SUPREME COURT OF INDIA

Parakh Vanijya Private Limited

Vs.

Baroma Agro Product

C.A.No.6642 of 2018

(Ranjan Gogoi and R.Banumathi,JJ.,)

12.07.2018

JUDGMENT

R. Banumathi,J.,

SLP(C) No.17445 of 2017

1. Leave granted.

2. This appeal arises out of the order dated 01.03.2017 passed by the High Court of Calcutta in AOPT No.349 of 2016 affirming the order of the Single Judge in and by which it was held that the respondent- defendant is entitled to use the word 'MALABAR' in conjunction with the mark 'BAROMA' for selling its product - Biryani Rice. By the impugned order, the Division Bench has also affirmed the findings of the Single Judge that subject to the outcome of the suit, the respondents can pursue their application for registration of their label.

3. Appellant-plaintiff claims to have been using the mark 'MALABAR' for selling Biryani Rice from 2001. The appellant filed the suit CS No.27 of 2012 for infringement and passing off special Biryani Rice under the mark "MALABAR GOLD" or other mark/trade name which is identical with and/or deceptively similar to the appellant's trade mark 'MALABAR'. On consideration of various features of the respondent's then mark and other materials, the learned Single Judge vide order dated 02.07.2012 granted interim injunction observing that there was similarity between the two labels/marks and restrained the respondents/defendants from using the label mark 'MALABAR'. The Division Bench declined to interfere with the said order by its order dated 14.09.2012.

4. While the suit and application for temporary injunction was pending before the Single Judge, the respondents/defendants filed application for vacating the order dated 02.07.2012 inter alia on various grounds contending that the appellant is relying upon fabricated documents and that the appellant cannot claim exclusive right over the mark 'MALABAR' and therefore, the interim order of injunction has to be vacated. The learned Single Judge by its order dated 05.07.2016 which was passed with the consent of the parties gave liberty to

the respondents to file a supplementary affidavit to clearly indicate the device/mark that the respondents proposed to use. The respondents filed application indicating the proposed modification in their label by changing the get-up. After hearing the parties, the interim order of injunction initially passed, was modified vide order dated 08.08.2016 to the effect that the respondents shall be entitled to use the word 'MALABAR' in conjunction with 'BAROMA' where all the words and letters must be in the same font but the word 'MALABAR' may be increased with font size of not more than 25% than the rest of the words or letters. Being aggrieved, the appellant-plaintiff has preferred appeal before the Division Bench. The Division Bench dismissed the appeal by the impugned order holding that the Single Judge has passed the order balancing the interest of the parties who are having a substantial turn over in their respective business.

5. We have heard Mr. Shyam Diwan, learned senior counsel appearing on behalf of the appellant and Mr. Gourab K. Banerji, learned senior counsel appearing on behalf of the respondents and perused the impugned order and considered the materials placed on record.

6. The appellant is the registered owner of the label mark in Class-30 in respect of rice, flour and preparations made from cereals, bread, cakes, biscuits, pastry and spices. The appellant sells Biryani Rice and the most prominent feature of its label mark is the word 'MALABAR'. The appellant-plaintiff is granted registration in Class-30 for its products. Class-30 of the classification of goods and services under the statute covers diverse spices and other edible materials as wheat, rice, coffee, tea etc. In the registration under Class-30, there is a disclaimer for the word 'MALABAR'. The disclaimer is worded thus:-

> "Condition & Limitation: REGISTRATION OF THIS TRADE MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF WORD 'MALABAR' AND ALL OTHER DESCRIPTIVE MATTERS"

7. The appellant though claims exclusive right over the word 'MALABAR' since there is a disclaimer to the exclusive use of the word 'MALABAR', the appellant has no right over the exclusive use of the word 'MALABAR'. The respondents have also inter alia brought on record the materials to show the registration of other goods under Class-30 with the word 'MALABAR MONSOON' granted in favour of Amalgamated Bean Coffee Trading Company Limited for Coffee Cream, Coffee included in Class-30. The registration of the mark 'MALABAR MONSOON' under Class-30 also contains similar disclaimer of the word 'MALABAR'. Likewise, the label 'MALABAR COAST' has been registered in Class-30 for Coffee, Tea, Cocoa, Sugar etc. in favour of Tropical Retreats Private Limited which again contains a similar disclaimer for the exclusive use of the word 'MALABAR COAST'. Having regard to the materials placed on record, we are of the view that the High Court rightly held that the appellant cannot claim exclusive right over the use of the word 'MALABAR'.

8. Insofar as the label mark used by the parties, we have perused the label mark of the appellant selling Biryani Rice with word 'MALABAR' and also the modified label mark of the respondents. The label of the respondents containing the words "BAROMA",

"MALABAR", "GOLD" are circled having a different get-up from that of the appellant. By comparison of the two label marks, in our view, both appear to be substantially different. There appears to be no similarity between both the labels, more so, deceptive similarity. Keeping in view the interest of the respective parties who are said to be having substantial turn-over in their respective business, the High Court rightly held that the respondents would be entitled to use the word 'MALABAR' in conjunction with 'BAROMA' with the different get-up as approved by the High Court. We do not find any serious infirmity warranting interference with the impugned order.

9. Having regard to the various contentions raised by the parties, the High Court rightly held that subject to the outcome of the suit, the respondent can pursue their application for registration of the device. Both parties have inter alia raised various contentions. Since the suit and the respondent's application for registration of its label with the marks thereon under Class-30 is pending, we are not inclined to go into the merits of those contentions. Lest, it would prejudicially affect the rights of the parties in the pending suit and proceedings.

10. In the result, the appeal is dismissed. All the contentious issues raised by the parties are left open to be resolved in the suit. No costs.