

**RAJASTHAN HIGH COURT**

(Jaipur Bench)

Before :- Bela M. Trivedi, J.

S.B. Civil Misc. Appeal No. 2896 of 2015. D/d. 15.09.2015.

M/s Pandit Kulfi and Cafe - Appellant

**Versus**

M/s. Pandit Kulfi - Respondent

**Equivalent Citation:** 2015(4) W.L.C. 328 : 2015 AIR (Raj) 218 : 2015(4) R.C.R.(Civil) 566 : 2015(4) DNJ 1627 : 2016(65) PTC 414

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

For the Respondent :- Shashank Sharma, Advocate.

**Trade Marks Act, 1999 Section 29 Defendant's Trade Mark "Shri Balaji Pandit Kulfi" is deceptively similar to plaintiff's Trade Mark "Pandit" - Registration of Trade Mark gives exclusive right to the registered proprietor to use of the Trade Mar - Section 28, in case of infringement of Trade Mark or copyright normally an injunction must follow - Defendant cannot be permitted to use Trade Mark "Pandit" in the firm name - Appeal allowed - Order of trial Court set-aside.**

[Paras 5, 6, and 8]

Cases Referred :

[Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., 2001\(2\) R.C.R.\(Civil\) 583 : \(2001\) 5 Supreme Court Cases 73.](#)

[Midas Hygiene Industries P. Ltd. v. Sudhir Bhatia, 2004 \(28\) PTC 121 \(SC\).](#)

[Rajendra Singh Shekhawat v. M/s. Shrinath Heritage Liquor Pvt. Ltd., 2014 WLC \(Raj.\) UC 454.](#)

ORDER

**Bela M. Trivedi, J.** - With the consent of the learned counsels for the parties, the appeal is being decided finally at the admission stage.

2. The present appeal has been filed by the appellant-plaintiff under Order 43, Rule 1 (r) CPC, challenging the order dated 21.05.2015 passed by the Additional District Judge No.17, Jaipur City, Jaipur (hereinafter referred to as "the trial court") in Civil Misc. Application No.9/2015, whereby the trial court has rejected the said application seeking temporary injunction against the respondent-defendant from using the mark "PANDIT" for his business of Kulfi, Ice creams and other milk products.

3. The appellant-plaintiff claiming to be the registered proprietor of the trademark "PANDIT" in respect of manufacturing and marketing Kulfi, Ice creams and other milk products, has filed the suit seeking permanent injunction against the respondent-defendant alleging interalia that the defendant had adopted deceptively similar trademark of "PANDIT KULFI" for carrying on his business of Kulfi, ice cream and other milk products, and therefore had committed infringement of the registered trademark of the plaintiff. The appellant-plaintiff had also filed the application seeking temporary injunction, which has been dismissed by the trial court vide the impugned order.

4. It is submitted by the learned counsel Mr. G.D. Bansal for the appellant that the trademark "PANDIT" is not only the registered trademark, but it also has the goodwill and reputation in the City of Jaipur and the appellant has an exclusive right to use the said trademark "PANDIT". He further submitted that the defendant had started similar business under the trademark of "PANDIT KULFI" which is deceptively similar to the trademark of the appellant-plaintiff, and therefore the appellant is entitled to the temporary injunction, as prayed for. He has relied upon the decision of Apex Court in case of **Midas Hygiene Industries P. Ltd. & Anr. v. Sudhir Bhatia & Ors., 2004 (28) PTC 121 (SC)**, and the decisions of this Court and other High Courts, to submit that in cases of infringement of registered trademark, an injunction must follow. However, the learned counsel Mr. Shashank Sharma for the respondent submits that the respondent is using the trademark "Shri Balaji Pandit Kulfi" since last more than 20 years and the said trademark cannot be said to be phonetically or visually similar or deceptively similar to the trademark of the appellant. Relying upon the decision of this Court in case of **Rajendra Singh Shekhawat v. M/s. Shrinath Heritage Liquor Pvt. Ltd., 2014 WLC (Raj.) UC 454**, he submitted that the word "PANDIT" being generic term, the appellant-plaintiff could not claim his exclusive right to use the same. He also submitted that though the trademark of the appellant is registered, there is a rectification application pending before the Registrar of trademark, and till the same is decided, no injunction should be granted against the respondent.

5. Having regard to the submissions made by the learned counsels for the parties and to the impugned order passed by the trial court, it appears that undisputedly the appellant is carrying on the business of Kulfi, Ice creams and other milk products using his registered trade mark "PANDIT" and the respondent is doing the same business with the name of "Shri Balaji Pandit Kulfi". Though, it is sought to be submitted by the learned counsel for the respondent that the name or trademark used by the respondent could not be said to be deceptively to be similar, the Court does not find any substance in the said submission. Having regard to the photographs produced by the learned counsels for the parties, it clearly appears that the respondent-defendant has written the words "Shri Balaji" in a very small fonts or letters and highlighted the words "PANDIT KULFI" in the board put at his shop. Since the words "PANDIT KULFI" has been written with highlighted bigger fonts, the customers may be misled that it must be same "PANDIT KULFI" of the appellant-plaintiff. Such name being deceptively similar to that of the appellant-plaintiff, which is a registered one, the respondent-defendant appears to have prima facie committed infringement of the registered trademark as per the provisions contained in Section 29 of the Trademarks Act.

6. It is needless to say that the registration of a trade mark gives to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of the infringement of the trade mark, in view of Section 28 of the said Act. At this juncture, a very pertinent observation made by the Apex Court in case of Midas Hygiene

Industries P. Ltd. & Anr. (supra) is required to be reproduced. Para 5 thereof, reads as under:-

"5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest."

7. As held by the Supreme Court in case of ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., 2001(2) R.C.R.(Civil) 583 : (2001) 5 Supreme Court Cases 73:-***

"31. Trade mark is essentially adopted to advertise one's product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the original owner of the mark....."

8. In that view of the matter, the Court is of the opinion that there being prima facie case of infringement of trademark and case of passing off made out by the appellant-plaintiff, the respondent-defendant cannot be permitted to use the trademark "PANDIT" for running his business of Kulfi. The respondent-defendant is therefore hereby restrained from using the word "PANDIT" in his trade mark for his business of Kulfi till the pendency of the suit. Having regard to the facts and circumstances of the case, the trial court is directed to expedite the trial of the suit. The impugned order passed by the trial court is set-aside. The appeal stands allowed accordingly. By this order, the stay application also stands disposed of.