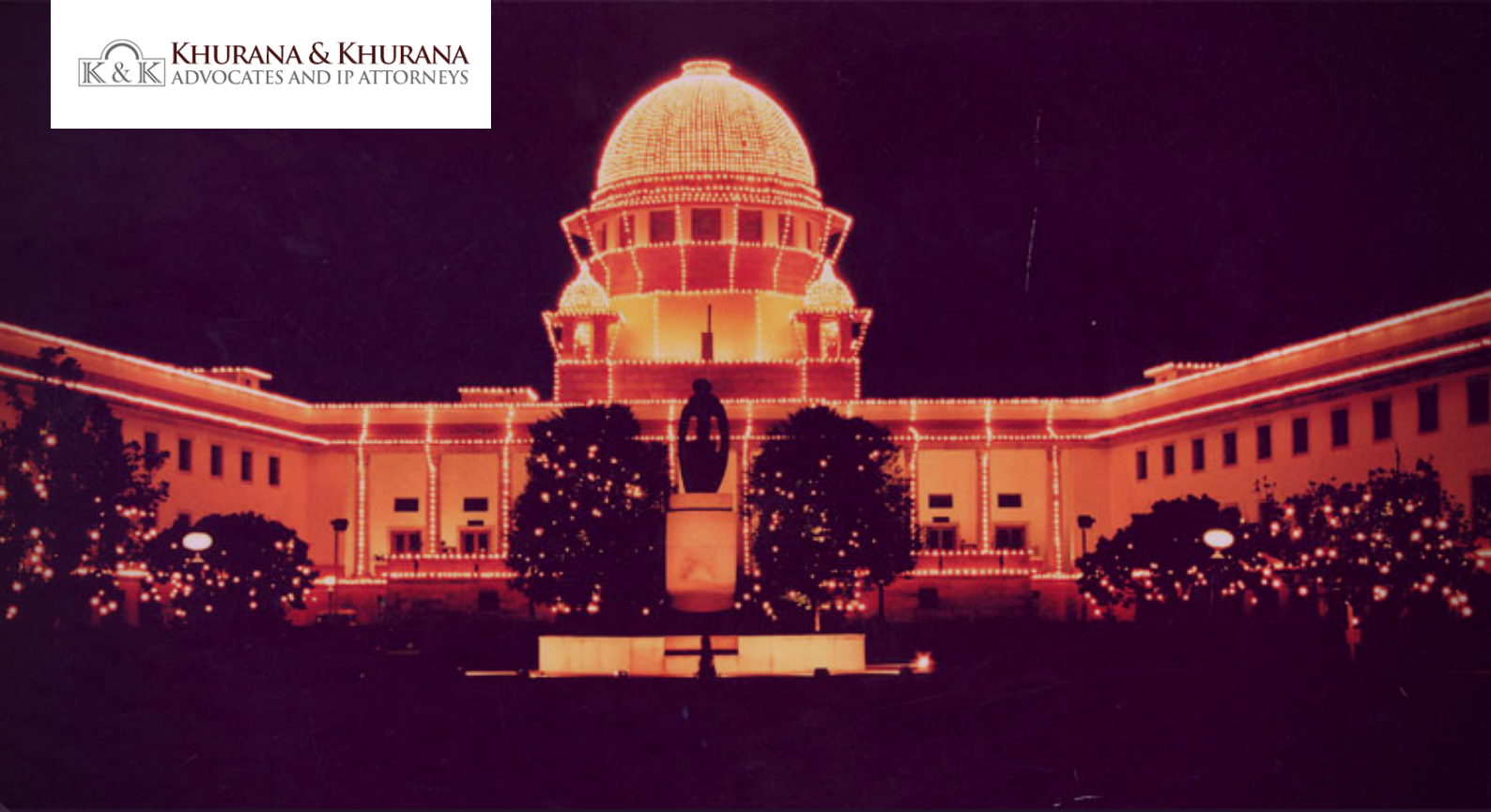




**KHURANA & KHURANA**  
ADVOCATES AND IP ATTORNEYS



# **A HOLISTIC COMPENDIUM: INDIAN TRADE MARK CASES SUMMARY FOR 2018**

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## **PREFACE**

Indian Trade Mark jurisprudence continued its rapid development in the year 2018, passing many important milestones. With the significant rise in the number of litigations, Indian judiciary has made its immense contribution to the trademark ecosystem by way of notable volume and diversity of trademark cases. Year 2018 had witnessed a substantial development in the IP ecosystem crystallizing the Trademark Jurisprudence which has a direct influence on the confidence of stakeholders in the wake of globalization and “Make in India” regime. To mention a few:

- Setting up precedent by awarding higher punitive damages to habitual offender in IP matters
- IPR offices welcoming new technologies.
- increase in number of injunctions based on Passing off principle
- Providing clarity on the aspect of Territorial Jurisdiction of Court in IP infringement matters for effective invocation of IP rights by Stakeholders
- Court imposing costs against frivolous litigations deterring litigants from initiating sham litigations
- Providing Clarity on Comparative Advertisement.
- Reaffirming the procedure of removal of Trademark from the register of Trademarks.
- Clearly distinguishing a Passing off case and an infringement case.

With that background and Khurana and Khurana's involvement in trademark litigations, this compendium aims to provide certain key judgment summaries that reflect a diverse range of issues discussed and adjudicated upon by the Indian Judiciary in the year 2018 pertaining to the interpretation/ implementation of various provisions of The Trade Marks Act, 1999 as provided herein below:

**1. Abbreviation along with a trademark<sup>1</sup>:**

There is no passing-off in abbreviation of descriptive words used along with another different mark.

**2. The Trade Marks Act,1999 facilitates an informed choice<sup>2</sup>:**

Comparative advertising is allowed, considering, that the information in the advertisement is not deceptive and the consumer is equipped with the knowledge to know more about the two competitors.

**3. Exemplary damages for habitual infringement of trademarks<sup>3</sup>:**

Imposing exemplary damages of 1.5 Crore in order to deter habitual infringers from making counterfeit, sub-standard drugs that might have a huge implication on Public health.

**4. Use of common Surname as a Trade Mark<sup>4</sup>.**

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<sup>1</sup>Superon Schweissttechnik India V. Modi Hitech India Ltd. (2018) 250 DLT 308

<sup>2</sup> Horlicks Ltd. &Anr. Vs. Heinz India Pvt. Ltd 2018 SCC OnLine Del 12975

<sup>3</sup> Glenmark Pharmaceuticals Ltd V Curetech Skincare And Anr, 2018 (76) PTC 114 (Bom)

Use of common surname is not passing-off and thus not prohibited.

**5. Rights for registered Trade mark only restricted to the registered class of goods<sup>5</sup>.**

The proprietor of a trademark cannot enjoy a monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class.

**6. Expounding on the actual use of the Trademark<sup>6</sup>:**

The Delhi High Court made a distinction between the usage of a trademark for a product and using a similar mark for a manufacturing company.

**7. Requirement of O-3 Notice by the registrar for removal of registered mark<sup>7</sup>:**

The Bombay High Court has reiterated the settled principle of Trademark Law that a mark cannot be removed from the register of trademarks for non-renewal unless the Registrar of Trademarks has sent O-3 Notice to the registered proprietor of the mark.

**8. Application of associative thinking theories on deciding the cases in Trade mark infringement<sup>8</sup>:**

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<sup>4</sup>Somashekar P PatilVs D V G Patil AIR 2018 Kar 135

<sup>5</sup>M/S Nandhini Deluxe V. M/S Karnataka Co-Operative Milk Producers Federation Limited (2018) 9 SCC 183

<sup>6</sup> Mankind Pharma Ltd vs. Chandra Mani Tiwari & Anr (2018) 253 DLT 39

<sup>7</sup> Kleenage Products (India) Private Limited V. The Registrar Of Trademarks &Ors 2018 SCC OnLine Bom 46

The Delhi High Court opined that the person with “ordinary intellect” should be able to distinguish between products with similar trademarks. The Hon’ble Court relied on consumer psychology, associative thinking and memory to judge whether a similarity is found.

#### **9. Punitive damages under consideration<sup>9</sup>:**

This judgment also analyses the circumstances and tests to be undertaken before awarding punitive damages in lieu of previous judgements.

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<sup>8</sup> The Gillette Company Llc Vs. Tigaksha Metalics Private Ltd. (2018) 251 DLT 530

<sup>9</sup> Christian Loubotin v. Pawan Kumar (2018) 250 DLT 475

## LIST OF IMPORTANT CASES ON TRADE MARKS - 2018

S. NO	TOPIC	CITATION	PAGE
1	There is no passing off in abbreviation used along with another different mark.	Superon Schweissttechnik India V. Modi Hitech India Ltd. (2018) 250 DLT 308	7-12
2	If information is already in the public domain, then comparative advertising according to the ASCI code is not said to be misleading the consumers.	Horlicks Ltd. &Anr. Vs. Heinz India Pvt. Ltd. (2018) 9 SCC 183	13-19
3	Exemplary damages awarded for Habitual infringement of trademarks of Pharmaceutical products.	Glenmark Pharmaceuticals Ltd V Curetech Skincare And Anr. 2018 (76) PTC 114 (Bom)	21-24
4	Use of surname is not Trademark passing-off and thus not prohibited.	Somashekar P Patil Vs D V G Patil. AIR 2018 Kar 135	25-30
5	The proprietor of a trademark cannot enjoy a monopoly over the entire	M/S Nandhini Deluxe V. M/S Karnataka Co-Operative Milk	31-37

	class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class.	Producers Federation Limited.  (2018) 9 SCC 183	
6	No Trade mark infringement, if the mark is not used as in the context of the registered Trademark.	Mankind Pharma Ltd vs Chandra Mani Tiwari & Anr.  (2018) 253 DLT 39	38-43
7.	It is mandatory to issue O-3 notice before removal of a Trade mark from the Trade mark Register.	Kleenage Products (India) Private Limited V. The Registrar Of Trademarks & Ors.  2018 SCC OnLine Bom 46	44-46
8.	Application of associative thinking theories on deciding the cases in Trade mark infringement.	The Gillette Company Llc Vs. Tigaksha metallica Private Ltd.  (2018) 251 DLT 530	47-51
9.	Single Colour not Entitled to Trademark Protection:	Christian Louboutin v. Abubaker.  (2018) 250 DLT 475	52-57

**SUPERON SCHWEISS TECHNIK INDIA V. MODI HI-TECH INDIA LTD.**

**(2018) 250 DLT 308**

**PARTIES:**

- The Plaintiff, SUPERONSCHWEISSTECHNIK INDIA, is engaged in manufacturing of fire suppression systems coatings, fire barriers, etc and various other products
- The Plaintiff is claimed to be the owner of the Trademark SUPERON with another trademark VAC PAC, which is used in manufacturing and selling of welding electrodes.
- The Defendant, Modi Hitech India Ltd, is engaged in the same line of business as that of the Plaintiff and is claimed to be the owner of the Trademark GMM/arc with the word VAC PAC.

**BRIEF FACTS:**

- The plaintiff company has its well-known trademark of SUPERON under which the plaintiff sells its goods, and along with this trademark SUPERON the plaintiff also claims to have adopted from the year 2004 the trademark of VAC-PAC. , Whereas the defendant is selling its goods under its primary trademark GMM/arc with an addition of the words VAC-PAC on the packaging.
- The Plaintiff alleged that the Defendant has dishonestly adopted an identical trademark VAC-PAC for the same goods as that of the plaintiffs', such as welding electrodes. Therefore, adoption of "VAC PAC" is completely dishonest.



- Hence, the plaintiff has filed a suit before the Court claiming the following reliefs:
  - a. Permanent injunction to restrain the Defendants from infringing their mark “VAC-PAC”.
  - b. Delivery up of impugned products by the defendants
  - c. An order of rendition of account of the defendant by their aforesaid impugned trade activities and a decree to the plaintiff on the amount so ascertained.
  - d. Damages amounting to rupees 1,00,00,001/-.

#### **ISSUES:**

- Whether Defendant’s act of using the words VAC PAC leads to passing off the Plaintiff’s Trademark?

#### **APPLICABLE LAWS:**

- ***Section 9(1)(a) of the Trade Marks Act: Absolute grounds for refusal of registration-***
  - (1) The trade marks-(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person shall not be registered:  
 Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

- **Section 11(3)(a) of the Trade Marks Act: Relative grounds for refusal of registration-**

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade;"

### **ARGUMENTS**

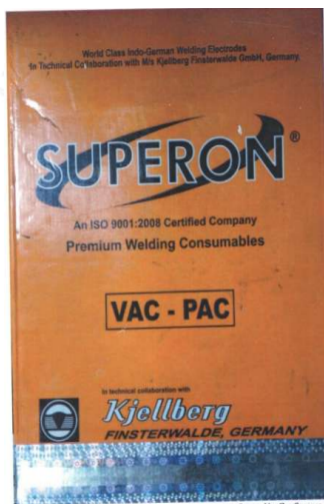
- The Plaintiff argued that the trademark VAC-PAC has been coined, conceived and adopted by the Plaintiff with respect to its products and thus, the trademark is an arbitrary and fanciful trademark. The Plaintiff stated that VAC PAC is the abbreviated form of Vacuum Package.
- The Plaintiff further contended that once its additional trademark, which is used with the main trademark, achieves distinctiveness, then the Plaintiff is entitled to be the owner of such an additional trademark.
- The Defendant contended that the Plaintiff does not have any real prospect of succeeding and in which circumstances the suit can be dismissed in view of Order XIII-A CPC by placing reliance on **Godfrey Phillips India Limited Vs. P.T.I Private Limited &Ors**, wherein the court had dismissed the commercial suit due to lack of any real cause of action.

- The Defendants, in furtherance of the above contention, also relied upon Marico Limited Vs. Agro Tech Foods Limited 2010 (174) DLT 279: 2010 (44) PTC 736, stating that that abbreviation of descriptive words cannot and should not be given protection as a trademark.

## **DECISION**

The Delhi High Court dismissed the suit on the following grounds:

- The Plaintiff's main trademark is SUPERON with an added word VAC PAC, whereas the Defendant's main trademark is totally different being GMM/arc with the use of work VAC PAC. Therefore, there is no identical characteristic on the Trademarks of both the parties.
- The packaging and get up of the parties is entirely different as provided by the Plaintiff:



**Plaintiffs' Packaging**



**Defendant's Packaging**

- The case of infringement and passing off are dealt differently. The present case being a passing off case, the Court has to observe the trademarks as

well as the packaging of both the parties, unlike the case of infringement. Thus, on examining these, the Court found that the defendants cannot be said to have pass off the Plaintiff's trademark.

- d. The court relied on an array of cases; one of such case was **Godfrey Phillips India Limited.**, where the facts of the case were similar to the present case. Thus, concluded that the trademarks of the two Parties are not similar and this suit is accordingly liable to be dismissed owing to no real prospect to succeed by the Plaintiff alleging Defendant, for using the expression VAC PAC.
- e. The court also referred to the ratio of Marico Limited case, which upheld that no one can claim exclusive ownership over an ordinary descriptive word or their abbreviation as trademark in view of Section 9, 30 and 35 of the Trade Marks Act, 1999. In the present case, the word VAC PAC was an abbreviated form of Vacuum Pack/packaging as affirmed by plaintiff. This is descriptive in larger term as it is used in packaging a welding shield to give a longer shelf life. Thus, using words like VAC PAC shall not entitle the owner of such word, an exclusive owner.
- f. The Court was also inclined to dismiss the suit with actual costs wherein Defendants were instructed to file the affidavit with actual costs and relevant documents and Plaintiff were ordered to pay the same to the Defendants at actual. Besides, as Court was of the opinion that suit

abused the process of law, additional cost of INR 50,000/- was imposed on the Plaintiff.

## **CONCLUSION**

The Court has very clearly made a distinction between a passing off case and an infringement case with respect to the procedure of suit. It is highlighted that in infringement suit, the Court has to look into the impugned Trademark only and not packaging, whereas in a passing off suit, the Court examines respective trademark as well as the get up and packaging of the products of the two parties.

The Court also pronounced that one cannot claim an exclusive use over an abbreviated form of an ordinary descriptive term.

**HORLICKS LTD. & ANR. VS. HEINZ INDIA PVT. LTD**

**(2018) 9 SCC 183**

**PARTIES:**

- The Plaintiff, HORLICKS LTD. & ANR, is engaged in the business of manufacturing and selling health food drink products under the trade mark of “Horlicks” and has been using the product extensively since many decade.
- The Defendant, HEINZ INDIA PRIVATE LIMITED, is associated with similar business and manufactures and sells milk product under the Trade mark “Complan”.

**BRIEF FACTS:**

- The Plaintiff No.1 is the registered proprietor of the trade mark HORLICKS in India under Classes 25, 28, 29, 30 and 32 of the Trade Marks Act, 1999.
- Plaintiff became aware of the fact that the defendant had published an advertisement for its brand COMPLAN in a newspaper namely “Telegraph” (Kolkata and Patna Edition), disparaging the plaintiffs’ health food drink product “HORLICKS”
- The Defendant published an advertisement, which was comparative in nature with the Plaintiff’s product ‘HORLICKS’: The advertisement stated “*One cup of Complan (33g) gives 5.94g of protein while two cups*”

*of Horlicks (27\*2=54g) gives 5.94g of protein basis recommended pack dosage....”*

- The above statement was claimed to be a disclaimer, which was further modified and made more eminent. The Defendant also used a line, “*From Now On, Only Complan*”.
- The plaintiff claimed that the defendant’s advertisement intentionally belittled and disparaged plaintiff’s health food drink “Horlicks”.
- Thus, the Plaintiff filed a suit against Defendant before Delhi High Court, for damages and permanent injunction restraining infringement, disparagement and unfair trade practices against the defendant.

### **ISSUES:**

- Whether under Article 19(1) (a) of the Constitution of India an advertisement that may be a facet of commercial speech be protected?
- How to assess a misleading advertisement?
- Whether during comparative advertisement some disparagement of the other product is legal?

### **APPLICABLE LAW:**

- ***Article 19 (1) (a) of Constitution of India:*** All citizens shall have the right  
(a) to freedom of speech and expression;

(2) Nothing in sub clause (a) of clause (1) shall affect the operation of any existing law, or prevent the State from making any law, in so far as such law imposes reasonable restrictions on the exercise of the right conferred by the said sub clause in the interests of the sovereignty and integrity of India, the security of the State, friendly relations with foreign States, public order, decency or morality or in relation to contempt of court, defamation or incitement to an offence.

- ***Section 29(8) of the Trademark Act, 1999: Infringement of registered trademarks:***

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) Takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

- ***Section 30(1) of the Trademark Act, 1999: Limits on effect of registered trade mark.—***

(1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or service

(2) as those of the proprietor provided the use—

(a) is in accordance with honest practices in industrial or commercial matters, and



(b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

### **ARGUMENTS ON BEHALF OF PARTIES:**

#### **PLAINTIFFS:**

- The Plaintiff contended that the disclaimer in the impugned advertisement was not an integral part of the advertisement and the font size of the super did not comply with the ASCI guidelines regarding font size requirements for a disclaimer.
- Advertisement wrongly stated that the amount of protein in the defendant's product was double the amount of protein in the plaintiffs' product, which is untrue and misleading.
- Plaintiff condemned the tagline of the Defendant- "From now on, Only Complan", and thereby relied on case of **Dabur India Limited v Emami Limited, (2004) 112 DLT 73, Unibic Biscuits India Pvt. ltd. Vs. Britannia Industries Limited, MIPR 2008 (3) 347**etc, which restrained the defendant from such advertisements.
- Use of such advertisements by Defendant violated Section 29 (8) and 30(1) of Trademark Act, 1999.

#### **DEFENDANTS:**

- The Defendants suo moto modified the advertisement according to the prescribed font size and manner as prescribed by ASCI.

- The Defendants contended that such advertisement showing protein content of the product in per serving size intended to educate the consumers. It was further stated that the impugned advertisement was neither disparaging nor defamatory and provided an accurate, true, verifiable and representative comparison to the consumers.
- The Defendant emphasized that primary objective of Sections 29(8) and 30(1) of the Trade Marks Act, 1999, is to allow comparative advertisement as long as the use of the competitor's mark was honest. The Defendant relied on **Havells India Ltd. Vs. Amritanshu Khaitan, 2015 (62) PTC 64 (Del)** and stated that mere trade puffery, even if uncomfortable to the registered proprietor of the trade mark, would not bring the advertisement within the scope of the trade mark infringement.
- The Defendant stated that the tagline 'From Now On, Only Complan' was a mere promotional statement, i.e., to encourage and urge customers to purchase the products of the Defendant.

### **DECISION**

- The Delhi High Court held that there is no disparagement of the plaintiff's product by the defendant. The impugned advertisement as amended did not show any wrong or fallacious

information about its product or disparaged the Plaintiff's product as the comparison was technically true.

- The Court stated that the tagline, "*From Now On, Only Complan*" was not disparaging or belittling the Plaintiff's product in any way. This tagline was only to encourage the consumers to buy Complan.
- The Court also held that advertisement is a part of commercial speech and therefore, will be protected under Article 19(1) (a) of the Constitution of India. Further, restrictions will be put only under Article 19(2) of the Constitution of India.
- The Court stated that the product packaging of Horlicks already contained the information that was mentioned in the advertisement of the Defendant. Since, the information was already in public domain, then the plaintiff cannot seek any protection under Right to Privacy.
- The Court further held that, comparative advertisement is allowed so that the consumer may know more about the goods and services between two competitors. Comparative advertisement is permissible until the information in the comparative advertisement is not deceptive, i.e. the information is not misleading the consumers till then some disparagement during comparative advertisement is legal and is allowed.

- Thus, the application was dismissed by holding that Defendants have not mislead the consumers and have published comparative advertisement according to ASCI code. Thus, the impugned advertisement is not denigrating or disparaging the Plaintiff in any way.
- The court also held that it is not necessary for the advertiser to mention all the constraints and parameters. The advertiser may only mention those points for comparative advertisement that may highpoint any special feature of the product.

## **CONCLUSION**

The present case is about the advertising war between the two parties who have been rivals for several years. The Court elaborately discussed on Comparative advertisements and stated that Comparative advertisement is legal and admissible, if it is true and not misleading.

It concurred with the Havells' judgment, which pronounced that comparative advertising is permitted to stimulate competition between suppliers of goods and services to the consumer's advantage, by allowing competitors to highlight objectively the merits of the various comparative products, while at the same time, prohibiting practices which may distort competition, be detrimental to competitors and have an adverse effect on consumer's choice.

The court restated the definition of misleading advertisements as, “*any advertising which is in any way, including its presentation, deceives or is likely to deceive the persons to whom it is addressed or whom it reaches and which, by reason of its deceptive nature, is likely to affect their economic behavior or which, for those reasons, injures or is likely to injure a competitor*”; as given in Article 2(2) of European Union Council Directive 8/450. It further accepted the Defendant’s contentions and reiterated that the object of Section 28 and 29 of Trademark Act is to educate people and enable them to make informed choice as well as to avoid any practices detrimental to Trademark mark Act and amounts to infringement.

**GLENMARK PHARMACEUTICALS LTD V CURETECH SKINCARE AND**

**ANR.**

**2018 (76) PTC 114 (Bom)**

**PARTIES:**

- The Plaintiff, GLENMARK PHARMACEUTICAL is a pharmaceutical company, which is engaged in manufacturing an anti-fungal cream 'Candid B'.
- The Defendant No.1, CURETECH SKINCARE is a contract manufacturer, who was manufacturing on behalf of GALPHA LABORATORIES.
- The Defendant No.2, GALPHA LABORATORIES is the principal Defendant, which is the proprietor of a similar drug as of the Plaintiff's, selling under the trade name Clodid – B.

**BRIEF FACTS:**

- The dispute in question is over the product trademark of CANDID- B which is an anti-fungal cream that is manufactured and sold by the Plaintiff.
- The Plaintiff was brought to notice of the fact that the Defendants were engaged with manufacturing and selling a similar product under a similar mark of CLODID-B having the similar artwork, trade dress,

label etc. Thus, the Plaintiff filed a suit against the Defendant for infringement of their Trademark.

**ARGUMENTS ON BEHALF OF PARTIES:**

- The Defendants No. 2 admitted that adoption of their mark was a mere mistake and they ought to have acted diligently before using the impugned mark. They also contended that they have not involved with any other infringing activity. The Defendants did not contest the case.
- The Plaintiff contended that Defendant No 2 had copied the color scheme, trade dress, art work, the manner of writing and even the font style of the Plaintiff's product 'CANDID B'.
- The Plaintiff contended that the defendant has earlier also infringed their trademark to which they had issued cease and desist notice to Defendants, which they failed to comply with. Plaintiff also submitted that the defendant has also in past involved in infringement of Trade Marks of other pharmaceutical companies.
- The Plaintiff highlighted the judgment of Court in **Win-Medicare Pvt. Ltd. Vs. Galpha Laboratories**, wherein the Defendant was declared as a 'habitual infringer'. Thus, they should not be allowed to scot free.
- The Plaintiff submitted a report made by the Maharashtra Office of Drug Control Administration, Central Drugs Standard Control Organization and certain FDA regulations, where five products of the

Defendants were declared 'substandard'. With regard to this, the Plaintiff pleaded for exemplary damages in order to give detrimental impact on such manufacturers.

### **DECISION**

- On hearing the arguments of both the cases and examining various reports and equipment provided by Plaintiff, the Court opined that the Defendant has blatantly copied the trademark of the Plaintiff and hence has infringed the Plaintiff's mark.
- The Court also went through the history of the Defendant of using the substandard products and thus, the Court imposed a heavy cost of Rs. 1.5 Crore against the Defendant, despite of the settlement.
- The Court instructed the Defendant to:
  - a. Withdraw the products from the market.
  - b. To cancel the manufacturing permission under the trademark CLODID and its variants.
  - c. To destroy the goods that had been seized, at the cost of the defendant and in the presence of the plaintiff.

### **CONCLUSION**

The court held that the principle defendant had infringed the intellectual property rights of the Plaintiff and reprimanded the practices adopted by the defendants. It also awarded exemplary damages of 1.5 Crore which was



donated to the Kerala Chief Ministers Distress Relief Fund upon the request of Plaintiff.

Such heavy cost was imposed in this case with a view to deter such habitual infringer and manufacturers from making sub-standard drugs that have huge implication on Public health as well. The present case is therefore, a proof of the court's firm stand against habitual infringement by the Defendant, where the Court also mentioned that "drugs are not sweets. Pharmaceuticals companies which provide medicines for health of the consumers have a special duty of care towards them"

**SOMASHEKAR P PATIL VS D V G PATIL**

**AIR 2018 Kar 135**

**Parties:**

- The Plaintiff, SOMASHEKAR P PATIL, is a proprietor engaged in the business of selling incense sticks as 'M/s. Patil Parimala Works' in Bangalore, India.
- The Defendant, D.V.G. PATIL, is engaged in the manufacturing and trading of incense sticks under the trading name 'Patil Fragrances' in Bangalore.

**Brief Facts:**

- By a Civil Suit [(O.S) No. 6665 of 2017] instituted before the Additional City Civil Judge at Bengaluru, the plaintiff sought for a decree of interim injunction against the defendant to refrain him from infringing upon and passing-off the plaintiff's trademark and trading name 'Patil and Patil Parimala Works', which was identical and deceptively similar to the defendant's trading name i.e. 'Patil Fragrances'. The temporary injunction was initially granted. However, on an application to vacate the interim order, the Ld. Trial Judge vacated the same by the order dated 31st March 2018, which was then challenged before the High Court of Karnataka.

- The Plaintiff claimed that the Defendant's use of the trademark 'Patil Fragrances' was an infringement of his registered trade name 'Patil and Patil Parimala Works'.
- The Defendant argued that the Plaintiff Somashekar P. Patil and the Defendant, Doddanna Veeranagouda were brothers and thus shared the same last name, 'Patil'. The Defendant was also working as a General Manager with the Plaintiff's business. It was further argued that the family members of both the plaintiff and the defendant used the surname 'Patil' for their businesses predominantly.
- The Appellant filed an interim application under rule I and II of Order XXXIX for interim injunction to restrain respondent from using the name "Patil Fragrances" or any other identical or deceptively similar trading name or trademark during the pendency of the Suit, which was accepted and granted by Additional City Civil Judge.
- The Respondent filed an application under Order XXXIX Rule 4 for vacating ex parte Interim order, and thereby the injunction was vacated by the learned judge by the order dated 31st March 2018. The present appeal is filed by the plaintiff [Appellant] before the High Court of Karnataka, to set aside the order dated 31st March 2018 which vacated the interim order of injunctions granted to appellant.

### **ISSUES:**

- Whether the use of a surname as a trademark by Defendant amounts to infringement and passing off of the Plaintiff's trademark?

### **APPLICABLE LAWS:**

- ***Section 34, Trade Marks Act, 1999 :***

**Saving for vested rights:-** Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior- (a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his, or (b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his. Whichever is the earlier, and the Registrar shall not refuse (on such use being proved), to register the second mentioned trade mark by reason only of the registration of the first mentioned trade mark.

### **Section 35 in The Trade Marks Act, 1999**

35. Saving for use of name, address or description of goods or services.—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona

fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.

- **Article 19, CONSTITUTION OF INDIA - Protection of certain rights regarding freedom of speech, etc**

- (a) To freedom of speech and expression;
- (b) To assemble peaceably and without arms;
- (c) To form associations or unions 7[or co-operative societies];
- (d) To move freely throughout the territory of India;
- (e) To reside and settle in any part of the territory of India;1[and]
- (g) To practice any profession, or to carry on any occupation, trade or business.

### **ARGUMENTS**

- The Plaintiff had sought registration of its mark on 1<sup>st</sup> Jan 1978, whereas, the Defendant had registered his trademark in the year 2017. The Plaintiff argued that the Defendant's trademark was phonetically, visually, conceptually and aurally identical and deceptively similar to that of the Plaintiff.
- The Plaintiff Asserted an ex parte injunction due to the same reason, was granted on 09<sup>th</sup> October 2017.

- The Defendant argued that the Plaintiff had suppressed the fact that both the parties are a part of the same family and share the same surname. , and that the defendant was in-fact an ex-employee of the Plaintiff but the relationship wasn't disclosed so as to obtain an ex parte temporary injunction.
- The Defendant also stated that Section 35 of the Trade Marks Act, 1999 covered the Defendant's interest in using his surname i.e. 'Patil' and that most of the family members used the same surname invariably for their businesses as well.

## **DECISION**

- Affirming the decision of the Ld. trial court, the Hon'ble High Court dismissed the appeal on two grounds:
  - a) The court held that the right of a bona fide user of a mark cannot be intervened anyone, including a registered trademark user. Furthermore, it noted that merely using the similar surname does not itself make an act as an infringing act, therefore, cannot be a valid ground for injunction from using the word 'Patil' in his Trade mark.
  - b) In furtherance of the same, Hon'ble court said that granting an injunction to the respondent will result in the breach of his fundamental right of right to trade under Article 19(1)(g) which provides for freedom to any person in order to have his own trade, commerce, etc. then while dealing with the said subject,

the Courts have to take care before preventing or injuncting any person in this regard. Also section 35 of The Trade Marks Act, 1999 enables the Respondents to use the Word 'Patil' as they are bona fide user because of its link to the Plaintiff's family and the brand name i.e. 'Ullas' and 'Hitushree5" of both the parties are entirely different except the name of the company which includes the word Patil.

## **CONCLUSION**

The legal issue, per se, to be dealt with, in the case was in respect to the vacating of the ex parte injunction granted to the appellant. However, the bigger issue before the court was to decide whether the using a surname by the Defendant constitutes infringement and passing off of trademark which the court adjudicated validly. The court in the case bolstered the established principle of equity that 'a person seeking relief must come to court with clean hands'. Furthermore, he checked the constitutional validity of the impugned injunction and held that the right of a bona fide user cannot be sacrificed on the altar of a registered trademark user. Thus, the mere use of a surname does not constitute the act of infringement and passing off of a registered trademark.

**M/S NANDHINI DELUXE V. M/S KARNATAKA CO-OPERATIVE MILK**

**PRODUCERS FEDERATION LIMITED**

**(2018) 9 SCC 183**

**COURT:**

Supreme Court of India, A K Sikri, Ashok Bhushan

**PARTIES:**

- The Plaintiff, M/s NandhiniDelux, is in the business of running restaurants and it adopted the mark 'NANDHINI' for its restaurants in the year 1989 and applied for registration of the said mark in respect of various foodstuff items sold by it in its restaurants.
- The Defendant M/s Karnataka Co-operative Milk Producers Federation Ltd (Respondent) had adopted the Mark 'NANDINI' in 1985 and they had been selling their milk and milk products under the same.

**BRIEF FACTS:**

- M/S Nandhini Deluxe, the appellant is having business of series of restaurants which has been running since 1989 under the name of “NANDINI”.
- The appellant had moved an applications for registration of trade mark 'NANDHINI DELUXE WITH LOGO (Kannada)’ in respect of meat,



fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, eggs, milk and milk products, edible oils and fats, salad dressings, preserves and all other goods being included in Class 29 and 30. The respondent also has registration of its trademark “NANDINI” in respect of milk and milk products falling under class 29 and 30 as per classification under Schedule IV to the Trade Marks Rules, 2002.

- The Respondent had opposed the registration and the objections of the Respondent were dismissed by the Deputy Registrar of the Trade Mark who passed orders dated August 13, 2007 allowing the registration of the said mark in favour of the Appellant.
- The impugned mark of the Appellant as objected by the Respondent was on ground of deceptive similarity to the mark of the Respondent “NANDINI” and likelihood of deception to the public or cause confusion.
- When these objections were rejected by the Deputy Registrar and registration was granted to the Appellant, the Respondent approached the Intellectual Property Appellate Board ('IPAB'), Chennai by filing appeal for setting aside the order of Deputy Registrar. These appeals of the Respondent were allowed by the IPAB vide common order dated 4th October, 2011 and the writ petitions filed by the Appellant there against have been dismissed by the High Court vide impugned order

dated 2nd December, 2014, thereby confirming the order of the IPAB and, in the process, accepting the plea of Respondent.

- This led to the Appellant in filing a write petition before the Honble Supreme Court.

### **ISSUES**

- Is Appellant's registration of its Trade mark "NANDHINI" valid?

### **DECISION**

#### **ORDER OF DEPUTY REGISTRAR, TRADE MARK**

M/S Karnataka Co-operative Milk Producers Federation Limited had filed an opposition before the Deputy Registrar for cancelling the registration of the Appellant, whereby the deputy registrar held:

- The issue involved section 9 of Trademark Act, 1999, which provides that the generic words cannot be registered as trade mark unless they have acquired distinctiveness and are associated with the persons/company using the said mark. In the present case, IPAB, with regard to the above mentioned principle noted the word "NANDHINI" being a generic word, which represents the name of goddess and a cow in Hindu Mythology and is used by a large mass of people. Thus, the Respondent cannot claim monopoly over this word.

- The description of goods dealt provided by both the parties that are falling under class 29 and 30 are different and hence objection by respondents under section 11(2) of the Trademark Act is not tenable.
- Thus, the Appellant is entitled to the trademark “NANDHINI” under class 29 and 30 but cannot claim any rights with respect to milk and milk products (the goods that are dealt by the respondents under class 29 and 30.) Thus, the objection was dismissed directing the Appellant to remove milk and milk products from its description of goods under class 29.

#### **IPAB 20TH APRIL, 2010**

- The aforesaid order was challenged by the Respondent before IPAB. IPAB upheld the order of Deputy Registrar by dismissing the appeal of respondent. IPAB relied on the case of Vishnudas Trading as Vishnudas Kushandas, where the court held that when a person trades or manufactures one good under the broad classification having no bona fide intention to trade in all other goods falling under that broad classification, he cannot be permitted to enjoy monopoly in articles falling under such classification, ordered the Appellant to file TM 16 to amend its description of goods by deleting milk and milk products.
- Therefore, in the instant case, when the Respondent has its limited business only in milk and milk products with no intention to expand

the business of trading in other goods falling under Class 29 and the Appellant was given registration in other articles only, specifically excluding milk and milk products, there was nothing wrong in according registration of those products in favour of the Appellant under the trade mark 'NANDHINI'.

### **SECOND APPEAL OF IPAB ORDER DATED 4TH OCTOBER, 2011**

IPAB allowed the appeal of Respondent on the following grounds:

- Respondent's registered trademark 'NANDINI' is a well-known trade mark and a household name in the State of Karnataka.
- Respondent's trade mark 'NANDINI' has acquired distinctiveness. It further held that since milk and milk products fall under Classes 29 and 30 and the goods registered in the name of the Appellant also fall in the same class, the average consumer would conclude that goods manufactured by the Appellant belonged to the Respondent and, therefore, there is likelihood of confusion.
- The Respondent is a prior user of the mark and hence, therefore, registration of the Appellant's mark could not be permitted.

### **IMPUGNED JUDGMENT OF THE HIGH COURT:**

The High Court upheld the order of IPAB by reaffirming the reasoning of IPAB.

## SUPREME COURT OF INDIA

- The court said that the nature and style of the business of the appellant as well as the respondent are altogether different. Where, the respondent is a Cooperative Federation of Milk Producers of Karnataka and is producing and selling milk and milk products under the mark 'NANDINI', the appellant does the business of running restaurants . Even the mark 'NANDHINI' as sought by the appellant pertains to meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies etc. that are sold by restaurants.
- In spite of the fact that there was a phonetic similarity insofar as the words NANDHINI/NANDINI are concerned, the trade mark with logo that have been adopted by the two parties are altogether different. The manner in which the appellant has written NANDHINI as its mark is totally different from the style adopted by the respondent for writing its mark 'NANDINI'.



- Furthermore, the appellant has even used and added the word 'Deluxe' and, thus, its mark is 'NANDHINI DELUXE'. It is followed by the words 'the real spice of life'. There is device of lamp with the word 'NANDHINI'. In contrast, the respondent has used only one word, namely, NANDINI which is not prefixed or suffixed by any word. The court further remarked that "here plaintiff's mark is a strong one and there is hardly any similarity between the two names. The evidence of actual confusion, when analyzed, is not impressive. The proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class."

## **CONCLUSION**

The Court clarified that there is no provision of law which expressly prohibits registration of a trademark which is similar to an existing trademark and used for dissimilar goods, even when they fall under the same class. It was held that no person can have exclusive right or monopoly over the entire class of goods, especially when the trademark is not being used with respect to all the goods falling under the said class. Supreme Court's decision clearly construes that two visually distinct and different marks cannot be called deceptively similar especially when they are being used for different goods.

**MANKIND PHARMA LTD VS CHANDRA MANI TIWARI &ANR**

**(2018) 253 DLT 39**

**PARTIES:**

- The Plaintiff, MANKIND PHARMA LIMITED, is the fourth largest pharmaceutical company based in New Delhi.
- The Defendant No.1, CHANDRA MANI TIWARI, is the founder Director of the MERCYKIND PHARMACEUTICALS LIMITED.
- The Defendant No. 2, MERCYKIND PHARMACEUTICALS LIMITED is a pharmaceutical company based in Mumbai, Maharashtra. It is engaged with the business under the trademarks such as “MERCYKIND”, “MERCYMOX”, “MERCYCOUGH”, “MERCYCOPE” etc.

**BRIEF FACTS:**

- The Plaintiff is the registered proprietor of the mark “MANKIND” in 42 different classes and owns numerous mark adding prefix or suffix to the elements “MANKIND” and / or “KIND” for many decades. It also owns a website with “MANKIND” in their web addresses.
- The Plaintiff came across the trade name “MERCYKIND PHARMACEUTICALS PRIVATE LIMITED”, which belongs to the Defendant no. 2.

- The Plaintiff had issued a cease and desist notice against the Defendant, which the defendant refused to comply with.
- Hence, the Plaintiff filed a suit against the Defendants before Delhi High Court, seeking for permanent injunction to restrain them from using the plaintiff's registered trademark 'MANKIND' and the series of marks with the suffix/prefix "KIND" and from passing off their goods as that of the plaintiff.

### **ISSUES:**

- Whether the Defendant is guilty of infringing/ passing off the Plaintiff's trademark and goods by using their Trade mark "MERCYKIND" constituting infringement under Section 29(5) of the Act.

### **APPLICABLE LAWS:**

- ***Section 29(5), Trademarks Act, 1999***
  - a) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.
- ***Section 29(6), Trademarks Act, 1999***



b) :- For the purposes of this section, a person uses a registered mark, if, in particular, he- (a) affixes it to goods or the packaging thereof; (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark; (c) imports or exports goods under the mark; or (d) uses the registered trade mark on business papers or in advertising."

### **ARGUMENTS:**

- The Plaintiff contended that defendants were carrying their business by impersonating themselves to be under the umbrella of the Plaintiff.
- The plaintiff contended that the usage of suffix 'KIND' in 'MERCYKIND' is a deceptive act of the Defendants, and therefore, infringes its registered trademark 'MANKIND'.
- The Plaintiff cited an array of case laws, which were decided in their favour, restraining defendants from using any mark with the word element "KIND". **(Mankind Pharma Ltd. Vs. Ultrakind Health Care &Anr, Mankind Pharma Ltd. Vs. Cadila Pharmaceuticals Ltd.)**. Thus, the adoption of the Trademark MERCYKIND by the defendant in the present case amounts to infringement of Trademark.
- The Defendant highlighted the fact that the Plaintiff does not hold any registration of the word 'KIND' per se and thus, the trade name of the

Defendant does not cause infringement under section 29 (5) of Trade Mark Act, 1999.

- In addition, the defendant claimed that 'KIND' is a public juris term and mere presence of this word in the trade name of the Defendants does not conclude that the Defendants impersonated the name of Plaintiff to gain a business advantage.
- The Defendant highlights that the Plaintiff itself had submitted a reply to the examination report of the registration application of the Plaintiffs before the Trademark Registrar that “ATORKIND” and “ATORVAKIND” are visually, structurally and phonetically different of “ATORVAKIND. Thus, while accepting the Plaintiff’s above statement, “MERCYKIND” and “MANKIND” cannot be the same.
- The defendant also stated that according to the records of Trade mark registry that many companies have used the word 'KIND' as a part of their name and hence the Plaintiff’s mark is not distinctive by relying on the judgment of **P.P. JewelersPvt. Ltd. Vs. P.P. BuildwellPvt. Ltd. (2009) 41 PTC 217 (Del)** and on **Aviat Chemicals Pvt. Ltd. Vs. Intas Pharmaceuticals Ltd. (2001) 21 PTC 601 (Del)**.
- The Defendant contended that they have adopted “MERCYKIND” as their name of the company and do not use it in distribution/sale of their product, thus, it is not trademark of defendants.

## **DECISION**

- The Hon'ble Court dismissed the interim application. The Hon'ble Court, at the very first instance took the view that the Plaintiff had taken a stand in its own case that ATORKIND and ATORVAKIND are different. This fact was to be considered while deciding on interim injunction. However, the fact was concealed by the Plaintiff; thus, they are disentitled from equitable relief.
- The Court said that section 29(5) of Trademark Act explains infringement as the use of registered trademark as trade name or a part of trade name. Thus, there would have been infringement under Section 29(5), if the defendant had used MANKIND as its trade name or a part of trade name.
- Further, for infringement of a registered trade mark by use as trade name, the goods in which the defendant is dealing have to be "*same / identical*" and not "*similar*", equally applies to the use of the trade mark as trade name. Use of a trade name similar or deceptively similar to the registered trade mark would not constitute infringement under Section 29(5).
- Thus, prima facie, no case of infringement within the meaning of Section 29 is made out.

## **CONCLUSION**

The present case expounded that the aim of Section 29(5) of the Trademarks Act is to highlight the distinction between actual usage of a registered trademark and using a trademark similar to the already registered trademark. It highlighted a thin line between usage of a trademark for the product and using a similar mark for the manufacturing company. The former is barred by the trademark Act whereas the latter does not contravene any trademark law, therefore, is valid usage. Here, the defendant company used MERCYKIND as the name of its company and not for the sale of its products which suggests that it does not intend to pass off its product as that of the plaintiff.

The Delhi High Court, while interpreting section 29(5) of the Indian Trademarks Act 1999, has ruled that the use of a trade name deceptively similar to a registered trade mark does not constitute trade mark infringement, as section 29(5) only applies to the use of a trade name identical to a registered trade mark.

**KLEENAGE PRODUCTS (INDIA) PRIVATE LIMITED V. THE REGISTRAR OF  
TRADEMARKS &ORS**

**2018 SCC OnLine Bom 46**

**PARTIES:**

- The Petitioner, KLEENAGE PRODUCTS (INDIA) PRIVATE LIMITED, is a private limited company incorporated under the Companies Act, 1956 and engaged in the business of manufacture and sale of washing and cleaning preparations under various Trademarks 'SWAN BRAND' and 'KLITOLIN'.
- The Respondent No.1 is the REGISTRAR OF TRADEMARKS, and
- The Respondent No.2 is the UNION OF INDIA through the Ministry of Commerce, Department of Industrial Policy & Promotion

**BRIEF FACTS:**

- By way of suit 2018 SCC OnLine Bom 46, filed in the Bombay High Court, the Petitioner sought for a decree, prohibiting Respondent No. 1 from removing the trademark 'KLITOLIN' under No.379894 from the records of the register of trademarks.
- Petitioner asserted the fact that it owns various trademark including 'KLITOLIN' first registered in 1988 and duly renewed from 21.08.1988 to 21.08.2009. However, on 21.02.2009, the due date of renewal, the petitioner failed to file an application for renewal.

- The petitioner contended that the Respondent no. 1 removed the trade mark of the Plaintiff from the Trade mark register without complying with Section 25(3) of Trade Marks Act, 1999, which mandates the issuance of notice in Form O3 to the proprietor.
- Thus, the petitioner contended that respondent No.1 should allow restoration and renewal of the said trademark because of the failure to issue O-3 notice by the Respondent No.1

### **ISSUES:**

- Whether a trademark can be removed by the Registrar without issuing **Form O-3** which is a requisite notice under Section 25(3) of the Trade Marks Act, 1999.

### **APPLICABLE LAWS:**

- ***Section 25(3), Trade Marks Act, 1999 :-***

At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register: Provided that the Registrar shall not remove the trademark from the register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the

expiration of the last registration of the trademark and shall renew the registration of the trademark for a period of ten years under subsection (2).

### **DECISION**

- The Bombay High Court relied on ***Cipla Limited v. Registrar of Trade Marks and Anr*** and considered the theme and objects of Section 25 (3) of the Trade mark Act and held that it is mandatory to issue O-3 notice before removal of a mark that has not been renewed. The act of removal of mark due to non-renewal shall be contrary to Section 25 (3) of the Act. Therefore, the Court allowed the writ petition.
- The respondents were therefore, directed to consider the petitioner's application for renewal of the trademark subject to payment of the required fees.

### **CONCLUSION**

The Bombay High Court explicated that a right does not get exhausted when a corresponding duty is not performed. In the instant case, the petitioner had a right to file an application for the renewal of its trademark and the corresponding duty lies in the registrar to give mandatory notice of such removal. However, Registrar failed to perform his duty, therefore, petitioner's right sustained.

**THE GILLETTE COMPANY LLC VS. TIGAKSHAMETALLICS PRIVATE LTD.**

**(2018) 251 DLT 530**

**PARTIES:**

- The Plaintiff, Gillette Company LLC in the present case deals in manufacturing and sale of shaving blades under the Trademark “TALVAR”.
- The Defendant, Tigaksha Metallica Private Limited and Supermax Personal Care Pvt. Ltd manufacture and sell similar product, i.e. shaving blades under various trademarks including “ZORRIK”.
- The defendants have coined various trademarks comprising the word “ZORRIK” namely “ZORRIK PLATINUM”, “ZORRIK STAINLESS” and now “ZORRIK TALVAR” and have been selling the blades under the trade name “ZORRIK” for more than 50 years.

**BRIEF FACTS:**

- The Plaintiff, had filed a suit for permanent injunction against the two Defendants Tigaksha Metallica Private Limited and Supermax Personal Care Pvt. Ltd., restraining them from infringing their trademarks “WILKINSON SWORD”/ “LEMON SPLASH”
- The Plaintiff asserted that by adopting the mark “TALVAR” and/or the device of a sword and/or deceptive variations of the Plaintiff’s



trademarks, the Defendants were passing off their goods as that of the Plaintiff's.

- The trademarks of the Plaintiff, as well as the Defendants', had the depiction of a sword and thus the Plaintiff claimed that the Defendants had adopted a deceptively similar variation of their marks in respect of identical goods.

**ISSUE:**

- Whether words which convey the same ideas should be protected or not under Trade Marks Act, 1999.

**ARGUMENTS ON BEHALF OF PARTIES:**

**PLAINTIFF:**

- The usage and depiction of the word 'TALVAR' was infringing because it is a literal translation of the word SWORD, and was being used in a conceptually similar manner.
- Both marks had similar images of double-edged swords and were written in the italics font. These similarities, they argued, are accentuated since these marks represent the same product "safety razor blades".

**DEFENDANT:**

- It was argued that Defendants' product was being sold under the mark of ZORRIK for more than 50 years. It is known among people. The association of the image of sword and "TALVAR" with the mark "ZORRIK" was an inventive idea and was likely to negate any impression of similarity between the marks.
- The Defendants argued that the trade mark "SWORD" is neither the registered trade mark of the plaintiff nor is "TALVAR" a registered trade mark of the plaintiffs. Therefore, the Plaintiff has concealed the fact that they are not the registered proprietor of the words "SWORD" or "TALWAR".

**DECISION:**

- The Delhi High Court opined that the person with "ordinary intellect" should be able to distinguish the products. The Hon'ble Court relied on consumer psychology, associative thinking and memory to judge whether a similarity is found. It presented the examples of OFFICER'S CHOICE and COLLECTOR'S CHOICE, where both the words 'officer' and 'collector' may cause confusion for an ordinary consumer.
- The court in the present case applied various researches and psychological theories in order to decide the case. The court referred

to the case of *Allied Blenders & Distillers Pvt. Ltd v. Shree Nath Heritage Liquor Pvt. Ltd*, wherein, it was held that “marks containing words with the same sense relation (or falling in the same sematic field or conveying the same or similar idea in the mind) as that of previously existing marks are likely to be considered so similar as to be refused registration or deemed to constitute infringement of the previously existing trademark.”

- The case of *Prathiba M Singh v. Singh and Associates*, wherein the theory of “word association” has been applied, which means “stimulation of an associative pattern by word”. In simpler words, it means that our mind associates words with other concepts and words are not stored in isolation. Therefore, applying this theory in the present case, the Hon’ble Judge held that there will certainly be confusion in the minds of the consumers since both the trademarks, being similar in depiction, are in relation to the same product i.e. safety razor blades.
- Thus, the court allowed the continuation of the temporary injunction against the Defendants and dismissed their application to set aside the interim injunction.
- Relying upon the above mentioned case laws court went into the same line of the judgment and held that the words “SWORD” and “TALVAR” are words conveying the same meaning in respect of the same product and the Defendant’s mark is deceptively similar to that of the

Plaintiff's mark, therefore, there would be likelihood of confusion amongst consumers.

**CONCLUSION:**

This case seemed to be one of the cases which have opened a wide way for "likelihood of confusion" test; while on the other hand this case is unsettling because now the Courts not only have to get into the psychological analogy to an extent but also need to consider some behavioural patterns to decide the case, which not being uniform may lead to uncertainty to the rights of the parties.

**CHRISTIAN LOUBOUTIN SAS v. ABUBAKER**

**(2018) 250 DLT 475**

**PARTIES:**

- The Plaintiff, Christian Louboutin, is a company incorporated under the laws of France, having its registered office in Paris. The company derives its name from a famous designer of the high-end luxury products, Mr. Christian Louboutin, known for his signature “RED SOLE” high-heeled shoes.
- The Defendant, Abu Baker is, the sole proprietor of two a proprietorship entities; in Mumbai and Vile Parle; under the name M/S. Veronica.

**BRIEF FACTS:**

- The, Plaintiff is the exclusive owner of registered Trademark “Red Sole” in India.
- The Defendant sold its shoes with red colored sole under the trademark “VERONICA”.
- The Plaintiff instituted a suit at the High Court of Delhi, to seek injunction against the Defendant for infringement of trademark, passing off, damages etc. due to the sale of shoes with red colored

soles. The Plaintiff specifically directed its claim at the red colored soles of Abubaker's manufactures shoes.

**ISSUES:**

- Whether a cause of action sustained in the suit plaint?
- Whether a single color can be a trademark under the trademark act 1999?

**APPLICABLE LAWS:**

**Section 2(m) of the Trade Marks Act 1999**

"Mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof.

(ii) When we read the definition of "mark" it is crystal clear that the legislature has categorically used the expression „combination of colours“ with or without its combination with the other ingredients of the definition of „mark“ being a device, brand, heading, label, ticket, name, signatures, word, letter, numeral, shape of goods and packaging.

**Section 2(zb) of the Trade Marks Act 1999:**

“Trade mark” is a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from choose of others and may include shape of goods, their packaging and combination of colors, and- (i) in relation to Chapter XII (other than section 107), a registered trade mark or mark used in relation to goods or services for the

purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark, and (ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate to a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

**Section 10(2) of the Trademarks Act 1999:**

10. Limitation as to colour.—(1) A trademark may be limited wholly or in part to any combination of colors and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trademark.

(2) So far as a trademark is registered without limitation of color, it shall be deemed to be registered for all colors.”

**DECISION:**

- The single judge bench of the Hon’ble Delhi High Court, that issued a summary dismissal of the trademark infringement and passing-off case filed by shoe-maker Christian Louboutin, held that Order XII Rule 6 CPC, gave the Court the power as well as the discretion to dismiss a suit in the absence of a valid cause of action.

- The Court also observed that the case of *Bright enterprises Private Ltd.* relied upon by the Plaintiff wasn't relevant as the issue relied upon the ingredient of "real prospect" contained in Order XIII A CPC, which can be invoked only by the defendant, *after* the defendant is served the summons of the suit. In the present case, the court does not proceed under Order XIII A CPC but rather under Order XII Rule 6 CPC.
  
- The Court further held that provision 2(zb) made it evident that a 'mark' was used in the context of the expression 'combination of colors'. Hence 'combination of colors' was a *sine qua non*. Thus, the court claimed that a single color, being absolutely different when compared to a combination of colors, didn't fall under the purview of 'mark' at all.
  
- The Delhi HC held that-
  - a) The use of Single color by the plaintiff cannot be considered as a trademark in respect of provisions of Sections 2(m) and 2(zb) of the Trade Marks Act.
  - b) *The Court held that the benefit of the Proviso to Section 9(1) of the Trade Marks Act read with Section 32 of the Trade Marks Act would be available to the Plaintiff only the red colour which the Plaintiff claims to be the exclusive owner of, is at all capable of being a mark.*



## **CONCLUSION**

The Court in the instant case, observed that no doubt the plaintiff by virtue of Proviso of Section 9(1) and Section 32 of the Trade Marks Act can claim to have become owner of the trademark having the red colour applied to the soles of its shoes, yet even if the plaintiff is the owner of such trademark being a single colour red applied to soles of ladies footwear, then because of and by virtue of Section 30(2)(a) of the Trade Marks Act, other manufacturers or sellers are not prohibited from using the colour red on their goods/shoes/footwear if the colour is serving a **non-trademark function** i.e colour is a feature of the product or goods. In the present case colouring of the soles of the footwear by the defendants as red is a feature of the Defendant's products inasmuch as the defendants to sell their footwear are using a word mark trademark being "VERONICA". The colour red applied by the defendants to the soles of their footwear being sold, adds to the appeal or the looks of the products, and therefore such a feature which is not used as a trademark will not entitle the plaintiff to seek injunction against user of such feature of the products by the defendants simply on the ground that the plaintiff is the owner of the trademark red colour shade applied to the soles of the ladies footwear being sold by the plaintiff.

**-DISCLAIMER-**

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