
JUDGEMENT RE-WRITING ON PRAVEEN KUMAR MEWARA V/S M/S ADITYA INDUSTRIES

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ABSTRACT

This judgement rewriting of Praveen Kumar Mewara v. M/s Aditya Industries looks critically at the ruling handed down by the Jharkhand High Court in reference to the doctrine of infringement of trademarks and prior use. The case centers around the claim that the Adhunik mark, with its particular typeface and depiction, had legitimately been used and should also be claimed to precede the registration by the respondent at issue. The case would throw light on some of the depths in possibilities of intellectual property rights, viz., the necessity of having registration to protect trademark rights, the evidentiary issues concerning prior use, and those parts of consumer confusion framed in an environment with dominance of visual indicia. The position argued holds cautiously that the precedent vibrates with risks of opportunistic registrations in respect of real brand equities due to its own severely over-prescriptive application of prior use standards. This paper intends to hinge upon an alternative conception of the judgment by surveying the far-ranging implications that bear on not merely the instant case but the entire intellectual property law field and to call for an investigation, much more thorough and substantiated with the facts, which would value such inquiries as paramount over mere formalities, particularly in bid claims of prior use.

Keywords: trademark, logo, prior use, registration, adhunik, aadarsh, goodwill, intellectual property rights

A. Brief summary of facts

The decision by the Court of Presiding Officer, Commercial Court, Ranchi in the Misc. Civil Application No. 307/2019 (Arising out of Commercial Case No. 47/2019) is under challenge here before the Jharkhand High Court.¹ The principal reason the learned court below denied the injunction application was that no prima facie case could be presented at this point since proof of the prior use of the registered trade mark and copy right would have been needed. The appellant contends that he has been using the trade mark ADHUNIK since 1990. The appellant argues that even while the aforementioned was registered on January 20, 2016, it was in use as early as April 1, 1990, and as such, the learned court below should have issued an order in the appellant's favour.

In the year 2018, it came to their knowledge that the respondent had been selling identical product under the name of AADARSH using an identical artistic style and trade dress as that of the appellant which is identical and/or deceptively similar as that of the structural representation of the mark and logo and thereafter the case was filed before the learned Court below.² When they discovered in 2018 that the respondent was marketing an identical product under the name AADARSH using the appellant's artistic style of writing the product name in a stylised manner within an archway that forms the predominant and distinctive feature of the artistic getup of the label alongside trade dress, which is identical or strikingly similar to the appellant's structural representation of the mark and logo.³ It should be pertinent to mention that the respondent filed their trade mark registration application before the appellant did. What is the point of contention is that whether or not the appellant used the style since 1990.

B. Issues involved in the case

1. What are the intellectual property law issues over the use of a similar artistic style for the logo in an identical business?

It is well settled that a logo can be granted protection under both the copyright and trademark regime. Generally speaking, trademark protection extends to designs and logos used as brand identities to identify businesses. As they are also original artistic works that include an element of originality, they are likewise protected as copyrights.⁴ Apart from the trouble in identification

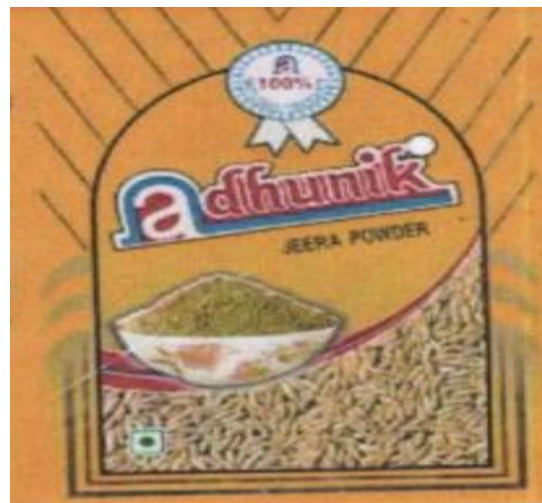
¹ Praveen Kumar Mewara v/s M/s Aditya Industries MANU/JH/0907/2023

² *ibid.*

³ *ibid.*

⁴ Anastasia Troshkova, 'Logo: is it a trade mark, is it a copyright?' (*Briffa*, 18 October 2022) <<https://www.briffa.com/blog/logo-is-it-a-trade-mark-is-it-a-copyright>> accessed 22 December 2023, Suneeth

as a result of duplicity, there are many other issues that are faced by a business due to an identical logo. As importantly elucidated in the present case, specially when the consumers are mostly illiterate who rely on the design elements of the product to distinguish it from the other, misrepresenting Aadarsh's products as identical to Adhunik's in all respect has detrimental impact to the goodwill of the business. The petitioner suffers financial losses along with also having to bear a repetitional loss in the consumer base due to the change in quality of product. The wilful malicious intention of the respondent is apparent in the employment of the identical archway, as well as in the structural arrangement and colour palette.



Adhunik



Aadarsh

II. Is registration mandatory for protection under the Intellectual Property law regime?

All of the aforementioned analysis holds ground only when the petitioner is able to prove that he is the rightful prior user of the trademark. What merits attention is the decision of the Delhi High Court in *Rajesh Masrani v Tahiliani Design Pvt. Ltd.*⁵ wherein it was held that registration of copyright is not compulsory to claim protection under the 1957 Copyright Act.

Section 44 of the Copyright Act, 1957 read with Section 48 of the Registration Act, 1908 favours this mode of interpretation alongside providing for a rebuttable presumption of the proof of the contents of the copyrighted work.

44. "There shall be kept at the Copyright Office a register in the prescribed form to be called the Register of Copyrights in which may be entered the names or titles of works and the names and addresses of authors, publishers and owners of copyright and such other particulars as may be prescribed"⁶

48. "All non-testamentary documents duly registered under this Act, and relating to any property, whether movable or immovable, shall take effect against any order agreement or declaration relating to such property, unless where the agreement or declaration has been accompanied or followed by delivery of possession [and the same constitutes a valid transfer under any law for the time being in force]"⁷

In the present case, the cost-benefit analysis of what the relevant consumer demography of the product in the area of operation would undergo on account of a possibility of confusion. In the case of *Parle Products (P) Ltd vs. J. P. & Co. Mysore*⁸, the Hon'ble Supreme Court made an important observation:

"After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes." This ruling applies to trademarks as it considers the broad and essential features of both marks to determine whether they are deceptively similar to one another. It also determines whether one can be mistaken for the other.

⁵ MANU/DE/1683/2008

⁶ Copyright Act 1957, s 44

⁷ Copyright Act 1957, s 46

⁸ AIR 1972 SC 1359

C. Implication of the case in the broad IP Law framework

I. Prior use doctrine

In my understanding, the court could have devised other mechanisms to ascertain prior use in the present case beyond just mere registration by the Trade Mark Registry, the veracity of which has been dubious in its grant of the logo to both the parties.

The court seems to have missed its analysis on the well established subject of Section 28 of the Trade Marks Act, 1999⁹ under which the registered proprietor of a trademark has exclusive rights to use the trademark in relation to the goods/services, and will be able to prevent other parties from using the identical or similar mark in relation to the identical/similar goods/services. Section 34 of the Act, on the other hand, provides an exemption to the aforementioned exclusive rights of the registered proprietor under section 28 and protects the rights of the earlier user in a mark used in relation to the same/similar goods/services as the registered proprietor.¹⁰

The question of prior use is often a disputed question of fact. The extent, quantum and nature of the use of the mark, claiming and justifying prior user right, is a mixed question of law and facts. The example of evidentiary documentation that can be used to establish prior use are, *inter alia*, Documents evidencing advertising expenditure vis-à-vis goods/services under the trademark; Sales turnover of goods/services under the trademark¹¹; Brochures, purchase orders, invoices for the sale/purchase of the goods/services under the trademark; Domain names and websites reflecting the use of the trademark vis-à-vis goods/services.¹²

The prolongation of trial without granting of any injunction is unwarranted by the Commercial Court, Ranchi as it leads to the bona fide business facing loss and goodwill. Such malicious duplication of identity damages the reputation and profits of the original user and therefore, the trial courts should expedite the fact finding which is a prudent approach than re-starting the process again.

II. Balance of convenience

The balance of convenience refers to the respective merits of the parties' cases, the calculation

⁹ Trade Marks Act 1999, s 28

¹⁰ Lakshmikumaran & Sridharan, 'Prior use v. registered trademark - An analysis of Section 34 of Trade Marks Act,' (*Lexology*, 24 February 2022) < <https://www.lexology.com/library/detail.aspx?g=51d2a8a0-fcd5-4323-a13428896c1370da> > accessed 23 December 2023

¹¹ MANU/MH/0437/2011

¹² Lakshmikumaran & Sridharan (n 10)

of damage experienced by the parties, and whether the parties registered the trademark before commencing the litigation. The injury in question might be monetary, loss of goodwill, occupational, and so on.

Interim injunctions are awarded by the courts in 'extraordinary circumstances' and are to be used sparingly, as laid down in *Ramrameshwari Devi & Ors versus Nirmala Devi & Ors*.¹³ The court often takes into account the nature of business, the loss that would be suffered, etc. The balance of convenience should also incorporate other factors such as the geographical location of firms with similar trademarks and the expansion of the internet market for customers.

While this is appreciated, the reasoning of the trial court in the present judgement that “Both are in trade. So balance of convenience is not in favour of plaintiff.” The court ought to look into the deeper facets of the geographical location and the nature of business that both these companies engage into and the similarity thereof.¹⁴ To operate in an FMCG market might not be as necessary a condition like that of a medical or legal profession, where a mistake of identity can have serious consequences as laid down in *Sujata Chaudhri vs Swarupa Ghosh*.¹⁵ However, the loss of goodwill amongst the consumers who belong to the lower strata of society, which is not as exposed to literacy can have adverse consequences in building a reputation for the particular product again which might be severely hampered by its duplication.

D. Conclusion

This paper attempts to put in gist the judgement of the Jharkhand High Court on *Praveen Kumar Mewara v/s M/s Aditya Industries* in an appeal of the decision by the Court of Presiding Officer, Commercial Court, Ranchi. It highlights as to what are the issues in an IP regime over the use of similar style logo and is whether a registration compulsory for the grant of protection under this regime.

On a broader scale, it looks into what the prior use exception is and how it could have been effectively utilised by the courts in this decision. A cursory glance over the concept of balance of convenience is also made in regards of the product in question.

¹³ 8 SCC 249

¹⁴ Niyati Prabhu, ‘Trademarks, “Nature” of the Business and Interim Injunctions: Some Thoughts on the Delhi High Court’s Two (Opposing?) Orders’ (*SpicyIP*, 17 March 2023) < <https://spicyip.com/2023/03/trademarks-nature-of-thebusiness-and-interim-injunctions-some-thoughts-on-the-delhi-high-courts-two-opposing-orders.html> > accessed 23 December 2023

¹⁵ MANU/DE/0855/2023