

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION NO. 1306 OF 2019
IN
COMMERCIAL IP SUIT NO. 769 OF 2019**

RPG Enterprises Limited

...Plaintiff

Versus

1. Riju Ghoshal

2. Poulami Ghoshal

.... Defendants

Mr. Hiren Kamod with Mr. Kunal Kanungo, Mr. Himanshu Deora and Mr. Prem Khullar I/by M/s. Cogito Legal, for the Plaintiff

Mr. P. Mukherjee, Senior Advocate I/by Mr. S.R.Pandey, for the Defendants

CORAM: S.J. KATHAWALLA, J.

RESERVED ON : 16th MARCH 2022

PRONOUNCED ON : 21st MARCH, 2022

JUDGMENT :

1. *"Some men do as much begrudge others a good name, as they want one themselves: and perhaps that is the reason of it."*

— William Penn.

2. The present suit is filed by the Plaintiff against the Defendants claiming infringement of its registered trade marks; infringement of copyright and passing off. Vide order dated 26th February 2019, the Leave Petition taken out by the Plaintiff under Clause XIV of the Letters Patent, Bombay for combining the cause of action for passing off with the cause of action for infringement of trade mark and copyright, has already been allowed.

3. The matter was heard at length in the past, when Mr. Hiren Kamod, the Ld. Counsel for the Plaintiff and Mr. P Mukherjee, Ld. Senior Advocate for the Defendant, made extensive submissions. The parties have also filed their respective Written Submissions. Since, because of the pandemic some time had lapsed, today the above Notice of Motion was once again kept for hearing. I have heard Mr. Kamod and Mr. Mukherjee in detail. They submit that their respective written submissions are exhaustive and include all of their respective contentions.

4. From a perusal of the entire record and after hearing the submissions, according to me, the moot question that requires consideration in the present case is whether the Defendants' use of the trade mark and/or trade name containing 'RPG' as its only leading, essential and prominent feature in respect of their services is likely to cause confusion or deception in the minds of the public so as to mistake or associate the same with the Plaintiff or the services offered by the Plaintiff under its RPG trade marks.

FACTS LEADING TO THE DISPUTE

5. The Plaintiff claims to be a multi-industry Indian conglomerate, consisting of over fifteen companies across core sectors of the economy. Over the years, the Plaintiff has diversified into various business fields with primary areas of businesses being tyres, infrastructure, information technology, pharmaceuticals, energy, senior care, e-commerce and plantations. The Plaintiff's history is traced back to 1900s through the Goenka Family, when the Goenka Family established themselves in diverse business sectors like banking, textiles, jute and tea. In 1950, the Goenka Family acquired two British trading houses - Duncan Brothers and Octavius Steel. After successful acquisitions in the areas of tea, automobile, tyre, jute, cotton textile and electric cables, Late Shri Keshav Prasad Goenka passed on his business empire to his three sons. One of the sons, Shri Rama Prasad Goenka, established RPG Enterprises in 1979 and initially encompassed Phillips Carbon Black, Asian Cables, Agarpara Jute and Murphy India companies.

6. According to the Plaintiff, in the year 1979, the Plaintiff honestly adopted the distinctive and unique trade mark RPG, i.e. an acronym derived from the initials of its founder, Mr. Rama Prasad Goenka, a known industrialist. Over the subsequent years, the Plaintiff and its group companies, have adopted various stylized / formative trade marks incorporating the mark RPG in respect of their various products and services. It is stated that Plaintiff has been actively involved in various charitable

endeavours through its trust viz. RPG Foundation and RPG Academy of Art and Culture and its activities have touched the lives of a significant population which enhances the brand value associated with RPG. Documents in respect of the above CSR activities are at Exhibit-F to the Plaintiff.

7. It is the Plaintiff's case that it has been using the aforesaid RPG Marks continuously, extensively and uninterruptedly in respect of its products and services, in the sense of a trade mark, trade name as well as trading style, and therefore, the mark RPG has become a source identifier of the Plaintiff and its goods / services thereunder. The Plaintiff has applied for and secured registration of several RPG / RPG formative marks in various classes under the Trade Marks Act, 1999. Documents pertaining to the Plaintiff's subsisting trade mark registrations in India are at Exhibits H1 to H17 to the Plaintiff. Documents pertaining to the trade mark registrations obtained by the Plaintiff in foreign jurisdictions for its RPG Marks are at Exhibit I to the Plaintiff.

8. In addition to the aforesaid trade mark registrations, the Plaintiff has also secured copyright registration in respect of the artistic work in its RPG Logo i.e.



. Documents pertaining to the copyright registration bearing Registration No. A-49373/88CO dated 30th June 1988 obtained by the Plaintiff in respect of its said RPG Logo are at Exhibit J to the Plaintiff. The Plaintiff claims to be the owner of various websites under the domain names, incorporating the trade mark

RPG. The said websites clearly and prominently display the Plaintiff's RPG Marks and these websites are interactive and easily accessible from anywhere in the world including in India, thereby increasing the popularity of the Plaintiff's RPG trade marks. Printouts of records in respect of the Plaintiff's websites from the popular website www.whois.com are at Exhibits K1 to K6 to the Plaint. Printouts of extracts from the Plaintiff's websites hosted under the aforesaid domain names are at Exhibits L1 to L6 to the Plaint. The Plaintiff is also active on popular social media websites such as Facebook, YouTube, Twitter and LinkedIn and has a substantial following on its Facebook and Twitter pages. Printouts of the pages from the Plaintiff's social media accounts are at Exhibit M to the Plaint. It is stated that the Plaintiff has effected large sales of its products and services bearing the RPG marks. The Plaintiff has generated over Rs.1140 Crores in sales revenues in India during the period 2011 to 2017. The Plaintiff has also expended substantial sums on the advertisement and promotion of its goods and services under the RPG marks. The Plaintiff also exports its goods bearing the RPG marks to various countries including but not limited to Brazil, Argentina, Mexico, Canada, UK, Iran, Indonesia, Malaysia, Saudi Arabia, Egypt, France and Germany. Plaintiff's Import Export Code and the other relevant certification regarding export are at Exhibit Q to the Plaint.

9. It is the Plaintiff's case that its trade mark RPG / RPG Marks are inherently distinctive and have also acquired a higher degree of distinctiveness owing

to the continuous, extensive and uninterrupted use and promotion of the said trade marks in India as well as in various countries around the world. By virtue of such use, the Plaintiff's RPG marks have come to acquire a secondary meaning to connote to the public the goods and / or services emanating from the Plaintiff and none else.

10. According to the Plaintiff, in or around the last week of October 2017, the Plaintiff became aware of trade mark application bearing No.3536173 in Class 35



for the mark , applied for in the name of "Riju Ghoshal trading as RPG Opticals" i.e. the Defendant No. 1. The Plaintiff immediately filed an Opposition Application before the Trade Marks Registry and which is presently pending before the Trade Marks Registry. Copies of the Defendant's application and Opposition proceedings are at Exhibit-V to the Plaintiff. Further, in or about May 2018, the



Plaintiff came to know about the trade mark registration  bearing No.3536174 in Class 44 in the name of "Poulami Ghoshal trading as RPG PHARMACY" i.e. the Defendant No. 2. The Plaintiff immediately filed a Rectification Application bearing NO.42/2018/TM/KOL/ORR/6316 before the IPAB for rectification of the Register of Trade Marks and removal of Defendant No.2's impugned trade mark registration. The said Rectification Application is presently pending. Trade Mark Registration Certificate and other documents pertaining to

Defendant No.2's impugned trade mark registration bearing No.3536174 in Class 44 are at Exhibit X to the Plaint. Copy of the Rectification Petition filed by the Plaintiff before the IPAB in respect of the impugned trade mark registration is at Exhibit Y to the Plaint.

11. According to the Plaintiff, in or about December 2018, the Plaintiff learnt that the Defendants had placed advertisement hoardings bearing the impugned trade marks on the road connecting to the Defendants' shops in Kolkata. Photographs of the impugned hoardings are at Exhibit B2 to the Plaint. The said photographs are reproduced hereinbelow :



Upon discovering the hoardings, the Plaintiff learnt that the Defendants were related to one another. The Plaintiff, thereafter, conducted an investigation which revealed that the Defendant Nos.1 and 2, were a married couple jointly operating and managing the impugned businesses i.e. RPG Pharmacy and RPG Opticals, bearing the impugned trade marks from a common address i.e. 565, Diamond Harbour Road, Kolkata-

700063. The Defendants have also registered the domain names <http://www.rpgpharmacy.com/> and <http://www.rpgopticals.com>, incorporating the mark RPG, in the name of one “GBC Infrastructure”. Pertinently, the Defendant No.1 is director and Defendant No.2 is the Chief Executive Officer of one GBC Infrastructure Private Limited. Printouts of records in respect of the Defendants’ said domain names from the popular website www.whois.com are at Exhibits Z1 and Z2 to the Plaint. Printouts of extracts from the Plaintiff’s websites hosted under the aforesaid domain names are at Exhibits AA1 and AA2 to the Plaint. The Plaintiff’s representative visited the Defendants’ business premises’ where he purchased a few products. The storage case and the microfiber cloth provided with the sunglasses, both, bear the impugned mark RPG. Further the Defendants’ employees working in the Defendants’ shops wear shirts bearing the impugned mark RPG. Photographs of the products purchased by the Plaintiffs’ representative from the Defendants’ shops are at Exhibit B2 to the Plaint. A photograph of the Defendants’ employee wearing a T-shirt bearing the impugned trade mark RPG is reproduced hereunder:



PLAINTIFF'S SUBMISSIONS

12. Mr. Kamod submitted that the Plaintiff has a long standing goodwill and reputation and due to its extensive and continuous use of the RPG Marks throughout India and abroad, the Plaintiff has acquired substantial and valuable reputation and goodwill in the RPG marks. He submitted that the Plaintiff has the exclusive right to use the RPG Marks and owing to the diversified business of the Plaintiff and the substantial investment that the Plaintiff makes in supporting and sponsoring diverse activities, such recognition, reputation and goodwill of the Plaintiff in respect of its RPG Marks is no longer restricted to any particular class of goods and/ or services but is associated with and used by the Plaintiff across a diverse range of categories. He submitted that Plaintiff's mark deserves to be considered as a well-know trade mark since according to the Plaintiff, its RPG mark satisfies all the parameters required to be fulfilled for a mark to be recognized as a well-known trade mark.

12.1 Mr. Kamod submitted that the Defendants' marks

 and  are visually, structurally, phonetically identical with and/ or deceptively similar to the Plaintiff's prior **RPG** Marks in each and every aspect. He submitted that the only distinctive and prominent element in the Defendant's mark is RPG and the remaining terms/ elements in the impugned marks namely- 'Opticals'/ 'Perfect Look. Perfect Vision' and 'Pharmacy'/'

‘Your health is our world’ are descriptive of the concerned services covered thereunder and/ or non-distinctive.

12.2 He submitted that the Defendants’ services, namely advertisement, wholesale, retail of optical lenses, sunglass, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products rendered under the trade

mark/name  and pharmacy services, pharmacy advice, pharmacy dispensary services rendered under the trade mark/name

 by the Defendants are also cognate and related to the goods and/ or services in respect of which the Plaintiff’s prior and famous RPG Marks are used and/ or registered. He submitted that the adoption and/or use of the impugned marks by the Defendants, is likely to cause confusion and deception in the minds of the consumer and/or members of the relevant trade. Such consumers are likely to be misled into assuming that the services of the Defendants originate from the Plaintiff, when they do not, and/or that the services of the Defendants are in some way endorsed, licensed by, affiliated with and/or connected with the Plaintiff, when no such connection exists.

12.3 He further submitted that since the Plaintiff has been actively engaged in various business sectors in India and abroad under the RPG marks since 1979 which is almost 37 years before the Defendants’ alleged adoption of the impugned marks

coupled with the extensive use, promotional efforts and the extent of Plaintiff's diverse business operations throughout India and abroad, it is impossible that the Defendants were not aware of the Plaintiff's prior and famous RPG Marks when it chose to adopt the impugned marks- RPG Pharmacy and RPG Opticals. Therefore, the adoption itself of the impugned marks by the Defendants is dishonest and inspired by the malafide intention to ride upon and encash the enormous goodwill and reputation enjoyed by the Plaintiff throughout India, in diverse business sectors. He submitted that the adoption and use of the identical and deceptively similar impugned marks by the Defendants is without due cause and takes undue advantage of and/or is detrimental to the distinctive character and/or repute of the Plaintiff's prior, famous and registered **RPG Marks**.

12.4 Mr. Kamod submits that the adoption and use of the impugned marks by the Defendants also amounts to passing off. The Defendants are using the impugned marks in relation to services (namely retailing of optical and pharmacy shop) which are related and cognate to the goods and/or services for which the Plaintiff has used its earlier and well-known RPG Marks and for which the Plaintiff has acquired immense goodwill and reputation. Mr. Kamod further submits that the use by the Defendants of the identical impugned marks to that of the Plaintiff's prior and well-known RPG Marks dilutes and is bound to continue to dilute the distinctive character of the Plaintiff's prior and famous RPG Marks. It follows that the distinctive character of the

Plaintiff's RPG Marks are likely to be eroded. Such debasement and erosion of the Plaintiff's reputation and goodwill strikes at the very root of the Plaintiff's existence. He submits that in any event, common field of activity is no more a relevant criteria for grant of injunction in terms of passing off and even if the Court holds that the rival fields of activities are not the same, the same should not come in the way of the Plaintiff's prayer for injunction in terms of passing off.

12.5 He submits that the Defendants' use of RPG as a part of the impugned domain names (www.rpgpharmacy.com and www.rpgopticals.com) also amounts to infringement and passing off since the Plaintiff maintains various active websites under the domain names incorporating its prior and famous trade mark RPG, *inter alia*, www.rpggroup.com, www.rpg.in, www.rpglifesciences.com, www.kecrpg.com, www.rpgcables.com and www.raychemrpg.com. A person accessing the websites of the Defendants is likely to believe that these websites and the services mentioned thereon are associated and/ or connected and/or endorsed and/or emanating from the Plaintiff.

12.6 Mr. Kamod relied upon the following judgements to support his contentions-

- (i) Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd.¹;
- (ii) Midas Hygiene Industries P. Ltd. and Anr. Vs Sudhir Bhatia and Ors.²

¹ 2004 (28) PTC 566 SC

² 2004 (28) PTC 121 SC

- (iii) Mac Personal Care Pvt. Ltd. & Anr. Vs. Laverana GMBH and Co. KG & Anr.³
- (iv) Laxmikant V. Patel vs. Chetanbhat Shah and Anr.⁴
- (v) Ruston and Hornsby Ltd. Vs. Zamindara Engineering Co.⁵
- (vi) Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited⁶;
- (vii) Kantilal Premji Maru Vs. Madan Kumar⁷
- (viii) Kirloskar Diesel Recon Pvt. Ltd. and Ors. Vs. Kirloskar Proprietary Ltd. and Ors.⁸
- (ix) FDC Limited Vs. Docsuggest Healthcare Services Pvt. Ltd. & Anr.⁹
- (x) Manu Kagliwal and Ors. Vs. Mayo Foundation for Medical Education and Research¹⁰
- (xi) Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd.¹¹
- (xii) Sony Kabushiki Kaisha Vs. Mahaluxmi Textile Mills¹²
- (xiii) Larsen and Toubro Limited Vs. Lachmi Narain Trades and Ors.¹³
- (xiv) KSB Properties Private Limited Vs. KSB Aktiengesellschaft and Ors.¹⁴
- (xv) H&M Hennes & Mauritz AB and Ors. Vs. HM Megabrands Pvt.Ltd. and LRS¹⁵

3 2016 (65) PTC 357

4 AIR 2002 SC 275

5 (1969) 2 SCC 727;

6 2014 (57) PTC 617 (Bom.)

7 2018 (75) PTC 81 (Bom.)

8 AIR 1996 Bom. 149

9 2017 (69) PTC 218

10 USA 2018 (2) MhL.J. 720

11 (2002) 2 SCC 147

12 2009 (41) PTC 184 (Cal)

13 149 (2008) DLT 46

14 (2013) 1 CALLT 203 (HC)

15 251 (2018) DLT 651

(xvi) Kalpataru Properties Private Limited and Ors. Vs. Kalpataru Hospitality and Facility Management Services (P) Limited¹⁶.

DEFENDANT’S SUBMISSIONS

13. Mr. P. Mukherjee, Senior Advocate, appearing on behalf of the Defendants raised the following defenses:

13.1 Sole Proprietary concerns – Localized operations: The Defendants, Riju Ghosal and Poulami Ghosal, are husband-wife and are sole proprietors of their respective retail businesses. The Defendants have growing business concerns which are operating in West Bengal and have no operations outside the State of West Bengal. Riju Ghosal – Defendant No.1 has two shops in Kolkata under the name ‘RPG Opticals’. Poulami Ghosal – Defendant No. 2 has two shops in Kolkata under the name RPG Pharmacy.

13.2 Rival trade marks/labels/names are different: The Defendants’ marks



and



are different from the Plaintiff’s RPG

Marks. Defendants’ marks are logo marks whereas the Plaintiff’s marks are ‘word marks’ and ‘logo mark’; Defendants’ impugned marks are combination of the words ‘RPG’ + “Opticals”/“Pharmacy”. Defendant No. 1 and 2’s impugned marks also include the taglines “PERFECT LOOK PERFECT VISION” and “YOUR HEALTH

¹⁶ 2011 (7) ALL MR 579

IS OUR WORLD”, respectively. The tagline attached with the Defendants’ marks are inherently distinctive and/or creative and when the same are used along with the logo marks of the Defendants, respectively, they clearly stand out as a distinctive marks which have no similarity with any of the trade marks of the Plaintiff. The font, colour scheme and stylization of the Defendants’ logo marks are different from the Plaintiff’s RPG Logo and other RPG Marks.

13.3 Goods/services are different: the Defendants have claimed that they are using the impugned marks in respect of services (i.e. ‘RPG Opticals’ in respect of the services falling in class 35 namely- advertisement, wholesale, retail of Optical lenses, sunglass, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products, and ‘RPG Pharmacy’ in respect of the services falling in class 44 namely- pharmacy services, pharmacy advice, pharmacy dispensary services), that they are not manufacturing or supplying any goods under their trade marks and that the Defendants are not manufacturers, but only retailers. In contrast, the Plaintiff is manufacturing goods under its RPG Marks. The Defendants have filed their respective applications in classes 35 and 44 and the Plaintiff has no registration for the service category. Plaintiff has peripheral activity as a manufacturer of Active Pharmaceutical Ingredients (API) through RPG Life Sciences but such goods are never sold through pharmacy retail channels and they are only sold to drug manufacturers as raw materials and therefore, there is no common field of activity.

13.4 The 'logo marks' of the Defendants are distinct, having different fonts, visual and phonetic impression than that of 'word mark' of the Plaintiff and there cannot be any confusion in the minds of the consumers more when the Defendants only provide service in Classes 35 and 44 whereas the Plaintiff is registered owners of the trademarks for 'manufacturing of goods' falling in Classes 05, 09, 12, 16 and 30. The Defendants submit that there cannot be any dissection (splitting up) of a 'logo mark' in order to contend passing off or infringement of any word mark since a man of ordinary prudence considers the pictorial depiction of the 'logo mark' and that there is no deceptive similarity or likelihood of confusion in the minds of an ordinary consumer, more particularly when the Plaintiff has never stated in its application that it renders any 'service' or 'goods' in retail sale under the trade mark 'RPG'.

13.5 This Court should not encourage monopoly of a 'word mark' when the trade mark registration classes are distinct and different.

13.6 The adoption of the mark/name RPG Optical and RPG Pharmacy is honest. RPG comes from the first letter of the name of the Defendant No.1 (Riju); first letter of the name of Defendant No. 2 (Poulami) and first letter of the surname of both the Defendants (Ghoshal), i.e.- **R**iju + **P**oulami + **G**hoshal = **RPG**. Defendants' use of RPG is therefore protected under Section 35 of the Act. The Defendants are justified in coining the trade name followed with the generic word describing the services offered by them as composite logo marks.

13.7 The use of RPG as a trade name: the Defendants are using their marks ‘RPG Opticals’ and ‘RPG Pharmacy’ only as a trade name and they are not selling any goods under the mark RPG. The use by the Defendants of the expression RPG is found only in the trading name and hence the Plaintiff has to prove infringement, if any, under Section 29(5) of the Trade Marks Act, 1999. That, for infringement of a registered trade mark by use as a trade name, the goods in which the Defendant is dealing have to be ‘same/ identical’ and not ‘similar’, which is not the case herein, since the Plaintiff has no registration for the RPG Marks in classes 35 and 44.

13.8 Mis-joinder and non-joinder of parties: the Defendants have been wrongly impleaded in the present suit and the suit is defective on the ground of mis-joinder and non-joinder of parties.

13.9 The Plaintiff has not set up its case for infringement under Section 29(4) of the Act. Plaintiff’s trade mark ‘RPG’ is neither a well-known trade mark, nor has it acquired any secondary meaning. ‘RPG’ is not a household name for any products or services as claimed by the Plaintiff. The Supreme Court in the case of *Nandhini Deluxe vs. Karnataka Co-operative MilkProducers Federation Ltd.*¹⁷, held that a proprietor of a trade mark cannot enjoy monopoly over the entire class of goods when he is not using the said trade mark in respect of certain goods falling under the same class.

17 2018(9) SCC 183

13.10 Defendants have also registered domain names, i.e. www.rpgpharmacy.com and www.rpgopticals.com, however, they are only for the purpose of providing information concerning the establishment of the Defendants and the Defendants do not provide any service through such domain name. Therefore, mentioning of the domain name in the context of allegation of trade mark infringement is out of place, baseless and do not have any bearing to the controversy in issue.

13.11 Defendant No. 2 is the registered proprietor of the trade mark



under No. 3536174 in respect of “*Pharmacy services, pharmacy advice, Pharmacy dispensary services*” and therefore its use is protected by virtue of registration. The use by the Defendant No.2 of its registered trade mark in respect of the services covered thereunder do not amount to infringement of the Plaintiff’s registered trade marks.

13.12 Some of the Plaintiff’s marks including the mark  are “proposed to be used”. Whereas the Defendants herein are already using their respective marks since 2016 in a bonafide manner without any interruption.

13.13 Mr. P. Mukherjee has relied upon the following judgements to support his contentions on behalf the Defendants-

- (i) Cipla Limited Vs. Cipla Industries Private Limited¹⁸
- (ii) Nandhini Deluxe (supra) - Para- 2, 3, 30, 31, 32, 33 and 34;
- (iii) People Interactive (India) Private Limited Vs. Vivek Pahwa and Ors.¹⁹
- (iv) Raymond Limited Vs. Raymond Pharmaceuticals Pvt. Ltd.²⁰
- (v) Raymond Limited Vs. Raymond Pharmaceuticals Pvt. Ltd.²¹
- (vi) Reliance Industries Ltd. Vs. Concord Enviro Systems Pvt. Ltd.²²
- (vii) Uniply Industries Ltd. Vs. Unicorn Plywood Pvt. Ltd.²³

PLAINTIFF'S SUBMISSIONS IN REJOINDER

14. Mr. Kamod has made the following submissions in rejoinder -

14.1 With regards to the Defendants' argument of 'the rival marks are different', Mr. Kamod submits that the said argument is misconceived, unsustainable and liable to be rejected for the reasons that:

- (a) Plaintiff has been using its famous trade mark RPG in a standalone manner as well as in conjunction with its other trade marks and is also used as an essential part of its corporate name.
- (b) During its long history, the Plaintiff has adopted various trademarks incorporating its famous trademark RPG, including but not limited to RPG LIFE,

18 2017 (69) PTC 425 (Bom) paras 1 to 3, 6, 21 to 27, 30 to 32, 39 and 43

19 2016 (68) PTC 509 Bom. Paras 24, 25, 26, 29 to 33.

20 2010 (44) PTC 25 (Bom) paras 6, 12, 13 and 14.

21 2016 SCC Online Bom. 5159 paras 54 to 79

22 2016 (67) PTC 217 (Bom.) para 5 to 23

23 2001 (21) PTC 417 (SC) paras 6 to 9

RPG LIFE SCIENCES, RPG LIFE SCIENCES LIMITED, RPG PHARMACEUTICALS, RPG LIFE SCIENCES DIRECT, RPG LIFE SCIENCES GENERIC, RPG LIFE SCIENCES GENERIC PLUS, RPG LIFE SCIENCES PLUS, RPG LIFE SCIENCES CARE, etc. The Plaintiff has an entire family of RPG based formative marks and owing to this fact whenever the trade mark RPG is used in conjunction with any prefix or suffix, the general public assumes that it belongs to the Plaintiff. The trade mark RPG has become the source identifier of the Plaintiff and is solely associated with the Plaintiff.

(c) Plaintiff's prior mark RPG is completely incorporated in the impugned marks. The most prominent portion of the impugned marks is RPG which is the trade mark of the Plaintiff herein. There is nothing distinctive about the impugned marks-

RPG Opticals/  and RPG Pharmacy/ , except the term RPG. As per the Defendants' own admission, the remaining portion of the impugned marks is merely descriptive of the alleged services being provided by the Defendants, i.e. the suffix "Opticals" and "Pharmacy" signify that the concerned entity operates an optical shop or a pharmacy.

(d) The addition of the suffix Opticals/ Pharmacy to the word 'RPG' which is identical to the Plaintiff's trade mark RPG only connotes that the offending business entities 'RPG Opticals' and 'RPG Pharmacy' are in some way connected, associated

and/or endorsed by the Plaintiff, when no such connection exist. Further, the alleged taglines are also descriptive/indicative of the concerned offending services provided by the Defendants and also, do not form prominent part of the impugned marks.

(e) Mr. Kamod has relied on *Ruston and Hornsby (supra) Para 5, 7 & 8; Pidilite Industries (supra) (Para 8, 10, 11, 15, 16, 21)* and *Kantilal Premji (supra)* to contend that while comparing the two rival marks the prominent and distinctive features of the marks are required to be compared.

14.2 Further, as regards the arguments on difference in goods/services, Mr. Kamod submits that:

(a) Plaintiff has registration for the RPG Marks (namely RPG Logo and RPG formative marks) in class 5 for pharmaceutical preparations and is engaged in the manufacturing and selling of pharmaceutical preparations and the Defendants are allegedly operating a pharmacy shop engaged in the sale of medicines/ pharmaceutical preparations. Therefore, the Defendants' offending activities under the impugned mark RPG Pharmacy are directly overlapping with the Plaintiff's business interests and both the business activities relates to the same field, i.e. medical field. The same customers are likely to buy the Plaintiff's products under the RPG Marks and will also avail the offending services of the Defendants under the impugned mark- RPG Pharmacy.

(b) Further, regarding the Defendants' offending services under RPG

Opticals, Mr. Kamod submits that the Plaintiff has business interest in the optical sector as well based on the following- (1) the Plaintiff's Flagship CSR program NETRANJALI is focused on Preventive, Rehabilitative and Curative Eye Care interventions ranging from children to elderly; (2) similarly, the Plaintiff's group company- RPG Life Sciences, manufactures and supplies various eye care products such as *Cmvee* tablets, etc.; and (3) Plaintiff owns registration for its RPG Logo in class 09 (i.e. the class in which the optical and related goods fall). Therefore, the Defendants' offending activities under the impugned mark RPG Optical are overlapping with the Plaintiff's said business interests.

(c) In support of the above contentions, Mr. Kamod has relied upon the judgments **(i) Allied Auto Accessories Ltd. Vs. Allied Motors Pvt. Ltd. and Ors.,²⁴**; **(ii) Kirloskar (*supra*) (Para-12, 13, 14, 15, 16)**; **(iii) FDC Limited (*supra*) (Para-47, 48, 49, 50, 51, 52, 56, 57, 60)**; and **(iv) Manu Kagliwal (*supra*) (Para 18, 19, 20, 21).**

(d) Mr. Kamod further submits the Plaintiff's RPG Marks, being well-known trade marks, are also liable to be protected in respect of different goods and/or services as well, *inter alia*, under Section 29(4) of the Trade Marks Act, 1999 and given the extensive business operations and goods/ services provided under the trade mark RPG, the Plaintiff's prior and famous RPG Marks satisfy all the requirements for

24 2003 (27) PTC 115 (Bom) paras 22, 31, 33, 34, 41

seeking protection under Section 29(4) of the Act. He placed reliance upon- ***Sony Kabushiki Kaisha Vs. Mahaluxmi Textile Mills***²⁵ and ***Mahendra & Mahendra Paper Mills Ltd. vs. Mahindra & Mahindra Ltd.***²⁶. He submits that it is not a legal requirement that for setting up a case under Section 29(4) of the Act, the Plaintiff's trade mark must be recorded in the list of well-known trade marks and only then the Plaintiff can seek protection under Section 29(4). He relied upon the definition of well-known trade mark in Section 2(zg) and provisions contained in Sections 11(6), 11(7) and 29(4) of the Act to contend that the expression 'well-known' trade mark is not used in Section 29(4) of the Act and the said provision only uses the word 'reputation'. He submits that this Court is empowered to consider even at the interim stage, the well-known status of the Plaintiff's trade mark RPG, given the extensive evidence of use and promotion material filed by the Plaintiff in the present proceedings.

(e) Mr. Kamod submits that the explanation given by the Defendants for adoption of RPG is *malafide* and a clear afterthought. The Defendants' conduct of adopting the initials of their names in the manner that it forms RPG, cannot be termed as honest adoption. The fact that the Defendants came up with the combination of three alphabets and that too, in an identical sequence, speaks volumes about their *malafide* intention to adopt an identical mark RPG. Going by their explanation, the

²⁵ 2009 (41) PTC 184 (Cal)

²⁶ (2002) 2 SCC 147

Defendants could have adopted “RGPG” for that matter. The fact that the Defendants came up only with RPG, it is clear that this is a clever attempt to ride upon the hard earned goodwill and reputation of the Plaintiff. Moreover, the Defendants are coming up with this explanation for the first time and no such explanation was given before the Registrar of Trade Marks in the Opposition Proceedings pertaining to the



“ ” Logo. In support of these contentions, Mr. Kamod relied upon the judgments in *(i) Larsen and Toubro (supra) 149(2008)DLT46*; *(ii) KSB Properties (supra)*, and *(iii) H&M Hennes & Mauritz (supra)*. It is a settled principle of law that when the adoption itself is *malafide* and dishonest, no amount of subsequent use can purify an act, which was dishonest since its inception. Mr. Kamod placed reliance upon the judgments in *(i) Midas Hygiene Industries (supra) (Para-5)*; *(ii) KSB Properties (supra)*; *(iii) Mac Personal (supra) (Para- 30 & 31)*.

(f) Mr. Kamod further contended that the Defendants’ argument regarding Section 29(5) of the Act and in this regard reliance on the judgement of the Full Bench of this Court in *Cipla(supra)* is misconceived and liable to be rejected as the Defendants are using the impugned mark RPG as a trade mark/ service mark/ trading style/ domain name (and not merely as a trading name); Defendants have applied for trade mark registrations for the impugned marks and in such case the Defendants cannot argue that the impugned marks are only being used as trading names; the

Plaintiff has valuable common law rights in and to its RPG Marks and in an action for passing off the manner of use, whether as a trade mark or a trade name, is totally irrelevant; the Plaintiff's trade mark RPG has achieved the status of a well-known trade mark and is therefore, liable to be protected in respect of trade name use by third parties, including the present Defendants.

14.3 As regards the Defendant No. 2's registration for RPG Pharmacy Logo, Mr. Kamod submits that the registration is no defence to an action for passing off based on common law rights. A passing-off action emanates from common law and not from statutory provisions. He placed reliance upon the judgment of the Supreme Court in the case of **S. Syed Mohideen v. P. Sulochana Bai**²⁷. He submits that the Defendant has obtained the registration wrongly and prior to initiating the present proceedings, the Plaintiff has already filed the appropriate action for rectification of the Defendant No. 2's registration No. 3536174 before the IPAB, which is presently pending. He submits that the present case is a fit case for this Court to exercise its discretion to go behind the Defendant No.2's trade mark registration bearing registration No. 3536174 at the *interim* stage. Mr. Kamod placed reliance upon the judgment of the Full Bench on this Court in **Lupin Ltd. vs. Johson and Johnson**²⁸.

14.4 Mr. Kamod further submits that the Defendants' argument that their use of the mark RPG is protected under Section 35 of the Act is completely misplaced

²⁷ 2015 (7) SCALE 136

²⁸ 2015 (61) PTC 1 (Bom.)

and unsustainable, since the Defendants have not chosen to do business under their names but they are using the initials in the form of RPG in respect of their offending business activities. Even otherwise, the Defendants are not entitled to protection since Section 35 applies only in case of 'bonafide user' and the Defendants' adoption of the impugned marks is not bonafide in the present case.

OBSERVATIONS / FINDINGS

15. This is an action for infringement of trade mark, copyright and passing off. Generally, in these kind of matters, if a case for infringement of trade mark is made out and injunction in terms of the cause of action for infringement is granted, the same fate follows even for the cause of action for passing off. More often than not, if reliefs are granted in terms of one cause of action then the same also follows for the other cause of action as the issues involved in both the cause of actions are intrinsically connected to each other. However, there is every possibility that in a given case, an action for infringement of a registered trade mark may succeed on the same facts while a passing-off action may fail or vice versa i.e. an action for passing off may succeed while on the same facts, an infringement action may fail. The reasons for the same can be many which would depend upon facts and circumstances of each case. For the reasons stated in the subsequent paragraphs of this order, I have held that (i) the Plaintiff has made out a case for infringement of its RPG trade marks in relation to the

use of the impugned trade marks RPG OPTICALS/  ; RPG

PHARMACY/  and the impugned domain names

www.rpgpharmacy.com and www.rpgopticals.com by the Defendants; (ii) the Plaintiff

has not made out a case under Section 29(5) for infringement of its RPG trade marks

in relation to the use of the trading names RPG Opticals and RPG Pharmacy by the

Defendants; (iii) the Plaintiff has made out a case for passing off for the impugned

marks of the Defendants RPG OPTICALS/  ; RPG PHARMACY/



, the impugned domain names www.rpgpharmacy.com and www.rpgopticals.com, as also the trading names 'RPG Pharmacy' and 'RPG Opticals'.

RIGHTS OF THE PLAINTIFF IN 'RPG' MARKS - WHETHER WELL-KNOWN?

16. The Plaintiff has adopted the trade mark **RPG** (i.e. an acronym derived from the name of its founder- **R**ama **P**rasad **G**oenka) in the year 1979. The Supreme Court, in the case of *Laxmikant Patel (supra)* has held that a mark includes amongst other things a 'name' or a 'word' also; and 'name' would include any abbreviation of a name. In fact, the said position also becomes clear from the definition of the terms

‘trade mark’, ‘mark’ and ‘name’ as provided in the Trade Marks Act, 1999 which are reproduced hereinbelow:

“Section 2 - Definitions and interpretation

(1) In this Act, unless the context otherwise requires,--

(m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

(o) "name" includes any abbreviation of a name;

(zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and-

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;”

17. It is clear from the above definitions that a trade mark includes a mark; mark includes a name; and a name includes an abbreviation of the name. Hence, RPG which is an abbreviation of ‘R.P.Goenka’ is a trade mark within the meaning of the Trade Marks Act, 1999 and is entitled to protection. This is not the first time that abbreviation is being sought to be protected in Court. The reference may be made to *Larsen and Toubro Limited (supra)*; *KSB Properties (supra)*; *H&M Hennes & Mauritz AB (supra)*. In all of these cases, the acronym marks were under

consideration by the Courts and the Courts have given protection to the acronym marks. In the present case, the Plaintiff's trade mark RPG is a natural acronym derived from the name of its founder Rama Prasad Goenka, who was a renowned industrialist in India.

18. The Plaintiff has filed considerable documentary evidence in support of its claim that the trade mark 'RPG' is distinctive of the Plaintiff's goods and business and is exclusively associated with the Plaintiff. The Plaintiff is a multi-industry Indian conglomerate consisting of several companies across core sectors of the economy with a turnover of more than Rs. 255 Billion (US\$ 3.5 Billion). The Plaintiff, through its subsidiaries, operates in tyres, information technology, infrastructure, pharmaceuticals, Electric Power Transmission tower, Power Transmission Engineering, Procurement and Construction (EPC), Railway signalling, Cable, Solar, civil and engineering, energy, properties, and plantation businesses in India and internationally. The Plaintiff has *inter alia* annexed and relied upon the following documents:

Sr. No.	Particulars of evidence filed by Plaintiff with the plaint	Exhibit No.
1.	Evidence showing the history and growth of its business under the RPG brand and also, showing the extensive use of its prior and well-known RPG Marks	C & G
2.	Documents pertaining to its various subsidiaries/ group companies operating in diverse business sectors	D1 to D16

3.	Evidence pertaining to its pharmaceutical business company- RPG LIFE SCIENCES LIMITED	E
4.	Evidence pertaining to extensive Corporate Social Responsibility (CSR) initiatives undertaken by the Plaintiff	F
5.	CA certificate in support of the extensive sale figures of Plaintiff's pharmaceutical business segment- RPG Life Sciences Limited	N
6.	Copies of some invoices pertaining to the sale of its products under the RPG Marks	O
7.	Various promotional and advertising material	P
8.	Whois (an internet service, used to look up information about a domain name) extracts showing the Plaintiff's ownership for the domain names- www.rpggroup.com , www.rpg.in , www.rpglifesciences.com , www.kecrpg.com , www.rpgcables.com and www.raychemrpg.com .	K1 to K6
9.	Extracts from the Plaintiff's websites showing extensive use of the RPG Marks on the internet	L1 to L6
10.	Extracts from the Plaintiff's social media pages/ accounts showing its various activities and popularity on the social media platforms.	M
11.	Documents pertaining to its export business and also, certificates received from government departments in foreign jurisdictions ('Good Manufacturing Practice' certificate issued by European Union and "ICH Good Manufacturing Practice Guide for Active Pharmaceutical Ingredient" certificate issued by the Department of Health and Ageing Therapeutic Goods Administration, Government of Australia)	Q, R1 & R2
12.	Certificates pertaining to the awards and recognition received by the Plaintiff	S
13.	Copy of the interim order dated January 10, 2018 passed by Delhi High Court in Suit CS (Comm.) No.21 of 2018 in favour of the Plaintiff	T

14.	Some orders issued by the Registrar of Trade Marks pertaining to successful opposition proceedings initiated by the Plaintiff	U
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19. Some of the RPG formative marks as adopted by the Plaintiff are reproduced below:

- a)  ,
- b)  ,
- c) RPG Life,
- d) RPG Life Sciences,
- e) RPG Pharmaceuticals,
- f) RPG Life Sciences Limited,
- g) RPG Life Sciences Direct,
- h) RPG Life Sciences Generic,
- i) RPG Life Sciences Generic Plus,
- j)  , and
- k)  .

20. Some of the Plaintiff's charitable endeavours through its trust viz. RPG Foundation and RPG Academy of Art and Culture activities are as follows:

- (i) RPG Foundation Netranjali;
- (ii) RPG Foundation Swayam;
- (iii) RPG Foundation Pehlay Akshar;
- (iv) RPG Foundation Saksham; and
- (v) RPG Foundation Jeevan.

21. The Plaintiff has secured registration of several RPG / RPG formative marks in various classes under the Trade Marks Act, 1999. Details of some of the Plaintiff's registered trade marks are reproduced below:

Sr. No.	Trade Mark	Reg. No.	Class	Date of Registration
1.		2083063	05	11 th January 2011
2.	RPG Life	2409620	05	11 th October 2012
3.	RPG Life Sciences	2409621	05	11 th October 2012
4.	RPG Pharmaceuticals	2409622	05	11 th October 2012
5.	RPG LIFE SCIENCES LIMITED	2409623	05	11 th October 2012
6.		3549247	05	15 th May 2017
7.		3549248	05	15 th May 2017
8.	RPG LIFE SCIENCES DIRECT	3571200	05	15 th June 2017
9.	RPG LIFE SCIENCES GENERIC	3571201	05	15 th June 2017
10.	RPG LIFE SCIENCES GENERIC PLUS	3571202	05	15 th June 2017
11.	RPG LIFE SCIENCES PLUS	3571203	05	15 th June 2017
12.	RPG LIFE SCIENCES CARE	3571204	05	15 th June 2017
13.		851098	09	13 th April 1999
14.		2083064	09	11 th January 2011

15.		850255	12	8 th April 1999
16.		850256	16	8 th April 1999
17.		2083065	30	11 th January 2011

22. Details of some of the registrations secured by the Plaintiff in respect of its RPG Marks in foreign jurisdictions are mentioned below:

S. No	Mark	Reg. No.	Class	Country
1.		T99015371	9	Singapore
2.		2008/039324	12	Nepal
3.		4-1999-009171	12	Philippines
4.		35971	12	Vietnam
5.		62470	12	Bangladesh
6.		94994	12	Sri Lanka

23. In addition to the aforesaid trade mark registrations, the Plaintiff has also secured copyright registration comprised in its artistic work / RPG Logo i.e.



bearing Registration No. A-49373/88CO dated 30th June 1988.

24. The following is the list of the Plaintiff's domain names incorporating the trade mark RPG:

- www.rpggroup.com,
- www.rpg.in,
- www.rpglifesciences.com,
- www.kecrpg.com,
- www.rpgcables.com, and
- www.raychemrpg.com.

25. The Plaintiff's sales revenues in India for the period 2011-2017 was in excess of Rs. 1140 Crores. The details of the sales generated and promotional expenses undertaken by the RPG Life Sciences in respect of pharmaceutical business are as follows:

Financial Year	Sales figures of RPG Life Sciences (In Crores)	Advertisement figures (In Crores)
2017	298.46	0.07
2016	274.54	0.07
2015	233.08	0.05
2014	229.36	0.11
2013	216.21	0.09
2012	189.23	0.05
2011	184.67	0.08
2010	159.85	0.03
2009	140.47	0.06
2008	127.72	0.03

26. As per Plaintiff, RPG Life Sciences' products have been well received both in the domestic market as well as the international markets and it also has the distinction of being the only company in India manufacturing and marketing

cyclosporine, a critical organ transplant medicine, using the novel fermentation technology. The Plaintiff claims it is a pioneer and a leader in several core sectors including in the pharmaceutical sector, through RPG Life Sciences and the trade mark **RPG** not only forms integral part of its trade name but also being used extensively for

the life sciences division in the following manner- RPG Life Sciences/ 

and/or  .

27. The documentary evidence filed by the Plaintiff *prima facie* supports the extensive use, promotion and diverse business operations of the Plaintiff under the trademarks RPG and establishes the prior use of the trademark RPG by the Plaintiff. The Plaintiff has also relied upon favourable decisions from Court/ Tribunals in favour of the Plaintiff, which supports the Plaintiff's claim that it has been enforcing its rights against the infringers/ offenders misusing the Plaintiff's prior and registered RPG Marks. It is clear that RPG trade mark is used by the Plaintiff in different forms - trademark, part of corporate/trade name, domain name. Further, RPG is the house mark of the Plaintiff and is used by its group companies in respect of their business/ goods and/ or services. Further, the Plaintiff has business interest in diverse sectors of the economy and has extensive and diverse business operations under the RPG Marks,

as has been shown in the plaint and supported by extensive evidence. It is thus *prima facie* established that the Plaintiff's RPG marks have acquired the status of a well-known trade mark and the Plaintiff has immense reputation and goodwill in the said trade marks/names and the products offered thereunder. Considering the factors such as (i) the extent of knowledge of the RPG mark, and its recognition by the relevant public; (ii) the duration of the use of the RPG marks; (iii) the extent of the products in relation to which the RPG mark is being used; (iv) the extent and duration of advertising and promotion of the RPG mark; (v) the geographical extent of the trading area in which the RPG mark is used; (vi) the state of registrations of the RPG mark; (vii) the volume of business under the RPG marks; and (viii) successful enforcement against infringers/offenders before the Courts of law/registry, I am of the opinion that *prima facie*, the Plaintiff's RPG mark deserves protection as a well-known trade mark as the same has come to acquire a secondary meaning to connote to the public the goods and / or services emanating from the Plaintiff. It can be very well said that the goodwill and reputation of the Plaintiff is not limited to a particular category or business segment and the use of the trade mark RPG in respect of any category of goods and services is liable to be associated with the Plaintiff.

28. At this point, let me immediately deal with the contention of Mr. Mukherjee that the Plaintiff has not pleaded that the trade mark RPG has acquired secondary meaning and in the absence of such pleading, the Court should not consider

the claim of the Plaintiff that its RPG mark has acquired secondary meaning or well-known status. A bare perusal of the Plaint would reveal that the Plaintiff has specifically pleaded extensive goodwill and reputation of its RPG marks in respect of diverse business sectors and has also filed evidence along with the Plaint to substantiate the same. Particularly in Paragraphs 37 to 42 of the Plaint, the Plaintiff has summarized its claims of extensive goodwill, reputation and entitlement for protection across category of goods and services. In Paragraph 42 of the Plaint, Plaintiff has specifically claimed that the RPG trade marks have acquired secondary meaning with the source of the Plaintiff and therefore, entitled to be protected as well-known trade marks in India under Section 2(1)(zg) of the Trade Marks Act, 1999. The said Paragraph-42 of the Plaint is reproduced herein below:

“42. The Plaintiff’s **RPG** trademarks being inherently distinctive in relation to the Plaintiff’s products and/ or related services - have acquired a high degree of distinctiveness owing to the continuous, extensive and uninterrupted use and promotion of the said trade marks in India as well as in various countries around the world. By virtue of the same, the products under the prior and famous **RPG** trademarks have acquired secondary meaning with the source of the Plaintiff. Therefore, the **RPG** trademarks of the Plaintiff are today liable to be considered as well-known trade marks in India, as per the provisions of Section 2(1)(zg) of the Trademarks Act, 1999.”

SIMILARITY BETWEEN THE RIVAL TRADE MARKS/NAMES

29. Both the counsels made a great deal of submissions on the aspect of deceptive similarity - Mr. Kamod on the existence of it and Mr. Mukherjee on the lack

of it. The principles in relation to the law of 'deceptive similarity' of trade marks are well settled by the Supreme Court and catena of judgments of various High Courts. Some of these principles can be summarized as follows:

- (i) Both at the stage of *interim* and final relief, the matter rests on first impression itself;
- (ii) Trade marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole;
- (iii) It is important to find out what is the distinguishing or essential feature of the Plaintiff's trade mark and what is the main feature or the main idea underlying that trade mark, and ascertain if the Defendants' trade mark contains the same distinctive or essential feature, or conveys the same idea;
- (iv) In deciding the question of similarity between the two marks, the approach must be from the point of view of a man of average intelligence and imperfect recollection;
- (v) Marks must be compared as a whole;
- (vi) The true test is whether the totality of the Defendants' trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark;
- (vii) While ascertaining the question of deceptive similarity, the Courts must not conduct a microscopic examination and both the visual and the phonetic tests

must be applied;

(viii) The nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be considered.

30. I have reproduced the rival trade marks/name below:

PLAINTIFF	DEFENDANTS
  	 
RPG Life	RPG Pharmacy
RPG Life Sciences	RPG Opticals
RPG Pharmaceuticals	

31. Now, it is evident that the most prominent and the only distinctive

portion of the Defendants' impugned marks/name - RPG Opticals/ 

and RPG Pharmacy/ , is the expression 'RPG' which is also the only

leading, essential and prominent feature of the Plaintiff's registered trade marks. I do not find anything distinctive in the Defendants' marks except the term 'RPG'. The remaining portions of the Defendants' marks are merely descriptive of the services being provided by the Defendants, i.e. the suffix "Opticals" and "Pharmacy" indicate that the concerned entity operates as an Optical shop or a Pharmacy. The taglines are also descriptive and indicative of the services provided by the Defendants and also, do not form prominent part of the Defendants' marks. From a comparison the rival marks as a whole as well as the prominent and distinctive features of the rival marks, it is

evident that the impugned marks- RPG Optical/  and RPG

Pharmacy/  are deceptively similar to the Plaintiff's registered RPG trade marks. I do not believe that the addition of the non-distinctive expressions such as 'pharmacy' or 'opticals' can make the Defendants' mark distinctive or dissimilar to the Plaintiff's trade marks. In fact, applying the well settled principles of law relating to deceptive similarity, I find the Defendants' trade marks/labels/names to be similar to the Plaintiff's registered trade marks. Further, applying the test, as to how a customer with an average mind of ordinary intelligence and imperfect recollection will look upon or react to the marks of the Defendants and what association he will form by looking at them and in what respect he would connect the marks to the services he was

availing, the only answer is that a customer familiar with the Plaintiff and its trade mark/name RPG, seeing the name/mark of the Defendants and seeing it described as Pharmacy and Opticals, is likely to associate and connect the services/business of the Defendants as those of the Plaintiff. Further, the documents filed by the Plaintiff show that the Defendants are also using the term RPG in standalone manner (T-shirt of employees bearing the mark RPG - at page 83 of the exhibits; website at pages 747-750/ Exhibit-AA1, etc.) as well as in word form (invoices filed at Pages-694 to 697; Website extracts at Pages-745-750/Exhibit-AA1) and therefore, the Defendants' arguments that the marks are different does not hold good.

32. Reliance placed on the following judgments by Mr. Kamod is applicable to the present case: *Ruston and Hornsby (supra)*; *Pidilite Industries (supra)*; *Kantilal Premji Maru (supra)*, and *H&M Hennes & Mauritz (supra)*.

DEFENDANTS' USE - TRADE NAMES AND TRADE MARKS

33. Now, in so far as the present case is concerned, it is important to first determine whether the Defendants are using the expression 'RPG Pharmacy' and 'RPG Optical' as their respective trade names only or whether they are using the same as trade marks in addition to their trade names. The Ld. Senior Advocate for the Defendants has contended that the Defendants are using RPG as a part of their trading

name only and has heavily relied upon Section 29(5) to contend that the use by the Defendants of RPG as a part of their trading name does not amount to infringement of the Plaintiff's registered trade mark. The said distinction between the 'use as trade name' and 'use as trade mark' is important considering the fact that the scope and requisites to prove infringement of trade mark by Defendants' use of it as trade name under Section 29(5) of the Act are different than those required to prove when the Defendant is using it as 'trade mark' as provided in remaining provisions of Section 29 of the Act.

34. There is no doubt that the Defendants are using the trade name 'RPG Pharmacy' in respect of their services of pharmacy services, pharmacy advice, pharmacy dispensary services and trade name 'RPG Opticals' in respect of their services of advertisement, wholesale, retail of optical lenses, sunglass, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products. A bare

perusal of the labels  and  that are being admittedly used by the Defendants to offer their services would reveal that the Defendants are using the term RPG as a part of their trade mark/labels also. The same is also evident from the argument advanced by the Ld. Senior Advocate for the Defendant albeit in support of his another submission regarding dissimilarity of trade marks - that the Defendant's mark is a logo mark which contains other elements also

which would help the consumers to differentiate between the Plaintiff's marks and Defendants' mark. I have already dealt with the argument of deceptive similarity, but the said argument also shows that the Defendants themselves also admit that they are using the term RPG Pharmacy and RPG Optical not only as their trade names but also as their trade marks. In common parlance, the trade mark used in respect of service is called as a 'service mark', though the said term 'service mark' is not defined or used in the Trade Marks Act, 1999. Before the Trade Marks Act, 1999 was enacted, the law of trade marks was governed by the Trade & Merchandise Marks Act, 1958 ("**the old Act**"). The old Act did not provide for registration of trade marks in respect of services and the same was limited to registration of trade marks in respect of goods. Under the old Act and the Rules thereunder, the goods in respect of which registration could be sought were classified in 34 different classes. After the Trade Marks Act, 1999 came into force, the registration and statutory protection was also made available to trade marks used in respect of services thereby widening the scope of protection and increasing the number of classes to 42 (subsequently increased to 45 classes as exist today) in accordance with the Nice International classification of goods and services. As per the Nice Classification, all the goods have been categorized in classes 1 to 34 and services have been categorized in classes 35 to 45. The fact that the Defendant has filed application for registration of the trade mark/label



under class 35 which is opposed by the Plaintiff and the fact that



the Defendant has secured registration of the trade mark/label in class 44 proves that the Defendants are using RPG not only as a part of their trading name but also as trade marks/service marks. The Defendants are estopped from contending that the same are not trade/service marks. The use of the trade name as contemplated under Section 29(5) of the Act means the actual name under which the Defendant is doing a particular business that may or may not be his trade mark. The use of the expression 'trade name' and 'name of his business concern' in Section 29(5) is akin to a corporate name/business name of an entity. The moment the Defendants use their trade names 'RPG Pharmacy' and 'RPG Opticals' not in a sense of a pure corporate name/business name and add something more to it like creating a logo/label



such as



and

in respect of their services, such use

of the logo/label amounts to use as a trade mark. In the present case, it is evident that the Defendants are using the expression 'RPG' not only as part of their trading names but also as trade marks.

35. Let me now separately consider whether the use of the trade

marks/service marks  and  as also the use of their trade name RPG Opticals and RPG Pharmacy by the Defendants in respect of their services amounts to infringement of the Plaintiff's registered trade marks. Since there is a distinction between 'use as a trade name' and 'use as a trade mark' within the meaning of Section 29 of the Act, I have considered the said aspects separately.

USE OF TRADE MARKS AND BY THE DEFENDANT NO.2 - INFRINGEMENT?

36. Let me first address the defence taken under Section 28(3) read with Section 30(2)(e) of the Trade Marks Act, 1999 for use of the trade mark



by the Defendant No.2. It is an admitted position that the

Defendant No.2 is also the registered proprietor of its trade mark  bearing registration No.3536174 in Class 44, against which the Plaintiff has filed Rectification Application bearing NO.42/2018/TM/KOL/ORR/6316. The said Rectification Application is presently pending. Since the Defendant No.2 has also

secured registration of its trade mark label , the use of that very

trade mark label by the Defendant No.2 in respect of her pharmacy services would not amount to infringement of Plaintiff's registered trade marks as per Section 28(3) read with Section 30(2)(e) of the Trade Marks Act, 1999 which are reproduced hereinbelow:

“Section 28 - Rights conferred by registration

(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.

Section 30 - Limits on effect of registered trade mark

(2) A registered trade mark is not infringed where-

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.”

37. Though the above provisions are clear, the same does not mean that the Court can never grant injunction in terms of infringement against another registered proprietor at an *interim* stage. As per the dicta of the Full Bench of our Court in the case of *Lupin Ltd. (supra)*, a challenge to the validity of the registration of the trade mark can finally succeed only in rectification proceedings, 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. Hence, this Court can certainly go behind the registration of the Defendant No.2 and grant injunction against the Defendant No.2 (registered proprietor) in case the parameters laid down by the Full Bench of our Court in *Lupin* (*supra*) are met. In the present case, the Plaintiff has pleaded and argued that the Defendant No.2's registration is obtained illegally and that this Court must go behind the Defendant's registration No.3536174 in class 44 and grant the relief of injunction on the basis of infringement of Plaintiff's trade marks. I do *prima facie* find that considering the goodwill and reputation of the Plaintiff's prior registered RPG trade

marks, the Defendant's adoption and use of the trade mark  with 'RPG' as its only leading, essential and prominent feature is not honest. In view of the kind of goodwill and reputation that had been obtained by the Plaintiff in its RPG Marks even at the time of adoption of the impugned mark by the Defendant No.2, she could never have validly obtained registration of the impugned mark



bearing No.3536174 in class 44. If the Defendant No.2 would have brought the correct facts on record before the Registrar of Trade marks, the Registrar of Trade Marks may not have granted the registration to the Defendant No.2. I therefore believe that the parameters laid down by the Full Bench in *Lupin* (*supra*) are fully met in the present case. In view thereof, the Defendant No.2 cannot take seek

shelter of Section 28(3) or Section 30(2)(e) in the present action. I shall now test whether the Plaintiff has made out a case for infringement of its RPG trade marks.

38. Since the Plaintiff has registration for the RPG Marks (namely RPG Logo and RPG formative marks) in class 5 for pharmaceutical preparations and is engaged in the manufacturing and selling of pharmaceutical preparations and the Defendants are operating a pharmacy shop engaged in the sale of medicines/ pharmaceutical preparations, the Defendants' activities under the mark



are directly overlapping with the Plaintiff's business as broadly both the business activities relates to the same field, i.e. medical field. Further, since the Plaintiff owns registration for its RPG Logo in class 09 (i.e. the class in which the optical and related goods fall), the Defendants' activities under the mark



are overlapping with the Plaintiff's business interests.

39. Assuming that the goods of the Plaintiff and services of the Defendants are not considered to be overlapping, cognate, allied or complimentary, let us test the aspect of infringement of the Plaintiff's RPG registered trade marks by Defendants'

use of the impugned trade marks  and  in the backdrop of Section 29(4) of the Act.

40. Broadly, as per Section 29 of the Act, for infringement to result the following conditions should be fulfilled:

- the impugned mark has to be either similar to or identical with the registered mark;
- the goods or services for which the impugned mark is used has to also either be identical with or similar to the goods or services for which registration has been granted;
- likelihood of confusion or association.

41. The scenario is however different as regards Section 29(4) of the Trade Marks Act, 1999. Section 29(4) of the Act reads thus:

“Section 29 - Infringement of registered trade marks

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which--

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.”

42. From the above provision, it is clear that for infringement to result under Section (4), the following conditions are required to be fulfilled:

- (i) the person using the impugned mark is neither a registered proprietor in relation to the goods and services for which the mark is registered nor is using it by

way of permitted use;

- (ii) the impugned mark must be used in the course of trade;
- (iii) the impugned mark has to be either similar to or identical with the registered mark;
- (iv) the impugned mark is used for goods or services different from those for which registration has been granted;
- (v) **the registered trade mark has a reputation in India;**
- (vi) **the use of the impugned mark is without due cause, and takes unfair advantage of or is detrimental to,**
 - (a) **the distinctive character of the registered trade mark; or**
 - (b) **the reputation of the registered trade mark.**

For the purposes of Section 29 (4) of the Act, what is important is that the registered trade mark must be shown to have a reputation in India and should be shown to have been used by the infringer “without due cause”. Further, it should be shown that such adoption or use has resulted in the infringer taking unfair advantage of the registered mark or is detrimental to the distinctive character or repute of the registered trade mark.

43. It is interesting to note that Section 29 (4) is also distinct from Section 29(1) to (3) of the Act in another important aspect. The requirement of having to

demonstrate the likelihood of confusion is absent. In other words, the intention of the legislature is to afford a stronger protection to those marks that have wide reputation without the registered proprietor of such marks having to demonstrate the likelihood of confusion arising from the use of an identical or similar mark in relation to dissimilar goods and services. The word 'detriment' (i) in the context of the 'distinctive character' of the mark brings in the notion of 'dilution' or 'blurring' and (ii) in the context of 'repute' it brings in the notion of 'tarnishment' and 'degradation'. The words "takes unfair advantage" refers to 'free-riding' on the goodwill attached to mark which enjoys a reputation.

44. Turning to the present case, all the requirements contained in Section 29(4) of the Act are fulfilled. I have already held that the Plaintiff's registered RPG marks are similar to the Defendants' impugned trade marks . The only leading, essential and prominent feature of the Plaintiff's registered RPG marks and Defendant's trade mark is the word 'RPG'. For a mark like RPG that is distinctive and well known and solely associated with the Plaintiff, if the same is associated with retail business of optical or pharmaceutical products, the same can *prima facie* be detrimental to its distinctive character and lead to dilution. Further, such use would also take unfair advantage of the reputation of the Plaintiff's RPG registered trade marks. The use of the expression "RPG" in the Defendants' trade marks is without any due cause. In so far as the argument of Mr. Mukherjee that the Plaintiff cannot

claim infringement of its RPG trade marks under Section 29(4) of the Trade Marks Act until and unless the Plaintiff's marks are recorded in the list of well-known trade marks as maintained by the Trade Marks Registry is concerned, I do not agree with the same. None of the provisions contained in the Trade Marks Act support this submission. In fact, I agree with the submission of Mr. Kamod that for setting up a case under Section 29(4) of the Act, even at the *interim* stage, there is no requirement that the Plaintiff's trade mark must be recorded in the list of well-known trade marks. Though the provision pertaining to well-known trade marks has been statutorily recognized for the first time by the Trade Marks Act, 1999, the concept of well-known trade marks has been in existence for past several decades when the Courts have protected well-known trade marks in a passing off action thereby granting injunction against defendants who were using the mark for completely different services than those of the plaintiff. Reliance can be placed on:

"Daimler Benz Aktiengesellschaft and Ors. vs. Hybo Hindustan reported in 1994 (14) PTC 287 (Del)

7. I see no reason why any trader in India should adopt the name "Benz", which is, as stated above, associated with one of the finest engineered cars in the world, and use the same name with respect to ordinary goods, in this case undergarments, particularly underwears."

Kamal Trading Co., Bombay and Ors. vs. Gillette U. K. Limited reported in 1988 (8) PTC 1 (BOM)

2. The plaintiffs are a Company incorporated under the laws of the United Kingdom and are a subsidiary of the Gillette Company, U.S.A. The Gillette Company and its subsidiaries have been carrying on worldwide business in the manufacture and sale of safety razor blades, safety razors, shaving cream, shaving brushes, etc. since last over several

years....

9. Mr. Tulzapurkar very rightly submitted that the trade mark '7 O'CLOCK' had acquired worldwide reputation and any customer purchasing the goods with that mark would immediately connect the goods to the house of Gillets which are the registered owners of the mark '7 O'CLOCK'. It cannot be overlooked that it is not necessary for the plaintiffs to establish that in fact any customer was deceived, it is enough if it is shown that there is likelihood of deception. We have no hesitation in concluding that the user of the mark '7 O'CLOCK' by the defendant would clearly result in deceiving the customer with the impression that the tooth brushes come from the house of Gilletes.”

45. Even today, a passing off action is maintainable in the case of a well-known mark even if the goods and services being dealt with by the parties are not similar. Hence, even in the past without the marks being recorded in the list of well-known trade marks, they have received protection as well-known trade marks from our Courts albeit in a passing off action. Further, none of the provisions pertaining to well-known trade marks support the submission made by Mr. Mukherjee. Mr. Kamod correctly placed reliance upon the definition of the well-known marks as contained in Section 2(1)(zg) to contend that there is no requirement in the said definition that to be recognized as a well-known trade mark the same has to be recorded in the list of the well-known trade marks of the Trade Marks Registry. Further, it is important to note that while the Act specifically provides for the definition of well-known trade mark in Section 2(1)(zg) and the factors which are required to be considered while determining whether a mark is a well-known trade mark are provided in Section 11(7) of the Act, the expression “well-known trade mark” is conspicuous by its absence in Section

29(4) of the Act. Section 29(4) of the Act uses the expression “reputation”. It is therefore clear that while claiming infringement under Section 29(4) of the Act, it is not necessary, in a strict sense, for the proprietor of a registered mark to show that the mark is a ‘well-known trade mark’ as defined in Section 2(1) (zg). Although, in fact, if the mark is shown to be well-known, it makes it easier to satisfy the ‘reputation’ requirement contained in Section 29(4) of the Trade Marks Act. The Courts can consider the pleadings and documentary evidence filed by the Plaintiff while ascertaining whether such mark can be protected as well-known trade mark/trade marks with reputation while considering infringement under Section 29(4) of the Act and the same is not dependent upon the mark being recorded in the list of the well-known trade marks as maintained by the Trade Marks Registry. I, therefore hold that

the use of the impugned trade mark RPG OPTICALS /  by the Defendant No.1 in respect of its services pertaining to advertisement, wholesale, retail of optical lenses, sunglass, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products and the use of impugned trade mark RPG

PHARMACY /  by the Defendant No.2 in respect of pharmacy services, pharmacy advice and pharmacy dispensary services, amounts to infringement of the Plaintiff’s well-known RPG registered trade marks.

USE OF TRADING NAMES ‘RPG PHARMACY’ AND ‘RPG OPTICALS’ BY DEFENDANTS – INFRINGEMENT?

46. Since I am now considering the ‘use of the trade name’ of the Defendants against the registered trade mark of the Plaintiff, the only relevant provision which governs such a situation of ‘trade mark vs. trade name’ is contained in Section 29(5) of the Act as laid down by the Full Bench of our Court in *Cipla (supra)*. This question is required to be answered considering the provisions contained in Section 29(5) of the Act. The said provision is reproduced below:

“Section 29 - Infringement of registered trade marks

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.”

47. It is clear from the above provisions that Section 29(5) comes into play when (i) the Defendant uses a registered trade mark as his trade name or part of his trade name or name of his business concern or part of the name of his business concern and (ii) Defendant is in the business of dealing with goods or services in respect of which the Plaintiff’s trade mark is registered. If both the conditions are satisfied, it is not necessary to prove anything further for establishing the infringement such as likelihood of confusion or deception. To attract this Sub-Section, the person who infringes the trade mark should be doing trade or business in goods or services in

respect of which the trade mark is registered. Now, the Plaintiff has secured registration of the RPG trade marks in classes 5 in respect of medicinal and pharmaceutical preparations. Similarly, though the Plaintiff has registered its RPG trade marks in class 9, the said registration does not include optical lenses or other optical products. The Defendant No.1 is using its trade name RPG Optical in respect of its retail services relating to advertisement, wholesale, retail of optical lenses, sunglasses, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products., subsequently, the Plaintiff has obtained trade mark registration in Class 35 Hence, it cannot be said that the Defendant is dealing in goods or services in respect of which the Plaintiff's trade mark is registered as contemplated in Section 29(5) of the Act. Following the dicta of Full Bench of our Court in *Cipla (supra)*, it is clear that the requirements contained in Section 29(5) of the Act are not satisfied in the present case.

48. Though I have held earlier that the Plaintiff's RPG trade marks deserve protection as well-known trade marks within the meaning of the Trade Marks Act, 1999, in so far as the trading names 'RPG Pharmacy' and 'RPG Optical' of the Defendants are concerned, the provisions contained in Section 29(4) for infringement of well-known trade mark would not be attracted. This position has been made clear by the Full Bench of our Court in *Cipla (supra)* wherein it is held that use of a registered trade mark as corporate name or trading name or style is excluded from the purview of

Section 29(1), 29(2) and 29(4) of the Trade Marks Act, 1999. The following observations of the Full Bench are relevant:

“26. Unless both the conditions are satisfied, Sub-Section (5) will not apply. The question before us is when the first condition of Sub- Section (5) is satisfied but the second is not satisfied, whether Sub- Section (4) can be invoked. In other words, the question is whether a person who is dealing with goods or services which are dissimilar to those for which the trade mark is registered, uses registered trade mark as a part of business/corporate name, such use will attract the mischief covered by Sub-Section (4). The plain language used by the Sub- Sections (4) and (5) answers the question. Sub-Section (4) provides that "A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which - (a) is identical with or similar to the registered trade mark, and (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered..." Thus, the provision is attracted when a mark which is identical with or similar to registered trade mark is used in the course of trade in relation to goods or services which are not similar to those for which the trade mark is registered. Whereas Sub-Section (5) provides that "A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern..." . 27 The Sub-Section (4) uses the words "in the course of trade" and "in relation to goods or services" which are absent in Sub-Section (5). The Sub-Section (5) uses the words "..... if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern.." These words are conspicuously absent in the Sub-Section (4). The difference in the phraseology and language used in the two Sub- Sections makes it clear that Sub-Section (4) applies in "trade mark versus mark" situation. It applies when the mark is used in the course of trade in relation to goods and services. Sub-Section (5) applies to a "trade mark versus trade/corporate/business name" situation. It is a special provision which is different from Sub-Sections (1), (2) and (4). Thus, Sub-Sections (4) and (5) apply to different situations arising out of use of a mark. Sub-Section (5) does not make Sub-Section (4) otiose. The fact that the definition of the word "mark" includes "name" is of no consequence while interpreting Sub-Sections (4) and (5). If we hold 32 of 50 33 nms-2463.12 in suit-

1906.12 that Sub-Section (4) will apply to those cases where the first condition of Sub-Section (5) is satisfied but second one is not satisfied, the requirement specifically incorporated in Sub-Section (4) of the mark being used in relation to goods and services will become redundant. A statute cannot be interpreted in such a manner. The use of trade mark as a part of corporate/business/trade name cannot be read into Sub- Section (4).”

49. Hence, the requirements to attract infringement under Section 29(5) are not met in the present case and in so far as the use of the trading name ‘RPG Pharmacy’ and ‘RPG Opticals’ by the Defendant in respect of its services is concerned, the same would not amount to infringement of the Plaintiff’s registered trade mark under Section 29(5) of the Act.

PASSING OFF

50. Now, it cannot be disputed that principles governing a case of passing of action are substantially different from an action for infringement. Traditionally, passing of in common law is a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The action for passing off originated from an action for deceit, and the main ingredient of the tort of passing off is false representation made by a trader as regards source or origin of his goods. Unlike an action for infringement which is a statutory remedy provided under the Trade Marks Act, passing off is a remedy in common law and the principles governing it are found in judicial precedents. Originally, passing off was confined to the goods, however, later

on it was extended to services. The whole basis of the passing off theory is that no one has a right to represent his goods or services as those of someone else and secondly, the court will restrain the making of such misrepresentation, even though, it is not made fraudulently.

51. It is a settled principle of law that in an action for passing off, to succeed, the Plaintiff must satisfy three important ingredients:

- a) Goodwill and reputation in the plaintiff's mark,
- b) Actual or likelihood of deception and confusion caused amongst the public by the defendant's use of the impugned trade mark, and
- c) Actual or likelihood of injury to the plaintiff by such use of the impugned trade mark by the defendant.

52. The five guidelines as originally laid out by Lord Diplock in *Erven Warnink v. Townend & Sons Ltd.*²⁹ (the "Advocate Case") were reduced to the above three by Lord Oliver in the case of *Reckitt & Colman Products Ltd. v. Borden Inc*³⁰ which is popularly known as "Jif Lemon" case. The said three guidelines are referred to as the classic trinity test. The reasons why a prior user is considered to be superior than that of any other rights is simple - a proprietor who has acquired goodwill and reputation by the prior and continuous use of its trade mark is entitled to protect such

29 (1979) AC 731, 742 (HL)

30 (1990) 1 ALL E.R. 873

goodwill and reputation against any subsequent user of the mark who misrepresents his business as that of business of the prior right holder.

53. In so far as the first requirement of goodwill and reputation is concerned, I have already held that the Plaintiff has acquired goodwill and reputation in its RPG trade marks and the said RPG marks have in fact become well-known not only amongst the consumers and traders but the general public at large and have acquired secondary significance.

54. In so far as the second requirement i.e. actual or likelihood of confusion and deception amongst the public by the Defendants' use of their trading names/trade marks is concerned, the Plaintiff is using its RPG marks for diverse activities. The Plaintiff's use of RPG marks is much prior (about 37 years prior) to that of the Defendants'. Secondary significance has been acquired by the Plaintiff's said trade mark RPG by virtue of long, continuous and extensive use and promotion and also, given the Plaintiff's substantial involvement in diverse sectors of the economy, under the trade mark/ trade name RPG. Therefore, any use of "RPG" by the Defendants will inevitably lead to an association of the Defendants' services and business with those of the Plaintiff's. In so far as the Defendants' use of the trading name RPG Pharmacy and the trade mark RPG Pharmacy is concerned, they are using the same in respect of pharmacy services, pharmacy advice, pharmacy dispensary services. The word 'pharmacy' has been defined by various dictionaries as follows:

“Merim Webster:

“The art, practice, or profession of preparing, preserving, compounding, and dispensing medical drugs”

“A place where medicines are compounded or dispensed”

Dictionary.com:

“Also called pharmaceuticals the art and science of preparing and dispensing drugs and medicines.”

“A drugstore”

55. In the present case, the Plaintiff has substantial business operations under the RPG Marks in pharmaceutical industry. Pharmaceutical products and pharmacy are very closely related. Thus, it is evident that the business activities relate to the same field, i.e. medical field and the Defendants’ activities under the mark/name RPG Pharmacy overlap with the Plaintiff’s business interests. There is, therefore, definitely a likelihood of confusion and/or deception amongst the consumers since they may be confused or deceived or put into a state of wonderment that the Defendants are associated with and / or their services are an extension of or endorsed by the Plaintiff.

56. Even if it is considered that the goods and services offered by the Plaintiffs under the RPG marks are dissimilar to the optical services and pharmacy services offered by the Defendants under their trade marks, yet, it would make no difference to the cause of action of passing off since the requirement of ‘common field of activity’ is no more a requirement in order to succeed in an action for passing off.

Traditionally, a passing off action could be maintained, provided the defendant's goods in respect of which misrepresentation was being made were identical with the goods of the plaintiff. Later, similar goods were also brought within the ambit of passing off. Though the plaintiff was not in direct competition with the defendant as far as the goods were concerned, still protection was afforded on the ground that the defendant was trying to take advantage of the reputation of the plaintiff and the defendant's goods though not exactly the same as those of the plaintiff but were similar goods and could be said to be coming from the same origin i.e. the plaintiff. The concept of passing off has however, with time, expanded. Today, even totally dissimilar goods being sold under the plaintiff's trade mark or a trade mark deceptively similar to the plaintiff's trade mark come within the purview of passing off. The real question in each case is whether there is, as a result of misrepresentation, a real likelihood of confusion or deception of the public and consequent damage to the plaintiff. The focus is shifted from the external objective test of making comparison of activities of parties to the state of mind of public in deciding whether it will be confused.

57. In **Sunder Parmanand Lalwani and Ors. vs. Caltex (India) Ltd.**³¹, the Division Bench of our Court while dealing with the question whether there was any probability of confusion between 'Caltex' watches and 'Caltex' petrol and various

31 (1968) 70 BOMLR 37

other oil products of the opponents, observed that although the goods were completely different and there was no trade connection between them still there was a likelihood of deception or confusion. The Court observed:

“On the facts of this case, we have no hesitation in holding that a large number of persons, if they see or hear about the mark 'Caltex' in connection with watches, would be led to think that the watches were in some way connected with the opponents, or they would at least wonder whether they were in any way connected with the opponents. Persons seeing the mark attached to watches, which is a new class of goods, would assume, or are most likely to assume, that they originated from the proprietor of the mark, namely, the opponents”

58. In *Bata India Ltd. vs. Pyare Lal and Co. Meerut City and Ors.*³², the Allahabad High Court was dealing with a situation where the plaintiff was manufacturing shoes, while the Defendant was producing goods like foam and similar products. Rejecting the argument that there was no possibility of any deception on the purchase of foam materials in the market, the Court observed:

“This argument loses sight of an important feature viz., how would a lay customer know in the first place that the plaintiff was not producing foam or foam material? How would the customers know that Bata were not producing foam? It is well known that the name represented makers of shoes and analogous products, but a question would also arise in the mind of the lay customers whether Bata were also producing foam. Who is going to answer this question? Does an ordinary customer ask the seller as to whose product it is? The answer generally is in the negative. He buys a thing on the basis of his own impression.

..... A passing off action would lie even if the defendants were not manufacturing or producing any goods similar to that of the plaintiff. A passing off action would lie where a misrepresentation is likely to be caused or a wrong impression created, as if the product was of some one

32 AIR 1985 ALL 242

else.”

59. In *Kiriloskar Diesel (supra)*, our Court while dealing with a similar contention, observed as follows:

“13. The expression 'common field of activity' was coined by Wynne-Parry J. in *McCulloch v. Levis A. Mary (Product Distributors) Ltd.* popularly known as 'Uncle Mac' case reported in 65 RPC 58 in which he held that its presence or absence was conclusive in determining whether or not there was passing off. However, the requirement that a 'common field of activity' is conclusive in determining whether there can be passing off has been extensively criticised by Manning J. in the case of *Henderson v. Radio Corporation Pty.* reported in (1969) RPC 218 holding that it would be unsafe to adopt the view expressed in *McCulloch v. Mary* that what has been called a common field of activity must be established in every case to entitle the plaintiff to succeed. He further held that it is going too far to say that the absence of this so-called common field of activity necessarily bars a plaintiff from relief. **With the passage of time, law on requirement of common field of activity in a passing off action has radically changed. There is no requirement for a common field of activity to found a claim in passing off.** In *Marage Studies v. Counter Feat Clothing Co. Ltd.* reported in (1991) FSR 145, Browne Wilkison V-C said that **the so-called requirement of the law that there should be a common field of activity is now discredited. The real question in each case is whether there is as a result of misrepresentation a real likelihood of confusion or deception of the public and consequent damage to the plaintiff. The focus is shifted from the external objective test of making comparison of activities of parties to the state of mind of public in deciding whether it will be confused.**

14. In the case of trading name which has become almost a household word and under which trading name a variety of activities are undertaken, a passing off can successfully lie if the defendant has adopted identical or similar trading name and even when the defendant does not carry on similar activity. Even if the defendant's activities in such circumstances, are remote, the same are likely to be presumed a possible extension of plaintiff's business or activities.”

(Emphasis Added)

60. In *Mahendra and Mahendra Paper Mills (supra)*, the Apex Court has held the following:

“Without intending to be exhaustive some of the principles which are accepted as well settled may be stated thus: that whether there is a likelihood of deception or confusion arising is a matter for decision by the court, and no witness is entitled to say whether the mark is likely to deceive or to cause confusion; that all factors which are likely to create or allay deception or confusion must be considered in combination; that broadly speaking, factors creating confusion would be, for example, the nature of the market itself, the class of customers, the extent of the reputation, the trade channels, the existence of any connection in course of trade, and others.

19. We have, in the light of the above pronouncements, no difficulty in holding that the dissimilarity in some of the products in which the parties trade does not make any material difference insofar as the grant or refusal of injunction against the defendants in the facts and circumstances of this case are concerned.”

61. In *Sony Kabushiki (supra)*, the Full Bench of the Calcutta High Court while specifically answering a reference in relation to the question of passing off when the defendant's products are completely different than the plaintiff's, held:

“26. It would be apparent from this passage that the Judicial Committee had dismissed the appeal upon coming to a finding that there was no possibility of confusion in the mind of the purchasers. All the authorities which were considered by the Hon'ble Division Bench in the case of Rustom Ali Molla appear to have proceeded on an underlying reasoning that if the goods of the rival traders were different, there would be no possibility of deception or confusion in the mind of consumers as regards the source or origin of the goods. But from the days of "one company one product", the commercial world has considerably changed and the large corporations in the contemporary world operate with multiple products or services across the globe. Modern marketing technology aided with improved communication system has also strengthened the distinctive properties of individual trade marks. Under these circumstances, to hold that the reputation of a trade mark shall

remain restricted to those goods and services only in which its proprietor is directly engaged in, would be ignoring the ground realities of today's business world.

28. The key function of a trade mark is to indicate the source or origin of goods and services. The tort of passing off is committed if the offending trader applies an established trade mark in such manner so as to cause confusion or deception in the mind of the consumers as regards the source or origin of the goods and the mind of purchasers are directed to the firm whose identity is already linked with the trade mark in the market place. Even if the goods or services of the rival traders are different, in our opinion this factor alone would not altogether eliminate the possibility of confusion or deception. If a highly distinctive trade mark is applied to a class of goods which its proprietor does not deal with, consumers may always wonder as to whether the proprietor of the trade mark has launched a new product. The purchasing decision of the consumers may be determined by this factor.”

62. It is therefore clear that the principle that common field of activity is not essential to succeed in case of passing off, is well established. In the facts of the present case, the fact that the Plaintiff and Defendants’ fields of activities are not identical is of no consequence. Such misrepresentation by the Defendants is certainly likely to cause damage to the Plaintiff.

63. In so far as the argument of Mr. Mukherjee that the Defendant No.2 has secured registration of the trade mark RPG Pharmacy in class 44 is concerned and hence Defendant No.2 has a statutory right to use the said trade mark/name, as correctly submitted by Mr. Kamod, it is settled law that registration of trade mark by the Defendant is no defence to an action for passing off. Registration under the Trade Marks Act, 1999 does not confer any new right to the mark claimed or any greater

right than what already existed at common law and at equity without registration. Registration itself does not create a trade mark. The trade mark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected. Priority in adoption and use of a trade mark is superior to priority in registration. In the case of *S. Syed Mohideen (supra)*, the Supreme Court held:

"23. The above were the reasonings from the provisions arising from the plain reading of the Act which gives clear indication that the rights of prior user are superior than that of registration and are unaffected by the registration rights under the Act. Secondly, there are other additional reasonings as to why the passing of rights are considered to be superior than that of registration rights. Thirdly, it is also recognized principle in common law jurisdiction that passing of right is broader remedy than that of infringement. Fourthly, It is also well settled principle of law in the field of the trade marks that the registration merely recognizes the rights which are already pre-existing in common law and does not create any rights"

DEFENDANTS' USER IS RESTRICTED TO THE STATE OF WEST BENGAL

64. The contention of the Defendant that they are presently operating only in West Bengal, to suggest that they may be allowed to continue using the impugned marks within that area also does not hold any ground. The Plaintiff's goods and services under its RPG trade marks are available throughout India. Further the Plaintiff has secured prior registrations for its RPG marks which extend to the entire territory of India. Moreover, the Plaintiff's founder Shri R.P Goenka himself is

Bengali and has been strongly associated to Kolkata. This is clear from the news article at Exhibit-C to the Plaint at Pages-94 to 98 which has the title “If I’m not Bengali, who is? A perusal of this article itself makes it evident that RPG Group has a very strong association with West Bengal/Bengalis. In such circumstances, irrespective of the scale of the Defendants’ operations, their use of the impugned trade marks has the propensity to dilute the distinctive character and/or affect the reputation of the Plaintiff’s registered trade marks. The general public and consumers, being of average intelligence and imperfect recollection, are likely to believe and/or associate the services of the Defendants under the impugned marks with the Plaintiff. Therefore, the Defendants’ argument that they are operating only in Kolkata and may be allowed to run their stores/ shops in Kolkata, cannot be accepted.

WHETHER ADOPTION OF THE TRADE MARKS / TRADE NAMES BY THE DEFENDANTS IS BONAFIDE ? DEFENCE UNDER SECTION 35 OF THE TRADE MARKS ACT, 1999

65. The Defendants are admittedly not conducting their businesses in their own names viz. POULAMI GHOSAL and RIJU GHOSAL and are merely using an abbreviation coined therefrom. The provisions of Section 35 of the Trade Marks Act, 1999 do not protect the use of abbreviations of a name as a trade mark. The defence under Section 35 may have been available to the Defendants if they were using their

actual names such as “RIJU GHOSAL PHARMACY” or “RIJU GHOSAL OPTICALS” or other similar mark. But the Defendants are not doing so. Thus, Section 35 will be of no assistance to the Defendants’ case.

66. It is also not as if the Defendants initially set up business under the mark / name Riju Poulami Ghosal and which businesses over a period of time came to be known as “RPG” and thus claim that their customers are aware that they are transacting business with Riju Ghosal and Poulami Ghosal. In my opinion, it is inconceivable that in 2016, while the Defendants allegedly adopted the impugned marks, they were unaware of the Plaintiff’s RPG marks which are in use since over 30 years. Assuming that the Defendants wanted to coin a mark based on their names, the Defendants could have adopted any other combination instead of RPG, particularly when their knowledge about the Plaintiff’s said trade mark RPG cannot be ruled out. In such circumstances, the Defendants’ adoption of the impugned marks cannot be termed as bonafide. Moreover, the provisions of Section 35 are not available in a passing off action.

67. In the case of *Mahendra & Mahendra Paper Mills Ltd (supra)*, the Apex Court held that since the plaintiff in that case had been using the word “Mahindra” and “Mahindra & Mahindra” for its business/business concerns for a long span of time and since the name had acquired a distinctiveness and a secondary meaning in the business or trade circles and people had come to associate the name “Mahindra” with the

plaintiff, the attempt by the defendant in that case to use the name and business in trade circles was likely to create an impression of a connection of the defendant with the plaintiff and was likely to prejudicially affect the plaintiff. Accordingly, inspite of the surname of the defendant also being "Mahendra", the defendant was restrained from using the same.

USE OF THE DOMAIN NAMES BY THE DEFENDANTS

68. The Plaintiff has contended that the Defendants' registration of the domain name viz. www.rpgpharmacy.com and www.rpgopticals.com is dishonest and malafide. It is correctly submitted by the Plaintiff that the domain name not only serves as an address for Internet communication, but also identifies the specific Internet site as the address of its owner and also has trade mark value. The consumer would be misled into thinking that the Defendants' goods/services under the impugned domain names are those of the Plaintiffs and/or related to the Plaintiff. The domain name serves the function of a trade mark and is not a mere address and is therefore entitled to equal protection as a trade mark. Further, since the use of a domain name amounts to use of a trade mark, the use thereof would amounts to infringement of the Plaintiff's said RPG trade mark as also passing off. The reliance by the Plaintiff on the Supreme Court judgment in *Satyam Infoway (supra)* at paragraphs 11-15 and 23 is apposite. The Defendants' use and registration of the impugned domain names containing the word 'RPG' cannot be permitted.

DEFENDANTS' OBJECTION OF MISJOINDER OF PARTIES

69. Defendants are related as husband-wife and both of them are involved in running the concerned stores/ doing the offending business jointly. The Defendants' explanation for adoption of the impugned mark RPG itself shows that the adoption has its association with both of them. The addresses claimed in both the trade mark applications filed by both the Defendants are same (Exhibit-V/ Pg-618 and Exhibit-X/ Page-708). As correctly submitted by Mr. Kamod, the Defendants have been joined in this one suit as the right to relief claimed in it is in respect of, and arises out of, the same act or series of acts or transactions, jointly and/or severally and/or in the alternative, and if separate suits were brought against such Defendants, common questions of law and fact would arise. The objection taken by the Defendants of misjoinder of parties is therefore rejected.

INFRINGEMENT OF COPYRIGHT

70. The aspect of infringement of copyright though pleaded was not pressed by Mr. Kamod on instructions and hence I am not dealing with the same.

DISTINGUISHING JUDGMENTS RELIED UPON BY THE DEFENDANTS

71. The case laws relied upon by the Defendants can be distinguished as under:

- (a) M/s. Nandhini Deluxe (Supra)

This judgment was delivered in the context of Opposition Proceedings and not a suit for infringement and / or passing off. Thus, the findings of the Supreme Court cannot be axiomatically applied to the present case. Additionally, the factors which were considered by the Supreme Court to come to the conclusion that the orders of High Court should be set aside are:

“(A) Respondent started using trade mark in respect of its products, namely, milk and milk products **in the year 1985**. As against that, the appellant adopted trade mark ‘NANDHINI’ in respect of its goods **in the year 1989**.

(B) Though, the respondent is a prior user, the appellant also had been using this trade mark ‘NANDHINI’ **for 12-13 years** before it applied for registration of these trade marks in respect of its products.

(C) The goods of the appellant as well as respondent fall under the same Classes 29 and 30. Notwithstanding the same, the **goods of the appellant are different** from that of the respondent. Whereas the respondent is producing and selling only milk and milk products the goods of the appellant are fish, meat, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, edible oils and fats, salad dressings, preserves etc. and it has given up its claim qua milk and milk products.

(D) Insofar as application for registration of the milk and milk products is concerned, it was not granted by the trade mark registry. In fact, the same was specifically rejected. The appellant was directed to file the affidavit and Form 16 in this behalf to delete the goods ‘milk and milk products’ which affidavit was filed by the appellant. Further concession is already recorded above.

(E) **NANDINI/NANDHINI is a generic**, it represents the name of Goddess and a cow in Hindu Mythology. It is **not an invented or coined word** of the respondent.

(F) The nature and style of the business of the appellant and the respondent are altogether different. Whereas respondent is a Cooperative

Federation of Milk Producers of Karnataka and is producing and selling milk and milk products under the mark 'NANDINI', the business of the appellant is that of running restaurants and the registration of mark 'NANDHINI' as sought by the appellant is in respect of various foodstuffs sold by it in its restaurants.

(G) Though **there is a phonetic similarity insofar as the words NANDHINI/NANDINI are concerned, the trade mark with logo adopted by the two parties are altogether different.** The manner in which the appellant has written NANDHINI as its mark is totally different from the style adopted by the respondent for its mark 'NANDINI'. Further, the appellant has used and added the word 'Deluxe' and, thus, its mark is 'NANDHINI DELUXE'. It is followed by the words 'the real spice of life'. There is device of lamp with the word 'NANDHINI'. In contrast, the respondent has used only one word, namely, NANDINI which is not prefixed or suffixed by any word. In its mark 'Cow' as a logo is used beneath which the word NANDINI is written, it is encircled by egg shape circle. A bare perusal of the two marks would show that there is hardly any similarity of the appellant's mark with that of the respondent when these marks are seen in totality."

(Emphasis Added)

However, in the present suit, it is not even the Defendants' case that the Plaintiff's mark is common to trade. Further, the Court therein had observed *inter alia* that the subject marks were generic in nature and the appellant had been using the marks for several years before applying for registration. The Court therein observed that the mark NANDINI/NANDHINI was name of a deity in Hindu Mythology and it was not a coined or invented mark. Most importantly, the Court therein was of the opinion that the rival marks are different.

(b) Uniply Industries Ltd. (Supra)

In the aforesaid case, the Court therein observed that the respondent's claim of prior

user since the year 1993 was dubious. In the facts and circumstances of the case, the Court therein also observed that the Appellant therein may be an honest concurrent user, unlike the present case where the Plaintiff is a prior user by over 3 decades and the Defendants' adoption and use of the impugned marks cannot in any matter be termed as honest. Also, the Court's observations therein that "the first user in sale of goods or services is the owner and senior user" in fact assists the present Plaintiff's case rather than the Defendants. Thus, the Defendants' reliance on the aforesaid case is misconceived.

(c) Reliance Industries Ltd. (Supra)

In the cited case the issue was entirely different as the two rival marks were device marks which did not contain any words and the Court held that they had no similarity. The Court held that the defendant's mark therein did not include the essential feature of the plaintiff's mark. In the present case, the Defendants have adopted the identical mark 'RPG', therefore there is no question of any difference in the impugned marks of the Defendants and the Plaintiff's RPG marks. Thus, the cited case lends no assistance to the Defendants herein.

(d) People Interactive Private Limited (Supra)

In the facts of the cited case the plaintiff therein was claiming a monopoly on the generic and descriptive term "SHAADI" in respect of matrimonial services in a passing off action i.e. the plaintiff therein had not obtained registration in respect of its

trade mark. It was the argument of the defendant therein that the word SHAADI is generic and that no one can claim monopoly over the same. The Court therein observed that in its opinion there was not enough evidence to show that the plaintiff's mark therein had acquired a secondary meaning. However, the present case pertains not only to passing off but also infringement of the Plaintiff's registered trade marks. Further, I have already observed that the Plaintiff has been able to make out a case for infringement and passing off of its well-known trade mark. Still further, the use of the impugned domain names amount to use of a trade mark. Thus, the Defendants' reliance on the aforesaid case is misconceived.

72. To summarize, the Plaintiff has been able to make out a *prima facie* case

that (i) the use of the trade marks RPG PHARMACY /  ; RPG

OPTICALS /  ; domain names www.rpgpharmacy.com and

www.rpgopticals.com by the Defendants in respect of their goods and services

constitutes infringement of the Plaintiff's trade marks; (ii) use of the trading name

"RPG Optical" and "RPG Pharmacy" by the Defendants does not amount to

infringement of the Plaintiff's registered trade marks; and (iii) use of the trade marks

RPG PHARMACY /  ; RPG OPTICALS /  as also

trading names RPG Pharmacy; RPG Optical and domain names www.rpgpharmacy.com and www.rpgopticals.com amounts to passing off. If injunction is not granted, the Plaintiff is likely to suffer / continue suffering irreparable injury. The balance of convenience is also in favour of the Plaintiff and against the Defendants. The adoption of the impugned marks by the Defendants is *prima facie* dishonest and therefore there are no equities in favour of the Defendants.

ORDER

73. Accordingly, the Plaintiff's Notice of Motion is allowed and the following order is passed in terms of prayer clauses (a) and (b) of the Notice of Motion, except the bracketed portion, which read as follows:

(a) Pending the hearing and final disposal of the suit, the Defendants by themselves, their directors/ proprietor/ partners/ principals/ employees/ agents/ distributors/ franchisees/ representatives/ assigns and all those connected with them in their business be restrained by an order and injunction of this Hon'ble Court from manufacturing, marketing, trading, selling and/or using in any manner whatsoever in relation to any goods and/or services, inter alia, advertisement, wholesale, retail of Optical lenses, sunglass, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products and pharmacy services, pharmacy advice, pharmacy dispensary services, the impugned marks-

RPG,

RPG Optical /



and/or

RPG Pharmacy/  or any other mark, device, logo, domain name [or trade name], which are identical with or deceptively similar to the Plaintiff's prior, registered and well-known trade marks ,

, RPG Life, RPG Life Sciences, 

and  in any manner whatsoever without the permission, consent, license of the Plaintiff so as to infringe upon the Plaintiff's said trade marks registered in India in classes 05, 09, 12, 16, 30 as per the details mentioned hereinabove;

(b) Pending the hearing and final disposal of the suit, the Defendants by themselves, their directors/ proprietor/ partners/ principals/ employees/ agents/ distributors/ franchisees/ representatives/ assigns and all those connected with them in their business be restrained by an order and injunction of this Hon'ble Court from manufacturing, marketing, trading, selling and/or using in any manner whatsoever in relation to any goods and/or services, inter alia, advertisement, wholesale, retail of Optical lenses, sunglass, eyewear, eyeglasses, contact lens, ophthalmology, spectacles and other optical products and pharmacy services, pharmacy advice, pharmacy dispensary services, the impugned marks-

RPG, **RPG Opticals/**  and **RPG Pharmacy/**  or any other mark, device, logo, domain name or trade name, which are identical with or deceptively similar to the Plaintiff's prior, distinctive and reputed trade marks- **RPG,** , , RPG Life, RPG Life

Sciences,  and  so as to pass off their goods and business or enable others to pass off the Defendants' business and goods as and for those of the Plaintiff or in some way connected therewith or from taking benefit of the reputation and goodwill of the Plaintiff in any manner whatsoever;

74. The above Notice of Motion is accordingly disposed of. Needless to add, the findings arrived at are *prima facie* in the nature which shall have no bearing when the suit is decided at final stage after recording the evidence.

(S.J.KATHAWALLA, J.)

75. At the request of the learned Advocate appearing for the Defendants, time is granted to the Defendants upto 11th April, 2022 to carry out the directions set out in the above matter.

(S.J.KATHAWALLA, J.)