



Commercial Suit No.1/2021
(CNR No. : MHPU01-000107-2021)

Cutis Biotech
Vs.
Serum Institute of India Pvt.
Ltd.

ORDER BELOW EXH. 5

1] This is an application under Order XXXIX, Rule 1 and 2 of Code of Civil Procedure by plaintiff for seeking temporary injunction to restrain defendant company temporarily from committing act of passing off of the trade mark, namely, '**Covishield**', so also, to restrain it temporarily from using the trade mark, namely, '**Covishield**' and also to direct defendant to maintain and submit the accounts of profit earned through using the trade mark '**Covishield**'.

2] Plaintiff is a sole proprietorship concern, namely, "Cutis Biotech". The address of plaintiff is shown at Nanded, Maharashtra. The sole proprietor of plaintiff firm is Smt.Archana Ashish Kabra. As per plaintiff, they are in business of pharmaceuticals since 2013. They have got the required licences from Foods and Drugs authorities. On 25/04/2020 plaintiff coined the word '**Covishield**' and decided to use the same in respect of pharmaceuticals and other related products. Therefore, plaintiff took search about the trade mark '**Covishield**' for the products mentioned in Class-5 category. As no one had obtained such trade mark previously, plaintiff applied for the registration of trade mark '**Covishield**' in respect of veterinary, Ayurvedic, Allopathic, medicinal and pharmaceutical preparations

and vitamins and dietary food supplements for human and animals in Class-5 category. The application is placed on record of dated 29/04/2020. The application is made to the trade mark office at Gaziabad for the jurisdiction of Delhi.

3] Plaintiff further submits that, then it is started using the trade mark '**Covishield**' and thereby placed orders to manufacturers. Since 30th May 2020 plaintiff started receiving products like antiseptic, disinfectants, sanitizers, surface spray, fruit and vegetable washing liquid bearing the trade mark '**Covishield**'. After receiving the products bearing the name of '**Covishield**', plaintiff started selling the products in the market from 30/05/2020. Plaintiff submits that, products which their firm is selling under the above said trade mark is of high quality and earned good reputation. The photographs of the products are placed on record.

4] Copies of invoices issued by the manufacturers are also placed on record. Plaintiff submits that, up till now i.e. since 30/05/2020 to 31/12/2020 it has done the turn over of about Rs.16,00,152/- by doing the trade of the products, named as '**Covishield**'. However, on 07/12/2020 plaintiff came to know through news that defendant has applied before the Drugs Controller General of India for approval of vaccine for preventing disease Covid-19, under the brand/trade mark, namely, '**Covishield**'. Then, plaintiff took the trade mark search on website of Trade Mark Registry and found that, on 06/06/2020 defendant has applied for the trade mark '**Covishield**' in the same class-5 bearing application No. 4522244 for the product i.e. vaccine for human use. Defendant

has applied not only for getting trade mark, namely, '**Covishield**', but for other five alternate trade marks for the product i.e. vaccine for human use i.e. Covidshield, Covid Protect, Covid-Vac, Covi-Vac, Covi-Vaxx.

5] Plaintiff further submits that, on 15/08/2020 one of the trade partners of plaintiff i.e. Indorama Engineers denied to supply multi-vitamin injection to plaintiff under brand name '**Covishield**' as there is possibility of confusion. Thereafter, on 11/12/2020 plaintiff filed Civil Suit No.1/2020 against defendant before the District Court at Nanded, in which defendant appeared and raised ground of jurisdiction. That suit is still pending at Nanded Court.

6] Plaintiff submits that, a fresh cause of action to file present suit has arisen on 02/01/2021 when plaintiff came to know through website that, director of the defendant company Mr. Poonawalla announced that, they are launching vaccine to prevent Covid-19 under the brand name '**Covishield**'. As soon as plaintiff got the knowledge of the proposed launching of the said vaccine under the trade mark '**Covishield**', plaintiff immediately approached to this Court by filing the present suit on 04/01/2021.

7] Plaintiff submits that, plaintiff and defendant are trading in the common field of activity. Defendant is using the same trade mark '**Covishield**', which is firstly used by the plaintiff firm. Therefore, plaintiff is the prior user. The act of defendant is of misrepresentation and deceitful to the customers/consumers. Due to the act of defendant, dealers of the plaintiff are not ready to sell the product of the plaintiff; thereby plaintiff is suffering losses. The act

of defendant is passing off of the trade mark '**Covishield**', which is already earned goodwill and reputation and used by the plaintiff. As such, plaintiff submits that, it has prima facie case, balance of convenience and likely to suffer irreparable loss. Therefore, plaintiff is seeking temporary injunction against the defendant.

8] Defendant company appeared through advocate and filed its reply below Exh.20. Defendant company has strongly contended that, plaintiff has no prima facie case, because firstly, plaintiff is not manufacturing any vaccine for human use, for that matter any vaccine to prevent Covid-19. Plaintiff has applied for registration of trade mark '**Covishield**' for products disinfectant spray, sanitizer etc. in category Class-5. Defendant is not manufacturing any of the articles/products in which the plaintiff has applied for the registration of trade mark. Defendant has only manufacturing vaccine to prevent Covid-19 and for human use only. Therefore, there is no common nature of activity between plaintiff and defendant company.

9] Further, defendant submits that, it is seriously doubtful whether plaintiff is using the trade mark '**Covishield**' prior to the defendant. Further, the nature of products, visual appearance of the products of plaintiff and defendant are totally different. There is no possibility of creating any confusion, misrepresentation or deceit in the mind of consumers. Further, at the most, plaintiff has entered into the market in May 2020, then also it cannot be said that, plaintiff has earned substantial goodwill or reputation of such nature that defendant is taking undue advantage of it. Therefore, the basic

ingredients of the action of passing off are missing in this matter.

10] Further, defendant has no intention to divert the customers of plaintiff, nor it has any intention to produce any such products similar to the plaintiff's product. Therefore, neither there is goodwill of plaintiff's products nor there is misrepresentation on the part of defendant. Therefore, there is no question of any financial damage to the plaintiff through the act of defendant. As such, plaintiff has no prima facie case against the defendant.

11] Defendant further submits that, plaintiff has concealed the material fact and document that it had applied to the Trade Mark Registry at Gaziabad on 12/12/2020 for registration of trade mark '**Covishield**' for the product i.e. vaccine for human use also. That application is placed on the record by the defendant to show that, plaintiff has not approached to the present Court with clean hands. Therefore, defendant submits that, plaintiff has concealed the material fact and document; it amounts fraud on the court. Therefore, plaintiff is not entitled for equitable relief.

12] Defendant further submits that, balance of convenience lies in favour of the defendant only, because the vaccine innovated by the defendant company is a medicine to prevent a deadly disease i.e. Covid-19. Defendant presently supplying the human vaccine under trade mark '**Covishield**' to Government of India and also exporting it to many other countries. Therefore, the consumers of the product of defendant i.e. vaccine '**Covishield**' are much much larger in numbers than the number of consumers of the product of plaintiff. At this stage, if the preventive order is passed against

defendant, a major portion of society in the world is going to affect; who is trying hard to fight with the deadly disease Covid-19. On the other hand, the product of the plaintiff is being used at the most by the consumers within limited area and limited numbers and that too the product of disinfectants. Therefore, the balance of convenience fully lies in favour of the defendant. Ultimately, defendant is going to face comparative more hardship and irreparable loss if the preventive interim order is passed against defendant. As such, defendant has contended that, plaintiff is not entitled for any interim relief.

13] After going through the contentions of both the sides, I prefer to frame following points for adjudication of this application alongwith the findings for the reasons discussed below.

	<u>Points</u>	<u>Findings</u>
1]	Whether Plaintiff proves the prima facie case ?	 No.
(1a)	Whether Plaintiff prima facie proves that, it has established goodwill in the market?	
(1b)	Whether Plaintiff prima facie proves that, Defendant has misrepresented or likely to misrepresent the trade mark “ Covishield ” to the public at large ?	
(1c)	Whether Plaintiff prima facie proves that, it has suffered damages due to the act of Defendant ?	

- 2] Whether balance of convenience lies in favour of the Plaintiff? No.
- 3] Whether Plaintiff prima facie proves that, it would suffer irreparable loss if the Defendant is not temporarily restrained from using the trade mark, namely, **'Covishield'**? No.
- 4] What Order? As per final order.

14] Heard the learned Advocate Mr. Aditya Soni for Plaintiff and learned Advocate Mr.S.K.Jain for Defendant. Perused the papers.

REASONS

AS TO POINT NO.1 [(1a). (1b) & (1c)] :

15] Learned advocate for plaintiff has contended that, plaintiff's firm has coined the trade mark **'Covishield'**. Plaintiff has applied for the registration of trade mark **'Covishield'** by filing application on 29/04/2020 itself bearing No. 4493681. Advocate for plaintiff has relied upon the invoice dated 30/05/2020 and contended that, they started using the trade mark **'Covishield'** since 30/05/2020. He further pointed out the E-mails of their trade partner Indorama Engineers, dated 07/12/2020. As such, on 07/12/2020 their trade partner refused to manufacture injection under name **'Covishield'** because of upcoming **'Covishield'** vaccine of defendant institute. Advocate for plaintiff has relied upon

certificate issued by their Chartered Accountant to show their actual turn over through the brand name '**Covishield**'.

16] As such, advocate for plaintiff has contended that, prima facie plaintiff firm is using the trade name '**Covishield**' prior to the defendant. It has already started using the trade mark '**Covishield**' and thereby earned goodwill in the market. Defendant's application for registration of the trade mark '**Covishield**' is of dated 06/06/2020 i.e. subsequent to the plaintiff's application. Defendant's product is presently not available in the market, but it is likely to create confusion in the mind of consumers as the trade name is the same. Therefore, defendant's act amounts to misrepresentation. Further, as per the certificate of Chartered Accountant of plaintiff, they have done turn over through products, namely, '**Covishield**' of amount of Rs.16,00,152/-. But, now no dealer is ready to sell the product of the plaintiff. Therefore, plaintiff is suffering financial loss, the actual amount of loss can be calculated during the course of trial. As such, advocate for plaintiff has contended that, it has prima facie fulfilled three ingredients for seeking relief against defendant i.e. goodwill of the plaintiff firm, misrepresentation by the defendant company and financial loss / damages to the plaintiff through the act of defendant. As such, advocate for plaintiff contends that, it has proved the prima facie case against the defendant.

17] Advocate for plaintiff has relied upon following some citations in support of its contention :

- [1] **Neon Laboratories Ltd. Vs. Medical Technologies Ltd. & Ors.**, reported in (2016) 2 Supreme Court Cases 672.

In this case, Hon'ble Supreme Court has discussed about the first user test and first in market test. As respondent/plaintiff is using the trade mark "**Profol**" well before admitted user of an identical or closely similar trade mark by appellant/defendant. Therefore, by applying the first user test, the injunction in favour of respondent / plaintiff for the act of passing off by appellant/defendant is upheld. It is held that, rights of prior user over prior registration are to be protected applying first in the market test.

[2] Laxmikant V. Patel Vs. Chetanbhai Shah & Anr., reported in (2002) 3 Supreme Court Cases 65.

By passing off cases under Trade Marks act, protection of goodwill of the plaintiff is necessary. If the defendant's act intends to deceive and to divert the business from the plaintiff and if the act of the defendant is likelihood of injury to the business of plaintiff even innocently, then such act of the defendant should be restrained.

[3] Kirloskar Diesel Recon Pvt. Ltd. & Anr. Vs. Kirloskar Proprietary Ltd. and Ors., reported in AIR 1996 Bom 149 (decided by Hon'ble Bombay High Court on 10/10/1995).

Though, the fields of activity of plaintiff and defendant are different, then also, if confusion or deception of public and consequent damage to the plaintiff are prima facie shown or even likelihood of it is shown, then defendant to be restrained from using the similar trade mark.

- [4] **Shri Pankaj Goel Vs. Dabur India Ltd.**, reported in 2008 DGLS (Del.) 1507 (decided by Hon'ble Delhi High Court on 04/07/2008).

When the products of appellants and respondent are not only similar, but are identical and purchased by same class of customers and sold through same trading channel, it is a case of confusion and passing off. Such act of appellants prima facie noticed to be dishonest and hence injunction is upheld.

- [5] **Consolidated Foods Corporation Vs. Brandon and company Pvt. Ltd.**, reported in AIR 1965 Bombay 35 (decided by Hon'ble Bombay High Court on 26/04/1961).

It is held that, registration of a trade mark does not confer any new right or greater right than what already existed at common law and at equity without registration. The trade mark exists independently of registration which merely affords further protection under the statute. Priority in adoption and use of trade mark is superior to priority in registration.

- [6] **Bengal Waterproof Limited Vs. Bombay Waterproof Manufacturing Company & Anr.**, reported in (1997) 1 Supreme Court Cases 99.

It is held that, continuous passing off action on the part of defendants subsequent to filing of earlier suit and continuing till date of filing of second suit, then cause of action in two suits are different. Therefore, bar under Order II, Rule 2 of Code of Civil Procedure would not be attracted.

[7] **Hindustan Unilever Ltd. Vs. Emami Ltd.**, reported in MANU/MH/1001/2020 (decided by Hon'ble Bombay High Court on 17/08/2020).

Appellant being the prior user of the trade mark Glow & Handsome, defendant is restrained from using the same trade mark. Though, the trade mark of plaintiff is not registered, but it has been already launched and used by the plaintiff, defendant is restrained from using it.

[8] **Dhariwal Industries Ltd. and Anr. Vs. M.S.S. Food Products**, reported in (2005) 3 Supreme court Cases 63.

Product of plaintiff as well as defendant under trade mark "Malikchand" and "Manikchand" are unregistered trade marks. But, prima facie plaintiff is shown to be prior user of the trade mark and that balance of convenience was in favour of plaintiff and thereby interim injunction has been granted.

[9] **Indian Bank Vs. Maharashtra State Co-operative Marketing Federation Ltd.**, reported in (1998) 5 Supreme Court Cases 69.

Bar under Section 10 of Code of Civil Procedure is to the proceeding with the trial of the subsequently instituted suit. But in summary suit, under Order XXXVII of Code of Civil Procedure, a Court can proceed up to stage of hearing of summons and passing of judgment against defendant. The word "trial" is discussed and interpreted. It is not barred to pass interlocutory orders.

[10] **Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. & Ors.**, reported in (2018) 2 Supreme Court Cases 1.

If plaintiff proves prima facie his goodwill or reputation in the market, it is not burden on plaintiff to establish actual confusion. But even possibility of it can be demonstrated while restraining defendant from doing the act of passing off.

[11] **Kamal Trading Co. & Ors. Vs. Gillette U.K. Limited**, reported in MANU/MH/0828/1987 (decided by Hon'ble Bombay High Court on 25/09/1987).

Though, the goods manufactured by plaintiffs and defendants are different in nature and in different classes, still there is likelihood of deception to the customer.

[12] **K. Narayanan & Anr. Vs. S. Murali**, reported in (2008) 10 Supreme Court Cases 479.

In a suit for passing off action, location of the Registrar Office of the under trade mark or the place where the application for registration of trade mark is filed, is irrelevant. It is not necessary for plaintiff to prove that, he had applied for registration of such trade mark to establish his right on the trade mark when restraining order is sought for passing off of the trade mark.

18] As such, relying on aforesaid authorities, advocate for plaintiff has contended that, firstly, plaintiff and defendant have applied for registration of trade mark for the goods of same class or category i.e. Class-5. Plaintiff has already manufactured and started

using the trade mark '**Covishield**'. Therefore, plaintiff is prior user. Though, act of the defendant may be unintentional, but it is going to create confusion, misrepresentation in the mind of consumers. Therefore, the act of defendant is deceitful. Plaintiff has suffered financial losses. As such, advocate for plaintiff has strongly contended out that, it has prima facie case and defendant is necessary to be restrained during pendency of the trial of present suit.

19] Advocate for defendant has strongly relied upon two important case laws in this regard :

[1] **Nandhini Deluxe Vs. Karnataka Co-operative Milk Producers Federation Limited**, reported in (2018) 9 Supreme Court Cases 183.

[2] **Vishnudas Trading as Vishnudas Kishendas Vs. Vazir Sultan Tobacco Co. Ltd., Hyderabad & Anr.**, reported in (1997) 4 Supreme Court Cases 201.

It is pointed out that, the *Vishnudas Trading AS Vishnudas Kishendas* case mentioned supra is cited and relied upon in the case *Nandhini Deluxe* mentioned supra at Serial No.1.

Advocate for defendant has submitted that, this is the latest view of Hon'ble Supreme Court which is now law of the land. He submits that, in both the above said cases, Hon'ble Supreme Court has stated that, even though the plaintiff has got the registration of trade mark for products or goods in a category falling under one class; it does not vest monopoly over the entire class of the goods with the proprietor of such registered mark.

20] When the visual appearance of the trade marks of plaintiff and defendant are different, when the products are for different purposes and it does not create any confusion in the mind of average man of ordinary intelligence, then it is not deception or misrepresentation.

21] Advocate for defendant contends that, in the case in hand, defendant is manufacturing vaccine for preventing Covid-19 for human use. It has applied for registration of trade mark '**Covishield**' for the said vaccine. On the other hand, the product of plaintiff is about the disinfectant spray, hand and vegetable washing liquid etc. It does not have any connection with the vaccine for human use. Though, the goods/items mentioned by the plaintiff and the defendant fall within the same category i.e. Class-5, as per the ratio in the above said citations, when the visual appearance of the product of plaintiff and product of defendant is totally different, the purpose of product of plaintiff and defendant is also totally different. Prima facie, it does not create any confusion in the minds of ordinary person of average intelligence. Then, there is no deception or misrepresentation on the part of defendant. Therefore, advocate for defendant has strongly contended that, there is no prima facie case.

22] I perused the above said two citations placed on record by the defendant, in which Hon'ble Supreme Court has discussed about the test of deceptiveness and confusion. In the case of *Nandhini Deluxe* mentioned supra, the question was about the products of plaintiff/appellant applied for registration of the trade mark '**Nandhini**' for goods like meat, fish, poultry and hen and other

food articles. On the contrary, the trade mark of respondent was using the trade mark '**Nandini**' for milk and milk products. Hon'ble Supreme Court has held that, though the trade mark of respondent i.e. '**Nandini**' is registered one for milk or milk products which fall under Class-29 and 30. The trade mark of appellant '**Nandhini**' is for the above said different articles and fall under same Class-29 and 30, the products are different. There is no intention on the part of the respondent to manufacture any of the articles as like of appellant. In such scenario, the proprietor of trade mark cannot enjoy monopoly over the entire class of goods. Appellant can certainly have trade mark "**Nandhini**" for the goods mentioned above i.e. other than milk and milk products which are manufactured by the respondent company.

23] In the case of *VishnudAS Trading AS VishnudAS KishendAS* mentioned supra, trade mark '**Charminar**' was registered in favour of respondent for the product of Tobacco, which fall under Class-34 of schedule of trade mark rules. But, respondent manufactures only Cigarettes and no other article of Tobacco. Appellant applied for rectification of trade mark registration and to the extent of using it for other products of Tobacco, like Zarda. It is held by the Hon'ble Supreme Court that, there is no intention on the part of respondent to manufacture any other product of Tobacco than Cigarette. On the contrary, appellant wanted to use the trade mark for other products of Tobacco within the same class. Then, appellant is entitled rectification of the registration of trade mark '**Charminar**' to the extent of other products of Tobacco. Once a registration of trade mark is granted for a product in a class, it does

not mean that, the proprietor of such trade mark gets the monopoly for the entire class. It is the ratio in both the above said citations.

24] In the present matter, trade mark for products of plaintiff and defendant are not yet registered. But, the test of deceptiveness or misrepresentation discussed in the above said two citations, can be applied to the case in hand. I perused the photographs of the products of plaintiff as well as defendant. Prima facie, visual appearances of the products are totally different. Though, plaintiff and defendant both have applied for the registration of trade mark '**Covishield**' in Class-5 category, as per the ratio in the above said citations, if the plaintiff succeeds in getting the trade mark for the disinfectant spray, sanitizer etc., then also it does not mean that, he would get monopoly for the goods in Class-5. The product of the defendant is the vaccine to prevent Covid-19 that too for human use. The visual appearance is different. The purpose of the product is different. The consumers of product may be different. In such scenario, the trade mark of '**Covishield**' for the product of defendant cannot be said to be prima facie misrepresentation or confusion in the mind of people about the product of plaintiff. The above said two judgments are of Hon'ble Apex Court and subsequent in time than the citations placed by plaintiff at Serial No. 1, 3, 4, 7, 8, 10 and 11 mentioned in above Para No.17. Therefore, the ratio in present two citations i.e. *Nandhini Deluxe* and *VishnudAS Trading AS VishnudAS KishendAS* shall certainly prevail and presently law of the land. These citations are seen to be applicable to the case in hand.

25] Further, advocate for defendant has relied upon following citation i.e.

[1] **Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.**, reported in AIR 2001 Supreme Court 1952.

In this case, Hon'ble Supreme Court has held that, for an action for passing off of unregistered trade mark, the question of deceptive similarity is to be considered on the basis of certain factors which are given in Para No. 35 of the judgment.

Advocate for defendant has contended that, if these factors are considered about the plaintiff's and defendants' products, then it can certainly be held that, there is no deceptive similarity and there is no misrepresentation. If the criteria given by Hon'ble Apex Court in the above said citation is applied prima facie to the plaintiff's product and to the product of defendant, prima facie, it is seen that, the visual appearances of both the products are different. Though, both the products have applied for registration of trade mark in same category i.e. Class-5; firstly, there is no prima facie resemblances between the products, character, and performance of the products are different. Class of the purchaser may be different. The mode of purchase the products may be different; because products of plaintiff can be purchased without any medical prescription and product of the defendant is a purely medicinal product and if even launched in open market, then also, it would be available on prescription only.

26] Further, Hon'ble Apex Court has also directed to consider the surrounding circumstances relevant for dissimilarity between the competing markets. Plaintiff's advocate has also

clearly submitted that, they have no objection about selling of vaccine by defendant; but have objection only about usage of the trade mark '**Covishield**'. The surrounding circumstances are such that, plaintiff is exclusively in trade of the disinfectant spray and the products as mentioned in its application dated 29/04/2020. He has no intention prima facie to manufacture any vaccine to prevent Covid-19. It has not even complied any procedure for preparation or manufacturing any vaccine for prevention of Covid-19. On the contrary, defendant is exclusively manufacturing the vaccine to prevent Covid-19 under the trade mark '**Covishield**'. It has no other product but to the vaccine under the said trade mark. Defendant has no intention to manufacture any of the product similar to the product of plaintiff under the trade mark '**Covishield**'.

27] The further surrounding circumstances are such that, presently Government of India is the buyer of the product of defendant, in India. It means, it is a medicine for the disease Covid-19 presently made available through Government of India. Therefore, class of the present consumers of the product of defendant is totally different. Plaintiff has no consumers out of India or in any foreign country. On the contrary, defendant is exporting the product in foreign countries as it is a vaccine to prevent Covid-19. Therefore, there is no question of misrepresentation or confusion in the mind of ordinary person of average intelligence.

28] The further act of the defendant is not prima facie seen to be with intention to divert customers of the plaintiff or to create any confusion in the mind of the ordinary person or to divert the

business of the plaintiff. In the above said case of *Laxmikant V. Patel* mentioned supra, Hon'ble Supreme Court has observed that, if the act of the defendant is likely to divert the business and thereby, likely to cause injury to the plaintiff; then it is to be restrained. But, in the present matter, considering the nature of products of plaintiff and defendant, firstly, no prima facie intention is seen on the part of defendant to create confusion or misrepresentation and further, there is no likelihood found to cause injury or divert business of the plaintiff. Therefore, prima facie, plaintiff could not put forth the case against defendant.

29] Further, defendant has relied upon the case of *Toyota Jidosha Kabushiki Kaisha*, mentioned supra and cited by plaintiff also. Advocate for defendant has submitted that, at the most, prima facie plaintiff has launched his product since 30/05/2020. The question remained whether he is selling the product at Nanded where its office situates or within the jurisdiction of Delhi where it applied for registration of trade mark. But, still even assuming that, since May 2020 it is using the trade mark '**Covishield**', it is very hard to believe that, standing of the plaintiff is such that, it has earned goodwill of such nature that, defendant has intended to pass it off. In this regard, I find that, firstly, defendant's product i.e. vaccine for Covid-19 is a medicine and it has been presently made available for the consumers through government machinery only. So far as, probability of future confusion in the mind of ordinary person is concerned, it is burden on the plaintiff to prima facie prove at this stage without trial that the deception on the part of defendant is intentional and to harm the goodwill of the plaintiff and it is so sure

that, such probable deception would definitely be caused. This is the ratio of *Toyota Jidosha Kabushiki Kaisha* case. But, in the case in hand, plaintiff has failed to point out prima facie that the probable or likelihood deception in future is so probable. Firstly, the usage of products of plaintiff and defendant is different, visual appearances are different. The standing of plaintiff's product in market is prima facie recent one and not substantial. The place where there is no trade of plaintiff's products, at that place, prima facie there is no possibility of confusion. In such scenario, I find that, the ratio of *Toyota Jidosha Kabushiki Kaisha* case mentioned supra, is also not much useful for the plaintiff's case. Prima facie plaintiff could not prove its goodwill as well as misrepresentation on the part of defendant, plaintiff has failed to prima facie show the damages caused to it due to act of defendant. The turnover of plaintiff's company through the said products is not clearly made out. Moreover, assuming so when defendant's act is not shown to be responsible for affecting its turnover. Therefore, there is no question of damages to plaintiff at this stage.

AS TO POINT NO.2 & 3 :

30] Defendant has relied upon the following citation and contended that, while granting the injunction for the act of passing off of trade mark, the comparative hardship and balance of convenience are also necessarily to be considered.

[1] **N.R.Dongre & Ors. Vs. Whirlpool Corporation & Anr.**, reported in (1996) 5 Supreme Court Cases 714.

In this case, product of Whirlpool were already in the market.

Hon'ble Apex Court has considered that, irreparable injury would be caused to the respondent Whirlpool, whereas no injury would be caused to the appellant by grant of injunction as their product can be sold by replacing the label Whirlpool. Advocate for defendant has contended that, mere test of prior user is not sufficient, but since how long the product of the plaintiff is in market is also very important; whether there is injurious fraudulent intention or unfair trade on the part of defendant and whether there is intention to deceive the customer. If no such intention is there on the part of defendant, then merely plaintiff is prior user of the trade mark cannot be the sole basis for grant of injunction.

31] Advocate for defendant has contended that, plaintiff has placed on record only the invoices of their trade partners or manufacturers or dealers. Firstly, plaintiff is not itself manufacturing any product under trade mark '**Covishield**'. Further, plaintiff has failed to point out prima facie that, any individual customer denied the product of plaintiff because of launch of product of the defendant. Therefore, plaintiff has failed to prove that, prima facie there is confusion or misrepresentation or deception to the individual customer or ordinary person of average intelligence. If any dealer or trade partner denied to purchase any product under the name of '**Covishield**', it does not mean that, defendant misrepresented or deceived any customer. Therefore, the basic ingredient of misrepresentation on the part of defendant is not prima facie made out in the present matter.

32] After going through the documents filed on record filed by the plaintiff i.e. invoices of the product and some E-mails by the

dealer or manufacturer or trade partner, it is seen that, it is the internal communication between plaintiff and such trade partners or dealers. Plaintiff has prima facie failed to point out that, there is any deception to an individual customer. Though, it is settled principle of law that, the probable or likelihood deception can also be considered in case of passing off. In the present matter, prima facie such likelihood of deception or probable future deception, also could not be pointed out by the plaintiff. As discussed above that there is difference in visual appearance between the products of plaintiff and defendant, the purpose of products of plaintiff and defendant are different. Therefore, prima facie such likelihood of deception is also not seen.

33] Advocate for defendant has further pointed that, now, the vaccine '**Covishield**' is available in India as well as abroad. It is a preventive medicine for disease Covid-19. If the restraining order is passed by the court, it is going to affect not only the consumers in India, but abroad. Comparative hardship certainly would be to the defendant company and its customers. Therefore, advocate for defendant has strongly contended that, balance of convenience completely lies in favour of defendant only.

34] Since last several months, not only India, but the world is facing the pandemic of Covid-19. All people are desperate to get a preventive medicine for said disease. Now, the defendant company and some other companies are manufacturing the vaccine for such deadly disease of Covid-19. It is a step towards control over the pandemic of Covid-19. Now, it is much desirable product and much

awaited product by the people all over the country and all over the world. If, at this stage, defendant is restrained from using the trade mark of '**Covishield**' and distributing this vaccine under the said trade mark, it would be great hardship to the people to identify the product of defendant. Therefore, comparative hardship and balance of convenience certainly lie in favour of defendant. On the contrary, if the interim injunction is not granted, the products of plaintiff still can be in the market and it can sell the product under its name as the purposes of products of plaintiff are totally different. Those are disinfectants for hand, surface and vegetable washing liquid and other purposes mentioned in their application. Comparatively, defendant and its customer would suffer great hardship than the plaintiff, if the injunction is granted. Therefore, this point lies in favour of the defendant. Plaintiff has failed to prove the balance of convenience in its favour.

35] It is case of plaintiff that, if the defendant is not temporarily prevented from using the trade mark '**Covishield**', the product of plaintiff will not be purchased by its buyers or not manufactured by their manufacturers, trade partners and thereby plaintiff is going to suffer irreparable loss. But, this point is closely related with the earlier points. Firstly, as for the ratio in the cases of *Nandhini Deluxe* and *Vishnudas Trading AS Vishnudas Kishendas* mentioned supra, even assuming that, plaintiff is manufacturing certain products in Class-5 category under the trade mark '**Covishield**', then also, it does not mean that, it got monopoly over the all goods in the same category. Further, plaintiff prima facie could not point out that, any of the individual customer has denied

its product, because defendant company has launched the vaccine under the trade mark '**Covishield**'. There may be denial on the part of trade partners or dealers of the plaintiff for purchasing the product under the trade name '**Covishield**'. But, it does not mean that, customers are not ready to purchase the product of plaintiff under the trade mark '**Covishield**'.

36] Prima facie, plaintiff could not point out that, due to the use of the trade mark '**Covishield**' by defendant, it is going to suffer irreparable loss. The losses alleged by plaintiff can be quantified, if proved during trial. Therefore, loss cannot be said to be an irreparable loss and that too prima facie at the hands of defendant. Therefore, this point also goes against the plaintiff.

37] Advocate for defendant has further pointed out that, plaintiff has not approached to this court with clean hands. It has suppressed the material document and fact that, it has applied to the concerned authority under the trade mark for registration of trade mark '**Covishield**' for vaccine purpose. On the contrary, advocate for plaintiff has submitted that, it is not seen to be necessary or relevant to point out the document and the fact to this Court for decision of the present application or suit. But, in my view, the subsequent application dated 12/12/2020 filed by the plaintiff for registration of the trade mark '**Covishield**' for vaccine and other purposes, is a relevant document and this fact should have been pointed out by the plaintiff to this Court. I find substance in the contention of the advocate for defendant that, plaintiff has not approached to this court with clean hands. Therefore, prima facie, on this count also I

am of the view that, plaintiff is not entitled for the equitable relief of interim injunction.

38] So far as, the further arguments about maintainability of the present second suit by the plaintiff when the first suit is filed in the Court at Nanded is concern, I am of the view that, this point can be considered during the course of trial. But, at this juncture, for grant of interim injunction or denial of it, the above said considerations and points are sufficient to come to a conclusion. As I discussed above that plaintiff could not point out the prima face case i.e. the trinity of the passing off a trade mark i.e. goodwill of the plaintiff, misrepresentation by the defendant and damages to the plaintiff. So also, plaintiff could not point out that, balance of convenience lies in its favour nor plaintiff could point out that, it is going to suffer irreparable loss. The prima facie approach of the plaintiff to this Court with clean hands, is seen to be doubtful. Therefore, in all, I am of the view that, plaintiff is not entitled for the interim injunction. Hence, the following order.

ORDER

- 1] The application (Exh.5) is rejected.
- 2] Cost in cause.

Pune.
Date : 30/01/2021.

[Smt. A. V. Rotte]
District Judge- 2, Pune

CERTIFICATE

I affirm that the contents of this P. D. F. file Order are
..25..

same word for word as per original Order.

Name of the Court :- Smt. A. V. Rotte,
District Judge-2 &
Additional Sessions Judge, Pune.

Name of the Steno :- Shri. D. L. Gudde,
Stenographer (Grade-I)

Date of Order :- 30/01/2021

Order signed by
presiding officer :- 30/01/2021

Order uploaded on :- 30/01/2021.