marks bearing nos.

1013152 (  in class 17), 2731071 (



in class 17) and 2731072 (  in class 11) by the use of the copyright registration nos. A-133962



, and impugned mark no. 3 ( , app. no. 4343664 in class 17), impugned mark no. 5 (  app. no. 4827338 in class 17), and impugned mark no. 6 (  app. no. 5120837 in class 17) at Exhibits AM, Y, AA and AB, or any other mark identical and/or deceptively similar to the aforementioned registered marks of the Plaintiff so as to pass off its impugned goods or like goods as and for the Plaintiff's, the said goods or in any other manner whatsoever;

- e) An order for permanent injunction of this Hon'ble Court restraining Defendant by itself, its proprietors, partners,

directors, servants, agents, stockists, dealers, distributors and all persons acting on its behalf from passing off the Plaintiff's registered crown device marks bearing nos.



1013152 ( in class 17) , 4728084 ( in class



17), 4728085 ( in class 19) by the use of the



copyright registration nos. A-118764/2017



and A-11818/2020 and impugned mark no. 1 (



app no. 3981950 in class 35) , impugned



mark no. 2 ( app no. 4343663 in class 17),



impugned mark no. 4 ( app. no. 4343665 in



class 17), impugned mark no. 7 ( app. no.



3179529 in class 17), impugned mark no. 8 ( app. no. 3981918 in class 17), impugned mark no. 9 (



app no. 3981919 in class 17), impugned mark



no. 10 ( app no. 3981927), impugned mark



no. 11 ( app. no. 3981940 in Class 35),



impugned mark no. 12 ( app. no. 3981949 in Class 35) at Exhibits AL, AM, W, X, Z, AE, AF, AG, AH, AI and AK, or any other mark identical and/or deceptively similar to the aforementioned registered marks of the Plaintiff so as to pass off its impugned goods or like goods as and for the Plaintiff's, the said goods or in any other manner whatsoever;

- f) An order for permanent injunction of this Hon'ble Court restraining the Defendant by itself, its proprietors, partners,

directors, servants, agents, stockists, dealers, distributors and all persons acting on its behalf from using in any manner the Plaintiff's registered 'PRINCE' and crown device marks including trade marks bearing nos. , 1013152 (



in class 17) , 4728084 (



in class 17),

4728085 (



in class 19), 1013152 (



in class



17), 2731071 ( in class 17) and 2731072 (



in class 11) or any of them, or any other trade mark which is identical with and/or deceptively similar to the Plaintiff's registered mark, of any description, so as to cause dilution or tarnishment of the Plaintiff's trade marks;"

128. Interim Application is accordingly, disposed of.

129. There shall be no order as to costs.

[R.I. CHAGLA J.]