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

INTERIM APPLICATION (L) NO. 20626 OF 2021
WITH
LEAVE PETITION NO. 295 OF 2021
IN
COMMERCIAL IP SUIT NO. 18 OF 2022
WITH
COMMERCIAL IP SUIT NO. 18 OF 2022

Pidilite Industries Limited ... Applicant/ Plaintiff

Versus

Innovation Coatings Pvt. Ltd. ... Defendant

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Mr. Hiren Kamod a/w Mr. Nishad Nadkarni, Mr. Aasif Navodia, Ms. Khushboo Jhunjhunwala, Ms. Rakshita Singh and Ms. Jaanvi Chopra i/by Khaitan & Co. for Applicant/Plaintiff.
Mr. Alankar Kirpekar a/w Mr. Shekhar Bhagat, Mr. Ayush Tiwari, Mr. Rajas Panandikar, Chinmay Pagedar i/by Shekhar Bhagat and Neelaja Kirpekar for Defendant.

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CORAM: MANISH PITALE, J.
RESERVED ON : 1st APRIL 2025
PRONOUNCED ON : 25th APRIL 2025

P.C. :

. In these proceedings, the applicant/plaintiff is asserting its intellectual property rights in its registered trade mark “1K PUR”, which is used in connection with adhesive products of the applicant along with its well known registered trade mark/house mark “FEVICOL”. The applicant claims that the said adhesive

product bearing the registered mark “1K PUR” is one component ready to use moisture curing fast setting adhesive with gap filling properties. The details of registration of the said trade mark “1K PUR” independently and in association with the said house mark “FEVICOL”, are given in paragraph 16 of the plaint. Registration certificates are also annexed to the plaint, which show that for the registered trade mark “1K PUR”, the registration dates back to 20th July 2013 with user claim since 13th October 2006, while the registration for the mark “FEVICOL 1K PUR” also the dates back to 20th July 2013 with user claim since 13th October 2006. The applicant also has registration for the label mark/device mark 

, showing that the registration dates back to 3rd January 2008. The applicant has also given details in paragraph 17 of its registration in respect of the said trade mark “1K PUR” in international jurisdictions.

2. As regards sales figures pertaining to products bearing the mark “1K PUR” of the applicant, it is stated that there is steady increase in the sales turnover between 2006 to 2021. While the sales figure for the year 2021 is stated to be approximately Rs.86 lakhs, the total sales turnover between 2006 to 2021 adds upto Rs.484 lakhs. The applicant has also given sales turnover figures of such products outside India. It is stated that substantial amounts were also spent towards promotional expenses in respect of the said products bearing the mark “1K PUR”. On the basis of such

pleadings and documents filed in support thereof, the applicant claims statutory rights in its registered trade mark "1K PUR", as also common law rights on the basis of continuous use since 2006.

3. It is further pleaded that the applicant came across adhesive products of the defendant in March 2021, which show that the product was bearing the mark "INOVA 1K PUR". It was also found that the defendant was selling and advertising the impugned product through third party e-commerce websites and in this backdrop, on 16th March 2021, the applicant sent a cease and desist notice to the defendant, specifically alleging that by using the impugned trade mark "INOVA 1K PUR" on its adhesive product, the defendant was indulging in infringement of the registered trade mark of the applicant and that it was passing off its product as that of the applicant. The said letter was delivered by email to the defendant, but the notice sent through registered post returned with the remark "office closed". It is stated that the applicant did not receive any response from the defendant to the said cease and desist notice. It is further pleaded that since covid-19 pandemic had hit the Nation, the applicant could not immediately pursue further action, although it was under a belief that the defendant would have stopped indulging in such conduct upon receiving the notice from the applicant. But, towards the end of July 2021, the applicant is stated to have come across trade mark application filed by the defendant on 5th April 2021, seeking registration of the impugned trade mark "INOVA 1K PUR" in class

1, on proposed to be used basis. The examiner of the trade marks raised objection to the said application and the same was found to be pending. It is the case of the applicant that the defendant by filing the said application on 5th April 2021 for registration of the impugned trade mark "INOVA 1K PUR", after having received the cease and desist notice from the applicant, shows the malafide and dishonest conduct of the defendant. The applicant reiterated the said pleadings made in the plaint and pressed for interim reliefs in the application.

4. The defendant filed its reply affidavit stating that the applicant had indulged in falsehood and suppression while seeking reliefs in the present proceedings. It was claimed that the defendant was using "1K PUR" on its product as a trade description, which literally means one component polyurethane resin and that the applicant had fraudulently obtained registration for such trade description. It was specifically stated in the reply that despite registration of the mark of the applicant i.e. 1K PUR, the applicant cannot claim any exclusive right to use the same, particularly when it could be demonstrated that since the year 1930, PUR is a known abbreviation for polyurethane resin/reactive and 1K means one component. Such a generic trade description can certainly not be used by the applicant exclusively as its trade mark.

5. The defendant further alleged that the photograph of the applicant's product annexed to the plaint was a misrepresentation

as the actual product used the words Moisture Curing 1K Polyurethane Adhesive, while in the photograph at Exhibit 'F' to the plaint, the words "1K" were deliberately suppressed and deleted. It was submitted that such conduct falsified the statement of truth filed on behalf of the applicant along with the plaint and on this ground also the application as well as the suit deserved to be dismissed.

6. Thereafter, the defendant pleaded about the history of use of PUR extensively in patent literature, which allegedly demonstrated common use of the trade description 1K PUR and 2K PUR, much prior to the applicant's claim of first use in the year 2006. In that regard, the defendant in its reply referred to patents of the years 1996 and 2004. It was further pleaded that the expression "1K PUR" was common to trade and its origin pertained to the German word "Komponente", which means "Component". Along with the reply, the defendant placed on record the photographs of various products, wherein the expression "1K PUR" was freely used in paints, adhesives and other such products. It was further stated that the defendant had moved the application for registration of its trade mark "INOVA 1K PUR", wherein "1K PUR" was being used as a generic trade description, in which the defendant was not claiming any exclusive right. On this basis, it was further submitted that the filing of the said application for registration of the trade mark "INOVA 1K PUR" cannot prevent the defendant from challenging the very registration of the trade mark of the

applicant i.e. "1K PUR". On this basis, it was submitted that the application deserved to be dismissed.

7. The applicant filed rejoinder affidavit in the application and refuted the contention raised on behalf of the defendant. It is to be noted that according to the defendant, the stand taken by the applicant in the rejoinder affidavit as regards the manner in which the registered mark "1K PUR" was adopted, is contrary to the stand taken originally in the plaint.

8. Mr. Hiren Kamod, learned counsel appearing for the applicant/plaintiff referred to pleadings and documents on record, including the reply affidavit and the rejoinder affidavit filed in the present application. He made submissions to deal with the contentions raised on behalf of the defendant. It was submitted that the defendant cannot claim that "1K PUR" is a commonly used trade description or it is common to trade, for the reason that the defendant itself has applied for registration of its trade mark "INOVA 1K PUR" and that therefore, the defendant is estopped from raising such a plea. In this regard, reliance was placed on judgment of this Court in the case of ***Jagdish Gopal Kamath & Ors. v/s. Lime & Chilli Hospitality Services, 2015 SCC OnLine Bom 531***. It was submitted that when 1K PUR forms a leading feature in the impugned mark of the defendant itself, it cannot lie in its mouth to claim that 1K PUR is common to trade or it is commonly used as a trade description. It was emphasized that the defendant has not incorporated any disclaimer in its application.

As regards the leading and essential features of a mark, the learned counsel placed reliance on judgments of this Court in the case of ***Pidilite Industries Limited v/s. Jubilant Agri & Consumer Products Limited, 2014 SCC OnLine Bom 50***, as also ***Ultra Tech Cement Limited v/s. Alaknanda Cement Pvt. Ltd. & Anr., 2011 SCC OnLine Bom 783***.

9. It was emphasized that the defendant itself was using 1K PUR as a trade mark and hence, it cannot fall back on the contention that the same is a commonly used trade description. It was further submitted that the defendant cannot casually raise the contention regarding common to trade or 1K PUR being a commonly used trade description without placing on record material to show substantial and extensive use of the same in India. In this regard also reliance was placed on the said judgment of the Supreme Court in the case of ***Jagdish Gopal Kamath & Ors. v/s. Lime & Chilli Hospitality Services*** (supra). It was submitted that the reply affidavit of the defendant fails to satisfy the high standard required to show substantial and extensive use of 1K PUR as a trade description or it being common to trade in India.

10. It was further submitted on behalf of the applicant that the defendant cannot rely upon the German word “Komponente” as the origin for the expression 1K, to claim that it is a commonly used trade description in India, for the reason that the said word is not commonly used or understood in India. In that regard, reliance was placed on judgments of this Court in the case of

Laboratories Griffon Private Limited v/s. Griffon Biometrix Private Limited, 2022 SCC OnLine Bom 6613 and *Kamani Oil Industries Pvt. Ltd. v/s. Bhuwaneshwar Refineries Pvt. Ltd., 2014 SCC OnLine Bom 595*. In this context, it was further emphasized that 1K PUR does not have any meaning in the mind of an average consumer. It was further emphasized that even according to the defendant its adoption and use of 1K PUR is much subsequent to the applicant's use of the same from the year 2006 onwards. In respect of addition of only the word "INOVA" to the applicant's registered trade mark "1K PUR", it was submitted that as per settled law laid down by the Supreme Court as far back as in the year 1969 in the case of *Ruston & Hornsby Ltd. v/s. Zamindara Engineering Co.*, *1969 SCC OnLine SC 329*, mere addition of a word cannot be of any advantage to the defendant and that a case for infringement is clearly made out.

11. As regards the contentions raised by the defendant under Section 30(2)(a) of the Trade Marks Act, 1999 (hereinafter referred to as 'Trade Marks Act'), it was submitted that the defendant cannot claim that its use of 1K PUR was for indicating the kind and quality of its product, but the same was being used evidently as a trade mark and hence, it was being perceived by the consumers as such. It cannot be claimed by the defendant that its mark was being used bonafide to describe the kind and quality of its product. In respect of the contentions raised by the defendant by relying on Section 35 of the Trade Marks Act, it was submitted

that the same cannot be of any assistance to the defendant for the reason that the adoption of the impugned mark "INOVA 1K PUR", wherein "1K PUR" is a leading feature, is obviously dishonest.

12. As regards the contention of the defendant that the registration of applicant's mark "1K PUR" itself is invalid, it was submitted that the defendant does not satisfy the limited scope available for raising such a plea as per the judgment of Full Bench of this Court in the case of ***Lupin Ltd. v/s. Johnson and Johnson, 2014 SCC OnLine Bom 4596***. It was submitted that the defendant has not been able to demonstrate that the registration of the applicant's trade mark can either be categorized as *ex-facie* illegal or fraudulent or that it would shock the conscience of this Court. Reliance placed on Section 36 of the Trade Marks Act on behalf of the defendant was also criticized on the ground that the said provision is clearly unavailable to the defendant as the same requires use of certain words in a widespread manner to the extent that no one can claim monopoly over such words or expressions. It was emphasized that reliance placed on behalf of the defendant on some patents was of no consequence because such patents did not pertain to any inventions titled 1K PUR and that such patents simply referred to one component polyurethane as an ingredient of specification in the patent.

13. The learned counsel for the applicant referred to the judgments upon which the defendant had placed reliance, stating

that the said judgments are inapplicable to the facts of the present case because the said cases concerned expressions like “MICRO”, “OXY”, or “THYROX” that were being commonly used as description terms and in such cases, the Court found that they could not be used as trade marks. It was submitted that, in the present case, the applicant has openly, continuously and commercially used its mark 1K PUR since the year 2006 and that it has valid registration from the year 2013, while the defendant on its own showing started using its mark, of which 1K PUR is a leading essential feature, only from the year 2021. It was submitted that the defendant has not placed on record any sales figures or such material in support of its contentions and on this ground also, the same deserve to be rejected. It was submitted that there is every possibility of a consumer being confused between the two products and therefore, the applicant has made out a strong *prima facie* case as regards infringement and passing off, thereby justifying the grant of prayers made in the present application.

14. On the other hand, Mr. Alankar Kirpekar, the learned counsel appearing for the defendant submitted that the aspect of suppression and falsehood, on the part of the applicant was already highlighted in the reply affidavit. The photograph of the product of the applicant did not match with the actual product and on this ground alone, the application as well as the suit deserve to be dismissed. Apart from this, it was submitted that the

applicant failed to make out its case on merits and therefore, the interim application ought to be dismissed.

15. It was vehemently submitted on behalf of the defendant that 1K PUR can never be treated as a trade mark, but only as a trade description in order to describe the kind of product i.e. one component polyurethane adhesive. It was emphasized that 1K PUR was nothing but a commonly used trade description and this was evident from the manner in which the said expression was used in various products, including adhesives and paints, apart from the fact that the said expression found wide usage in patents registered all over the world. It was further submitted that the very fact that the applicant uses the words 1K Polyurethane on its product, shows that 1K PUR is being used as a trade description and that it is the applicant that is blowing hot and cold at the same time, by getting its trade mark 1K PUR registered, although it is nothing but a trade description.

16. It was emphasized that patents published at least from the year 1996, much prior to the year 2006, used the expression 1K PUR in respect of one component polyurethane adhesive, thereby demonstrating that the same was nothing but a common trade description and that it was also common to trade. On this basis, it was emphasized that the very registration of the expression 1K PUR as a trade mark can be said to be *ex-facie* illegal and fraudulent, thereby satisfying the test contemplated under the Full Bench judgment of this Court in the case of ***Lupin Ltd. v/s.***

Johnson and Johnson (supra).

17. Much emphasis was placed on judgments of the Supreme Court in the cases of ***Corn Products Refining Co. v/s. Shangrila Food Products Ltd., (1960) 1 SCR 968*** and ***J.R. Kapoor v/s. Micronix India, 1994 Supp (3) SCC 215*** and judgments of this Court in the case of ***Shelke Beverages Private Ltd., v/s. Rasiklal Manikchand Dhariwal & Anr., 2010 SCC OnLine Bom 471***, ***Macleods Pharmaceuticals Limited v/s. Intas Pharmaceuticals Ltd. & Ors., (2013) 55 PTC 380, Datamatics Global Services Limited v/s. Royal Datamatics Private Limited, (2016) 66 PTC 52*** and ***Ultratech Cement Ltd. & Ors. v/s. Dalmia Cement Bharat Ltd. & Ors., 2016 (5) Bom CR 100***, in support of contention that commonly used trade description cannot be part of trade marks and that a particular party cannot claim exclusivity over such commonly used trade description. This was particularly important in the present case for the reason that the defendant in its application for registration of the trade mark "INOVA 1K PUR" is not seeking any exclusivity for 1K PUR, as it is a commonly used trade description. INOVA and FEVICOL are completely different and therefore, the applicant cannot raise any grievance against the defendant. As the applicant is also using 1K PUR, which is a commonly used trade description, the limitation under Section 30 of the Trade Marks Act would certainly apply and the applicant cannot maintain the present action against the defendant alleging infringement.

18. The learned counsel for the defendant specifically relied on Section 36 of the Trade Marks Act and in that context, relied upon Commentary of Venkateswaran on Trade Marks and Passing Off (Seventh Edition). By placing reliance on the same, it was contended that exclusive use of a trade mark is deemed to have been ceased on the date when the use of the words descriptive in nature first become well known and established or two years after expiration of the patent in which such words are used. It was submitted that in the light of the material placed on record as regards patents, at least from the year 1996 using the expression "1K PUR", the effect of Section 36 of the Trade Marks Act clearly demonstrates that despite registration of the trade mark "1K PUR", the applicant cannot assert its exclusive rights therein and that the present application deserves to be dismissed.

19. The rival submissions are considered in the light of the material placed on record. The certificates of registration issued by the Trade Marks Registry show that the applicant has registration for its trade mark "1K PUR" and "FEVICOL 1K PUR" dating back to 20th July 2013 with user claim since 13th October 2006. The registration of the label mark/device mark of the applicant dates back to 3rd January 2008. The aforesaid documentary material indeed shows that the applicant is entitled to claim statutory protection and rights in respect of the trade mark "1K PUR" in the light of the said registrations in its favour.

20. As opposed to this, the defendant applied for registration of the impugned trade mark "INOVA 1K PUR" on 5th April 2021 on proposed to be used basis. It is the case of the applicant that it came across adhesive products of the defendant in March 2021, bearing the aforesaid impugned trade mark and that the impugned products of the defendant were found on third party e-commerce websites in March 2021. In this backdrop, on 16th March 2021, the applicant issued cease and desist notice to the defendant. Thus, it is claimed that after the defendant received the cease and desist notice, it applied for registration of the impugned trade mark "INOVA 1K PUR" in class 1 on proposed to be used basis before the Trade Marks Registry.

21. In this situation, when the trade mark of the applicant i.e. "1K PUR" and its variants are registered, the defendant has taken a stand attacking the very registration of the trade mark of the applicant and it has claimed that, in any case, the mark "1K PUR" is common to trade and a commonly used trade description of one component polyurethane resin adhesive. The defendant has also claimed that it is using "1K PUR" in a descriptive sense in the impugned trade mark "INOVA 1K PUR" and that it is not claiming any exclusivity in "1K PUR" as regards its own trade mark. On this basis, it is claimed that since "INOVA" on the one hand and "FEVICOL" of the applicant on the other hand cannot be said to be similar in any manner, the applicant can have no grievance.

22. Before considering the contentions pertaining to common to

trade and commonly used trade description, it would be appropriate to first consider the question as to whether the defendant is using the expression "1K PUR" as a trade mark. In this context, when the impugned trade mark of the defendant "INOVA 1K PUR" is considered, it is evident that "1K PUR" forms a leading and essential feature of the said trade mark of the defendant. This Court is unable to agree with the defendant that "1K PUR" is used in a descriptive sense, indicating the nature of the adhesive. In the application filed by the defendant for registration of its trade mark "INOVA 1K PUR", the defendant has not incorporated any condition or limitation to the use of the impugned trade mark and registration is sought for the entirety of the trade mark i.e. "INOVA 1K PUR". On the impugned product, the defendant has used the words "Moisture Curing Polyurethane Adhesive" in a descriptive sense to state the nature of the adhesive. It is clear from the manner in which the impugned trade mark "INOVA 1K PUR" is being used on the impugned product, that "1K PUR" forming an integral and essential feature of the trade mark is used in a trade mark sense and not in a descriptive sense. Therefore, the defendant is not justified in seeking to defend its position by stating that it is not claiming any exclusivity in "1K PUR" while incorporating the same in its impugned trade mark "INOVA 1K PUR". In this context, the definition of trade mark under Section 2(1)(zb) of the Trade Marks Act becomes relevant as it states that trade mark means a mark capable of being represented graphically and which is capable of distinguishing

goods or services of one person from those of others.

23. In this backdrop, when the registered trade marks/label mark of the applicant are considered i.e. "1K PUR", "FEVICOL 1K PUR" and 

, this Court finds that "1K PUR" due to continuous use since the year 2006 with registrations dating back to the years 2008 and 2013, can be said to be a product identification mark/brand. This is because the house mark of the applicant i.e. "FEVICOL" has been in use for a considerable period of time. But, in conjunction with the trade mark "FEVICOL", the applicant has a number of sub-brands or product identification marks/brands, which distinguish one product from the other. This aspect was noted in the judgment of this Court in the case of ***Pidilite Industries Limited v/s. Jubilant Agri & Consumer Products Limited*** (supra), when the mark "MARINE" was identified as such a product identification mark/brand or sub-brand of "FEVICOL". There is substance in the contention raised on behalf of the applicant that "1K PUR" as a trade mark and a label mark is also one such product identification mark/brand or sub-brand of the applicant, which in itself serves the purpose of identifying and distinguishing one product from the other.

24. In the aforesaid judgment of this Court in the case of ***Pidilite Industries Limited v/s. Jubilant Agri & Consumer Products Limited*** (supra), this Court has also accepted the contention raised on behalf of the very same applicant/plaintiff that normally the

persons purchasing the products of the plaintiff herein and the defendant are carpenters and they would ask for a product by referring to such a product identification mark/brand or sub-brand, depending on the purpose for which such a product is to be utilized. Hence, a carpenter would specifically ask for a "1K PUR" product when such an adhesive is required for a specific purpose as opposed to another type of adhesive. But, at the same time, this in itself does not mean that "1K PUR" can be said to be a commonly used trade description, for the reason that such a consumer (mainly carpenters) do not understand "1K PUR" to mean one component polyurethane resin adhesive, but they identify the mark "1K PUR" with the product of the applicant. Hence, this Court is unable to agree with the defendant that "1K PUR" is a commonly used trade description, in which the applicant cannot claim exclusivity despite registration of the same as a trade mark for the past 12 years with user claim for the past about 20 years. So long as the defendant is also using "1K PUR" as a mark and not as a description of its product, a strong *prima facie* case is indeed made out by the applicant in its favour to seek appropriate interim relief against the defendant.

25. It is also relevant to note that even in the products of the applicant, the words "moisture curing polyurethane adhesive" are used and it is this part that can be said to be descriptive in nature instead of the trade mark "1K PUR" being labelled as a commonly used trade description. Therefore, the contentions raised on behalf

of the defendant to attack the registered trade mark "1K PUR" of the applicant by claiming that the same is a commonly used trade description, cannot be accepted.

26. The defendant has further claimed that "1K PUR" as an expression is common to trade or *publici juris*. It is settled law that a party asserting that a word or expression has become common to trade or *publici juris*, must place on record substantial material to support such a contention. The assertions regarding common to trade or *publici juris* cannot be made by simply referring to certain material in the public domain, showing the use of a particular expression. The party is required to satisfy the test of extensive, actual and continuous use of such an expression in the market, which necessarily entails detailed material to be placed on record showing sales figures and other such material of third parties using such an expression or mark extensively, substantially and continuously. This Court has emphasized on the said position of law in the judgment in the case of ***Pidilite Industries Limited v/s. Jubilant Agri & Consumer Products Limited*** (supra) and also ***Jagdish Gopal Kamath & Ors. v/s. Lime & Chilli Hospitality Services*** (supra).

27. Applying the aforesaid test to the material placed on record on behalf of the defendant in the present case, shows that the defendant has simply referred to products in the adhesive and paint industries, wherein "PUR" or "1K PUR" has been used. There is no material placed on record to show substantial,

continued, extensive and actual use of the said expression as a trade mark. There is no material to show that third parties have been using the said expression as a mark along with supporting material like substantial sales figures etc, to support the contention of common to trade or *publici juris*. Therefore, the said contention raised on behalf of the defendant cannot be accepted.

28. An attempt was made on behalf of the defendant to claim that the alphabet "K" used in the mark "1K PUR" refers to the word "Komponente" in German language and that it is a commonly used trade description in India. This Court is unable to agree with the said contention raised on behalf of the defendant, for the reason that the aforesaid German word "Komponente" is hardly understood in India and it would be stretching the matter a bit too far to expect that a carpenter and other such persons, who purchase adhesives from the market to understand "1K PUR" as one Komponente polyurethane resin adhesive. Even if a word or expression may be commonly used in another jurisdiction or Country, in the absence of the same being used commonly in India, a party cannot claim that the said word is commonly used in trade and hence, cannot form part of a trade mark. The law laid down by this Court in the cases of ***Laboratories Griffon Private Limited v/s. Griffon Biometrix Private Limited*** (supra) and ***Kamani Oil Industries Pvt. Ltd. v/s. Bhuwaneshwar Refineries Pvt. Ltd.*** (supra) is correctly relied upon by the applicant in this context.

29. An attempt was made on behalf of the defendant to claim

that by adding the word "INOVA" to the words "1K PUR", the impugned trade mark of the defendant had become distinctive. But, the said contention is in the teeth of the said position of law laid down by the Supreme Court in the case of ***Ruston & Hornsby Ltd. v/s. Zamindara Engineering Co.*** (supra), wherein it was laid down that mere addition of a word to the mark in question cannot be of any advantage to a party and that a case of infringement is indeed made out. It cannot be denied that in the impugned trade mark "INOVA 1K PUR", the expression "1K PUR" does form a leading and essential feature and therefore, the defendant cannot claim that looking at its mark in entirety, it cannot be said to be infringing upon the registered trade mark "1K PUR" of the applicant.

30. The defendant has heavily relied upon Section 36 of the Trade Marks Act, particularly by placing reliance on certain patents from the year 1996 onwards. It is the case of the defendant that since such patents are in public domain for a considerable period of time, wherein one component polyurethane adhesive has been referred to at multiple places as "1K PUR", on the lapsing of the patent and passage of time, no one can claim exclusivity in the expression or mark "1K PUR". But, a perusal of the documentary material placed on record in this context, shows that in the literature pertaining to the patents at some places "1K PUR" may have been referred to as an expression or a word, but the patent itself did not relate to any product or invention bearing

the title "1K PUR".

31. The defendant also relied upon Full Bench judgment of this Court in the case of ***Lupin Ltd. v/s. Johnson and Johnson*** (supra) to contend that the registration of the trade mark "1K PUR" could be said to be *ex-facie* illegal or fraudulent. As per the said Full Bench judgment of this Court, a very narrow window is available for granting interim relief in the context of a registered trade mark and the Court is required to come to a conclusion that such registration is either *ex-facie* illegal or fraudulent or that it shocks the conscience of the Court. In the present case, this Court is unable to reach to a conclusion that the registration of the trade mark "1K PUR" of the applicant can be said to be *ex-facie* illegal or fraudulent or that it would amount to shocking the conscience of this Court. The material placed on record on behalf of the applicant does show continuous commercial user of the mark "1K PUR" in respect of its adhesives by the applicant from the year 2006, with registration of the said trade marks/label mark dating back to the years 2008 and 2013. The defendant is unable to demonstrate how such registration can be said to be in the teeth of the statutory requirements under the provisions of the Trade Marks Act.

32. It was sought to be indicated that such a commonly used trade description could not be registered as a trade mark, but the defendant cannot be permitted to make such an argument in the light of the fact that the defendant has itself applied for

registration of its trade mark "INOVA 1K PUR", wherein "1K PUR" does form a leading and essential feature. As laid down by this Court in the case of ***Pidilite Industries Limited v/s. Jubilant Agri & Consumer Products Limited*** (supra) and ***Jagdish Gopal Kamath & Ors. v/s. Lime & Chilli Hospitality Services*** (supra), a party cannot be allowed to blow hot and cold at the same time. Hence, the principle of estoppel would apply against the defendant in the facts and circumstances of the present case.

33. This Court is also of the opinion that the defendant by adopting "1K PUR" in its trade mark and having failed to make out a case about the same being a commonly used trade description, can be said to have adopted it in a dishonest manner. A *prima facie* case is indeed made out by the applicant in its favour to claim that such adoption of "1K PUR" in the impugned trade mark can be said to be dishonest and that this factor ought to operate against the defendant. The documents on record show that after the applicant sent the cease and desist notice dated 16th March 2021 to the defendant, immediately on 5th April 2021, the defendant submitted its application for registration of the impugned trade mark "INOVA 1K PUR" in class 1 on proposed to be used basis. The defendant in its application did not specify any condition or limitation to the use of the trade mark, despite the fact that in these proceedings before this Court, the defendant states that it is not claiming any exclusivity in the expression "1K PUR" in its trade mark "INOVA 1K PUR". If the defendant had

really proceeded on the basis that it was not claiming any exclusivity in the expression "1K PUR" in its trade mark "INOVA 1K PUR" and that the same was being used purely in a descriptive manner, the same would have reflected in its application submitted before the Trade Marks Registry. This is all the more significant because the defendant is seeking registration for its mark as a word mark.

34. Apart from this, being in the business of adhesives, the defendant cannot be heard to say that it had not come across the registered trade mark "1K PUR" of the applicant, although the said registered trade mark of the applicant was in the public domain from the year 2006 and the trade marks/label mark enjoy registration from the years 2008 and 2013. As per the law laid down by this Court in the case of ***Bal Pharma Ltd. v/s. Centaur Laboratories Pvt. Ltd. & Anr., 2001 SCC OnLine Bom 1176***, while applying for registration of a trade mark, the applicant for such a trade mark is expected to carry out a reasonable search in the Trade Marks Registry to verify as to whether its mark is similar/identical to a mark already on the register of the Trade Marks Registry. Therefore, not only is the defendant blowing hot and cold at the same time by doubting the registration of the trade mark of the applicant on the one hand and on the other hand applying for registration of its own mark, of which one of the leading feature is the very mark of the applicant, it is also taking the risk of seeking registration when the trade mark "1K PUR" of

the applicant is already registered and forms part of the register of the Trade Marks Registry. Therefore, there is substance in the contention, raised on behalf of the applicant that *prima facie* the adoption of the trade mark "INOVA 1K PUR" by the defendant can be said to be dishonest and with an intention to ride upon the goodwill of the applicant.

35. It is to be noted that the applicant has placed on record sufficient material to show the extent of sales turnover and the goodwill earned by the applicant in the context of the said registered trade mark "1K PUR" that enjoys registration from the years 2008 and 2013, with user claim since the year 2006. A strong case is made out by the applicant to claim that by incorporating "1K PUR" as a leading and essential feature in the impugned trade mark "INOVA 1K PUR", the defendant is seeking to pass off its products as that of the applicant and therefore, a *prima facie* case for the action of passing off is made out against the defendant. It is also relevant to note that the defendant has not placed on record any material with regard to its sales turnover and other such aspects to indicate as to what goodwill it may have earned in respect of the impugned trade mark "INOVA 1K PUR".

36. Apart from this, the material brought to the notice of this Court on behalf of the applicant, on the basis of search conducted on the internet, shows that on third party e-commerce websites like indiamart.com, when the products of the defendant are searched, the first entry is seen as "FEVICOL" adhesive and below

that the words "INOVA 1K PUR" are found. This further demonstrates that a strong *prima facie* case of dishonesty on the part of the defendant is made out and the defendant has taken such steps to illegally ride over the goodwill of the applicant in the business of adhesives, particularly in the context of the registered trade mark "1K PUR".

37. It has been argued on behalf of the defendant that the plaintiff has misrepresented its product in the plaint and hence, the prayers made in the application may not be granted. Its emphasis is on the absence of "1K" along with the words polyurethane adhesive in the representation of the product of the applicant in the plaint. This Court is of the opinion that the said contention cannot be accepted, for the reason that the applicant has various products, in which the registered trade mark "1K PUR" is depicted. The descriptive words "moisture curing 1K polyurethane adhesive" are in any case used in a descriptive sense and these proceedings are really concerned with the depiction of the registered trade "1K PUR" on the products of the applicant.

38. The judgments upon which the defendants placed reliance i.e. ***Corn Products Refining Co. v/s. Shangrila Food Products Ltd.*** (supra) and ***J.R. Kapoor v/s. Micronix India*** (supra) and judgments of this Court in the case of ***Shelke Beverages Private Ltd., v/s. Rasiklal Manikchand Dhariwal & Anr.*** (supra), ***Macleods Pharmaceuticals Limited v/s. Intas Pharmaceuticals Ltd. & Ors.*** (supra), ***Datamatics Global Services Limited v/s. Royal Datamatics***

Private Limited (supra) and ***Ultratech Cement Ltd. & Ors. v/s. Dalmia Cement Bharat Ltd. & Ors.*** (supra), pertain to the aspect of commonly used trade description that cannot form part of trade mark. But, in view of the observations made hereinabove, this Court is unable to agree with the defendant that the ratio of the said judgments can be of any assistance to the defendant in resisting the interim reliefs claimed by the applicant in this application. Reference to the Commentary of Venkateswaran on Trade Marks and Passing Off (Seventh Edition) in the context of submissions made on behalf of the defendant pertaining to Section 36 of the Trade Marks Act, also cannot be of much assistance to the defendant. As noted hereinabove, the patents on which the defendant has relied did not pertain to "1K PUR" or any process or product concerning "1K PUR". Merely because the said expression is mentioned in the literature pertaining to the patents does not mean that Section 36 would apply in the facts and circumstances of the present case. Therefore, this Court finds that the defendant has not been able to raise valid defence as regards its use of "1K PUR" in the impugned trade mark "INOVA 1K PUR".

39. The applicant has also filed leave petition for combining the causes of action of infringement and passing off. The defendant has been served and upon hearing the learned counsel for the parties, this Court is of the opinion that sufficient ground is made out on behalf of the applicant to press for the leave petition being allowed. Accordingly, the leave petition is allowed.

40. In the light of the observations made hereinabove, this Court is convinced that unless interim reliefs as prayed on behalf of the applicant are granted, concerning infringement and passing off, it will continue to suffer grave and irreparable loss, thereby demonstrating that the balance of convenience is also in favour of the applicant.

41. In view of the above, the interim application is allowed in terms of prayer clauses (a), (b) and (c), which read as follows :

> *"a. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from manufacturing, marketing, selling, advertising, offering to sell or dealing in the Impugned Products or adhesives or any similar goods or any other goods bearing the impugned mark 1K PUR (with or without any other mark), or any other mark/label identical with or similar to or in any manner comprising of the marks 1K PUR of the Plaintiff;*
>
> *b. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the 1K PUR Registered Marks of the Plaintiff bearing nos. 2567654, 2567653 and 1637794 in any manner and from using in relation to the Impugned Products or adhesives or any other goods for which the 1K PUR mark of the Plaintiff is registered or any goods similar to the goods for which the 1K PUR mark of the Plaintiff are registered, the impugned mark 1K PUR (with or without any other mark) which is identical with or similar to the 1K PUR*

or FEVICOL 1K PUR or 1K PUR Registered Marks of the Plaintiff and from manufacturing, selling, offering for sale, advertising or dealing in adhesives or similar goods or any other goods bearing the impugned mark 1K PUR (with or without any other mark);

c. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from committing the tort of passing off in any manner and from manufacturing, marketing, selling, advertising, offering to sell or dealing in the Impugned Products or adhesives or any similar goods or any other goods bearing the impugned mark 1K PUR (with or without any other mark), or any other mark/label identical with or similar to or in any manner comprising of the marks 1K PUR of the Plaintiff;"

MANISH PITALE, J.