IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

INTERIM APPLICATION (L) NO. 26994 OF 2025
IN
COMMERCIAL APPEAL (ST) NO.26806 OF 2025

Laser Shaving India Pvt Ltd	..	Applicant/Appellant
Versus		
RKM International Products Pvt Ltd & Ors	..	Respondents

…

Mr. Rohan Kadam a/w Ms. Rucha Vaidya, Mr. Ashutosh Kane, Ms. Vedangi Soman, Ms. Sumana Roychoudhary i/b W.S. Kane and Co. Advocate for the Appellant.
Mr. Carl Patel a/w Mr. Gaurav Beyani, Advocate for the Respondents.

CORAM: BHARATI DANGRE &
MANJUSHA DESHPANDE, JJ.
RESERVED ON : 19th JANUARY, 2026
PRONOUNCED ON: 6th APRIL, 2026

JUDGMENT (PER BHARATI DANGRE J)

1. The present Commercial Appeal is filed by the Original Plaintiff, Laser Shaving (India) Pvt Ltd (hereinafter referred to as Laser Shaving) being aggrieved by the impugned order passed by the learned Single Judge on 25/06/2025, thereby dismissing the application by recording that applicant has failed to establish *prima facie* case and also that the applicants iniquitous conduct disentitle it for any relief.

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2. We have heard learned counsel, Mr. Rohan Kadam, for the Appellant and learned counsel Mr. Carl Patel for the Respondents. Since a consensus is expressed by the respective counsel to take up the Commercial Appeal for hearing, instead of adjudicating on the Interim Application, seeking stay of the impugned order dated 25/06/2025, we have taken up the Appeal for hearing.

3. Before we pronounce upon the legality and justiciability of the impugned order, in the wake of the arguments advanced by Mr. Kadam, countered by Mr. Carl Patel, we deem it appropriate to refer to the background facts leading to the filing of the Suit and subsequently refusal of the injunction as claimed by the Plaintiff through the Interim Application No.110 of 2025, filed in the Suit.

4. It is the case of the Plaintiff, that it is a company incorporated under the Companies Act, 1956 and is engaged in the business of manufacturing and selling inter-alia safety razors, safety razor blades, shaving systems and like goods.

As per the plaint, it is an old, established and reputed manufacturer and seller of safety razor blades which are sold world wide and the company vouches for its quality. According to the plaint, the goods belonging to the Plaintiff are available across the world including U.S.A, Europe, the Middle East, amongst others and the goods are popular in Men’s personal care and grooming industry. As per the plaint, the Plaintiff secured ISO certification for its product and also bagged several prestigious international awards, which stand testimony to the superior quality of its goods.

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It is the claim of the Plaintiff that with constant innovation and highest decree of precision the product manufactured by the Plaintiff has enhanced the shaving experience and the Plaintiff expanded its business activity to cover deodorants, after shave skin conditioners, shave gel, after shave splashes and bath gels etc.

In the course of its business activity, the Plaintiff adopted various distinctive trade marks to be used upon and in relation to its goods/ business and it coined and conceived mark "SETMAX" by commissioning one Mr. Palala Dwarka Nath, a graphic designer, to design and create the artistic work **'SetMax Platinum Blades'**. The packaging / trade dress designed, according to the Plaintiff is original and unique artistic work created by a graphic designer, for valuable consideration and the creation of it required a substantial investment of labour, time and capital. The Plaintiff therefore claimed that it is the owner of the copyright subsisting in the said artistic packaging/trade dress reflected below:-



5. This was followed by the Appellant procuring printing material for commencing manufacture of goods under the **'SETMAX'** trade mark and started using the packaging with its use.

In continuation of this venture, the Plaintiff applied for Trademark registration of the Trademark 'SETMAX' in Class 08 on a 'Proposed to be used basis' on 1/09/2023, and at this stage, we must note that the same is being granted in favour of the Laser Shaving on

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1/01/2026.

6. On an application being made for registration of the Word Mark, the Plaintiff commenced the sale of razor shaving blades under its mark “SETMAX” and in the distinctive red packaging, bearing the art work.

According to the Plaintiff, it enjoyed sales of Rs. 6 crores from September, 2023 to January 2024 and it spent a whopping sum of Rs. 1.31 crores for advertising and promoting its “SETMAX” shaving blades. The Plaintiff thus claim that it had acquired propriety and common law rights in the packaging/ trade dress/ trade mark and is entitled to its exclusive use in relation to the said goods/similar goods and use of the same and/or deceptively similar packaging/ trade dress/ mark in respect of the same/ similar goods and /or cognate, allied and/or complementary goods by any other manufacturers and/or traders would amount to passing off.

7. The Plaint made a reference to the respondent by stating that on 31/08/2023 one Galactic Conquistadors FZE (referred to as “Galactic”) applied for registration of label ‘SETMAX’ depicted in stylized writing SetMax

in Class 08 on a ‘Proposed to be used basis’. According to the Plaintiff, Galactic allegedly granted a non-exclusive, non-transferable license to RKRM International Products Pvt Ltd, i.e. Respondent No.1 for use of its mark ‘SETMAX’ under a Permissive User Agreement.

Somewhere in December, 2023 the Plaintiff gained the knowledge that RKRM is planning to launch a packaging/trade dress

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bearing an identical/deceptively similar trade mark as that of Laser Shaving, in relation to the same/similar goods. It carried out an investigation to reveal that RKRM is marketing and one Tigaksha Metallics Pvt. Ltd, Respondent No.2, is manufacturing safety razor blades under an identical trade mark “SetMax” and packed in a packaging/ trade dress which is substantial reproduction of its own packaging/ trade dress.

The Plaintiff was able to procure the impugned trade goods in Mumbai from the Respondent No.4, the stockist /retailer of the impugned goods and it also gained knowledge that the said store had purchased the impugned goods from Shree Mahavir Corporation Respondent No.3, but the Plaintiff could not produce on record a formal invoice / bill as despite specific request, the same was not allowed.

8. When Laser Shaving filed its application for grant of registration, the Trademarks Registry issued an examination report on 7/11/2023, in which Galactic’s Trademark Application No. 6093000 for 

label was cited.

On 28/11/2023, Galactic issued a Cease and Desist Notice to the Plaintiff impugning its use of the mark ‘SETMAX’ and alleging that it constituted trademark infringement and passing off.

The Plaintiff replied to the Examination Report of the Registry of Trademarks stating that it was a bonafide and honest user and a legal submission was advanced that its mark was visually and

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structurally different than Galactic's label mark of 'SetMax' depicted in black lettering and white background and this was so contended in the response furnished on 1/12/2023.

The Plaintiff also responded to the Cease and Desist Notice issued by Galactic and submitted that it was Prior user of the mark and therefore it had acquired superior title and had acquired enormous goodwill and reputation by virtue of sales and promotional expenses, and the mark was not distinctive of Galactic since it had never used the same, and if at all it was put to use by Galactic it was entirely dishonest attempt.

No action was thereafter taken by Galactic and the Plaintiff presumed that its superior title acquired through prior adoption was acceptable to it.

9. On 5/01/2024, the Plaintiff filed Notice of Opposition to Galactic's trademark and by comparing the two marks, specifically pleaded its case on following grounds:-

(i) The mark and goods are the same. The packaging is virtually identical.

(ii) The infringing goods were found in January 2024.

(iii) By their own admission, Respondents' earliest sales took place on 29/12/2023.

10. The Plaint had set out the comparison between the Plaintiffs packaging/trade dress and the Defendant's impugned packaging/trade dress to demonstrate the close and deceptive similarity between them and the said comparison is set out as below:-

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Plaintiff's artistic packaging/ trade mark	**Defendants' impugned packaging/ trade mark**
	

The Plaintiff, therefore, staked its claim that the impugned packaging/ trade dress / trade mark by the Defendant is identical with /closely and deceptively similar to the Plaintiff's packaging/ trade dress / trade mark 'SETMAX'.

It was therefore specifically pleaded that by using the impugned packaging/ trade dress/ trade mark, the Defendants are attempting to misguide the Plaintiff's consumer into purchasing its goods under the belief that the same originate from or are connected in the course of trade with the Plaintiff and they are passing off their impugned goods as and for the Plaintiff's goods.

The Plaintiff therefore sought a perpetual order and injunction restraining the Defendants by themselves their partners, proprietor, directors, servants, stockists, dealers, distributors and all persons claiming from using the impugned packaging/ trade dress/ trade mark and/or any other trade mark containing the said trade mark 'SETMAX' and/or any other mark identical with or deceptively

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similar with Plaintiff's said packaging/ trade dress/ trade mark.

By amending the Plaint, the Plaintiff specifically pleaded that by the acts of infringement of copyright and passing off, the Defendant has caused loss and/ or damage to the Plaintiff, which was estimated at Rs.100,00,00,000/- (Rupees One Hundred Crores) and the Defendants are liable to pay to the Plaintiff, the said amount by way of damages.

11. In the Commercial Suit filed seeking the aforesaid relief, an interim application was taken out by the Plaintiff, pending the hearing and final disposal of the Suit, seeking temporary order and injunction, thereby restraining the Defendant from using the impugned trade mark and/or any other packaging/ trade dress/ trade mark, which is identical with or deceptively similar to the Plaintiff's packaging/ trade dress/ trade mark, so as to pass off or enable others to pass off Defendant's impugned goods as and for the Plaintiff's goods in any manner whatsoever.

The learned Single Judge rejected the interim application on 25/06/2005, which gave a cause for the Plaintiff to file the present Appeal and we have heard the argument advanced by Mr. Kadam, representing the Plaintiff to face opposition from Mr. Patel representing the Defendants.

12. Mr. Kadam appearing for the Appellant, would submit that in the Suit for passing off an infringement, ad-interim relief was granted in favour of the Plaintiff on 30/01/2024, but upon the Defendants having invoked Order XXXIX Rule 4 of the Code of Civil Procedure, 1908, on the ground that the Plaintiff had suppressed vital

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information, and had misled the Court while it staked its entitlement for ad-interim relief without notice to the Defendants, by order dated 2/05/2024, the ex-parte ad-interim order was vacated. He would submit that the order was vacated only on the ground that the Plaintiff held back the relevant material due to which the Court was unable to examine the necessity of issuing notice to the Defendants before considering the ad-interim relief and had the material placed before the Court, notice would have been issued prior to consideration of the ad-interim/ interim relief.

According to Mr. Kadam, the Court did not pronounce on the merits of the matter and rather directed the Defendants to file their reply to the interim application and permitted the interim relief to be considered once the pleadings are completed. However, Mr. Kadam submit that when the impugned order is passed by the learned Single Judge, he has once again refused the said relief, on the ground that there is material suppression on behalf of the Plaintiff even now, as was the case when the ad-interim relief was procured by it. According to Mr. Kadam, the aspect of suppression of material fact, was the underlying reasoning in the conclusions drawn by the learned Single Judge based upon the submissions adopted on behalf of the Defendants, instead of applying the parameters for grant of injunction under Order XXXIX Rule 1 and 2.

According to him the impugned order solely has its existence in the previous order passed by the learned Single Judge, when the ad-interim relief was vacated.

13. In addition to the above, according to Mr. Kadam, much emphasis is laid by the learned Single Judge on the reply filed to the

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examination report dated 7/11/2023, in respect of the label mark of Galactic and it is held that since it was admitted that the mark was visually and structurally different from Galactic's label mark of 'Set Max', the Single Judge has erred in recording that now the Plaintiff is estopped from deviating from the statement made before the Registrar. Mr. Kadam, therefore, want us to determine the legal consequences of a statement made before the Registrar and whether it would operate as estoppel, as the learned Single Judge, has failed to take this aspect into consideration. He would further submit that when Galactic issued a Cease and Desist Notice on 28/11/2023, the Plaintiff responded by staking its claim of old, established and reputed manufacturer and seller of 'safety razors, safety razor blades, and shaving systems' and it also adopted a stand that various distinctive trade marks are used in relation to the said goods/ business from time to time and one such trade mark which was adopted and being continuously used in relation to the goods is 'SETMAX'. Relying upon the acquisition of valuable propriety and common law right in the trade mark, the Plaintiff categorically stated that it is entitled to the exclusive use of the said trade mark in relation to the said goods.

A categorical stand was adopted in the reply that the trading name and style 'Galactic Conquistadors FZE' make it obvious that it do not contain the word 'SETMAX' in any manner whatsoever, and it has not come across any impugned goods/business under the impugned trade mark/name or any advertisement or promotional material in respect thereof and therefore, it was alleged that the impugned trade mark was never used in relation to the impugned

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goods/business in India, and this is also borne out of the fact that Galactic's trade marks application dated 31/08/2023 for the impugned trade mark 'SETMAX' was filed for the proposed to be used basis.

On the other hand, according to Mr.Kadam by the said response, Appellant made its stand of Prior adoption and Use very evident and categorically stated that Galactic has not used the impugned trade mark 'SETMAX' in relation to the impugned goods in India till date, but if it was apprehensive that if and when the impugned trade mark is used in relation to the impugned goods in India, there will be a likelihood of confusion and deception, which will include likelihood of association of the impugned trade mark with Set Max and its said goods/business under the said trade mark.

While calling upon Galactic to withdraw the notice, it was also prayed that it shall agree and undertake not to use the impugned trade mark 'SETMAX' in relation to the impugned goods and withdraw its trade mark application in class 08.

14. Mr. Kadam, specifically urge that Laser Shaving never sued Galactic because its presence was abroad and it has not yet registered its mark in contradiction to the Plaintiff, which has registered its trade mark on 1/01/2026.

15. Inviting our attention to the impugned Judgment, Mr. Kadam would submit that the learned Single Judge, has failed to consider the sequence of events, as it pleaded its case that somewhere in January 2024, the applicant learned that Respondent No.1 was manufacturing safety razor blades under an identical 'SETMAX' trade mark in packaging which was substantially similar to the Applicant's

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packaging/trade dress.

On 5/01/2024, the Applicant filed a notice of opposition to oppose Galactic's application for trade mark by specifically contending that the same is identical to a earlier used trade mark 'SETMAX' of the opponents.

On 9/01/2021, Applicant procured the impugned products in Mumbai from Respondent No.4 to learn that they were procured from Respondent No.3 and the Suit was filed on 15/01/2024, and on 30/01/2024, the Court granted an exparte ad-interim relief.

16. According to Mr. Kadam, Plaintiff had placed reliance upon the affidavit of the Artist dated 26/03/2024, who deposed on oath that the artistic work depicted by the Plaintiff in its product was designed by him during the course of the employment and retainership and it was a 'original' work, since it emanated from him as an artist and was an expression of skill. He would therefore place reliance upon Section 13 (1) (a) and Section 17 of the Copyright Act, 1957 and stake its claim as a first owner of the copyright subsisting in the said artistic work. It is his claim that as an owner of the copyright the applicant was entitled to produce the artistic work in any material form and by manufacturing and distributing identical /similar infringing copies of the artistic work, the Respondents are infringing upon the Applicant's copyright. According to him, for infringement of copyright, it is not necessary to establish that the infringing copy is the exact replica of the original work, but what is to be seen whether on comparison of the two artistic works, it was easily discernible that one was the copy of the other, and he is insisting that in the present case, the test is fully satisfied.

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For an action of passing off, according to Mr. Kadam, the Plaintiff is required to prove existence of three elements (i) the plaintiff has good will in the market (ii) misrepresentation by the defendant to the public, (iii) loss or likelihood of it to the plaintiff and he would submit that passing off is an action not only to protect the Plaintiff's reputation but also to safeguard the interest of public at large, so that the public is not mislead and indulged in purchase of the product, which is not the product of the Plaintiff.

17. Coming to the second point on which the learned Judge has heavily relied upon, that is the admission given by Laser Shaving, when it replied to the examination report dated 7/11/2023, issued in respect of its label mark by stating that it was *bona fide*, where a statement was made that the marks are different and therefore, the Plaintiff is now estopped from claiming that the mark of the Plaintiff and the mark of the Respondent are similar/ identical. The observation of the learned Judge on the ground of suppression of the applicant's diametric opposite stand taken before the Trade Marks Registry in respect of the very same trade mark, and its contention that it was not aware of the connection between Galactic and Respondent no.1, Mr. Kadam would submit that the learned Single Judge has not considered the law laid down in this regard and according to him the decision of the learned Single Judge in *Shantapa alias Shantesh S. Kalasgond vs. M/s. Anna*[1], has not considered the decision of the Apex Court in *Chhaganlal Keshavlal Mehta vs. Patel Narandas Haribhai*[2], in its proper perspective.

1 2023 SCC Online Bom 2566
2 (1982) 1 SCC 223

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18. The precise point which Mr. Kadam to focus upon is what would amount to estoppel and whether a statement made before the Registrar of Trade Marks would amount to an estoppel when the Plaintiff plead its case of similarity/ deceptive similarity in the two marks and whether he can be denied relief on the ground of estoppel.

On the larger issue, Mr. Kadam has invoked the proposition of law laid down in *Laxmikant V. Patel vs. Chetanbhai Shah and anr*[3], where it is held that in an action for passing off, it is essential to seek injunction, temporary or ad-interim and the principle for grant of injunction are the same as in the case of any other action against injury complained of and the Plaintiff must prove a prima facie case, balance of convenience in his favour and irreparable injury if injunction is not granted. He would submit that the Plaintiff is not required to prove actual damage in order to succeed in an action for passing off and likelihood of damage is sufficient and therefore the Defendant's state of mind is wholly irrelevant as to the existence of the cause of action for passing off and injunction to be granted or refuse would all depend upon the facts and circumstances, which are placed before the Court.

According to Mr. Kadam, the finding rendered by the learned Single Judge, that Respondent No.1, admittedly, the licensee of Galactic in respect of the very same trade mark and had commenced the sale of the impugned products, in December 2023, i.e. after the Applicant's representation to Galactic and Respondents have clearly acted upon such representation and therefore the contention of the

3 (2002) 3 SCC 65

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Applicant that the Respondents have not satisfied the elements of estoppel as laid down in the judgments in case of *Kishori Lal vs Chalitbai*[4], and *Chhaganlal Keshavlal Mehta* (supra) would not be acceptable, apart from the fact that the judgments were in the context of final decrees and not in context of interim application. In addition, as regards the copyright infringement, the relief is refused to the Plaintiff/Applicant on the ground of suppression of material fact and its iniquitous conduct and making it a triable issue, the Single Judge has observed that by the material placed by the Respondents on record, it is reflected that the impugned packing / trade dress is one, which is commonly used in the trade and was infact being used even prior in time to the Applicant's claim of being the original users and since this was a triable issue, which would be determined during the trial.

According to Mr. Kadam, in copyright there is no question of a prior user, but when it had put its case before the learned Single Judge, that it was the creator of the original work, and when work has been copied by someone else than a person, who is entitled to make use of the same, it amounts to infringement under Section 51 of the Copyright Act, 1957 as the owner of the copyright has an exclusive right over the same and if anyone does anything without permission/ license being granted by the owner, it amounts to infringement of copyright. According to Mr. Kadam only certain acts are exempted from constituting infringement of copyright and they are clearly stipulated in Section 52.

4 1959 Supp (1) SCR 698

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Inviting our attention to Section 16 of the Copyright Act, 1957, Mr. Kadam would urge that no person is entitled to copyright or any similar right in any work, whether published or unpublished, otherwise than under and in accordance with the provisions of the Act or any other law for the time being in force and the Copyright Act, is a complete code and if any defense is to be adopted, in an action of infringement of the copyright, that must squarely fall within the four corners of the statute. The defense adopted that the mark is commonly used in trade, is no defense which falls within the scope of the Copyright Act, 1957 qua the Plaintiff, who is the owner of the Copyright.

19. Contesting the argument Mr. Patel, at the outset would submit that the Plaintiff had obtained the ex-parte relief by playing a fraud and he would place reliance upon the decision of the Apex Court in case of *S.P. Chengalvaraya Naidu vs. Jagannath*[5], to submit that it is a well settled proposition of law that a judgment or decree obtained by playing fraud on the court is a nullity and non est in the eyes of law. According to him, fraud is an act of deliberate deception with the design of securing something by taking unfair advantage and it is a deception in order to gain by another's loss.

According to Mr. Patel, one of the ground on which the Applicant is non-suited is found in point no.(E) of the impugned judgment, as the learned Judge noted that being a commercial suit, the Applicant was required to have compliance of Order XI Rule 1(3) of the CPC as amended by the Commercial Courts Act, 2015 and it was imperative for him to annex with the Plaint all documents in

5 (1994) 1 SCC 1

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power, possession, control or custody, irrespective of whether the same is in support of or adverse to the Plaintiff's case. He ought to have made a declaration that he do not have any other documents in his power, possession, control or custody, but the Applicant had not annexed or disclosed in the plaint, the material document pertaining to the Application filed by Galactic in respect of the very same trade mark, and the response of the Applicant to the Examination Report, and to the Cease and Desist Notice and response thereto. He would submit that the impugned order has further recorded that even independent of the provision of order XI as amended by the Commercial Courts Act, the litigant shall not decide what facts are material for adjudicating a case and what are not, but a litigant must disclose all the facts of the case and must leave the decision making to the Court. The Judge according to Mr. Patel has arrived at a conclusion that the Applicant has consciously not annexed its response to the Examination Report as well as the Cease and Desist Notice issued by Galactic and when the suppression was clearly willful and deliberate.

20. Learned counsel, Mr. Patel, would lay his emphasis on the decision in case of *Amar Singh vs. Union of India*[6], and he would submit that the Courts have frowned upon the litigants who would with an intent to deceive and mislead, initiate proceedings without full disclosure of facts, and it is held that the litigants who comes to the Court with 'unclean hands' are not entitled to be heard on merits. Similarly, he would draw benefit from the observations of Delhi High Court in case of *Lightbook and anr vs. Pravin Shriram Kadam and*

6 (2011) 7 SCC 69.

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ors[7] , where it is held that every litigant, who approaches the Court is required to place the cards on the table, face up, as a court which does not have the same before it, cannot dispense justice as it should.

He would also invoke the principle laid down in *Popaat Jamal & Sons vs. N.M. Venkatachalapathy alias Babulal and anr*[8], a decision of Madras High Court, which reiterated the principle that the Plaintiffs, who have not approached the Court with clean hands are guilty of fraud, suppression of facts and misrepresentation and are not entitled for any relief and it is further held that a fraud is proved when it is shown that a false representation has been made (i) knowingly or, (ii) without belief in its truth, or (iii) recklessly, careless whether it is true or false.

Mr. Patel has also placed reliance upon the following decisions:-

(i) Vee Excel Drugs & Pharmaceuticals Ltd. Vs HAB Pharmaceuticals & Research LIM[9]

(ii) BDA Private Ltd. Vs. Paul P. John & Anr[10].

(iii) Quantum Hi-Tech Merchandising Pvt. Ltd vs. LG Electronics India Pvt Ltd. And Ors[11] .

21. It is also the submission of Mr. Patel that the scope for interference in the findings rendered by the learned Single Judge is very limited, as it is based on factual aspect, which have been appreciated by the Court. By relying upon the decision in case of *Wander Ltd. V Antox India (P) Ltd.*,[12] it is his categorical submission

7 2023 SCC Online Del 2308.
8 2006 (5) CTC 251.
9 (2009) 111 DRJ 192.
10 (2008) 152 DLT 405.
11 2025 SCC Online Del 8238.
12 1990 Supp SCC 727.

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that the Appellate Court would not interfere with the exercise of discretion of the Court of first instance and substitute its own except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the Court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. He would submit that the Appellate Court would not normally be justified in interfering with the exercise of discretion on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion, and if the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference. Thus, he would submit that once the Court has held that the Plaintiff had adopted a fraudulent approach, which disentitled him for the relief, the Appellate Court, has very little scope for interference.

22. We have heard the counter submissions advanced as a challenge is raised to the order dated 25/06/2025, where the interim application filed by the Applicant/Plaintiff in COMIP Suit No .44 of 2024 for infringement of the Plaintiff's copyright in its original artistic packaging / trade dress and in an action for passing off, the injunction is refused.

We must gloss over the important events with reference to the dates of its occurrence;

(i) On 31/08/2023, Galactic, a Limited liability Company incorporated in Dubai, applied for registration of the label 'SETMAX' depicted as **'**SetMax**'** under Class 8 of the Trademarks Act, 1999 on a 'proposed to be used basis'.

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(ii) On the very next date i.e. on 01/09/2023, the Applicant Laser Shaving applied for the registration of the trademark of the word ‘SETMAX’ also under class 8.

(iii) On 18/09/2023, Laser Shaving also applied for registration of the label mark under Class 8 under the Trade Marks Act, 1999.

(iv) On 15/10/2023, a Permissive User Agreement is executed between Galactic and RKRM International Products, under which Galactic conferred non-exclusive, non-transferable licence to use its trade mark.

(v) On 07/11/2023, Trade Marks Registry issued an Examination Report in respect of Application No. 6115810 of Laser qua the label mark, in which the objection was raised under Section 11 (1) of the Trademarks Act, 1999 with reference to the conflicting trade mark of Galactic.

(vi) On 20/11/2023, an Examination Report was issued by Registry of Trade Marks in respect of the Applicant’s Application No. 6093233 qua the word mark, again citing that the mark was conflicting with Galactic’s Trademark as its Application was received one day prior.

(vii) On 28/11/2023 Galactic issued cease and desist notice to Laser calling upon it to (i) cease and desist from in any manner using Galactic’s Trademark; (ii) give an undertaking to Galactic that it would not use the trademark or trade dress from the date of the notice; (iii) de-list and remove all references/promotions/ advertisements in respect of the trademark; and also to render a full statement of accounts showing profits made from sale of products

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containing the impugned trade marks.

23. On 01/12/2023, the same received response from Laser Shaving, being addressed to the Registrar of Trade Marks, Chennai. With reference to the objection in the Examination Report that the trade mark application is open to objection on relative grounds of refusal under Section 11 of the Act because same/similar trade mark(s) is/are already on record of the Registrar for the same or similar goods/services, Laser Shaving responded thus:-

> *'Following are the Mark which are cited by the Learned Examiner :-*
>
> *a. It is humbly submitted that our mark "SETMAX" is visually and structurally and completely different from the cited mark SetMax. The Applicant has filed a colour mark which is written in white colour over a red background. Further, the Applicant has also written the words Platinum and Superior quality Platinum Blades along with the trade name SETMAX.*
>
> *b. It is further submitted that a pool of criteria including the nature, purpose and prospective clientele of the goods needs to be applied to judge their similarity. Thus, the channel of distribution, class of clients, area of providing goods/services and nature of business of other mark sharply differs from the instant mark and makes it dissimilar. Therefore, with regard to the above mentioned facts, it is submitted that the cited mark is overall dissimilar in all elements to the subject mark and hence does not stand as a bar to the registration of the subject mark."*
>
> *"In support of the above contentions, we rely upon the following decisions:-*
>
> *As ruled out by Parker, J. in Re PianotistCo.s Application (1906) 23 RPC 774, page 777also upheld in the case of Grijfithsvs Vick Chemical AIR 1959 CAL 654, while comparing two words "You must take the two words, you must judge them by the look and by sound, you must consider the goods to which they are to be applied, the nature and kind of customer who would be likely to buy the goods. Consider all the surrounding circumstances, as to what is likely to happen if each of those trademarks is used in the normal way as a trade mark for the goods, the respective owners of the mark. If there is likely to be confusion, the application must be refused."*

24. Reliance is also placed in case of *Cadila Health Care Limited. Vs Cadila Pharmaceutical Limited*[13], setting out the rules for comparison of trade marks and with its reference, it was suggested as below:-

13 (AIR 2001) SC 1952

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"In the light of facts, it needs to be noted that our mark "SETMAX" is totally different from all the trade mark applications and it is neither the same nor similar to any of the mark of your examination report. Therefore, our mark is liable to get registered.

Further, we submit that the mark "SETMAX" is an invented, coined and a fanciful adoption, which taken in its entirety, is conceptually, visually and structurally distinguishable from the cited trademark in the Examination report. The mere sharing of a part of the mark cannot be considered as a determinative of deceptive similarity as it is well settled that the mark must be considered in their entirety giving importance to the manner of representation and the meaning conveyed by the whole. It is also well settled that coined marks must not be split for the purpose of comparison and/or taking objection. Further, the mark applied for, taken as whole, is visually, and conceptually different from all the marks included in examination report.

Besides above, we may mention here that our mark "SETMAX" is being used with effect from 1st September, 2023 whereas the cited mark is proposed to be used. Please also associate our aforesaid label mark with our application no 6093233 dated 1-09-2023 for registration of our word mark "SETMAX"

Thus, our mark "SETMAX" is liable to get registered under the Trade Marks Act,1999."

25. This response is annexed with the affidavit in reply by Respondent Nos.1 and 2, responding to the interim application filed by the applicant, when it placed on record the copy of the Permissive User Agreement dated 15/10/2023 as well as the copies of the purchasers order in relation to the trade mark 'SETMAX' dated 5/08/2023, and also the copy of the e-registered page for trade mark application filed by Galactic, being described as a foreign entity praying for registration of dual mark/trade mark Set Max with the class of goods or services being set out as razor blades, razor cases, razor strops, electric or non-electric, shaving cases, shear blades etc, stated as 'proposed to be used'.

26. In the sequence of events, it is seen that it is Galactic, who applied for registration of its trade mark to be followed by two applications preferred by the Plaintiff/Applicant for registration of its label mark and word mark.

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On the application received, when the Registrar of Trade Marks notified objection under Section 11(1) of the Trade Marks Act, 1999, the mark being stated to be identical or similar to earlier marks in respect of identical or similar description of goods and on the basis that there existed a likelihood of confusion on part of public, the response was sought and we have already reproduced the response of the applicant. But admittedly, this response and the stand adopted therein was not included in the plaint or its documents nor was it a part of the interim application filed by the laser shaving, but it was brought on record through the reply filed by the Respondent Nos.1 and 2.

27. When Laser shaving is confronted with an objection under Section 11(1), by the Trade Marks Registry with reference to the conflicting mark ‘SetMax’ of Galactic Conquistadors FZE, Dubai UAE, which had preferred an application for registration on 31/08/2023 in regards to the goods / services razor blades, razor case, etc, the Plaintiff clearly pleaded that their mark ‘SETMAX’ is visually and structurally completely different from the cited mark ‘SetMax’.

It was also explained as to why it is different as the mark of the applicant was written in white colour over a red background with the inscription of the words Platinum and Superior quality Platinum blades along with trade mark ‘SETMAX’. A stand was also specifically adopted to the effect that a pool of criteria including the nature, purpose and prospective clientele of the goods need to be applied to judge the similarity in the mark and by considering the

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same the cited mark was dissimilar in all elements to the subject mark and therefore it was stated to be not a bar to the registration of the subject mark.

In the reply, there is no reference to the originality of the copyright as is claimed by the Plaintiff, but on the other hand, it is stated that SETMAX was invented/coined and a fanciful adoption, which taken in its entirety, was conceptually, visually, and structurally distinguishable from cited trademark and mere sharing of the part of the mark cannot be considered as determinative of deceptive similarity as mark must be considered in its entirety. A distinction was also sought to be drawn because of the background that 'SetMax' was being used from 1/09/2023, whereas the cited mark is 'Proposed to be used'.

28. The aforesaid factor turned out to be the determining consideration before the learned Judge, when the Applicant filed an application for injunction and contended that Galactic's trade mark application was on a 'Proposed to be used basis' and it was pending for registration and mere filing of an application for trade mark registration prior in point of time was not a bar to the applicant's claim for passing off, since the applicant was a prior user and therefore, was entitled for injunction against Respondent Nos.1 to 4. In contrast, the Defendants specifically adopted a stand of suppression of material fact and prosecution history estoppel by submitting that the Plaintiff/Applicant had willfully and deliberately suppressed its response to the Examination Report dated 7/11/2023 and its response to the 'Cease and Desist' Notice by Galactic.

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Reliance was placed upon Notice of Opposition dated 5/01/2024, filed by the Applicant opposing Galactic's application for trademark on the ground that Galactic's trademark is identical to earlier used trade mark 'SETMAX' of the Plaintiff.

The relief in the interim application was opposed on the ground of willful and deliberate suppression of the aforesaid facts and adoption of diametrically opposite stand before the Trade Marks Registry. It was therefore submitted that the applicant had not approached the Court with clean hands and it had suppressed material information and that is the reason why the ex-parte interim order granted on 02/05/2024 came to be vacated.

29. There cannot be any dispute about the proposition in law that a person, who do not come to the court with the clean hands is not entitled to be heard on merits of his grievance and rather is not entitled for any relief. The object underlying this principle being, that the Court is not only entitled but is duty bound to protect itself from unscrupulous litigants, who do not have any respect for truth and who try to pollute stream of justice by resorting to falsehood or by making misstatement or by suppressing facts, which shall have a bearing on adjudicating of the issue(s) arising in the case.

In *Ramjas Foundation and anr vs. Union of India and ors*[14] , the Apex Court reiterated the principle by reference to the precedents and we deem it appropriate to reproduce the relevant observation:-

> *"22. In Dalglish v. Jarvie, Mac & G at p. 238, Lord Langdale and Rolfe, B. observed: (ER p. 89)*
>
> *"It is the duty of a party asking for an injunction to bring under the notice of the court all facts material to the determination of his right to that injunction; and it is no excuse for him to say that he was not aware of the importance of any*

14 (2010) 14 SCC 38.

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fact which he has omitted to bring forward."

23. In Castelli v. Cook, Hare at p. 94, Wigram, V.C. stated the rule in the following words: (ER p. 38)
"... a plaintiff applying ex parte comes ... under a contract with the court that he will state the whole case fully and fairly to the court. If he fails to do that, and the court finds, when the other party applies to dissolve the injunction, that any material fact has been suppressed or not properly brought forward, the plaintiff is told that the court will not decide on the merits, and that, as he has broken faith with the court, the injunction must go."
24. In Republic of Peru v. Dreyfus Bros. & Co.7, LT at p. 803, Kay, J. held as under:
"I have always maintained, and I think it most important to maintain most strictly, the rule that, in ex parte applications to this Court, the utmost good faith must be observed. If there is an important misstatement, speaking for myself, I have never hesitated, and never shall hesitate until the rule is altered, to discharge the order at once, so as to impress upon all persons who are suitors in this Court the importance of dealing in good faith in the Court when ex parte applications are made."
28. The abovenoted rules have been applied by this Court in a large number of cases for declining relief to a party whose conduct is blameworthy and who has not approached the Court with clean hands — Hari Narain v. Badri Das, Welcom Hotel v. State of A.P. , G. Narayanaswamy Reddy v. Govt. of Karnataka , S.P. Chengalvaraya Naidu v. Jagannath, A.V. Papayya Sastry v. Govt. of A.P , Prestige Lights Ltd. v. SBI, Sunil Poddar v. Union Bank of India, K.D. Sharma v. SAIL, G. Jayashree v. Bhagwandas S. Patel and Dalip Singh v. State of U.P. "

30. In *Dalip Singh vs. State of U.P.,*[15] the Hon'ble Apex Court focused upon the emerging creed of dishonest litigants and deprecated the same in following words:-

"1. For many centuries, Indian society cherished two basic values of life i.e., "Satya" (truth) and "ahimsa" (non-violence). Mahavir, Gautam Buddha and Mahatma Gandhi guided the people to ingrain these values in their daily life. Truth constituted an integral part of justice-delivery system which was in vogue in pre-Independence era and the people used to feel proud to tell truth in the courts irrespective of the consequences. However, post-Independence period has seen drastic changes in our value system. The materialism has overshadowed the old ethos and the quest for personal gain has become so intense that those involved in litigation do not hesitate to take shelter of falsehood, misrepresentation and suppression of facts in the court proceedings.

2. In last 40 years, a new creed of litigants has cropped up. Those who belong to this creed do not have any respect for truth. They shamelessly resort to falsehood and unethical means for achieving their goals. In order to meet the challenge posed by this new creed of litigants, the courts have, from time to time, evolved new rules and it is now well established that a litigant, who attempts to pollute the stream of justice or who touches the pure fountain of justice with tainted hands, is not entitled to any relief, interim or final."

15 (2010) 2 SCC 114.

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31. This principle found to be reiterated in *Amar Singh vs. Union of India* (supra), when the Apex Court recorded thus:-

> *"53. Courts have, over the centuries, frowned upon litigants who, with intent to deceive and mislead the courts, initiated proceedings, without full disclosure of facts. Courts held that such litigants have come with "unclean hands" and are not entitled to be heard on the merits of their case."*

32. This principle when applied to the Commercial Courts Act, 2015, which has made the Code of Civil Procedure applicable to the trial of Suits with modification set out in Section 16 to be read with Schedule I, Order XI of the Code of Civil Procedure, relating to disclosure, discovery and inspection of documents being modified, Rule 3 of Order XI reads thus:-

> *"The plaint shall contain a declaration on oath from the plaintiff that all documents in the power, possession, control or custody of the plaintiff, pertaining to the facts and circumstances of the proceedings*
> *initiated by him have been disclosed and copies thereof annexed with the plaint, and that the plaintiff does not have any other documents in its power, possession, control or custody.*
> *Explanation.—A declaration on oath under this sub-rule shall be contained in the Statement of Truth as set out in the Appendix."*

33. Since, the Plaintiff kept away from the Court, the documents dated 1/12/2023 in form of its reply to the Examination Report of the Trade Marks Registry dated 7/11/2023, in respect of its label mark and which was brought on record by the Respondents along with their reply affidavit, the learned Single Judge held thus:-

> *"B. Second, even on an independent consideration of the suppressed material <u>none of which is either disputed or denied</u>, I have no hesitation in holding that there has been a suppression of material facts by the Applicant. The Applicant has, without so much as even the semblance of an explanation, <u>in respect of the very same trademark</u>, taken a diametrically opposite stand in the Plaint from the stand taken by the Applicant before the Trade Marks Registry. Hence, even accepting the Applicant's contention that the Applicant was unaware of the connection between the Respondents and Galactic, what is crucial to note is how the Applicant could, in respect of the very same trademark before the Trade Marks Registry, contend that the said mark was "not identical/similar and were*

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thus unlikely to deceive the public or create confusion on the part of the public in the market" and yet in the Plaint in respect of the very same trademark in the Plaint state that the said mark is "identical with/closely and deceptively similar with the Plaintiffs said packaging/trade dress/trademark…."

34. We do not find any illegality in the aforesaid observation as a finding is rendered that there was suppression of material fact by the Applicant and this was not disputed or denied.

Even today, Mr. Kadam has urged before us that he has not included it in the Plaint or Interim Application as his Suit was for passing off and he was not aware about the relationship of Respondent No.1 with Galactic, and he has assertively submitted that there was no question of any fraud being played, as he was unknown of the relationship and there was no deliberate attempt to conceal any relevant material.

35. Dealing with such an approach of the Respondent, we are guided by the principle of law laid down by the Apex Court in case of *Bhaskar Laxman Jadhav v. Karamveer Kakasaheb Wagh Education Society and Ors*[16], where it is categorically held that by virtue of Order 6 Rule 2 it is imperative for the Plaintiff to file a plaint containing statement in a concise form of the material facts on which the party pleads reliefs for its claim or defense and it is duty of the litigant to disclose all material facts and it is not for him to decide that which fact is material and which is not. In the background of the facts, the Apex Court observed thus:-

"42. While dealing with the conduct of the parties, we may also notice the submission of learned counsel for Respondent No.1 to the effect that the petitioners are guilty of suppression of a material fact from this Court, namely, the rejection on 2-5-2003 of the first application for extension of time filed by the trustees and the finality attached to it. These facts have not been clearly disclosed to this Court by the petitioners. It was submitted that in view of the suppression, special leave to appeal should not be granted to the petitioners.

16 (2013) 11 SCC 531.

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> *43. The learned counsel for the petitioners submitted that no material facts have been withheld from this Court. It was submitted that while the order dated 2-5-2003 was undoubtedly not filed, its existence was not material in view of subsequent developments that had taken place. We cannot agree.*
> *44. It is not for a litigant to decide what fact is material for adjudicating a case and what is not material. It is the obligation of a litigant to disclose all the facts of a case and leave the decision-making to the Court. True, there is a mention of the order dated 2-5-2003 in the order dated 24-7-2006 passed by the JCC, but that is not enough disclosure. The petitioners have not clearly disclosed the facts and circumstances in which the order dated 2-5-2003 was passed or that it has attained finality".*

36. The Apex Court also reiterated the Principle in *Ramjas Foundation* (supra) that a litigant, who do not come to the Court with clean hands is not entitled for any relief from any judicial court.

Therefore, we do not find any fault in the learned Single Judge taking note that the suppression of the fact and refusing the discretionary relief of injunction in its favour.

37. Though an attempt is made by Mr. Kadam to urge before us that this was the precise ground on which the ad-interim order granted on 30/01/2024, was vacated on 2/05/2024, we must note that the said order pronounces upon an application filed under Order XXXIX Rule 4 by the Defendant, alleging that the Plaintiff has suppressed vital information. The application relied upon the documents submitted to the Registrar of TradeMarks pursuant to the Examination Report dated 7/11/2023, where the Plaintiff had adopted a specific stand that its mark did not resemble with the mark of the licensor of defendant no.1, enclosed by the Registrar of Trade Mark with the Examination Report.

It was urged that these documents were relevant and within the knowledge of the Plaintiff and they ought to have been placed before the Court along with the Plaint so that the Court would have got an opportunity to examine the claim of the Plaintiff before any ad-

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interim / interim order could be granted. It was therefore urged that stand adopted by the Plaintiff before the Registrar of Trade Mark concerning analysis and interpretation of its own mark, when compared to the mark of Galactic, which was being used by the Defendants as licensees, the injunction was sought to be vacated.

With Reference to Order XXXIX Rule 4 of the CPC, the learned Single Judge on examination of the material placed on record came to the following conclusion:-

> *"37. The pleadings in the plaint and the said cease and desist notice, reply thereto and the reply of the plaintiff to the examination report of the Registrar of Trademarks, all pertaining to November 2023 and December 2023, indicate that such material held back by the plaintiff, was indeed relevant and it should have been placed before this Court. The absence of such material gave a different colour to the claims made by the plaintiff and this is the only relevant factor while deciding the present application filed under Order XXXIX Rule 4 of the CPC. Hence, the aforesaid judgment in the case of Asma Farid Noorani v/s. Haji Ali Fresh Fruit Juices & Ors. (supra), is distinguishable.*
>
> *39…..The emphasis placed on behalf of the plaintiff on the colour scheme of the label, placement of text, etc. at this stage, is irrelevant, particularly, when the statements made on behalf of the plaintiff before the Trademarks Registry in respect of the device mark are appreciated. In any case, as noted hereinabove, the suppression of vital material vitiates everything and it would equally apply to the claim of copyright made on behalf of the plaintiff, in the context of its right for ad-interim reliefs without notice to the defendants. This Court clarifies that the aforesaid observations are being made only in the context of the question as to whether sufficient grounds are made out by the defendants for vacating the ex-parte ad-interim order under Order XXXIX Rule 4 of the CPC. The said observations are not to be construed as any comment on merits, as regards the claim of the plaintiff regarding copyright in its artistic work concerning the mark "SET MAX".*
>
> *40. The failure on the part of the plaintiff to place the aforesaid material on record along with the plaint and/or with the application for interim reliefs does make out a case for the defendants to claim applicability of the first proviso of Order XXXIX Rule 4 of the CPC, thereby justifying its prayer for vacating the ex-parte ad-interim order. This has nothing to do with the merits of the rival claims and it has everything to do with ensuring the integrity of the judicial process. Therefore, the present application deserves to be allowed."*

38. Though, it is vehemently urged before us that the impugned order is once again based upon the very same reason, we do not agree with the said contention, as we find that on 02/05/2024, what was

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decided was an application under order XXXIX Rule 4 of CPC, and therefore the ad-interim reliefs granted ex-parte in favour of the Plaintiff was vacated, but it was made clear that the observations were not on the merits of the rival claims but it focused upon the integrity of the judicial process.

39. Applying the well settled Principle that a party, who seeks discretionary relief in form of an interim injunction must approach the Court with clean hands and if it does not do so, the relief can be refused, is evidently clear from the decision in case of *Amar Singh, Dalip Singh, Ramjas Foundation* (supra). We do not find any illegality in the impugned order, when the learned Single Judge on merits once again considered the said aspect, as it found that the Defendant has suppressed the material facts and even while considering grant of relief in form of an injunction it would be a material fact, and it weighed with the learned Single Judge, who found it to be one of the factor in not granting the relief amongst rest of the factors.

40. Another relevant submission for consideration before the learned Judge was that what is the effect of the admission in the response dated 1/12/2023 when the Applicant replied to the Examination Report dated 7/11/2023 and clearly admitted that its mark was visually and structurally different than Galactic's label mark of 'SetMax' depicted in black lettering and white background.

In case of *Chhaganlal Mehta* (supra), the concept of estoppel under the Evidence Act, 1872 received consideration when it was compared against the admissions given by a party and in paragraph 21, it is held as below:-

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> *"21. The difference between an admission and estoppel is a marked one. Admissions being declarations against an interest are good evidence but they are not conclusive and a party is always at liberty to withdraw admissions by proving that they are either mistaken or untrue. But estoppel creates an absolute bar. In this state of the legal position, if the endorsement made by Chimanrai or by his widow, Chhotiba or his daughter Taralaxmibai amounts to an estoppel they are their transferees would be prevented from claiming the property."*

41. In order to amount to estoppel, the test was laid down as below:-

> *"23. To bring the case within the scope of estoppel as defined in Section 115 of the Evidence Act : (1) there must be a representation by a person or his authorised agent to another in any form - a declaration, act or omission; (2) the representation must have been of the existence of a fact and not of promises de futuro or intention which might or might not be enforceable in contract; (3) the representation must have been meant to be relied upon; (4) there must have been belief on the part of the other party in its truth; (5) there must have been action on the faith of that declaration, act or omission, that is to say, the declaration, act or omission must have actually caused another to act on the faith of it, and to alter his former position to his prejudice or detriment; (6) the misrepresentation or conduct or omission must have been the proximate cause of leading the other party to act to his prejudice; (7) the person claiming the benefit of an estoppel must show that he was not aware of the true state of things. If he was aware of the real state of affairs or had means of knowledge, there can be no estoppel; (8) only the person to whom representation was made or for whom it was designed can avail himself of it. A person is entitled to plead estoppel in his own individual character and not as a representative of his assignee."*

42. Mr. Kadam has relied upon the decision of the Apex Court in case of *Kishori Lal vs Chalitbai* (supra), which according to him has laid down a proposition of law that when both the parties are equally conversant with true facts the doctrine of estoppel is inapplicable and reliance is placed upon the decision of Privy Council in case of *Mohori Bibi v. Dhurmodas Ghose*[17], where it is held that there can be no estoppel where truth of the matter is known to both parties.

We wonder as to how this principle apply to the case in hand.

43. Estoppel is a legal principle that prevents a person from asserting a claim, right, or fact that contradicts its own previous actions, statements, or representations, especially if someone else has

17 (1902) 30 IA 114.

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relied on them to their detriment. Estoppel is thus an equitable doctrine that prevents someone from asserting a claim or right that contradicts the one which is asserted. It is the legal bar in alleging or denying a fact because of one's own previous actions or words to the contrary.

The said principle ensures fairness and prevents injustice by holding parties to their own words, it prevents contradiction, as it is not permissible for the party to approbate and reprobate; that is, one cannot accept a benefit while later deny the obligation associated with it. Estoppel is often recognized as a rule of evidence that prohibits denying what has been previously established as true, and this common law principle is found incorporated in Indian Evidence Act, 1872.

On behalf of the Defendant, what was pressed into service is prosecution history estoppel as it was urged that in the proceedings before the Registrar of Trade Marks a stand was adopted and whether it estopped the Plaintiff from taking another stand, while establishing its case for infringing and passing off through the Suit.

The doctrine of prosecution history estoppel seeks to estop a person from claiming any advantage associated with a right which he has consciously waived in previous proceedings, and we are guided by the elaborate pronouncement on doctrine of 'Prosecution History Estoppel' by the learned Single Judge of this Court in case of *Shantappa @ Shantesh* (supra), when this doctrine predominantly used in patent infringement was noted to be increasingly applied to trademark infringement actions.

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The learned Single Judge (Justice Sandeep Marne) has referred to the plethora of precedents about the applicability of the doctrine to trademark infringement and passing off actions, and with reference to Section 115 of the Indian evidence Act, 1872, concluded thus:-

> *"45. Thus a consistent view taken in above quoted judgments is that a stand taken by the Plaintiff in previous proceedings, including the proceedings for registration of trademark, would continue to haunt him in all subsequent proceedings and would be a relevant factor while deciding Plaintiff's entitlement for temporary injunction. In most of the above judgments, non-disclosure of previous stand by Plaintiff is also held to be relevant factor for deciding injunction. However that aspect is being discussed separately in the judgment. For the moment, it would be necessary to concentrate on the issue of 'prosecution history estoppel"*

44. The aforesaid conclusion is derived on the basis of the precedents, with reference to the decision of parent High Court as well as Delhi High Court, and a conclusion is arrived to the effect that non-disclosure of the previous stand by the Plaintiff is a relevant factor for deciding injunction. Exhaustive reference is also made to the line of decisions, invoking the principle of non-applicability of estoppel against the statute, trying to suggest that the stand taken by a party during the procedure for registration of trade mark would be confined to registration proceedings only and would not haunt the Plaintiff in an infringement proceedings.

Once again with reference to the pronouncements to that effect, the learned Single Judge arrives at a following conclusion:-

> *"55. After having analyzed the judgments on the issue of applicability of principle of estoppel in actions for infringement of trademark and/or passing off, I am of the view that the stand taken by a party in proceedings for registration of a Mark cannot be ignored in each and every proceeding filed for infringement or passing off. In the present case, the doctrine of prosecution history estoppel would fully apply where Plaintiff has twice made a representation before the Trademark Registry that there is no resemblance between his and the Defendant's Marks. He took that stand with full knowledge that Defendant was intending to use the Mark 'ANNA' for same class of goods and services. He thus led Defendant to believe that the Defendant was free to*

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commence and operate business of selling same class of goods and services by using the Mark 'ANNA'. Plaintiff cannot now be permitted to take a volte face and contend that the two marks are deceptively similar."

45. Shantapa (supra) is thus a decision, on the issue of applicability of principle of estoppel in action for infringement of trade mark and /or passing off and it is held that the stand adopted by a party in a course of proceedings for registration of a mark cannot be ignored, and in the facts of the case, where the Plaintiff made representation before the Trade Marks Registry that there was no resemblance between his and the Defendant's Marks and having adopted a stand with full knowledge that the Defendant was intending to use the mark ANNA for same class of goods and services, it was held that the Plaintiff cannot be permitted to take a contrary stand and contend that the two marks are deceptively similar.

46. Similar is the situation before us as, we have noted that while responding to the Examination report, when the Plaintiff was confronted with Galactic's trademark, it categorically adopted a stand that the two marks are visually and structurally different and there is no likelihood of any confusion and therefore its mark was sought to be registered. When for the purposes of ascertaining its claim for registration of its mark, the Plaintiff with respect to the objection raised by the Registry of Trade Mark claim that the mark of Galactic was visually and structurally different and there was no resemblance, it adopted a stand that its mark 'SetMax' do not resemble with the other mark enclosing the Examination Report, and the same is not identical with or similar to earlier marks in respect to similar description of goods, and no similarity exists, which may likely to deceive or cause any confusion on part of the public in the market.

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With the categorical statement that, their mark 'SetMax' cannot be deemed to be similar or deceptively similar or identical and there was no question of conflict, as the mark 'SetMax' being a distinctive one qualify for registration, we are also of the view that the said stand haunt the Plaintiff, even in this proceeding, when he seeks injunction restraining the Defendants from using its mark on the ground that it is deceptively similar to the Plaintiff's mark.

47. A serious attempt is made on behalf of Mr. Patel to submit that non- disclosure of relevant material amounts to fraud and he has relied upon the decision in case of *S.P. Chengalvaraya Naidu* (supra), but we do not subscribe to the said view as fraud involves a mental element, as it is intentional deception for unfair gain or undue advantage.

Fraud becomes a crime when it is 'known misrepresentation of truth' and such fraud avoid all judicial acts and any judgment or decree obtained by playing fraud is in nullity and cannot be enforced. However, in our view, fraud is a matter of evidence and at this stage, we cannot conclusively establish whether there is a fraud played by the Plaintiff, but suffice it to note that the Plaintiff has not come before the Court with clean hands and having discredited himself, the Single Judge has refused him the interim relief.

Though, a feeble attempt is made by Mr. Kadam in submitting that there is no reliance placed on the representation made by the Plaintiff and ultimately passing off is an action to prevent public from being mislead and in absence of the Plaintiff being aware about the relationship between the Respondent No.1 and Galactic, he cannot be accused of intentional suppression, we can only observe that in grant

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of discretionary relief under Order XXXIX (1) and (2), the learned Single Judge has rightly refused any indulgence on two counts; firstly the Plaintiff had suppressed the relevant material, and secondly on the count of estoppel as he has adopted a stand in the previous proceedings before the Registrar of Trade Marks, that the mark which it had presented for registration is not similar to the mark of Galactic for which an application was made for registration and there is no scope for any confusion in the minds of its user and we find that this has justified the learned Single Judge in refusing the discretionary relief in favour of the Plaintiff.

48. Another ground on which the relief is refused to the Plaintiff is, the Applicant despite admittedly being aware that Galactic had filed an application for registration in respect of the very same trademark, it has chosen not to make Galactic as a party to the Suit and the Judge has recorded in Para (H) that 'the reason is not far to seek, since had Galactic being made a party, the Applicant would never have moved for exparte ad-interim relief'.

Recording that the licensee of Galactic in respect of the very same trade mark had commenced the sale of impugned products in December, 2023, after Applicant's representation to Galactic and therefore, it is concluded that Galactic and the Respondents have acted upon such representation and therefore, the contention that the Respondents have not satisfied the elements of estoppel as laid down in case of *Kishori Lal* and *Chhaganlal Mehta* (supra) was held to be not applicable, and we do not find any perversity in the said finding rendered by the learned Single Judge in refusing the relief of temporary injunction in favour of the Plaintiff.

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49. Considering the limited scope of interference as laid down by the Apex Court in case of *Wander Limited* (supra), determining the scope of an appeal, and unless the findings rendered in the judgment/order under challenge are perverse, it is not open for us to substitute the discretion exercised by the Court and since the Appellant has failed to prove before us that the discretion is arbitrary exercise of power we refrain ourself from interfering with the impugned order. By upholding impugned order dated 25/06/2025, we dismiss the present Commercial Appeal .

As a result, the pending interim application is also disposed of.

(MANJUSHA DESHPANDE, J.) **(BHARATI DANGRE, J.)**