

**RAJASTHAN HIGH COURT**

Before :- Mahesh Bhagwati, J.

S.B. Civil Misc. Appeal No. 933 of 2010. D/d. 31.12.2010.

Khannan Polymers - Appellant

**Versus**

Bairathi Shoes Company Private Limited - Respondent

**Equivalent Citation:** [2011\(45\) PTC 572](#) : [2011\(3\) R.A.J. 590](#)

For the Appellant :- Shashi Shekhawat, Advocate.

For the Respondent :- **G . D . Bansal** , Advocate.

**Trade Marks Act, 1999, Section 134 - Defendant started using trademark `Berati' whereas the plaintiff was using the trade mark `Bairathi' since 1980 - There is a phonetic similarity between both the marks - Therefore, a prima facie case of infringement is made out by the plaintiff - Interim injunction rightly granted against the defendant by the trial Court - Appeal dismissed.**

[Para ]

Cases Referred :

[Heinz Italia v. Dabur India Ltd., \(2007\) 6 SCC 1 : 2007 \(35\) PTC 1 \(SC\).](#)

JUDGMENT

**Mahesh Bhagwati, J.** - Challenge in this appeal is to the order dated 4th September, 2009, whereby the learned Additional District Judge, No. 5, Jaipur City, Jaipur restrained the Appellant-Defendant himself from using the trade mark 'BERATI' for the purpose of manufacturing, selling and exporting the shoes", foot-wears etc. or through his any agent or servant till the suit is finally adjudicated.

2. The nub, of the Appellant's story is that the Respondent-Plaintiff filed a suit for permanent injunction along with the application for temporary injunction under Section 134 of Trade Mark Act, 1999 (hereinafter referred to as 'Act of 1999'). It is averred that the Plaintiff-Respondent is a registered Company and indulges in the manufacturing and sale of foot-wears in the name and style of trade mark 'BAIRATHI'. This trade mark was got registered under the provisions of 'Act of 1999'. The Plaintiff came to know from Registrar of Trade Mark that the Defendant applied to get a trade mark registered in the name of 'BERATI' for manufacturing and sale of foot-wears. The Plaintiffs business has been established since 1980 and the Defendant was taking the advantage of his goodwill, so inclined to carry out business in the name of trade mark 'BERATI', which was deceptively and phonetically similar.

3. Heard learned Counsel for the parties and carefully perused the relevant material on record including the impugned order dated 4th September, 2009.

4. Learned Counsel for the Appellant canvassed that the trade mark 'BERATI' of Appellant-Defendant is registered. Learned trial court by way of adjudicating the temporary injunction application has, in fact, decreed the suit by restraining him from manufacturing foot-wears, shoes, chappals etc. and selling them to customers. Learned trial court also focused on the phonetic and deceptive similarities with regard to trade mark but; did not take into consideration the dis-similarities in both the trade marks emerging on record. Hence, the impugned order cannot be said to be good order in the eye of law, which deserves to be set aside.

5. E Converso, learned Counsel for the Respondent defended the impugned order and stated the same to be just and proper. He further canvassed that the Respondent-Plaintiff has been running business in the name and style of trade mark 'BAIRATHI' since 1980 and the Appellant-Defendant deceptively got his trade mark 'BERATI' registered with a view to take the advantage of his goodwill. Learned Counsel took me through the judgment of Hon'ble Apex Court rendered in the case of ***Heinz Italia and Anr. v. Dabur India Ltd., (2007) 6 SCC 1 : 2007 (35) PTC 1 (SC)*** and canvassed that in this case, the Plaintiff-Appellant was the proprietor of the trade mark 'Glucon-D' which had been registered in India under the Trade and Merchandise Marks Act, 1958. This trade mark had earlier been registered in the name of Glaxo on 21.5.1975, but subsequently Glaxo Laboratories assigned their rights in the artistic work used on the packaging and Plaintiff-Appellant thereupon used the trade mark 'Glucon-D' and the 'packaging' from the year 1994 to 2002 without any Interference and established a very good name in the market. In July 2002, the Appellants learnt that the Defendant-Respondent, Dabur India had launched a similar product under the name 'Glucose-D' by using packaging which was deceptively similar to the packaging used for 'Glucon-D'. The Hon'ble Apex Court allowing the application for interim injunction held that in an action for passing off, the Plaintiff has to establish prior user to secure an injunction and the registration of the mark or similar mark in point of time is irrelevant. The Hon'ble Apex Court further held that the principle of similarity cannot be very rigidly applied and if it can be prima facie shown that there was a dishonest intention on the part of the Defendant in passing off goods, an injunction should ordinarily follow and the mere delay in bringing the matter to court is not a ground to defeat the case of the Plaintiff. It also held that in the case of passing off action the similarities rather than the dissimilarities have to be taken note of by the court and the principle of phonetic "similarity" cannot be ignored and the test is as to whether a particular mark has obtained acceptability in the market so as to confuse a buyer as to the nature of product he was purchasing.

6. Placing reliance on this judgment rendered by the Hon'ble Apex Court, learned Counsel for the Respondent contended that in the instant case too, the Appellant-Defendant has been deceptively using the trade mark of 'BERATI' with a view to gain the advantage of the Respondent's trade mark 'BAIRATHI' and in view of the decision pronounced by the Hon'ble Apex Court, the aforesaid case of the Appellant deserves to be dismissed.

7. Having reflected over the submissions made at the bar and carefully scanned the relevant material including the impugned order, it is noticed that the Respondent-Plaintiff got the trade mark 'BAIRATHI' registered in the year 1980 and since then, he has been using this trade mark for manufacturing, selling and exporting shoes, foot-wears etc. The Appellant-Defendant having been mesmerised by the name of foot-wears being manufactured in the name and style of 'BAIRATHI' got the similar trade mark 'BERATI' registered with dishonest intention and ran business to gain the advantage of Respondent's goodwill. Learned trial court having discussed all the facts and circumstances of the case in detail, found the prima facie case made out in favour of the Respondent-Plaintiff and against the Appellant-Defendant. Learned trial court is also found to have observed that the trade mark "BERATI"

was phonetically and deceptively similar to that of the trade mark of 'BAIRATHI' of the Respondent-Plaintiff.

8. Section 134 of Trade Mark Act, 1999 envisages that the use of trade mark identical with or deceptively similar to the Plaintiffs trade mark was not permissible under the 'Act of 1999'. The Hon'ble Apex Court also in the case of **Heinz Italia v. Dabur India Ltd.** (supra) granted temporary injunction on the same ground that the Respondent-Defendant was using the trade mark 'Glucose-D' deceptively which was phonetically similar to the trade mark 'Glucon-D'. The fact of the instant case are similar to the case of **Heinz Italia v. Dabur India Ltd.** (supra), hence, in view of the afore-stated facts, the impugned order of the lower court seems to be just and proper and suffers from no infirmity. The prima facie case is found to have been made in favour of the Respondent-Plaintiff and the balance of convenience also goes in his favour. The argument advanced by the learned Counsel for the Appellant that the learned trial court by way of adjudicating the application with regard to temporary injunction has, in fact, decreed the suit, is not found to be sustainable. I am in full unison with the above finding of the learned trial court and the same, in my firm view, warrants no intervention.

9. For the reasons stated above, the civil misc. appeal fails and the same being bereft of any merit stands dismissed.

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