



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

INTERIM APPLICATION (LODGING) NO. 7446 OF 2025
IN
COMMERCIAL IP SUIT NO. 194 OF 2025

Mangalam Organics Ltd

... Applicant/
Org Plaintiff.

Versus

N Ranga Rao And Sons Pvt Ltd

... Defendant

Adv. Hiren Kamod a/w Adv. Anees Patel, Usha Chandrasekhar, Avisha Mehta and Rajamtangi i/by Suvarna Joshi for the Plaintiffs.

Adv. Rashmin Khandekar a/w Adv. Anand Mohan, Rahul Dhote, Shwetank Tripathi, Nipun Krishnaraj and Vidit Desai i/by ANM Global for the Defendant.

Coram : Sharmila U. Deshmukh, J.

Reserved on: July 11, 2025.

Pronounced on : September 3, 2025.

ORDER:

1. This is an action for infringement of trade mark and passing off.
2. The case of the Plaintiff is that in or around March, 2017, the Plaintiff coined and conceived the mark 'CAMPURE' for use in respect of various camphor-based products and camphor derived products such as deodorants, room fragrancings preparations, air fragrancings preparations, soaps, hair conditioners, hair lotions and sanitary preparations being toiletries wherein camphor is the main ingredient.

The Plaintiff conceived and designed a unique and stylized logo



bearing "CAMPURE" as one of its leading and essential features. The Plaintiff applied for registration of the mark "CAMPURE"



and under Class 3, 4 and 5 and obtained registrations which are valid and subsisting.

3. It is submitted that in the year 2014, the Plaintiff launched its camphor product bearing a unique cone shape trade dress wrapped in non-woven fabric, which trade dress was registered in Class 5 and was launched under the Plaintiff's trade mark "MANGALAM". The Plaintiff



has been using the trade mark "CAMPURE" and since the year 2017 in respect of its cone shaped camphor product. In order to demonstrate the goodwill and reputation, the statement of sales figure and the advertisement expenses are set out in paragraph 11 of the plaint and for the period from 2017 to 2024, the sales figure is Rs. 1,10,23,58,982/- and Rs. 29,25,90,351/- respectively. It is submitted that the Plaintiff maintains his website www.houseofmangalam.com wherein the Plaintiff's goods *inter alia* bearing the said trade mark



"CAMPURE"/ are prominently promoted and offered for

sale. The Plaintiff's trade mark has established a distinct identity in the market and the Plaintiff has acquired valuable statutory and common law rights in their registered trademarks.

4. In or around December, 2022, the Plaintiff learnt from market sources that the Defendant was preparing to launch its cone shape camphor product under the name "Air Kapur Camphor Cone" in a trade dress potentially identical with the Plaintiff's cone shape camphor products. The Plaintiff addressed legal notice dated 2nd December, 2022 to the Defendant conveying concerns over the Defendant's intention to launch of cone shape camphor product in identical shape as that of the Plaintiff. Vide reply dated 5th December, 2022, the Defendant contended that the Defendant's camphor products are sold under the Defendant's registered trade mark. It was stated that the Plaintiff does not hold any trade mark registration in respect of cone shape trade dress and the Plaintiff's trade mark Application No. 4465571 is facing opposition and the Plaintiff's trade mark no 5339527 stands liable to be refused for being non-distinctive as per the Registrar of Trade Marks examination report. The Plaintiff has stated in the plaint that the Plaintiff's cone shaped trade dress is not the subject matter of the present suit.

5. It is stated that subsequent to the Defendant's reply dated 5th December, 2022, the Plaintiff did not come across any cone shape

camphor product of the Defendant. In or around July-2024, while conducting general due diligence on the trade mark registry's online records, the Plaintiff came across Defendant's trade mark registration for the impugned mark "AIR KARPURE" bearing no. 4732154 dated 4th November, 2020 in Class 05 applied on proposed to be used basis which was identical/deceptively similar to the Plaintiff's trade mark "CAMPURE". The Plaintiff also came across the Defendant's website www.karpure.in which revealed that the Defendant is using the mark

"AIR KARPURE" as device mark  wherein the word 'AIR' is written in the smaller font about the word "KARPURE" written in larger font in respect of camphor products such as air fresheners, "air pouch", camphor tablets, camphor mosquito repellents, etc. as also the

device mark  is used in respect of range of personal care products.

6. On 1st August, 2024, the Plaintiff applied to the trade mark registry seeking rectification of the register/cancellation of the Defendant's impugned registration for the mark "AIR KARPURE" and on 20th January, 2025 the Defendant filed its counter statement to the Plaintiff's rectification Application contending that the impugned mark 'AIR KARPURE' was adopted by the Defendant in 2020 and commenced its use since 2022.

7. In the affidavit-in-reply, it is submitted that the Defendant was initially established as proprietary concern in 1948 by the grandfather of the current director of the Defendant which was then converted into partnership firm and subsequently into private limited company on 23rd December, 2014. The Defendant in course of his business coined and adopted various distinctive marks such as CYCLE, CYCLE BRAND THREE IN ONE, WOODS, LIA, HERITAGE, RHYTHM, etc., and the house mark "Cycle" is acknowledged as well known mark by the Madras High Court as well as published in the list of well known trade marks.

8. The Defendant has used the tagline in respect of its products in the fragrance industry such as "Everyone has a reason to pray", "Pray for India", "Bhagwan Hai", "Purity of Prayers" which is the foundation on the basis of which the word pure has been used as integral part of the Defendant's promotional campaign. The Defendant has been granted registration for the word mark "Cycle Pure" as well as the device mark along with tagline in Class 16, 3, 41 and 35. In October/November, 2020, the Defendant honestly coined and adopted the Defendant's mark 'KARPURE'/ 'AIR KARPURE' for use of the same in relation to *inter alia* sanitary preparations, disinfectants, foams, sprays, liquid etc falling in Class 5 and 11. The Defendant's mark "KARPURE" was coined based on the combination of the Sanskrit name for camphor i.e. Karpura and Pure which is unique and inherently

distinctive. The logo devised by the Defendant's employee prominently displays the Defendant's cycle logo at top right corner. The Defendant has applied for registration of "AIR KARPURE" and "KARPURE" mark on 4th November, 2020 which are valid and subsisting in Class 5 and 11 and in respect of registration of "AIR KARPURE" in Class 5 rectification Application is filed by the Plaintiff which is pending.

9. It is stated that in or about 2022, the Defendant commenced the use of the impugned mark in relation to the Defendant's goods and the long association of the said mark with the Defendant's goods has resulted in the mark being highly distinctive of the Defendant's goods. The sales figure in respect of the goods marketed under the Defendant's mark for the year 2024-25 was Rs. 479 lakhs. It is submitted that the Defendant being registered proprietor, no suit for infringement can lie against the registered proprietor. It is submitted that the Plaintiff has concealed the material fact that its trade mark

registration no. 3643444 for the mark 'CAMPURE'/  for wider specification of goods including Deodorizers and air purifiers was opposed by one Lifestar Pharma Private Limited", being proprietor of mark 'CALAPURE' in which the Plaintiff filed its counter statement stating that its mark 'CAMPURE' is entirely different from the mark 'CALAPURE' and that no one can claim monopoly over the word 'PURE'

as several marks including the mark "CAROPURE" were existing in record of trade mark registry. Pursuant to the opposition, the Plaintiff entered into memorandum of understanding whereby it restricted its specification of goods to deodorizers and purifiers including air purifying preparations, air deodorizing preparations, deodrants. It is stated that the rival marks are dissimilar and distinct, visually, phonetically, structurally and conceptually from each other. It is further submitted that the Plaintiff has failed to make out any case of goodwill and reputation in the Plaintiff's mark prior to the adoption of the Defendant's mark. It is further stated that on 2nd December, 2022, the Plaintiff had sent cease and desist notice which was responded by the Defendant and the suit has been filed after four years and therefore the Plaintiff's Application suffers from delay, laches and acquiescence. It is submitted that the Court will not have jurisdiction in case of passing off as the Defendant is selling its product online wherein the products can be ordered and delivered in every part of India.

10. In rejoinder, it is contended that this is fit case for the Court to go behind validity of the Defendant's registration of the impugned mark even at the interim stage. It is stated that the Defendant has obtained registration of its mark in Class 11 which is by playing fraud as Class 11 is not the relevant class. The Defendant's impugned mark "KARPURE", "AIR KARPURE" and device mark are identical/deceptively

similar to the Plaintiff's trade mark "CAMPURE" when the rival marks are taken as a whole rather than in parts.

11. It is stated that the opposition to the registration of the Plaintiff's mark filed by the third party was withdrawn pursuant to memorandum of understanding and the stand taken in the counter statement does not constitute material or relevant fact. It is contended that the Plaintiff does not claim any exclusivity of the standalone word "PURE" and the marks when taken as a whole are similar. It is stated that in the opposition proceedings, the third party opponent's mark "CALAPURE" was phonetically, visually and conceptually dissimilar to the Plaintiff's trade mark "CAMPURE" which consisted of three syllable and eight letters whereas the Plaintiff's mark comprises of two syllable and seven letters and in the present case the rival mark comprises of two syllable and seven letters. It is stated that in the present case the rival goods in the customer base in trade channels are the same leading to possibility of confusion. It is stated that there is no delay, laches or acquiescence on part of the Plaintiff and the cease and desist notice pertained only to the cone shape camphor product.

SUBMISSIONS:

12. Mr. Kamod, learned Counsel for the Plaintiff has taken this Court through the registration certificates of the Plaintiff's mark, the

sale figure, advertisement expenses and the invoices to demonstrate user and registration since the year 2017. He submits that in reply to the cease and desist notice, the Defendant had contended that the Defendant's camphor products are sold under the Defendant's registered trade mark without mentioning that the Defendant trade mark is "KARPURE". He submits that as the Plaintiff had learnt about the potential launch by the Defendant of cone shape trade dress, the cease and desist notice was issued and as the said product was not launched, there is no question of any delay. He would further point out that the Defendant had applied for registration of the word mark 'AIR KARPURE' on 4th November, 2020 on proposed to be used basis in Class 5. The user by the Defendant is of the year 2022 and the Plaintiff has filed for rectification/cancellation of Defendant's mark which is pending.

13. He would further draw attention of this Court to paragraph 35 of the plaint to contend that the Defendant has used the impugned mark in relation to similar goods as that of the Plaintiff's such as bathing soap, air freshener, liquid, mosquito repellent, suspendible sachet air freshener and camphor cone/ pouch. He submits that the Defendant uses the word "AIR" in negligible font and the trademark "KARPURE" is phonetically similar to the Plaintiff's mark "CAMPURE". He submits that the impugned mark uses the alphabet 'P' in capital

case similar to that of Plaintiff's mark.

14. He submits that the Defendant has registration of the word mark Cycle in Class 5 which it does not use. He submits that the explanation tendered that the mark is adopted by combination of the Sanskrit word 'KARPURA' and 'PURE' is unacceptable. He submits that the registration of the Defendant's mark 'AIR KARPURE' is *ex-facie* illegal as the essential features of the Plaintiff's mark are copied and this Court can go behind the validity of registration and restrain the Defendant.

15. He submits that for the purpose of passing off, the relevant date is date of user i.e. 2022. He submits that there is no delay, laches and acquiescence as notice issued by Plaintiff in 2022 was not for 'KARPURE' but for cone shaped trade dress.

16. He submits that in the opposition application to the Plaintiff's mark, the mark was 'CAROPURE' and the stand taken was 'CAMPURE' was different. He submits that the word 'CAROPURE' 'CAMPURE' and 'CALAPURE' are dissimilar and there is no question of any estoppel. He submits that for the purpose of acquiescence, the Defendant has not shown that he has altered his position. He submits that the Court will have jurisdiction in respect of passing off action as the Defendant's products are available on e-commerce website of Amazon and are delivered within the jurisdiction of this Court. In support he relies upon

the following decisions.

1	<i>Corona Remedies Pvt Ltd vs. Franco-Indian Pharmaceuticals Pvt Ltd.¹</i>
2	<i>Encore Electronics Ltd vs. Anchor Electronics & Electricals²</i>
3	<i>Sun Pharmaceuticals Industries Limited vs. Emcure Pharmaceuticals Ltd³</i>
4	<i>Hiralal Parbhudas vs. Ganesh Trading Company⁴</i>
5	<i>Pidilite Industries Ltd vs. Poma-Ex Products⁵</i>
6	<i>Pidilite Industries Limited vs. Riya Chemy⁶</i>
7	<i>Kantilal Premji Maru vs. Madan Kumar⁷</i>
8	<i>Hab Pharmaceutical and Research Ltd & Anr. vs. Regain Laboratories & Anr (decision of this Court in IAL-2307-2023 In Com IPR Suit No. 489 of 2022 Original side dated 18th July 2023.)</i>

17. *Per contra*, Mr. Khandekar learned Counsel appearing for the Defendant submits that the Plaintiff is not entitled to any interim relief as there is suppression of material fact as regards the opposition to the Plaintiff's registration of the mark 'CAMPURE'. He submits that in the counter statement, the Plaintiff had taken the stand that the mark 'CALAPURE' and 'CAMPURE' are different and distinct and there is no monopoly over the word "Pure" and therefore prosecution history estoppel will operate in the present case. He further submits that

1 MANU/MH/0410/2023
2 2007 SCC OnLine Bom 147
3 MANU/MH/0020/2012
4 AIR 1984 Bom218
5 2017(72) PTC1 (Bom)
6 2023(1)ABR 710
7 MANU/MH/1038/2018

there is no similarity between the rival marks and the Defendant is registered proprietor of the mark 'AIR KARPURE'/KARPURE in Class 5 and Class 11 and points out to the registrations. He submits that there can be no monopoly about the common descriptive word "Pure" and where the common element between the two rival marks is descriptive and common to the trade greater regard has to be paid to uncommon elements of the rival marks. He further submits that the Defendant is leading manufacturer in the fragrance industry and has adopted various distinctive trade mark of "Cycle" which is acknowledged as well known trade mark and that by virtue of tagline the word "Pure" is part of registration of mark. He submits that there is no case made out for going beyond the registration, that there is overlap of classification and the registration is not *ex-facie* illegal.

18. He submits that the Plaintiff seeks restraining order against the Defendant from using the impugned mark KARPURE /



/ AIR KARPURE /



or the impugned

domain name which relief cannot be asked as the Defendant is the registered proprietor. In support he relies upon following decision:-

1	<i>Liberty Oil Mills Ltd vs. BRS Refineries Pvt Ltd⁸</i>
2	<i>Skol Breweries Ltd. Vs Som Distilleries & Breweries Limited⁹</i>

⁸ 2016 SCC OnLine Bom 10470

⁹ 2012 (49) PTC 231 (Bom).

3	<i>Medley Pharmaceuticals Ltd vs. Megh Healthcare Pvt Ltd¹⁰</i>
4	<i>J & P Coats Ltd vs. Popular Thread Mills¹¹</i>
5	<i>Laser Shaving (India) Pvt Ltd vs. Rkrm International Products Pvt Ltd (decision of this Court in Interim Application No. 110 of 2025 in Comip Suit No. 44 of 2014 Original Side dated 25th June, 2025)</i>
6	<i>F. Hoffmann-LA Roche vs. Geoffrey Manners & Co pvt. Ltd¹²</i>
7	<i>Macleods Pharmaceuticals Ltd vs. Swissskem Healthcare¹³</i>
8	<i>Corona Remedies Pvt. Ltd. vs. Franco-Indian Pharmaceuticals Pvt Ltd.(supra)</i>
9	<i>Skol Breweries Ltd vs. Fortune Alcobrew Pvt Ltd.¹⁴</i>
10	<i>Allied Auto Accessories Ltd vs. Allied Motors Pvt. Ltd¹⁵</i>
11	<i>Paramjeet Singh Nande vs. Paramount Toys & Ors. (decision of this Court in IAL-35055-2023 in Comm IP Suit No. 332 of 2024 Original Side order dated 17th June, 2025.</i>

19. In rejoinder Mr. Kamod would submit that for the application of doctrine of estoppel it has to be shown there are contrary stand has been taken by the Plaintiff and the Defendant has altered its position. He submits that the decisions relied upon are in the case of medicinal preparations and it is not the Defendant's case that the word 'PURE' is common to the trade. He submits that the dishonesty of the Defendant is evident from the fact that his registration of the mark 'KARPURE' is in respect of Class-11 for apparatus whereas he uses the mark in respect of soap. He submits that the passing off action is maintainable as the Plaintiff is prior user and the consumer will be left in state of

10 2016 SCC OnLine Bom 4317

11 1996 (39) DRJ (DB)

12 (1969) 2 SCC 716

13 2019 SCC OnLine Bom 1186

14 2012 SCC OnLine Bom 513

15 2002 SCC OnLine Bom 1138

wonderment as the marks are phonetically and structurally similar and the added material will not come in aid of the Defendant.

REASONS AND ANALYSIS :

20. The Plaintiff seeks an injunction against use by the Defendant's of the impugned mark "KARPURE"



21. AIR KARPURE /  or the domain name www.karpure.in or any other device/logo/domain name identical or deceptively similar to the Plaintiff's registered trade mark and for relief against passing off.

22. Dealing first with the objection of maintainability of suit against registered proprietor, the statutory provisions does not bar the institution of the suit for infringement of trade mark against the registered proprietor of a trademark. The aspect of maintainability of suit against registered proprietor for infringement is no longer *res integra* and it is settled that the suit seeking action for infringement and passing off is maintainable even against a registered proprietor. [See *Kantilal Premji Maru vs Madan Kumar* (supra)]. The real question is whether the Plaintiff has made out a *prima facie* case so as to restrain a registered proprietor from use of its trade mark.

23. In so far as the Plaintiff is concerned, in paragraph 6 of the plaint and Exhibit "A", the Plaintiff has set out the various registrations obtained by the Plaintiff for the said trade mark CAMPURE /



as under:

Sr. No.	Trademark	Registration No. and Date	Class and Goods
1.	CAMPURE	3607515 06/08/2017	05 deodorizers and purifiers include air purifying preparations; air deodorizing preparations; deodorants; deodorants for clothing and textiles only.
2.		3643444 25/09/2017	05 deodorizers and purifiers including air purifying preparations; air deodorizing preparations; deodorants; deodorants for clothing and textiles only.
3.	CAMPURE	5339528 22/02/2022	03 deodorants; room fragrancing preparations; air fragrancing preparations; soaps; hair conditioners; hair lotions

			and sanitary preparations being toiletries.
4.		5339529 22/02/2022	03 deodorants; room fragrancing preparations; air fragrancing preparations; soaps; hair conditioners; hair lotions and sanitary preparations being toiletries.
5.	CAMPURE	5596745 05/09/2022	03 essential oils; Pine essential oils; Aromatic essential oils; Perfumery, essential oils; Non-medicated hand wash, floor cleaning preparations
6.		5596746 05/09/2022	03 essential oils; Pine essential oils; Aromatic essential oils; Perfumery, essential oils; Non-medicated hand wash, floor cleaning preparations.
7.	CAMPURE	5596747 05/09/2022	04 candles and wicks for lighting; prayer candles; perfumed candles; scented candles
8.		5596748 05/09/2022	04 candles and wicks for lighting; prayer candles;

			perfumed candles; scented candles
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24. The registrations are substantiated by production of the certificates at Exhibit “B” to “B-8” of the Plaint. The annexures when perused shows that the Plaintiff’s Registration No 3607515 dated 6th June, 2017 is in respect of the mark “CAMPURE”, where all alphabets

are depicted in capital case. It is in the mark of  which was registered on 25th September, 2017, that the Plaintiff depicted its mark by using the middle letter “P” in capital case. The wordmark “CamPure” using similar depiction of middle letter P was registered on 22nd February, 2022 vide Registration Number 5339528. The factum of the subsequent registration of the wordmark “CamPure” in the year 2022 is significant as one of the similarities claimed by the Plaintiff is the use of by the Defendant of the middle alphabet “P” in capital case in its trade mark. Pertinently, the Defendant had applied for registration of its mark in the year 2020 itself.

25. The Defendant applied for registration of its trade marks ‘AIR KARPURE’ and “KARPURE” in Class 5 and 11 on 4th November, 2020 on proposed to be used basis. The details of the Defendant’s registration are as under:

Sr. No.	Trade Mark	Application No. and Class	Application Date	Registration Date
1	AIR KARPURE	4732154 Class 5	04/11/2020	02/09/2022
2	AIR KARPURE	4732155 Class 11	04/11/2020	02/05/2021
3	KARPURE	4732156 Class 11	04/11/2020	02/05/2021

26. In or around July, 2022, the Defendant's employee at the instance of the Defendant created the original artwork of



and the no objection certificate dated 22nd July, 2022 is placed on record.

27. Section 29 of the T.M. Act, 1999 which governs the infringement of trade mark provides that a registered trade mark is infringed by a person, who not being a registered proprietor uses in course of trade, a mark which is identical with or deceptively similar to the registered trade mark. The provision makes it clear that to constitute infringement of a registered trade mark, the basic requirement of Section 29 of T.M. Act, 1999 is use of identical/deceptively similar mark by a person who is not a registered proprietor. In the present case, the Plaintiff and Defendant are both registered proprietors of their respective trade marks and therefore remedy of infringement under

Section 29 of T.M. Act, 1999 is not available to the Plaintiff. The pleadings in the plaint when read holistically would *prima facie* indicate that the Plaintiff has premised its suit on the requirements of Section 29 of the T.M. Act, 1999 by contending about the deceptive similarity of the rival marks, which expression finds place in Section 29 of the T.M. Act, 1999.

28. In ***Corona Remedies Pvt Ltd vs. Franco-Indian Pharmaceuticals Pvt Ltd***, (supra) the Hon'ble Division Bench of this Court considered the provisions of Section 28(3) of the T.M. Act, 1999 to hold that once trade mark is registered, remedy of infringement is not available against the registered proprietor. In that context the Co-ordinate Bench considered the decision of the Hon'ble Apex Court in the case of ***S. Syed Moideen vs. Sulochana Bai 2016 (2) SCC 683*** where the Hon'ble Apex Court held that as per Section 28(3) the owner of registered trade mark cannot sue for infringement of it against a trade mark which is registered and that the provisions of Section 27(2) as regards the passing off would still be available.

29. In order to restrain the Defendant from the use of its registered trade mark, the Plaintiff seeks to assail the validity of registration of the Defendant's trade mark. Though there are no specific pleadings which will indicate the grounds on which the validity is assailed, considering the arguments canvassed this Court has proceeded to

consider the aspect of validity of the registration of the Defendant's mark on the basis of the provisions of Section 9(2)(a) and Section 11 of T.M. Act, 1999. Section 9 deals with the absolute grounds for refusal and Section 11 deals with relative grounds of refusal of registration. The statutory provisions provides that a mark which by reason of identity/similarity to earlier registered trade mark and similarity/identity of goods is likely to cause confusion on part of the public which includes likely association with the earlier registered trade mark should not be registered. The refusal of registration would therefore be based on a finding that the subsequent mark is so identical or similar to the earlier registered trade mark so as to cause confusion amongst the public.

30. The rights which are conferred by virtue of registration of the mark is set out in Section 28 of T.M. Act, 1999 which reads as under:

"28. Rights conferred by registration.—(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give 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 infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or

nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.”

31. Section 28(3) of T.M. Act, 1999 provides for an eventuality where two or more persons are registered proprietors of identical or nearly resembling trade marks and in such cases, the exclusive right cannot be enforced against the other registered proprietor. The rights of registered proprietor is further protected by Section 30 of T.M. Act, 1999 which limits the effects of registered trade mark and Section 30(2)(e) provides that a registered trade mark is not infringed where the use of the registered trade mark, being one of two or more trade marks registered under the Act, which are identical or nearly resemble each other, is in exercise of the right to use of the trade mark given by registration under this Act.

32. Conjoint reading of Section 28 (3) and Section 30(2) (e) of the T. M. Act 1999 thus protects the right of use of the trade mark conferred by registration of trade mark, if valid, by keeping out the action for infringement where the mark is used in exercise of right conferred by

the registration. The significant use of the words, if valid, occurring in Section 28(3) of the T. M. Act, 1999 came up for consideration of the Hon'ble Full Bench of this Court in the case of **Lupin Ltd. vs. Johnson and Johnson**¹⁶ where the Hon'ble Full Bench was considering whether the Court can venture into the question of validity of registration of the trademark at an interlocutory stage upon defence of invalidity of registration being taken and Hon'ble Full Bench concluded its findings in paragraph 59(3), (5), (6) and (8) are as under:

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

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

(6) It is not sufficient for the defendant to show that the defendant has an arguable case for showing invalidity. The prima facie satisfaction of the Court to stay the trial

¹⁶ [2015(1) Mh.L.J. 501]

under section 124 of the Act is not enough to refuse grant of interim injunction. It is only in exceptional circumstances, such as, the registration being ex facie illegal or fraudulent or which shocks the conscience of the Court that Court will refuse the interim injunction in favour of the registered proprietor of the trade mark. (Para 57)

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

33. The Hon’ble Full Bench upheld the power of the Court to travel beyond the registration but with the caveat that the same can be done only in exceptional cases where the registration is *ex-facie* illegal or fraudulent or which shocks the conscience of the Court. The threshold to be met is not that of *prima facie* arguable case of invalidity but a higher threshold of ex-facie illegality or fraud or which shocks the conscience of the Court. For a plea of invalidity to fit in the small window left open in **Lupin’s** case, the Court is required to be *prima facie* satisfied upon bare comparison of rival marks and without embarking on a detailed inquiry, that the subsequent mark by reason of its identity/similarity with the earlier registered trade mark is likely

to cause confusion amongst the public. The burden to be discharged is heavy and rightly so as the registration of the trademark confers statutory rights on the proprietor which should not be interfered with lightly.

34. The Defendant had applied for registration of its mark on 4th November, 2020 and upon acceptance of the application for registration, as per the procedure, the Application must have been advertised in the prescribed manner. The Plaintiff did not file any opposition to the Defendant's registration and the fact that the Defendant's mark had been granted registration indicates that it has passed the muster of Section 9 and 11 of the T. M. Act, 1999.

35. In order to appreciate whether the registration of the Defendant's mark is *ex facie* illegal or which shocks the conscience of the Court, it would be apposite to reproduce the rival marks for comparison as under:

Plaintiff's trade mark	Defendant's impugned marks
CAMPURE / 	KARPURE /  / AIR KARPURE / 

36. It needs to be borne in mind that what is required to be ascertain is *ex facie* illegality in the registration of the Defendant's mark and not *prima facie* arguable case of invalidity of registration. In that context, the marks have to be compared and if upon a bare comparison, it can be demonstrable that the use of the Defendant's mark by virtue of its identity/similarity with the earlier registered trade mark is likely to cause confusion, the Defendant can be restrained from use of its registered mark by holding the registration to be *ex-facie* illegal. Whether the rival marks are likely to cause confusion by reason of its identity/similarity is a matter of first impression. When so viewed, the Defendant's marks does not resemble the Plaintiff's marks in a manner as to cause confusion as to whether the mark is that of the Plaintiff or the Defendant. As the illegality is not *ex facie* demonstrable, no case of infringement is made out and the case ought to have been put to rest here in so far as action of infringement is concerned. However, as substantial arguments were advanced on the similarities between the rival marks, which otherwise could be appreciated in the background of Section 29 of T.M. Act, 1999, going one step further, this Court has proceeded to consider whether *prima facie* case of arguable similarity is made out.

37. It is well settled that the marks have to be viewed as a whole and it is not permissible to dissect the marks and compare parts of the

mark. *Prima facie*, the Defendant is using its registered mark as device

mark  whereas the Plaintiff is using

its mark  . The Defendant's mark is depicted in stylized

cursive font with the initial alphabet "K" written in form of a flower

whereas the Plaintiff's mark  is depicted in block letters

with the middle letter "P" in capital case towering over the starting

alphabet "C". In the Defendant's mark the middle letter "P" even in

capital case is contiguous with the rest of the letters. The Plaintiff's

mark is depicted inside a distinct elongated shape, which is not so in

case of the Defendant's mark. The manner of depiction of the rival

marks and the artwork used in the rival marks *prima facie* sets apart the

rival marks. There is no possibility of slurring over the word "r" of the

impugned mark so as to sound phonetically similar to the word "m". It

needs to be noted that the relevant consumer base for the products

which are deodorizers, air purifiers etc would be an average educated

class with the ability to differentiate between the rival marks and the

products. *Prima facie*, the Plaintiff has not been able to meet the

threshold of *ex-facie* illegality so as to deprive the Defendant of the

use of its registered trade mark. Upon *prima facie* comparison of the

rival marks, in my view, there is no similarity/resemblance between the

two marks which will lead of causing confusion among the public or likely association of the Defendant's goods as that of the Plaintiff.

38. Though arguments were advanced on fraudulent registration, it is well settled that where plea of fraud is raised, it is necessary to set out the necessary particulars of fraud which are missing in the present case. It is not sufficient to reproduce the expression used in the decision of ***Lupin Ltd. vs. Johnson and Johnson*** (supra) without specific pleadings to demonstrate the fraud. In so far as the dishonest adoption is concerned, the argument is that the registration is made in Class 5 in respect of goods which do not fall in Class 5. *Prima facie*, the registration of the Defendant's mark "AIR KARPURE" under Class 5 is also in respect of room and car freshners and deodorizers, which is similar to the Plaintiff's registration for deodorizers and purifiers, air deodorizing preparations. If the classifications in Class 3 and 5 are seen, there is certain overlapping between the classification as some of the products can fall in either of the classifications. The Defendant is *prima facie* using the registered mark in relation to the goods in respect of which the mark is registered. Pertinently, in the case of ***Allied Auto Accessories Ltd vs Allied Motors Pvt Ltd***(supra), the Co-ordinate Bench of this Court held that guidelines or classification lists which are published are only administrative guidelines.

39. In the case of ***Kantilal Premji Maru vs. Madan Kumar*** (supra)

this Court applying the ***Lupin*** principles to the rival marks in that case held the same to be *ex-facie* illegal. The rival marks were “Classic Steels” and Defendant’s mark was “5 Classic Care”. The Court noted that the word “Classic” written in distinctive font in Plaintiff’s registered trade mark is bodily lifted and copied by the Defendant in its trade mark. Similarly in ***Pidilite Industries Limited vs Riya Chemy***(supra), the Plaintiff’s mark as “M-Seal” and Defendant’s mark was “R-Seal”. In ***Pidilite Industries vs Poma-Ex Products***(supra), the rival marks were “FEVIKWIK” and “KWIKHEAL”. It is in such facts of that cases, the Court went beyond the registration and held the same to be *ex-facie* illegal.

40. The decision in ***Hiralal Prabhudas vs Ganesh Trading Company and Ors*** (supra) sets out the settled test for considering the case of deceptive similarity in proceedings arising out of rejection of application for rectification.

41. In the case of ***Encore Electronics Ltd vs. Anchor Electronics & Electricals*** (supra) the Hon’ble Division Bench of this Court considered the phonetic similarity between the rival marks and took into consideration principle laid down by the Hon’ble Apex Court in the case of ***Cadila Health Care Ltd vs. Cadila Pharmaceuticals Ltd.***¹⁷ There is no quarrel with the principles laid down in the said judgments

¹⁷ (2001) 5 Supreme Court Cases 73

following the decision of the Hon'ble Apex Court and what assumes significance is the application of the principle to the facts of each case. The precedents would bind in so far as the tests are concerned and not in respect of the factual aspects. The well settled principles laid down by the Court will differ in its application to the facts of each case which is required to be considered by comparing the rival marks concerned therein. When the well settled tests are applied to the present case, the Plaintiff has failed to make out an exceptional case so as to warrant going beyond the registration of the Defendant's mark and deprive the Defendant who is registered proprietor of its statutory right of use of its mark.

42. Another reason which disentitles the Plaintiff to the discretionary relief is suppression of material fact as the Plaintiff has not placed on record the stand taken by the Plaintiff in the counter statement to the opposition of the registration of its mark. In case of ***Phonepe Private Limited vs Resilient Innovations Private Limited (2023 SCC Online Bom 764)***, the Co-ordinate Bench of this Court has held that the stand taken by the Plaintiff therein before the Registrar of Trade marks in the examination report is a relevant factor and by not placing its own stand, the Plaintiff dis-entitled itself to grant of discretionary reliefs under Order XXXIX Rules 1 and 2 of CPC.

43. The Plaintiff seeks to restrain the Defendant, who is also the

registered proprietor from use of its registered mark by claiming exclusive use of its mark. It was therefore necessary for the Plaintiff to place on record all facts which led to the registration of the Plaintiff's own marks. The non disclosure of the opposition to the Plaintiff's registration and the stand taken by the Plaintiff in the counter statement, which had to be produced by the Defendant, disentitles the Plaintiff to grant of discretionary relief.

44. There is bonafide explanation for adoption of the mark by the Defendant as its mark contains the word "Pure" which forms part of its earlier registered marks and is in consonance with its various tag lines using purity as its theme.

45. *Prima facie*, the Defendant's registration being valid and subsisting till date entitles the Defendant to use of the registered trade mark under Section 28(3) read with Section 30(2) (e) of the T.M. Act, 1999 and there is no infringement of statutory rights of the Plaintiff by reason of the use of the Defendant's validly registered trade marks.

46. In so far as the common law remedy of passing off is concerned, the relevant date which is required to be considered is the adoption of the Defendant's mark i.e. in the year 2022. In the case of ***Sun Pharmaceuticals Industries Limited vs. Emcure Pharmaceuticals Ltd., (supra)***, the Hon'ble Single Judge held that the mere fact of

registration has no relevance and the requisite goodwill and reputation has to be shown on the date on which the Defendant use their impugned mark. In the present case the Defendant has used the mark admittedly in the year 2022 and the relevant date for the purpose of considering the action of passing off is 2022.

47. To succeed in an action for passing off, the three ingredients to be *prima facie* established are goodwill, misrepresentation and damage. It is trite that an action for passing off is maintainable even against a registered proprietor. It is required to be demonstrated that by reason of the extensive use of the mark by the Plaintiff the same has acquired enormous goodwill and reputation that the registered mark is associated exclusively with the Plaintiff's goods, that the use of the mark is likely to cause damage, and, that there is misrepresentation by the Defendant. Paragraph 11 of the plaint pleads that the sales figure and advertisement expenses in respect of entire range of products sold under the registered mark "CAMPURE" for the year 2022-23 was Rs. 28,37,62,674/- and Rs. 4,07,79,619/- respectively. To support the figures, the Chartered Accountant's certificate is annexed at page 283 of the plaint which certifies that the sales figure and the advertisement expenses are in respect of all camphor product from 2014 onwards. What is necessary to be substantiated is the stand alone sales figure in respect of products marketed under the mark



'CAMPURE' /  device mark, which will indicate the goodwill and reputation earned by the Plaintiff in respect of the relevant marks and not the sales figure of all camphor products of the Plaintiff. There is no material on record pointed out on the basis of which it can be *prima facie* held that the Plaintiff's registered mark has acquired such distinctive character that the consumers identify the mark with that of the Plaintiff's products only.

48. The material on record shows that the rival marks are used by the Plaintiff and the Defendant respectively in respect of their various products. It was necessary for Plaintiff to specifically plead about the Plaintiff's products marketed under its mark which is so marketed by the Defendant so as to pass off its goods as that of the Plaintiff. The plea is that the Plaintiff's cone shaped trade dress is not the subject matter of the present suit and thereafter the plaint proceeds to set out the similarity in the packaging of the cone shaped trade dress. There is absence of specific pleading about specific products of the Defendants designed to pass off as that of the Plaintiffs.

49. The question to be asked as set out in ***Ruston & Hornsby Ltd vs The Zamindara Engineering Company [(1969) 2 SCC 727]*** is whether the Defendant is selling the goods so marked as to be designed or calculated to lead purchasers to believe that they are the Plaintiff's

goods. *Prima facie* comparison of the rival products set out in paragraph 35 of the plaint indicates dissimilarity in the packaging in which the rival products are vended. There is marked difference in the manner in which the Defendant is vending its products. There is variation in the colour scheme, packaging and the general look of the Defendant's packaging. The difference in physical appearances or the packaging plays a significant role in case of passing off. The differences are *prima facie* sufficient to distinguish the goods of the Defendant from that of the Plaintiff. Viewed thus, the Plaintiff has failed to make out *prima facie* case for passing off.

50. Though contention has been raised by Mr. Khandekar against grant of interim injunction on the ground of delay, laches and acquiescence, it is well settled that delay by itself is not sufficient as defense in an action for infringement and in so far as acquiescence is concerned it is necessary to show some positive act on part of the Plaintiff based on which the Defendant had altered its position. There is no such material which has been placed on record and therefore the contention on the ground of delay, laches and acquiescence fails.

51. In light of the above discussion, the Interim Application fails and stands dismissed.

[Sharmila U. Deshmukh, J.]

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