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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

***Reserved on: 31.05.2023***

***Pronounced on: 03.07.2023***

+ CS(COMM) 115/2023, I.A. 4235/2023 (Order XXXIX Rules 1 and 2 of the CPC) and I.A. 9493/2023 (Section 151 of the CPC)

**ZYDUS WELLNESS PRODUCTS LIMITED** ..... Plaintiff  
Through: Mr. Chander M. Lall, Sr. Advocate, Mr. Vanshika Arora, Ms. Ananya Chugh, Ms. Anuradha Salhotra, Mr. Sumit Wadhwa and Mr. Ayush Samaddar, Advs.

versus

**CIPLA HEALTH LTD & ANR.** ..... Defendants  
Through: Mr. Amit Sibal, Sr. Advocate with Ms. Archana Sahadeva, Ms. Brinda Nagaraja, Ms. Anjuri Saxena, Mr. Siddharth Raj Choudhary, Mr. Rishabh Sharma and Mr. Saksham Dhingra, Advs. for D-1

**CORAM:  
HON'BLE MR. JUSTICE C. HARI SHANKAR**

### **J U D G M E N T**

% **03.07.2023**

**I.A. 4235/2023 (Order XXXIX Rules 1 and 2 of the CPC)**

**The *lis***

1. This suit, at the instance of Zydus Wellness Products Ltd (“Zydus”) is directed against the following products of Defendant 1 Cipla Healthcare Ltd (“Cipla”):



The products in question are powders combining glucose and Vitamin C, or Vitamin D, to be mixed with water and consumed as an energy drink.

2. The plaintiff manufactures and sells the following product, combining Glucose and Vitamin D:



3. Zydus and Cipla, being the main *dramatis personae*, would be referred to by the epithets “plaintiff” and “defendants” (since Allozen Pharma Pvt. Ltd., as Defendant 2, is a distributor of Cipla) is also respectively.



4. The plaintiff alleges that
  - (i) the marks “GLUCO-C” and “GLUCO-D” are deceptively similar to the plaintiff’s registered trade marks “GLUCON-C” and “GLUCON-D”,
  - (ii) the trade dress adopted by the defendant infringes the copyright of the plaintiff in the trade dress of its “GLUCON-D”,
  - (iii) the trade dress of the defendant’s product is, even otherwise, so similar to the trade dress of the plaintiff’s product as to exacerbate the possibility of confusion and deception for the purposes of Section 29(2)(b)<sup>1</sup> of the Trade Marks Act, 1999 and
  - (iv) the defendant is also, thereby, seeking to pass off its products as those of the plaintiff.
  
5. The plaintiff is the proprietor of, *inter alia*,
  - (i) the word mark “GLUCON-D”
    - (a) in Class 30, for glucose, flour and preparations made from cereals, bread, biscuits, pastry and confectionery, milk chocolate,

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<sup>1</sup> 29. Infringement of registered trade mark. –

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(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.



- (b) in Class 29, for dried milk and preparations containing dried milk not being infants and invalid foods, dried or preserved foods edible oils and fats and
- (c) in Class 32 for mineral and aerated waters and other non-alcoholic drinks, syrups and other preparations for making beverages,
- (ii) the word mark “GLUCON-C”, in Class 30 for glucose, flour and preparations made from cereals, bread, biscuits, pastry and confectionery, milk chocolate,
- (iii) the earlier “GLUCON-D” pack as a device mark in Class 30 for glucose, flour and preparations made from cereals, bread, biscuits, pastry and confectionery, milk chocolate, and



- (iv) the “GLUCON-D” Tangy Orange pack as a device mark in Class 30 for glucose based beverage mix being glucose for food included in Class 30.

## 6. Applications by the petitioner for registration of the labels



and



as device marks are pending with the

Registrar of Trade Marks.



7. Prior to adopting the new labels for its “GLUCON-D”, the plaintiff was using the following packing, which, as already noted, stands registered as a device mark in the plaintiff’s favour:



8. The defendant’s mark is not registered either as a word mark or as a device mark.

9. This is the factual backdrop in which the present dispute arises. On facts, there is no dispute. One may, therefore, proceed directly to the rival contentions of learned Counsel for the parties, as contained in the pleadings and as urged by learned Senior Counsel before me.

### **Rival Contentions**

#### **Submissions of Mr. Chander M. Lall, learned Senior Counsel for the plaintiff**

10. Mr. Lall submits that, despite the overall design of the “GLUCON-D” pack having changed from time to time, certain essential features, like the overall colour combination, the inverted white triangle in which “GLUCON -D” is written, the contents of the





product being reflected at the lower edge of the pack and the picture of a happy family consisting a husband, wife and child, prominently figuring on the pack, have remained unchanged. Certain new features have now been introduced, like a slanted side panel with the words



“Instant Energy” written on it ( ) and the use of a motif of two batteries to reflect the instantly energizing effect of the drink at the



rear of the pack ( ). These features, too, submits Mr. Lall, have been duplicated by the defendant in its “Gluko-C ++” product. Mr. Lall emphasizes the following infringing/deceptively similar features:

- (i) “Gluko-D” is visually, phonetically, and otherwise deceptively similar to “GLUCON-D”. The defendant has merely deleted an “N”. Even the hyphen between “Gluko/Glucon” and “D” has been replicated.
- (ii) The defendants have also adopted the feature of a vertical slanting indented edge with the words “INSTANT ENERGY” on a yellow background.
- (iii) The “two batteries” device motif, to reflect the comparison between the energy intake comparison between the plaintiff’s product and an ordinary drink, has also been copied.



The manner in which the plaintiff and defendant use the motif are as under:

Plaintiff's Glucon-D	Defendant's Gluco-C ++
	

(iv) Alongside the batteries motif, the plaintiff prints “For Instant Energy GLUCON-D”, whereas the defendant prints “For Instant Energy Gluco-C ++”.

(v) The defendant has copied the green colour scheme for the regular, and the orange colour scheme for the orange, variants of their respective products.

(vi) The defendant has copied the words “Tangy Orange” for the orange variant of its product, just like the plaintiff.

**11.** Mr. Lall submits that the plaintiff is a market leader in the energy drink product range, with its GLUCON-D Tangy Orange commanding 74% of the market. GLUCON-D Tangy Orange is, therefore, the market leader in the orange glucose powder category. The mark “GLUCON-D” has, therefore, become a source identifier for the plaintiff.



**12.** Mr. Lall submits that the defendant was marketing its product under the mark “Prolyte” and has, with clear *mala fide* intent, now started using “Gluko C ++” and “Gluko D ++” alongside “Prolyte”, so that the brand name now reads “Prolyte Gluko C ++” and “Prolyte Gluko D ++”, with the intent of creating confusion in the mind of the customer into believing an association between the defendant’s and the plaintiff’s products. The impugned product of the defendant, he submits, is not available online either on Amazon or Flipkart. He submits that, on giving a search thread “Gluko-D” on Amazon, the only product, other than the plaintiff’s, which is thrown up as a search result is Dabur’s “GLUCOPLUS C”. Similarly, if one were to search using “Cipla Gluko-D”, the earlier “Prolyte” product of the defendant is displayed. A Flipkart search of “Cipla Gluko-D”, too, does not throw up the defendant’s impugned product. Similar is the result on the “1mg” and Pharmeasy websites. Clearly, therefore, submits Mr. Lall, the defendants are merely testing the waters, creating, in the process, rampant confusion. The impugned products are, Mr. Lall submits, not even reflected on the defendants’ own website, which



merely shows the product .

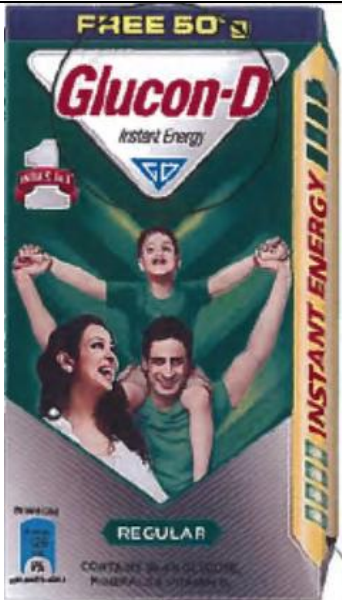

**13.** Mr. Lall submits that, in devising the trade dress for its product, the defendants has lifted, from the plaintiff’s trade dress, (i) the distinctive side panel, and (ii) the “two battery” motif, and has adopted an overall similar packing. He emphasizes the majority market share







that his client holds, to contend that the defendants' intent was merely to capitalize on the plaintiff's reputation. The shape of the plaintiff's pack, and its overall get up, he submits, are exclusively associated with the plaintiff.

**14.** Mr. Lall submits that "GlucO-D" is structurally and phonetically similar to "GLUCON-D", the only difference being the absence of the "N". The overall trade dress of the two products is also, in his submission, deceptively similar. He has drawn my attention to para 1 of the plaint, which sets out the features of similarity between the two products thus:

Plaintiff's GLUCON-D	Defendants' GLUCO-D
1. The Defendants have dishonestly adopted the mark GLUCO-D, which is virtually identical to the Plaintiff's well-known mark which is virtually identical to the Plaintiff's well-known mark GLUCON-D. In fact, the Defendants have only deleted the alphabet "N". The Defendants are even copied the hyphen like the Plaintiffs places between GLUCON and D.	
	
2. The Defendants have also copied and indented packaging wherein on the vertical edge of the packaging there is a slight indentation and on a yellow background, the words INSTANT ENERGY is written in a prominent and bold manner.	



	
<ol style="list-style-type: none"> <li>1. The Plaintiff's product uses a device of two batteries placed within glasses, with varying degrees of charge, to show a comparison of the product <i>vis-à-vis</i> an Ordinary Drink. The Defendants make use of an almost identical device of batteries to show a similar comparison.</li> <li>2. The Defendants have also copied wordings on packaging such as "For Instant Energy, GLUCON-D" versus "For Instant Energy GLUCO-D ++".</li> </ol>	

**15.** Mr. Lall points out that the defendants have admitted that, in its brand name, (i) "Gluko" is an abbreviation of "Glucose", (ii) "D" and "C" referred to Vitamin D and Vitamin C respectively and (iii) "++" is used to refer to the additional ingredients Calcium and flavour. Mr. Lall submits that, if the defendants were, in any case, using two "+" signs to denote the presence of additional ingredients, there was no justification for using the hyphenated "-D" and "-C" suffixes. This, he submits, could only be to create confusion with the plaintiff's registered trademark.

**16.** Mr. Lall emphasises the contention of the defendants that, in their brand name, "Gluco-D" is only used as a product identifier, and not as a trademark.



17. As the sales of the defendants' products have commenced only in December 2022, the balance of convenience would also, submits Mr. Lall, be in favour of grant of injunction as sought by the plaintiff, pending disposal of the suit. Though the defendants have asserted, in their reply to IA 4235/2023, that it had launched, and has been marketing, "Prolyte Gluco-C ++" and "Prolyte Gluco-D++" since May 2022, Mr. Lall submits that the contention is belied by the invoices that the defendants have chosen to place on record in support thereof, which reflect sales only of the "Prolyte Gluco-C" and "Prolyte Gluco-D" products.

18. Mr. Lall further submits that, though the plaintiff has discontinued manufacture and sale of GLUCON-C, the residual goodwill that remains in the brand is also entitled to protection, for which purpose he cites the judgment of this Court in *Saga Life Sciences v. Aristo Pharmaceutical Pvt. Ltd.*<sup>2</sup>. He submits that, further, the registration held by the plaintiff in the mark "GLUCON-C" continues, and has not been abandoned.

19. Mr. Lall has placed reliance on

- (i) paras 9, 15, 16, 19 and 22 of *Corn Products Refining Co. v. Shangrila Food Products Ltd*<sup>3</sup>
- (ii) *Kaviraj Pt Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories*<sup>4</sup>
- (iii) para 6 of *Amrithdhara Pharmacy v. Satya Deo Gupta*<sup>5</sup>

<sup>2</sup> 290 (2022) DLT 689

<sup>3</sup> AIR 1960 SC 142

<sup>4</sup> AIR 1965 SC 980

<sup>5</sup> AIR 1963 SC 449



- (iv) *K.R. Krishna Chettiar v. Shri Ambal & Co.*<sup>6</sup>,
- (v) para 4 of *Ruston & Hornsby Ltd v. Zamindara Engineering Co.*<sup>7</sup>,
- (vi) para 4 of *Parle Products (P) Ltd v. J.P. & Co.*<sup>8</sup>,
- (vii) para 55 of *Nature's Essence Pvt Ltd v. Protogreen Retail Solutions Pvt Ltd*<sup>9</sup>,
- (viii) *Marico Ltd v. Agro Tech Foods Ltd*<sup>10</sup>,
- (ix) para 49 of *Moonshine Technology Pvt Ltd v. Tictok Still Games Pvt Ltd*<sup>11</sup>,
- (x) para 77 of *Intercontinental Great Brands v. Parle Product Pvt Ltd*<sup>12</sup> and
- (xi) para-67 of *Cadbury India Ltd v. Neeraj Food Products*<sup>13</sup>.

Submissions of Mr. Amit Sibal, on behalf of the defendants

**20.** A major part of the submissions of Mr. Amit Sibal, learned Senior Counsel for the defendants, concentrate on questioning the validity of the marks that the plaintiff seeks to assert. The registrations granted to the plaintiff for the marks “GLUCON-C” and “GLUCON-D”, he submits, are invalid, and the marks are liable to removed from the register of Trade Marks. He submits that the presumption of validity of a registered trade mark, that Section 31(1)<sup>14</sup>

<sup>6</sup> (1969) 2 SCC 131

<sup>7</sup> (1969) 2 SCC 727

<sup>8</sup> (1972) 1 SCC 618

<sup>9</sup> 2021 (86) PTC 225

<sup>10</sup> 174 (2010) DLT 279 (DB)

<sup>11</sup> 288 (2022) DLT 195

<sup>12</sup> 2023 SCC OnLine Del 728

<sup>13</sup> 142 (2007) DLT 724

<sup>14</sup> 31. Registration to be prima facie evidence of validity. –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent



of the Trade Marks Act confers, is merely *prima facie*, and is rebuttable. He relies, for this purpose, on Section 124<sup>15</sup> of the Trade Marks Act. All that Section 31(2) proscribes, submits Mr. Sibal, is the *holding of a registered trade mark to be invalid* on the ground that it was not registerable under Section 9. A mark which infracts clauses (a) and (b) of Section 9(1)<sup>16</sup> is, nonetheless, *prima facie* invalid, and

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assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.

(2) In all legal proceedings, as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under Section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

<sup>15</sup> 124. **Stay of proceedings where the validity of registration of the trade mark is questioned, etc. –**

(1) Where in any suit for infringement of a trade mark –  
 (a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or  
 (b) the defendant raises a defence under clause (e) of sub-section (2) of Section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark,

the court trying the suit (hereinafter referred to as the court), shall, –

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the High Court, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is *prima facie* tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

<sup>16</sup> 9. **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;  
 (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;  
 (c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,





cannot constitute the basis for a claim of injunction against the defendants. The “GLUCON-C” and “GLUCON-D” marks asserted by the plaintiff are, in Mr. Sibal’s submission, *prima facie* invalid as being disentitled to registration by virtue of clauses (a) and (b) of Section 9(1), and the plaintiff would not be entitled to the benefit of the proviso to Section 9(1) as it had applied for registration of the marks on “proposed to be used” basis. Mr Sibal cites, in his support, paras 7 to 9 and 20 of *Marico*<sup>10</sup>.

**21.** Mr. Sibal further relies on Section 30(2)(a)<sup>17</sup> and 35<sup>18</sup> of the Trade Marks Act which, he submits, are a complete defence to his client in the present case. As the marks “Gluco-C” and “Gluco-D” are purely descriptive, Mr. Sibal submits that the defendants cannot be enjoined from the use thereof. He also relies on the fact that the plaintiff has, while obtaining registration for the marks “GLUCON-C” and “GLUCON-D”, disclaimed the suffixes “C” and “D”, so that the only part of the marks which the plaintiff could assert would be “Glucon”.

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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.

**17 30. Limits on effect of registered trade mark. –**

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(2) A registered trade mark is not infringed where –

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;

**18 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.





22. Mr. Sibal relies on the judgment of the Division Bench of this Court in *Marico*<sup>10</sup> to contend that there is, in fact, no infringement of the plaintiff's "GLUCON-C" and "GLUCON-D" marks in any class in which either of the marks is registered. He emphasizes the words "if valid" employed in Section 28(1)<sup>19</sup> of the Trade Marks Act. He points out that, in para 18 of the written statement filed by way of response to the suit, the defendants have specifically pleaded that the plaintiff's marks would not be entitled to the benefit of the proviso to Section 9(1)(b) of the Trade Marks Act, as the applications for registration of the said marks were filed on "proposed to be used" basis. Mr Sibal points out that, in para G of the rejoinder in the present application, the plaintiff has admitted that it has been using the "Glucon-D" mark since 1982 and the "Glucon-C" mark in 1984, which implies that, at the time when registration of the said marks were obtained by the plaintiff, it had no user of the marks whatsoever. There could, therefore, be no question of the marks having become distinctive to the plaintiff within the meaning of the proviso to Section 9(1)(b) of the Trade Marks Act.

23. The marks "GLUCON-C" and "GLUCON-D" are, he submits, descriptive of the kind, quality and intended purpose of the products in respect of which they had been registered and were, therefore, not registerable. Based on the law enunciated in paras 24 to 29 of *Marico*<sup>10</sup>, Mr Sibal submits that no action for infringement of the "GLUCON-C" and "GLUCON-D" marks asserted by the plaintiff was

<sup>19</sup> 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



legally maintainable. Mr Sibal further relies on para 30 of *Marico*<sup>10</sup> to contend that “Glucon” being a tweaked form of “Glucose”, the plaintiff could not, by claim of exclusivity over “Glucon”, block the use of “Gluco” by the defendants.

**24.** Further relying on para 33 of *Marico*<sup>10</sup>, Mr. Sibal submits that, in proceedings under Order XXXIX of the CPC, the Court can concern itself only with the user of the marks asserted in the plaint upto the date of their registration.

**25.** When the plaintiff applied for registration of its “GLUCON-D” mark, submits Mr. Sibal, the Registry of Trade Marks objected on the ground that, in view of the pre-existing registered trademarks GLUCANIL, GLUCOTONE, GLUCOSE-D and GLUCOSE, the proposed mark of the plaintiff was “incapable of distinguishing” within the meaning of Section 9(1)(a) of the Trade Marks Act. In its response dated 22 October 1975, to the said objection, the plaintiff submitted thus:

“The mark GLUCON-D is coined from the word glucose and vitamin ‘D’ and therefore the mark is adopted to distinguish the goods of the applicants. In view of this, the mark is distinctive of the goods for which it is proposed to be used and eligible for registration under Section 9(1) of the Act.

The mark GLUCON-D is nowhere similar to the marks cited in paragraph 11 of your letter much less deceptive similar to GLUCANIL and GLUCOTONE. We would point out that there is substantial graphic and phonetic differences between GLUCON-D and the marks cited. When the marks are compared in their totality, they are not confusingly similar. The mark GLUCON-D is a hyphenated word whereas GLUCANIL and GLUCOTONE are one word. Further the initial impression given by the word GLUCON-D is that it is a product containing vitamin ‘D’ whereas the other two marks do not give the same impression.



Insofar as the marks GLUCOSE-D and GLUCOSE are concerned, we submit that these are words common to the trade and no one can have monopoly rights in such a descriptive word.”

**26.** The registrations granted to the plaintiff for its trademarks “GLUCON-C” and “GLUCON-D” were subject to the disclaimer that the plaintiff would not claim any right to exclusively user of the individual letter’s “C” and “D” thereby. Additionally, the Registry of Trade Marks objected to the application for registration of the word mark “GLUCON-D” in Class 32 on the ground that the mark was deceptively similar to the existing registered trademark “Glucomax”. Mr. Sibal points out that this letter of objection was waived by order dated 3 March 1978 passed by the Assistant Registrar of Trade Marks expressing agreement with the plaintiff’s contention that “Gluco”, in respect of a product containing glucose, was common to the trade.

**27.** Thus, submits Mr. Sibal, if “Gluco” were to be treated as common to the trade and the plaintiff had already disclaimed its rights to exclusivity for the individual letters C and D, no case for alleging infringement could be said to survive. Mr. Sibal relies on para 14 of the written statement filed by the defendants, which reads thus:

“14. From the aforesaid trademark registrations obtained by the Plaintiff for its each word marks GLUCON-D and GLUCON-C, which are presently being enforced against Defendant No. 1 herein, the following facts emerge:

- a) The Plaintiffs marks have admittedly been derived from the word GLUCOSE;
- b) That the Plaintiff’s mark GLUCON-D is coined from GLUCOSE and VITAMIN-D;



c) It is an admission of the Plaintiff's predecessor-in-interest before the Trade Marks Registry that the word **'GLUCO' is common to the trade as it has been derived from GLUCOSE**;

d) That, **Disclaimers** have been placed on **all** word Mark registrations, precluding the Plaintiff from claiming any exclusivity over the use of the letters 'D' and 'C';

e) That, prior to the Plaintiff adoption of the marks GLUCON-C and GLUCON-D, there were multiple parties in the market which had adopted and/or were you see GLUCO/GLUCOSE formative marks for products relating to GLUCOSE, as is evident from a perusal of the Examination Reports issued against the Plaintiffs word marks, which cited prior adopted GLUCO formative marks and which have been distinguished by the Plaintiff in their responses to the respective Examination Reports.

f) That, in almost all marks, even though objections under S. 9, regarding marks being not distinctive were raised, it appears that no proof of actual use was ever submitted before the Registrar till the grant of registrations, on the basis of which the registrations were granted to such a descriptive mark. The trademark registrations granted to the Plaintiffs word marks are therefore invalid, having been granted in breach of Section 9 of the Act and are thus liable to be cancelled/rectified. Defendant No. 1 reserves its right to initiate appropriate proceedings in this regard.

15. In light of the aforesaid, it is humbly submitted that filing of the present suit by the Plaintiff, inter alia seeking to restrain the Defendants from using the words GLUCO, in relation to Glucose products, is contrary to the stand adopted by the Plaintiff before the Trade Marks Registry at the time of seeking statutory rights of a descriptive words, in which the plaintiffs predecessor-in-the interest admitted to **the word GLUCO being common to the trade in respect of products containing Glucose**. The plaintiff therefore is not entitled to plead to the contrary in the present proceedings.

(Emphasis in original)

Mr. Sibal submits that the stand adopted by the plaintiff before the Trade Marks Registry constitutes evidence on record, and the plaintiff



is estopped, in law, from adopting a contrary stand in the present proceedings. He relies, for this purpose, on

- (i) paras 31, 33, 34, 38, 40 to 42 of *Vasundhara Jewellers Pvt Ltd v. Kirat Vinodbhai Jadvani*<sup>20</sup>, by a Division Bench of this Court, the SLP against which stands dismissed by the Supreme Court,
- (ii) paras 16 to 18 of *S.K. Sachdeva v. Shri Educare Ltd*<sup>21</sup>, also by a Division Bench of this Court, the SLP against which stands dismissed by the Supreme Court (with respect to this decision, Mr. Sibal submits that, in para 33 of the present plaint, the plaintiff has advanced a submission similar to that which was held by the Division Bench in that case, not to be available) and
- (iii) para 43 of the judgment, also of a Division Bench of this Court in *Raman Kawatra v. K.E.I. Industries Ltd*<sup>22</sup>.

For the proposition that the plaintiff could not claim exclusivity over “GLUCO”, Mr. Sibal cites the decision of a learned Single Judge of the High Court of Madras in *Parle Products Ltd v. Bakemans Industries Ltd*<sup>23</sup> and para 16 of the judgment of the Supreme Court in *Corn Products*.

**28.** In any event, submits Mr. Sibal, there can really be no question of any confusion between the plaintiff’s and the defendants’ marks, as the defendants’ marks are “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++”.

<sup>20</sup> 2022 SCC OnLine Del 3370

<sup>21</sup> 2016 SCC OnLine Del 473

<sup>22</sup> 296 (2022) DLT 529 (DB)

<sup>23</sup> 1998 3 LW 294





29. In the alternative, contends Mr. Sibal, even if it were to be assumed that the plaintiff's marks are valid, the defendants stand protected from any finding of infringement by Sections 30(2)(a) and 35 of the Trade Marks Act. He submits that the mark "Gluko-C ++" merely denotes the presence of glucose, vitamin C, calcium and the tangy orange flavour, with the two "+"s meant to refer to the last two ingredients. Such a mark, he submits, merely describes the characteristics and content of the product on which it is affixed and cannot be regarded as infringing, in view of the law enunciated in paras 35 and 38 of *Marico*<sup>10</sup>.

30. On the impact of disclaimers, Mr. Sibal cites the decision of a Division Bench of this Court in *Bawa Masala Co. v. Gulzari Lal Lajpat Rai*<sup>24</sup>. At the very least, submits Mr. Sibal, the plaintiff surely cannot claim the disclaimed part of its mark to be its dominant part. If, he reiterates, the disclaimed "C" and "D" were to be disregarded, the remaining part of the defendants' impugned marks, i.e. "Gluko" is admittedly descriptive in nature. He relies, in this context, on paras 5 and 6 of the judgment of the Supreme Court in *Parakh Vanijya Pvt Ltd v. Baroma Agro Product*<sup>25</sup>.

31. Having disclaimed the letter suffixes "C" and "D", Mr. Sibal submits that the plaintiff cannot include, in the asserted marks, the said suffixes, to allege infringement. He draws the attention of the Court para 33 of the plaint, which reads thus:

<sup>24</sup> 11 (1975) DLT 270

<sup>25</sup> (2018) 16 SCC 632





“33. For full disclosure, it is submitted that there exist certain third-party entities which are making use of certain GLUCO formative marks. An indicated list of the same is given below:

i) Dabur India Ltd makes use of the mark GLUCOPLUS C for and in relation to its energy drinks.

ii) Tata Sons Pvt Ltd have adopted and used the mark



for and in relation to energy drinks.

However, it is clarified that whilst there are third-party is using the marks that comprise of the word GLUCO, the manner of presentation adopted by the first Defendant by using the suffix “-D” and “-C” to the mark GLUCO makes it virtually identical to the Plaintiff’s mark GLUCON-D and GLUCON-C. The Plaintiff reserves its right to take action against third parties, including those mentioned above.”

The right that the plaintiff seeks to reserve for itself, in the concluding passage of the above extracted para 33 of the plaint, submits Mr. Sibal, is not available to the plaintiff for reservation, as the plaintiff has consciously and expressly disclaims exclusivity in respect of the “-C” and “-D” suffixes in its marks.

**32.** Mr. Sibal proceeds, thereafter, to address on the allegation of passing off.

**33.** Insofar as the rival word marks are concerned, Mr. Sibal submits that the initial “Prolyte” part of the defendants marks sufficiently distinguish them from the marks of the plaintiff.

**34.** Without prejudice, Mr. Sibal submits that, in the case of a descriptive word mark, the onus is on the plaintiff alleging passing off



to prove acquisition of distinctiveness, by the asserted marks, by dint of use. That, he submits, is an aspect which is required to be relegated to trial, and on which the Court cannot conceivably return a finding at the Order XXXIX stage. He relies, for this purpose, on para 70 of the decision of this Bench in *Phonepe Pvt Ltd v. Ezy Services*<sup>26</sup> and para-30 of the decision of a coordinate Single Bench of this Court in *Red Bull AG v. PepsiCo India Holdings Pvt Ltd*<sup>27</sup>, as well as the judgment of the Supreme Court in *J.R. Kapoor v. Mirconix India*<sup>28</sup>.

35. In any event, submits Mr. Sibal, as the defendant's name ("Cipla Healthcare") is prominently visible on the face of the pack of the impugned product, there is no chance of a customer purchasing the defendants' product believing it to be the plaintiffs.

36. No passing off, it is submitted, can be alleged by the plaintiff in respect of "GLUCON-C" as the plaintiff has ceased manufacture and sale of the product in 1990, and there is no evidence of any residual goodwill vesting in the mark. Similarly, the mark "Glucon-C ImmunoFizz" was registered, on proposed to be used basis, w.e.f. 19 October 2020, and was discontinued in December 2020. In any event, all the marks asserted by the plaintiff are totally dissimilar to the defendants' "Prolyte Gluco-C ++" and "Prolyte Gluco-D ++".

38. Insofar as the alleged similarity in trade dress is being cited as a basis to contend that the defendants are passing off their product as the plaintiff's, Mr. Sibal submits that, to sustain such an allegation, the

<sup>26</sup> 2021 (86) PTC 437

<sup>27</sup> 290 (2022) DLT 673

<sup>28</sup> 1994 Supp (3) SCC 215



plaintiff would have to establish the existence of goodwill and reputation *in the asserted trade dress*. He relies, for this purpose, on paras 10, 14 to 16 and 18 of *Britannia Industries Ltd v. ITC Ltd*<sup>29</sup>, rendered by a Division Bench of this Court. Far from there being any evidence of reputation or goodwill in the trade dress presently being used by the plaintiff, Mr. Sibal submits that there is no evidence even of commercial user of the said trade dress. The plaintiff has placed, on record, he points out, one solitary invoice. Further, the application dated 22 February 2023 (10 days prior to the filing of the present suit), filed by the plaintiff for registration of the GLUCON-D trade dress being presently used by it claims user of the trade dress since 9 February 2018. No affidavit or supporting documents, evidencing said user have, however, been filed with the application, despite the mandate of Rule 25<sup>30</sup> of the Trade Marks Rules, 2017. The sole invoice filed by the plaintiff does not reflect the present trade dress. There is, moreover, no submission forthcoming, from the plaintiff, that the present GLUCON-D trade dress has acquired goodwill or reputation. Mr. Sibal also took me through the documents of user filed with the present suit, which, too, he submits, do not evidence user of the present trade dress w.e.f. 2018. He submits that certain advertisements, in magazines, filed by the plaintiff at S. No. 30 of the documents filed with the plaint, do not reflect the asserted trade dress. Similarly, certain additional documents were filed by the plaintiff

<sup>29</sup> 240 (2017) DLT 156 (DB)

<sup>30</sup> 25. **Statement of user in applications.—**

- (1) An application to register a trade mark shall, unless the trade mark is proposed to be used, contain a statement of the period during which, and the person by whom it has been used in respect of all the goods or services mentioned in the application.
- (2) In case, the use of the trade mark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use along with supporting documents.



under an Index dated 17 March 2023, S. No. 14 of which is a Compact Disc containing advertisements for the plaintiff's products bearing the marks "GLUCON-D" and "GLUCON-C", but there is no embedded date in the CD, and the date has been superficially added by the plaintiff. User of 2018 cannot, therefore, be established even on the basis of these documents. At the very least, the actual date to which the documents pertaining would be a matter to be decided consequent on trial. The sole document which might be said to reflect the date of 2018 is the following advertisement in the Ranchi edition of the *Dainik Jagran* of 1 April 2018:



One swallow, Mr. Sibal would seek to submit, cannot make a summer, and the above lone advertisement from the 1 April 2018 Ranchi edition of the *Dainik Jagran* cannot indicate extensive use of the asserted trade dress by the plaintiff since 2018. The plaintiff has



produced sales figures of its products, but Mr. Sibal submits that all the figures cannot be attributed to the asserted product or the asserted trade dress. Given these facts, Mr. Sibal submits that the aspect of whether the asserted trade dress commands the requisite reputation and goodwill would, at the very least, be a matter of trial.

**39.** Assuming, for the sake of argument, that the asserted trade dress did have the requisite reputation and goodwill, Mr. Sibal submits that the trade dress of his client's product and that of the plaintiffs "GLUCON-D" are completely dissimilar. Among the features which mark out the two trade dresses as being unlike to each other are, he submits, the "inverted triangle" motif used by the plaintiff, *vis-à-vis* the "lightning" motif of the defendants and the presence, prominently on the face of the pack, of the house mark of the defendants, which is completely absent on the "GLUCON-D" pack of the plaintiff. In this context, Mr. Sibal invites attention to para 14 of the plaint, which reads as under:

"14. Somewhere around 2009, the Plaintiff's predecessor in interest changed the packaging of its additional flavours being Tangy Orange and Nimbu Paani, which were sold over and above its Original flavour. The said flavours were thereafter sold in a slightly modified packaging but retain all the essential features of the original packaging used at least since 1980 such as the Inverted Triangle, Device of 'Happy Family' and the depiction of the descriptions below the pack."

None of the three features thus identified by the plaintiff as the "essential features" of its pack, namely the Inverted Triangle, the 'Happy Family' device and the depiction of descriptions below the pack, submits Mr. Sibal, figure in the impugned pack of the



defendants. Clearly, therefore, the two packs cannot be said to be similar, much less confusingly similar.

**40.** Mr. Sibal, thereafter, refers to paras 16 and 19 of the plaint, which seek to identify the “unique indentation along the vertical edge of the rectangular cuboid with the words INSTANT ENERGY-written on the indentation”, the “distinctive colour combination for the Regular and Tangy Orange flavours” and “the image of the batteries used to depict a comparison between GLUCON-D and ordinary sucrose-based drinks” as additional essential features of the plaintiff’s packaging. Apropos these features, Mr. Sibal draws attention to the following assertions contained in the written statement filed by his clients by way of response to the plaint:

“23. That even the Plaintiff’s assertion with respect to the colour of the packs being similar falls flat owing to the following reasons:

a) That the use of the colour orange or descriptors such as ‘*Tangy Orange*’ to depict that the product contains orange flavour is neither new nor original. The use of the colour orange at descriptors to denote the presence of the orange flavour in a particular product has been employed by companies worldwide, including those of Defendant No. 1 and its parent company and is not the plaintiff’s original creation. Illustrative images of other products, across industries, which used the colour orange an identical or similar descriptors in order to convey to its customer that the product is orange flavoured are as under:

USE OF THE COLOUR ORANGE & DESCRIPTORS TO DENOTE PRESENCE OF ORANGE
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<p>DEFENDANT'S &amp; DEFENDANT'S PARENT COMPANY'S OTHER PRODUCTS DEPICTING THE ORANGE FLAVOUR AS 'TANGY ORANGE'</p>		
		
		
<p>USE OF COLOUR ORANGE ACROSS PRODUCTS TO INDICATE PRESENCE OF ORANGE IN THE PRODUCT</p>		



b) Thus, as is amply evident from the aforesaid, the colour orange is used across industries and product





categories to denote the presence of 'orange' in a particular product to an ordinary consumer, who understands the use of the colour of the product as such and nothing more. Under no circumstances can the Plaintiff people permitted by this Hon'ble Court that the use of the colour orange by the orange flavoured pack, is associated solely with it or that it acts as a source identify. It is humbly reiterated that all consumers associate the colour orange only with the flavour of the drink and no exclusivity or monopoly can be conferred on any one party, including but not limited to the Plaintiff herein, over the use of such colour which is merely descriptive of the product and nothing more.

c) Similarly, use of the colour green to denote energy and/or charging/re-charging are standard industry practices and use of such colour by the Plaintiff is neither new nor original. Illustrative images of other products, across industries, which used the colour green in order to convey to its customer that the product increases energy, are as under:





<p align="center"><b>USE OF GREEN COLOUR ACROSS PRODUCTS INDICATING THAT THE PRODUCT IS AN ENERGY PRODUCT / ENERGISER</b></p>		



d) Without prejudice to the aforesaid, it is humbly submitted that the colours used on Defendant No 1's packs are different and distinct from the Plaintiffs packs and the same is evident from the following comparison:

DEFENDANTS' PRODUCTS	PLAINTIFF'S PRODUCTS





Similarly, submits Mr. Sibal, the words “Instant Energy” are purely descriptive of the plaintiff’s product. The indented side panel is also, he submits, common to the trade, and is a technical improvement in packing, which is referred to as the “Fifth Face” of the pack. It is for this reason, he submits, that the plaintiff has not chosen to obtain any design registration incorporating the said indentation. The use of the “battery motif”, he further submits, can make no difference, as the batteries figure on the rear, or the sides of the packs, which are sold front facing or online, in either of which case the batteries would not even be visible. These batteries, too, submits Mr. Sibal, cannot be regarded as a source identifier of the plaintiff. The use of the batteries by the defendants is purely descriptive and laudatory. He relies, for this purpose, on paras 7, 8 and 10 to 13 of the decision of a coordinate bench of this Court in *M.L. Brothers LLP v. Uma Impact Pvt Ltd*<sup>31</sup>.

**41.** Responding to Mr. Lall’s submission that the invoice dated 31 May 2022, filed by the defendants, is for sale of the “Prolyte Glucose-C Tangy Orange” and “Prolyte Glucose-D Regular” products of the

<sup>31</sup> 2023 SCC OnLine Del 1492



defendants, Mr. Sibal submits that the reference to “Glucose-C” and “Glucose-D” in the invoice is clearly a typographical error, and that the invoice in fact covered “Gluco-C” and “Gluco-D”.

**42.** “Prolyte”, submits Mr. Sibal, has been the defendants’ trademark adopted in 1958. Even prior to the impugned product, “Prolyte” figured, in a smaller font, in the defendants, ORS “Oral Rehydration Solution” product. He points out that the invoices since 31 May 2022 have been placed on record with his written statement.

**43.** The judgments on which Mr. Lall relies, submits Mr. Sibal, are all cases in which the word marks in issue were not descriptive. They cannot, therefore, assist in resolution of the dispute at hand.

**44.** Predicated on these submissions, Mr. Sibal submits that no case, for grant of any relief to the plaintiff, can be said to have been made out.

#### Submissions of Mr. Lall in rejoinder

**45.** Mr. Lall commenced his submissions, in rejoinder, with an emphatic denial of Mr. Sibal’s principal contention that the marks “GLUCON-C” and “GLUCON-D” were descriptive. He submits that, while it is correct that the marks were derived from “Glucose” and “Vitamin C”/” Vitamin D”, they were not descriptive, though they could, perhaps, be regarded as suggestive. The pleadings of both sides, he submits, indicate that the rival marks are not being used, either by the plaintiff or by the defendants, as descriptors. In the written statement, it is specifically averred by the defendants that they



are using “Prolyte Gluco-D” as a mark. The use of derivative combinations as names, he submits, is not unknown as, for example, “Dropovit” or “Whole Foods”. Suggestive word marks, he submits, are registerable under the Trade Marks Act.

**46.** Reiterating that it is an admitted position, in the written statement of the defendants, that “Prolyte Gluco-D” is used, by them, not as a descriptor, but as a mark, Mr. Lall submits, candidly, that, if the Court were to adopt the view that “Gluco-D” is a descriptor, his client has no case. The defendants, however, do not contend that their mark is “Prolyte” and that “Gluco-D” is only a descriptor. It is only during arguments that the defendants are seeking to urge, by dissecting the “Gluco-D” part of their mark, that it is descriptive, contending that “Gluco” represents “Glucose” and “D” represents “Vitamin D”. Such dissection is completely illogical, submits Mr. Lall, as the customer at the time of purchase of the product of the defendants, does not dissect its name and treat the product as a combination of glucose and vitamin D.

**47.** In any event, submits Mr. Lall, Section 32 of the Trade Marks Act provides a complete defence to the plaintiff against any attempt, by the defendants, to seek to invalidate the plaintiff’s marks. The marks asserted by the plaintiff, he points out, had been in use for over three decades, and have never been challenged till the filing of the written statement in the present case by the defendants. The marks asserted in the plaint have, to their credit, therefore, over 30 years of uninterrupted and extensive use. In the face of Section 32, therefore,



the Court, in order to hold that the plaintiff's mark was invalid – as the defendants would seek to contend – would have to return a finding that the plaintiff's marks were lacking in distinctiveness. Mr. Lall cites, in this context, para 32 to 34 of *Marico*<sup>10</sup>.

48. Relying, for the purpose, on the judgment of the Supreme Court in *Kaviraj Pt Durga Dutt Sharma*<sup>4</sup>, Mr. Lall submits that the prefix “Prolyte” is immaterial while assessing the existence, or non-existence, of infringement. Inasmuch as “Gluko-D” and “Gluko-C” are deceptively similar to “GLUCON-D” and “GLUCON-C”, Mr. Lall submits that infringement stands, *ipso facto*, committed. The defendants cannot seek to avail the benefit of Section 30(2)(a), as it is not their pleaded case that “Gluko-D” is used as a descriptor. Rather, the defendants' specific case is that they use “Prolyte Gluko-D” as a mark, thereby directly attracting the law enunciated in *Kaviraj Pt Durga Dutt Sharma*<sup>4</sup>. *Marico*<sup>10</sup> would not, therefore, come to the aid of the defendants as, in that case, “LOW ABSORB” was found to have been used, not as a trade mark, but as a descriptor of the product involving low absorb technology. That apart, Mr. Lall submits that, in view of the averments contained in para-13 of the reply filed by them to the present application, in which the defendants claim trademark rights in “Gluko”, they are estopped from contending that “Gluko” is descriptive.

49. Section 124 of the Trade Marks Act, Mr. Lall submits, would not apply, as no application under the said provision has been made by the defendants. Nor, in their pleadings, have the defendants sought to



take shelter behind Section 30(2) or Section 35 of the Trade Marks Act, obviously for the reason that it is not their pleaded case that “Gluco-D” is a descriptor. The case set up by the defendants in the pleadings is, rather, that “Gluco-D” is only a part of the overall mark “Prolyte Gluco-D ++”. Mr. Lall contradistinguishes the present case from *Marico*<sup>10</sup> on the basis of para 36 to 37 of the said decision.

**50.** In the context of these submissions, Mr. Lall has emphasised the following parts of para 7, 8 and 9 of the reply filed by the defendants to the present application:

“7. Therefore, the entire suit is premised on the assertion that Defendant No. 1 as *inter alia* adopted the marks *viz.* GLUCO-C and GLUCO-D for its energy drink variant, which purportedly infringes upon the Plaintiff’s trade mark registrations for the marks GLUCON-C and GLUCON-D.

8. However, contrary to the Plaintiff’s assertions before this Hon’ble Court, *the marks of Defendant No. 1 are not “GLUCO-C” or “GLUCO-D” but “PROLYTE GLUCO-C ++” and “PROLYTE GLUCO-D ++”,* represented as under:

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9. It is submitted that the trademark PROLYTE is the registered trademark of Defendant No. 1’s. Further, as is amply evident from the aforesaid Defendants packagings:

a) The marks used by Defendant No. 1 our PROLYTE GLUCO-C ++ and PROLYTE GLUCO-D ++. The trademark which is used predominantly by Defendant No. 1 on both its packs is PROLYTE, which is not only a registered trademark of Defendant No. 1’s parent company *viz.* Cipla Ltd, dating back to the year 1978, but is also 1 of Defendant No.1’s most established brands for its Energy Brings/Oral Rehydration Drinks (ORS). The mark PROLYTE was first adopted by Cipla Limited, the parent company of the Answering Defendant in the year 1978. Subsequently, in and around the year 2019, Defendant No. 1, under license from Cipla Limited, entered into the energy drink segment, launching multiple SKUs of ready-to-serve





energy drinks under the brand PROLYTE. Subsequently, Cipla Limited and Defendant no. 1 entered into a Business Transfer Agreement dated July 21, 2022, *vide* which the said Mark ‘PROLYTE’ was transferred to the said Defendant. Thus, as on date, all rights, title and interest in the brand PROLYTE based solely and exclusively with Defendant No. 1.

b) It is submitted that the term GLUCO has been used by Defendant No. 1 on the impugned packs, solely to indicate to the consumers/customers that the product is a Glucose powder. Therefore, the use of the mark GLUCO, which is descriptive of the product itself and has been derived from the generic name of the product, viz. Glucose, as per industry practice of deriving any element of the word Glucose and incorporating in the product brand name to identify the product, both with the content of the product as well as the purpose of which is commonly known to be used, and has been adopted *bona fide* and honestly from the product GLUCOSE, is *inter alia* protected under S. 30 of the Trade Marks Act, 1999.

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d) The use of ‘D’ and ‘C’ on the product packs indicates presence of Vitamin D and Vitamin C respectively, as is also amply evident from the description on the product packs, as identified in the aforesaid images.”

Thus, submits Mr. Lall, the defendants are seeking to claim that the “Gluco” part of “Prolyte Gluco-D ++” alone is a descriptor. Such a contention is not available under Section 30(2)(b), as the provision cannot be invoked by splitting the mark. Distinguishing the situation which obtained in *Marico*<sup>10</sup>, Mr. Lall points out that, in that case, the phrase with which the Court was concerned was “WITH LOW ABSORB TECHNOLOGY”. He cites, in this context, paras 37, 38 and 40 of the said decision. In conjunction, Mr. Lall also cites paras 1, 4, 20, 21, 26 and 27 of *Red Bull AG v. PepsiCo India Holdings Pvt Ltd*<sup>27</sup>.



51. Citing, for the purpose, paras 23, 24, 27, 28, 33, 55, 40, 45, 48 and 49 of the judgment of this Court in *Phonepe*<sup>26</sup>, Mr. Lall emphasises that the rival marks are to be considered as wholes, without breaking them up into parts. When considered as whole marks, he submits that the disclaimed “-D” and “-C” suffixes of the rival marks have also to be taken into account. Seen thus, Mr. Lall submits that the plaintiff’s and defendants’ marks are clearly deceptively similar. He relies, for this purpose, on paras 17 to 20 of *Corn Products*<sup>3</sup>.

52. Mr. Lall further submits that, having taken a stand that “Prolyte Gluco-D ++” is their trademark, the defendants cannot now claim that part of the mark as a descriptor. He relies, for this purpose, on paras 16, 24 and 25 of *PEPS Industries Pvt Ltd v. Kurlon Ltd*<sup>32</sup> and paras 37 and 38 of *Vasundhara Jewellers*<sup>20</sup>, both rendered by the same Division Bench of this Court.

53. Responding to the submission of Mr. Sibal that the plaintiff was, *vis-à-vis* the stand taken before the Trade Marks Registry while applying for registration of its “GLUCON-D” trademark, approbating and reprobating, Mr. Lall submits that, even at that stage, the plaintiff had claimed distinctiveness in respect of the mark which it was seeking to register, i.e. GLUCON-D. The further statement that “GLUCON-D” was not similar to the marks cited by the Registry as pre-existing registered marks, he further submits, cannot disentitle the

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<sup>32</sup> 295 (2022) DLT 527



plaintiff from claiming infringement of its registered trademarks by the use, by the defendants, of “Gluco-D”. The reliance, by Mr. Sibal, on *Raman Kawatra*<sup>22</sup>, he further submits, is misplaced, as the principle enunciated in para 43 of the said decision is that a party, having taken a particular stand before the Registry, to answer the Section 11 objection predicated on the defendant’s trademark cannot, in infringement proceedings, take a contrasting stand, *vis-à-vis* the same trademark of the defendants. Inasmuch as the impugned marks of the defendants were never cited as rival marks when the plaintiff applied for registration of “GLUCON-D” or “GLUCON-C”, Mr. Lall submits that the *Raman Kawatra*<sup>22</sup> principle would not apply.

**54.** Mr. Lall finally submits that the reliance, by Mr. Sibal, on the disclaimer, by the plaintiff, from claiming exclusivity in respect of the letter’s “C” and “D”, while obtaining registration of “GLUCON-C” and “GLUCON-D”, is misplaced, as, despite the disclaimer, comparison has to be made of the marks as whole marks, including the display portion. *Bawa Masala Co.*<sup>24</sup>, on which Mr. Sibal placed reliance, he points out, itself says so, in para 24.

## Analysis

### **55. A trek through the statute**

**55.1** In my opinion, it would be advantageous to address the issues raised by both sides after having, before one, a kaleidoscopic view of the legal position as it emerges from the relevant provisions of the statute and judicial authorities.



**55.2** Section 9 of the Trade Marks Act sets out absolute grounds on which registration of a trade mark can be refused. If the grounds apply, there is a complete proscription to registration, as is apparent from the use of the words “shall not” in each of the sub-sections of Section 9. Of these, we are concerned with Section 9(1)(a) and (b).

**55.3** Section 9(1)(a) disentitles a mark which is devoid of any distinctive character, i.e., which is not capable of distinguishing goods or services of one person from those of another, from registration. To the extent it is relevant, Section 9(1)(b) disentitles a mark which may serve in trade to designate the kind, quality, quantity, intended purpose or other characteristics of the goods or service from registration. Mr. Sibal’s contention is that “GLUCON-D” and “GLUCON-C”, are marks which merely describe the constituents of the product contained in the package on which they are affixed by the plaintiff i.e., Glucose and Vitamin-C/Vitamin-D. He contends that the plaintiff has candidly acknowledged this position in its response dated 27 October 1975 to the objection raised by the Registry against the application submitted by the plaintiff for registration of the mark “GLUCON-D”.

**55.4** The proviso to Section 9(1) carves out an exception from the rigour of the sub-section. It permits registration of a mark which may otherwise infract any of the clauses of Section 9(1) if, before the date of application for registration, the mark has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.



**55.5** In *Marico*<sup>10</sup>, the Division Bench of this Court held that the *terminus ad quem* fixed by the proviso to Section 9(1), of the date of application for registration, stands statutorily extended by Section 31(2) to the date of registration of the mark. In other words, if the mark, for which an application has been submitted for registration, has acquired distinctiveness or is recognised as a well-known trade mark on or before the date when the mark was registered, it would be entitled to registration, even if it otherwise infringed any of the clauses of Section 9(1).

**55.6** Sections 28 and 29 are cognate provisions. Section 28 enumerates the rights conferred by registration of a trade mark and Section 29 deals with infringement of a registered trade mark.

**55.7** Of the various sub-sections of Section 28, we are concerned only with Section 28(1). Section 28(1) starts with the words “subject to the other provisions of this Act, the registration of a trade mark shall, *if valid*...”. Mr. Sibal has stressed the use of the word “if valid” in Section 28(1) to submit that rights which enure by virtue of registration of a trade mark are subject to the registration being valid. In other words, it is only where the validity of the registration is established that a plaintiff can seek remedies premised on the registration – which would include a remedy against infringement of the mark. In other words, Mr. Sibal’s contention is that, even at the stage of arriving at a *prima facie* view regarding infringement, the court is required to satisfy itself that the mark asserted in the suit is





valid and the defendants can always raise a plea of invalidity of the mark as a defence against infringement.

**55.8** This aspect of the matter has also been considerably clarified by the Division Bench in *Marico*<sup>10</sup>. Even while accepting the proposition that the use of the words “if valid” in Section 28(1), results in the enuring, to the holder of a registered trade mark, of the rights recognised by Section 28(1), only if the registration is valid, the Division Bench has held that the purpose of inserting the words “if valid” in Section 28(1) is to protect the right of a person who desires to institute a challenge against the validity of the registered trade mark under Section 57 or Section 124.

**55.9** To that extent, therefore, Mr. Sibal’s submission that validity of the registered trade mark can be contested while defending an application for interlocutory injunction against infringement of the mark merits acceptance. At the same time, the Division Bench has clarified, in *Marico*<sup>10</sup>, that, where a written statement has been filed by way of response to a suit, Section 124(2) makes it incumbent on the defendant to raise a challenge to the validity of registered trade mark in the trade mark of the plaintiff, in the written statement. If no such challenge is raised, the defendant forfeits his right to seek the benefit of the words “if valid” in Section 28 or, consequently, the benefit of Section 124 of the Trade Marks Act. In a situation in which the application for interim injunction is being considered by the court before a written statement is filed, however, the court would have to satisfy itself that the registration of the trade mark asserted in the suit



is valid, before extending, to the proprietor of the registration, the rights conferred thereby.

**55.10** At the same time, this provision has to be read in conjunction with Section 31(1) of the Trade Marks Act. Section 31(1) specifically envisages the very fact of registration of a trade mark as being *prima facie* evidence of its validity. The use of the words “*prima facie evidence of the validity thereof*”, as employed in Section 31(1), is of stellar significance. It amounts to a statutory discharge of the initial onus which would otherwise rests with the plaintiff to prove *prima facie* validity of the registered trade mark asserted in the plaint. By operation of Section 31(1), the very fact of registration of the mark amounts to *prima facie* evidence of the validity of the mark. *In other words, the initial onus on the plaintiff, to establish prima facie validity of the mark, would stand discharged and, therefore, it would be for the defendant, who raises a challenge to the validity of the mark as one of the grounds to defend the charge of infringement, to initially satisfy the court that the asserted trade mark is not valid.*

**55.11** Section 28(1) confers, on the registered proprietor of a trade mark, the benefit of exclusivity of the mark in relation to the goods and services in respect of which it is registered and the right to protect the mark against infringement. This latter right dovetails into Section 29, which sets out the various circumstances in which one mark could be said to be infringed by another.



**55.12** Of the various sub-sections of Section 29, we are concerned, in the present case, only with Section 29(2)(b), which envisages infringement of a registered trade mark by a person who uses a mark which is similar to the registered trade mark, for goods or services which are identical or similar to the goods or services covered by the registered trade mark, in such a manner as is likely to cause confusion on the part of the public or cause the public to believe that his mark has an association with the earlier registered trade mark.

**55.13** Three conditions are, therefore, cumulatively required to be satisfied for Section 29(2)(b) to apply. They are

- (i) similarity between the mark of the defendant and the mark of the plaintiff,
- (ii) identity or similarity of the goods or services of the defendant and the goods or services covered by the registered trade mark of the plaintiff and
- (iii) resultant likelihood or confusion on the part of the public, or a belief, in the mind of the public, of an association between the marks of the defendant and the plaintiff.

**55.14** Section 30 sets out the limitations on the effect of a registered trade mark, and sub-section (2) thereof is a complete defence to any charge of infringement. In other words, even if a case falls within Section 29, and the ingredients of Section 29 stand satisfied, no charge of infringement would lie against the defendant if the defendant can pigeonhole his case into one of the clausal compartments of Section 30 (2).



**55.15** Of the various clauses of Section 30(2), we are concerned only with clause (a). Section 30(2)(a) negatives any allegation of infringement where the use of the impugned mark by the defendant indicates, *inter alia*, the kind, quality, quantity, intended purpose or other characteristics of the goods or services of the defendant. In other words, if the mark impugned in the suit is used by the defendants in a descriptive manner, i.e. as indicating, *inter alia*, the kind, quality, quantity, intended purpose or other characteristics of the goods or services of the defendant, then no allegation of infringement can lie on the basis of the use of the said mark by the defendant. The applicability of Section 29 is completely ruled out in such a case.

**55.16** It is important, at this juncture, to understand the interplay between Section 9(1)(b) and Section 30(2)(a) of the Trade Marks Act, especially as the two clauses are identically worded.

**55.17** At the cost of repetition, Section 9(1)(b) disentitles a descriptive mark to registration, unless the mark is entitled to the benefit of the proviso to Section 9(1). Section 9(1), therefore, applies to the mark of the plaintiff.

**55.18** As against this, Section 30(2) applies to the mark of the defendant. Even if the plaintiff's mark has crossed the threshold of Section 9(1), and the defendant's mark satisfies one or more of the clauses of Section 29 as would render it infringing of the mark of the plaintiff, nonetheless, Section 30(2) saves the impugned mark of the defendant from any action on the ground of infringement if the defendant uses the mark in a descriptive fashion.



**55.19** Mr. Sibal has invoked both these provisions. He has contended that the marks asserted in the suit, i.e. GLUCON-C and GLUCON-D are ineligible for registration under Section 9(1)(a) and (b), as they are merely descriptive and not-distinctive in nature. Assuming without admitting that the marks GLUCON-C and GLUCON-D are valid, he nonetheless submits that the defendants' marks "Prolyte Gluco-C ++" and "Prolyte Gluco-D ++" are entitled to the protection of Section 30(2)(b) as the words "Gluco-C ++" and "Gluco-D ++" are merely descriptive of the contents of the defendants' products, with "Gluco" representing Glucose, "C" representing Vitamin C and the two "++s" representing Calcium and the flavour of the concerned product.

**55.20** Section 31(1) has already been dealt with. Section 31(2) proscribes the declaration of a registered trade mark as invalid on the ground that it was not registerable under Section 9 if it has become distinctive by the date of registration. As has already been noticed, *Marico*<sup>10</sup> clarifies that Section 31(2) effectively extends the date by which a plaintiff is required to prove acquisition of distinctiveness from the date of application for registration [as envisaged by the proviso to Section 9(1)] to the date when registration is granted to the mark.

**55.21** If Section 30(2) is a shield available to the defendants against Section 29, Section 32 is, equally, a shield available to the plaintiff against Section 9(1). Section 32 provides that a mark which is registered in violation of Section 9(1) would, nonetheless, not be





declared invalid if, before commencement of legal proceedings challenging the validity of the registration, the mark has attained distinctiveness.

**55.22** Mr. Sibal submits that Section 32 is merely a protection against declaration of invalidity of the plaintiff's mark, if the conditions of the Section are fulfilled. It does not bar the defendants from contesting the validity of the plaintiff's mark as a defence to infringement. Nor, he would submit, does it excuse the court from examining the validity of the plaintiff's mark, if a defence in that regard is taken by the defendant in its written statement.

**56. A precedential peregrination**

**56.1** Having thus dealt with the relevant provisions of the Trade Marks Act, one may examine the judicial precedents which have spoken on the issues at hand. There are many; however, the decisions cited at the Bar are, thanks to the erudition of learned Senior Counsel who argued the matter, more than sufficient to pigeonhole the propositions that apply. I proceed, therefore, to examine the said decisions, and attempt to cull out the principles that emerge.

**56.2 *Corn Products Refining Co*<sup>3</sup>.**

**56.2.1** Shangrila Food Products Ltd. ("SFP", hereinafter) applied, on 5 November 1949, for registration of the mark "Gluvita" in respect of biscuits in class 30. Prior thereto, on 31 August 1942, the mark "Glucovita" already stood registered in clause 30 in favour of Corn



Products Refining Company (“CPR”, hereinafter) in respect of Dextrose, which was a combination of glucose and vitamins, as an ingredient in food. CPR, therefore, opposed SFP’s application for the mark “Gluvita”. The opposition was predicated on Section 8(a)<sup>33</sup> and 10(1)<sup>34</sup> of the Trade Marks Act 1940 (“the 1940 Act”). Of these, the opposition predicated on Section 10(1) was not pressed before the Supreme Court.

**56.2.2** Section 8(a) proscribed the registration of a mark which was deceptively similar to an existing mark and was, therefore, likely to cause confusion if it were registered. The Deputy Registrar of Trade Marks (the DR) disallowed the challenge of CPR predicated on Section 8(a) on the ground that the central syllable “co”, which was present in Glucovita and absent in Gluvita was sufficient to distinguish the two marks and to negative any possibility of confusion or deception.

**56.2.3** Aggrieved thereby, CPR appealed to the High Court of Bombay. Desai, J., sitting singly, allowed the appeal, holding that the marks Glucovita and Gluvita were confusingly similar to each other and that the registration of the mark Glucovita would, therefore, result in likelihood of confusion and deception. SFP appealed, thereagainst,

<sup>33</sup> **8. Prohibition of registration of certain matter.**—No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would—

- (a) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice; or
- (b) be likely to hurt the religious susceptibilities of any class of the citizens of India; or
- (c) be contrary to any law for the time being in force, or to morality.

<sup>34</sup> **10. Prohibition of registration of identical or similar trade mark.**—

- (1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or which so nearly resembles such trade mark as to be likely to deceive or cause confusion.



to a Division Bench, which reversed the decision of Desai, J., CPR, therefore, appealed to the Supreme Court.

**56.2.4** One of the grounds on which the Division Bench of the High Court negated the likelihood of confusion or deception if the marks Gluvita were to proceed to registration, was that there was no evidence that the mark Glucovita, of CPR, had acquired a reputation amongst the public. In the opinion of the Division Bench of the High Court, for confusion or deception to arise, the mark of the plaintiff was required to have a reputation amongst the public. Absent such reputation, there could be no question of confusion or deception.

**56.2.5** The Supreme Court disapproved of this view, observing that (i) there was no denial, in the counter statement filed by SFP to the assertion, in the plaint of CPR, that the mark “Gluvida” had acquired a reputation amongst the Indian public, (ii) there was ample evidence to show that CPR’s goods under the mark “Glucovita” were sold in very large quantities in retail packs which were intended for the public, (iii) CPR had spent considerable sums for advertisement of its product Glucovita in ordinary popular journals, which also indicated that it had considerable sale among the general public, (iv) an affidavit of K.M. Jamal, filed by SFP, specifically stated that a number of customers came to buy both the products Glucovita and Gluvita and (v) SFP had, therefore, succeeded in establishing that the mark Glucovita had acquired a reputation among the buying public. In this context, the Supreme Court also clarified that the reputation that was required to be acquired was of the mark of the plaintiff and not of the plaintiff



itself. A mark, it was observed, could very well command a reputation amongst the general public, who might be completely unaware of the identity of the owner or proprietor of the mark.

**56.2.6** The Supreme Court also disapproved of the observation of the DR, that there were a large number of marks in the register of Trade Mark which contained the prefix or suffix “Gluko” or “Vita”. The Supreme Court held that the “presence of a mark in a register does not prove its user at all”, as “it is possible that the mark may have been registered but not used”. As such, inference as to user of a mark could not be derived from the presence of the mark on the register.

**56.2.7** Of greatest significance, in the decision in *Corn Products*<sup>3</sup>, are the following paragraphs:

“18. We think that the view taken by Desai, J., is right. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai, J., that the marks with which this case is concerned are similar. Apart from the syllable “co” in the appellant's mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other.

19. We also agree with Desai, J., that the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. *The Aquamatic case (Harry Reynolds v. Laffeaty's Ld.)*<sup>35</sup> is a recent case where the test of the

<sup>35</sup> 1958 RPC 387



commonness of the idea between two marks was applied in deciding the question of similarity between them. Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them.

20. It was then said that the goods were not of the same description and that therefore in spite of the similarity of the two marks there would be no risk of confusion or deception. We are unable to accept this contention. It is true that we have to proceed on the basis that the goods are not of the same description for the purposes of Section 10(1) of the Act. But there is evidence that glucose is used in the manufacture of biscuits. That would establish a trade connection between the two commodities, namely, glucose manufactured by the appellant and the biscuits produced by the respondent. An average purchaser would therefore be likely to think that the respondent's 'Gluvita biscuits' were made with the appellant's 'Glucovita' glucose. This was the kind of trade connection between different goods which in the *"Black Magic" case (In re : an application by Edward Hack)*<sup>36</sup> was taken into consideration in arriving at the conclusion that there was likelihood of confusion or deception. The goods in this case were chocolates and laxatives and it was proved that laxatives were often made with chocolate coatings. We may also refer to the *"Panda" case (In re : an application by Ladislav Jellinek)*<sup>37</sup>. The goods there concerned were shoes and shoe polishes. It was observed that shoe polishes being used for shoes, there was trade connection between them and that this might lead to confusion or deception though the goods were different. The application for registration was however refused under that section of the English Act which corresponds to Section 8 of our Act on the ground that the opponents, the manufacturers of shoes, had not established a reputation for their trademark among the public.

21. It is true that in both the abovementioned cases the two competing trade marks were absolutely identical which is not the case here. But that in our opinion makes no difference. The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. *Ex hypothesi*, this latter test

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<sup>36</sup> 58 RPC 91

<sup>37</sup> 63 RPC 59





applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other just as much as it applies, as held in the “Black Magic” and “Panda” cases, where the competing marks were identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case.”

#### **56.2.8** The following principles emerge:

- (i) The question as to whether the marks of the plaintiff and the defendant were likely to cause confusion was a question of first impression.
- (ii) The question had to be decided by the court.
- (iii) English cases would not be of much use where the issue was one of phonetic similarity, as the manner in which words are pronounced in England is different from the manner in which they are pronounced in India.
- (iv) The marks had to be considered as whole marks.
- (v) Thus considered, except for the central syllable “CO”, there was no difference between the marks “Gluvida” and “Glucovita”. That central syllable “CO” was insufficient as to enable buyers to distinguish one mark from the other.
- (vi) The matter had to be examined from the point of view of a customer of average intelligence and imperfect recollection.



(vii) Infringement could also be on the basis of similarity of the idea conveyed by the two marks. The marks “Gluvita” and “Glucovita” conveyed the same idea, of glucose and the life giving properties of vitamins.

(viii) Thus viewed, a customer of average intelligence and imperfect recollection was reasonably likely to be confused between the marks “Gluvita” and “Glucovita” owing to their structural and phonetic similarity and the similarity of the idea conveyed by the two marks.

**56.2.9** Premised on the above reasoning, the Supreme Court reversed the decision of the Division Bench of the High Court of Bombay and affirmed and upheld the decision of Desai, J.

### **56.3 *Kaviraj Pt Durga Dutt Sharma*<sup>4</sup>**

**56.3.1** The mark “Navaratna Pharmaceutical Laboratories” was registered in favour of the respondent Navaratna Pharmaceutical Laboratories (NPL), under the Trade Marks Act, 1940 (“the 1940 Act”). Kaviraj Pt Durga Dutt Sharma (“Kaviraj”) applied for registration of the trademark “Navaratna Kalpa”, in respect of Ayurvedic medicinal preparations. NPL opposed the application, as a result of which the application was refused.

**56.3.2** NPL also filed Original Suit (OS) 233/1951 before the learned District Judge, Anjikaimal, for permanent injunction restraining



Kaviraj from using the mark “Navaratna”, either by itself or in combination with any other word. NPL claimed monopoly over the mark “Navaratna”, by virtue of being the registered proprietor of the trade Marks “Navaratna” and “Navaratna Pharmaceutical Laboratories”. Kaviraj’s mark “Navaratna Kalpa” and “Navaratna Pharmacy”, it was claimed, infringed the said trademarks of NPL. Additionally, it was alleged that Kaviraj was passing off its preparations as those of NPL, by use of the marks “Navaratna Kalpa” and “Navaratna Pharmacy”.

**56.3.3** The learned District Judge, adjudicating OS 233/1951, rejected the claim of passing off and also held that NPL could not claim exclusivity over the word “Navaratna”, as it was a common term in Ayurvedic phraseology. However, the right of NPL to claim exclusivity over the registered trade mark “Navaratna Pharmaceutical Laboratories” was confirmed. Consequently, an injunction was granted against Kaviraj, to the extent of use of the mark “Navaratna Pharmaceutical Laboratories”. Kaviraj appealed, thereagainst, to the Division Bench of the High Court.

**56.3.4** Kaviraj also filed, in the interregnum, Original Petition (OP) 19/1952, praying for a removal, from the Register of Trade Marks, of the mark “Navaratna”, either used by itself or as part of any other trade mark belonging to NPL.



**56.3.5** By a common judgment, the Division Bench of the High Court upheld, *in toto*, the decree of the learned District Judge in OS 233/1951 and disposed of OP 19/1952 in the same terms.

**56.3.6** Kaviraj appealed, against the said decision, to the Supreme Court.

**56.3.7** The Supreme Court first examined the aspect of entitlement of the trademark “Navaratna Pharmaceutical Laboratories” to registration, as a preliminary ground urged by Kaviraj was that the mark itself was not entitled to registration, being descriptive in nature. It may not, however, be of much use to refer to the findings of the Supreme Court in that regard, as the question was examined in the light of Section 6 of the 1940 Act, which is completely different from Section 6 of the present Trade Marks Act, and set out, in positive terms, the ingredients which were required to be present for a mark to be registerable as a trademark. In order, however, not to leave the recital incomplete, it may be noted that Kaviraj’s stand was that the mark “Navaratna Pharmaceutical Laboratories” did not contain any of the essential particulars which would entitle it to registration under Section 6(1)<sup>38</sup> of the 1940 Act. The Supreme Court, however, negated

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<sup>38</sup> 6.(1) A trade mark shall not be registered unless it contains or consists of at least one of the following essential particulars namely:-

- (a) the name of a company, individual or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) one or more invented words;
- (d) one or more words having no direct reference to the character or quality of the goods, and not being, according to its ordinary significance, a geographical name or surname or the name of a sect, caste or tribe in India;
- (e) any other distinctive mark, provided that a name, signature, or any word, other than such as fall within the description in the above clauses, shall not be registerable except upon evidence of its distinctiveness.

(2) For the purposes of this section, the expression 'distinctive' means adapted, in relation to the goods in respect of which a trade mark is proposed to be registered, to distinguish goods with which the proprietor



the contention in view of the finding, of fact, of the learned District Judge, that the mark “Navaratna Pharmaceutical Laboratories” had, by dint of use, acquired distinctiveness, which had remained undisturbed at the level of the High Court.

**56.3.8** Of greater significance are the findings of the Supreme Court on the issue of deceptive similarity between the marks of Kaviraj and NPA. The issue was examined in the context of Section 21<sup>39</sup> of the 1940 Act which, though otherwise significantly different in form and structure to Section 28 of the present Trade Marks Act, may be regarded, for our purposes, to be applicable, as we are concerned essentially with the concept of “deceptive similarity”, which remains unchanged in the present Trade Marks Act.

**56.3.9** The Supreme Court held, at the outset, that there could not be “much doubt” “that the words ‘Navaratna Pharmacy’ and ‘Navaratna Pharmaceutical Laboratories’ are similar in the sense spoken of by Section 21”. More important is the manner in which the Supreme Court addressed an argument, advanced before it by Kaviraj, that there were sufficient dissimilar features, in the manner in which the

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of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

<sup>39</sup> **21. Right conferred by registration.** – Subject to the provisions of sections 22, 25 and 26, the registration of a person in the register as proprietor of a trademark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trademark in relation to those goods act, without prejudice to the generality of the foregoing provision, that right shall be deemed to be infringed by any person who, not being the proprietor of the trademark or a registered user thereof using by way of the permitted use, uses a mark identical with or so nearly resembling it is to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either –

- (a) as being used as a trademark; or
- (b) to import a reference to some person having the right either as a proprietor or is registered user to use the trademark or to goods which such a person as aforesaid is connected in the course of trade.





products of Kaviraj and NPL were packed and presented, to repel any possibility of confusion. Paras 28 and 29 of the report, which dealt with this argument, read thus:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods” (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to



deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's, mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks — the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in



ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.”

**56.3.10** Another contention urged by Kaviraj was that “Navaratna” was descriptive, and an expression in common use in Ayurveda and that, if one were to disregard, from the rival marks, “Navaratna”, the remaining part of the two marks could not be held to be deceptively similar. The Supreme Court negated the submission, holding that the entirety of the rival marks were required to be compared. The exact words used by the Supreme Court, as they figure in para 30 of the judgment, are:

“30. The mark of the respondent which he claims has been infringed by the appellant is the mark ‘Navaratna Pharmaceutical Laboratories’, and the mark of the appellant which the respondent claimed was a colourable imitation of that mark is ‘Navaratna Pharmacy’. Mr Agarwala here again stressed the fact that the ‘Navaratna’ which constituted an essential part or feature of the Registered Trade Mark was a descriptive word in common use and that if the use of this word in the appellant's mark were disregarded there would not be enough material left for holding that the appellant had used a trade mark which was deceptively similar to that of the respondent. But this proceeds, in our opinion, on ignoring that the appellant is not, as we have explained earlier, entitled to insist on a disclaimer in regard to that word by the respondent. In these circumstances, the trade mark to be compared with that used by the appellant is the entire registered mark including the word ‘Navaratna’. Even otherwise, as stated in a slightly different context:

“Where common marks are included in the trade marks to be compared or in one of them, the proper course is to look at the marks as wholes and not to disregard the parts which are common”.”



**56.3.11** To the extent they are relevant for our purpose, therefore, the following principles emerge from the decision in *Kaviraj Pt Durga Dutt Sharma*<sup>4</sup>:

(i) The principles to be applied while examining the claim of infringement, and of passing off, are different. Differences in physical appearance of the goods, or the manner in which they are packed, are of the essence while examining the claim of passing off, but have a limited role to play while examining an allegation of infringement. Infringement involves violation of the right of the registered proprietor of a trademark, to exclusive use thereof, and to protection against use of the said mark, or of a colourable imitation of the said mark, by another. The-use, by the defendant, of the trademark of the plaintiff, or of a colourable imitation of the said mark, is not essential to constitute passing off, but is the *sine qua non* for infringement to be said to exist.

(ii) In an action for infringement, where the similarity between the plaintiff's and the defendants' marks are so close that the Court reaches the conclusion that there is an imitation, the plaintiff's rights stand *ipso facto* violated. In other words, if the essential features of the plaintiff's trademark had been adopted by the defendant, marked differences in the packing and other writing or marks on the goods or on the packets in which the goods are offered, even if they were to indicate a trade origin different from that of the registered proprietor of the plaintiff's mark, would be immaterial.



(iii) The question of deceptive similarity, for the purposes of infringement, has to be examined by a comparison of the marks. The degree of resemblance necessary for possibility of deception to exist cannot be definitively prescribed by objective standards.

(iv) The resemblance may be phonetic, visual, or in the idea conveyed by the mark.

(v) What has to be examined is whether the essential features of the plaintiff's trademark are to be found in the defendants' trademark. Identification of the essential features is a question of fact, to be decided by the Court. In any event, the marks have to be compared as a whole.

(vi) In comparing the marks as a whole, parts of the marks which are common have also to be included in the comparison.

#### **56.4 *Amritdhara Pharmacy v. Satya Deo Gupta*<sup>5</sup>**

**56.4.1** Satya Deo Gupta ("Gupta", hereinafter) applied for registration of a biochemical medicinal preparation commonly known as "Lakshmandhara" in class 5 on 19 July 1950, claiming user since 1923. The application was opposed by Amritdhara Pharmacy ("AP", hereinafter), on the ground that "Amritdhara" already stood registered in favour of AP for its medicinal preparation w.e.f. 1901. Gupta





denied the allegation, stating that there was no likelihood of confusion amongst the public, between the composite words “Lakshmandhara” and “Amritdhara”. Besides the fact that the names were different, Gupta contended that the phials, label and packaging of “Lakshmandhara” were completely different from those of “Amritdhara” in appearance and otherwise.

**56.4.2** Deciding the opposition, the Registrar of Trade Marks, vide his order, allowed registration of Gupta’s mark “Lakshmandhara” only for sale in Uttar Pradesh. This decision was challenged, before the High Court of Allahabad, both by Gupta as well as by AP, with Gupta contending that he should have been allowed the right to use the mark “Lakshmandhara” throughout the territory of India and AP contending, *per contra*, that there should have been an absolute prohibition against registration of the mark “Lakshmandhara”.

**56.4.3** The High Court allowed the challenge of Gupta and rejected the challenge of AP, holding that there was no possibility of an Indian confusing the ideas conveyed by the words “Amritdhara” and “Lakshmandhara”, inasmuch as “Amrit”, “Dhara” and “Lakshman” were all commonly used Hindi words, with “Amritdhara” meaning “current of nectar” or “flow of nectar” and “Lakshmandhara” being “current or flow of Lakshman”. Further, held the High Court, words of common usage such as “Amrit” and “Dhara” could not be permitted to be monopolized by anyone. No reason for rejecting the request for registration of the mark “Lakshmandhara”, therefore, existed, in the opinion of the High Court.



**56.4.4** The matter was examined by the Supreme Court in the context of Sections 8 and 10(1) and (2) of the 1940 Act.

**56.4.5** The Supreme Court proceeded to decide the matter thus:

“6. It will be noticed that *the words used in the sections and relevant for our purpose are “likely to deceive or cause confusion”*. The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion. On an application to register, the Registrar or an opponent may object that the trade mark is not registrable by reason of clause (a) of Section 8, or sub-section (I) of Section 10, as in this case. In such a case *the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not likely to deceive or cause confusion*. In cases in which the tribunal considers that there is doubt as to whether deception is likely, the application should be refused. A trade mark is likely to deceive or cause confusion by its resemblance to another already on the Register if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders in that market. In considering the matter, all the circumstances of the case must be considered. As was observed by Parker, J., in *Pianotist Co Application*<sup>40</sup> which was also a case of the comparison of two words:

*“You must take the two words. You must judge them, both by their look and by their sound. You consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”*

*For deceptive resemblance two important questions are: (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is*

<sup>40</sup> (1906) 23 RPC 774



*perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection. (See Kerly on Trade Marks, 8th Edition, p. 400.)*

7. Let us apply these tests to the facts of the case under our consideration. *It is not disputed before us that the two names “Amritdhara” and “Lakshman-dhara” are in use in respect of the same description of goods, namely a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townsfolk, literate as well as illiterate. As we said in **Corn Products Refining Co.**<sup>3</sup> the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity-of the two names “Amritdhara” and “Lakshmandhara” is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words “Amritdhara” and “Lakshmandhara”. We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as “current of nectar” or “current of Lakshman”. He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between “current of nectar” and “current of Lakshman”. “Current of Lakshman” in a literal sense has no meaning; to give it meaning one must further make the inference that the “current or stream” is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him; but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between “Amritdhara” and “Lakshmandhara”. He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments.*



8. *We agree that the use of the word “dhara” which literally means “current or stream” is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, “fools or idiots”, may be deceived. A critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing-the whole word has to be considered. In the case of the application to register “Erectiks” (opposed by the proprietors of the trade mark “Erector”) Farwell, J., said in **William Bailey (Birmingham) Ltd. Application**<sup>41</sup>:*

*“I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole.... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word.”*

9. *Nor do we think that the High Court was right in thinking that the appellant was claiming a monopoly in the common Hindi word “dhara”. We do not think that that is quite the position here. What the appellant is claiming is its right under Section 21 of the Act, the exclusive right to the use of its trade mark, and to oppose the registration of a trade mark which so nearly resembles its trade mark that it is likely to deceive or cause confusion.*

10. A large number of decisions relating to the use of composite words, such as Night Cap and Red Cap, Limit and Summit, Rito and Lito, Motrate and Filtrate etc. were cited in the High Court. Some more have been cited before us. Such decisions, examples of deceptive resemblance arising out of contrasted words, have been summarised at p. 429-34 in Kerly on Trade Marks. No useful purpose will be served by referring to them all. As we have said earlier, *each case must be decided on its own facts. What degree of resemblance is necessary to deceive or cause confusion must in the nature of things be incapable of definition a priori.*

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<sup>41</sup> (1935) 52 RPC 137





11. As to the decisions in Annexure 'A', it has been argued before us that they were not at all admissible by reason of Sections 40 to 43 of the Indian Evidence Act, 1872. On behalf of the appellant it has been contended that they were admissible under Section 13 of the Evidence Act as showing the particular instances in which the appellant claimed its right under Section 21 of the Act. We consider it unnecessary to decide this question for the purposes of this case, because those decisions even if they are admissible under Section 13 do not throw any light on the question whether "Amritdhara" and "Lakshmandhara" so nearly resemble each other as to cause deception or confusion. That is a question which we must determine as a case of first impression and irrespective of the earlier decisions.

12. *On a consideration of all the circumstances, we have come to the conclusion that the overall similarity between the two names in respect of the same description of goods was likely to cause deception or confusion within the meaning of Section 10(I) of the Act and the Registrar was right in the view he expressed. The High Court was in error in taking a contrary view.*

13. We now go to the second question, that of acquiescence. Here again we are in agreement with the Registrar of Trade Marks, who in a paragraph of his order quoted earlier in this judgment has summarised the facts and circumstances on which the plea of acquiescence was based. The matter has been put thus in Halsbury's Laws of England, Vol. 32, 2nd Edition) p. 656-57, para 966.

*"If a trader allows another person who is acting in good faith to build up a reputation under a trade name or mark to which he has rights, he may lose his right to complain, and may even be debarred from himself using such name or mark. But even long user by another, if fraudulent, does not affect the plaintiff's right to a final injunction; on the other hand prompt warning or action before the defendant has built up any goodwill may materially assist the plaintiff's case."*

We do not think that there was any fraudulent user by the respondent of his trade name "Lakshmandhara". The name was first used in 1923 in a small way in Uttar Pradesh. Later it was more extensively used and in the same journals the two trade marks were publicised. The finding of the Registrar is that the appellant and its agents were well aware of the advertisements of the respondent, and the appellant stood by and allowed the respondent to develop





his business till it grew from a small beginning in 1923 to an annual turnover of Rs 43,000 in 1949. These circumstances establish the plea of acquiescence and bring the case within sub-section (2) of Section 10, and in view of the admission made on behalf of the respondent that his goods were sold mainly in Uttar Pradesh, the Registrar was right in imposing the limitation which he imposed.’ ”

(Emphasis Supplied)

**56.4.6** From the decision in *Amritdhara Pharmacy*<sup>5</sup>, the following principles emerge:

(i) The issue of likelihood of deception or causing of confusion depends on the facts and circumstances of every case. Precedents are of value only in respect of tests to be applied, and not on facts.

(ii) The onus of proof, to establish that a mark, the registration of which was sought, was not likely to deceive or cause confusion, was on the applicant, seeking registration of the mark.

(iii) A trade mark is likely to deceive or cause confusion by resemblance to an earlier registered mark if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders.

(iv) The court is required to take into consideration all circumstances of the case before arriving at a conclusion regarding likelihood of deception or confusion.



(v) In the case of word marks, the *Pianotist*<sup>40</sup> test has to be applied.

(vi) The two important questions to be addressed are

- (a) the persons likely to be deceived and
- (b) the rules of comparison to be applied.

(vii) “Confusion” refers to the state of mind of a customer who, on seeing the defendant’s mark, thinks that it differs from the plaintiff’s mark on goods which he has previously bought but is doubtful whether the impression is not due to imperfect recollection.

(viii) The matter has to be examined from the point of view of a customer of average intelligence and imperfect recollection.

(ix) Such a customer is not likely to split a composite mark into its constituent part or go by the etymological significance of the mark.

(x) The suffix “dhara” was not decisive of the issue whether the marks “Amritdhara” and “Lakshmandhara” were, or were not, confusingly or deceptively similar.

(xi) That said, if one were to compare “Amritdhara” and “Lakshmandhara”, keeping in mind the fact that the customer of average intelligence and imperfect recollection would not split the names, or go by the etymological connotation of the words



“Amritdhara” and “Lakshmandhara”, the marks were confusingly similar, as a customer who first purchased Amritdhara and, at a later point of time, purchased Lakshmandhara, was likely at the least to have a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name.

(xii) By so holding, the court was not granting AP a monopoly over the suffix “dhara”, as the two marks, seen as whole marks, were found to be confusingly or deceptively similar.

**56.4.7** In view of the aforesaid, the Supreme Court allowed the appeal, of AP, set aside the order of the High Court and restored the decision of the Registrar of Trade Marks.

### **56.5 *K.R. Krishna Chettiar*<sup>6</sup>**

**56.5.1** K.R. Krishna Chettiar (KRKC) applied, on 10 March 1958, for registration of a device mark in respect of snuff, which was opposed by Shri Ambal and Company (SAC), on the ground that a similar mark, in respect of snuff, already stood registered in its favour. The nature of two marks is apparent from the opening paragraphs 1 and 2 of the judgment which may be reproduced thus:

“1. The appellant is the sole proprietor of a trading concern known as Radha and Co., The respondents Ambal & Co., are a partnership firm. The respondents as also the appellant are manufacturers and dealers in snuff carrying on business at Madras and having business activities inside and outside the State of Madras. On March 10, 1958 the appellant filed application no. 183961 for registration of a trade mark in class 34 in respect of “snuff manufactured in Madras.” The respondents filed a notice of opposition. The main ground of opposition was that the proposed



mark was deceptively similar to their registered trade marks. The respondents were the proprietors of the registered marks nos. 126808 and 146291. Trade mark no. 126808 consists of a label containing a device of a goddess Sri Ambal seated on a globe floating on water enclosed in a circular frame with the legend "Sri Ambal parimala snuff" at the top of the label, and the name and address "Sri Ambal & Co., Madras" at the bottom. Trade mark no. 146291 consists of the expression "Sri Ambal". The mark of which the appellant seeks registration consists of a label containing three panels. The first and the third panels contain in Tamil, Devanagari, Telugu and Kannada the equivalents of the words "Sri Andal Madras Snuff". The centre panel contains the picture of goddess Sri Andal and the legend "Sri Andal".

2. Sri Andal and Sri Ambal are separate divinities. Sri Andal was a vaishnavite woman saint of, Srivilliputur village and was deified because of her union with Lord Ranganatha. Sri Ambal is the consort of Siva or Maheshwara."

**56.5.2** The Registrar of Trade Marks rejected the opposition of SAC, holding that the words "Ambal" and "Andal" were not confusingly similar. This decision was reversed by a learned Single Judge of the High Court of Madras, who held that the words "Ambal" and "Andal" had such great phonetic similarity that there was bound to be confusion between them, irrespective of the surroundings and circumstances in which the names were uttered. The decision of the Registrar was, therefore, reversed by the learned Single Judge. The judgment of the learned Single Judge was affirmed in appeal by a Division Bench of the High Court. KRKC, therefore, carried the matter to the Supreme Court.

**56.5.3** The Supreme Court decided the matter thus:

"5. Now the words "Sri Ambal" form part of trade mark no. 126808 and are the whole of trade mark no. 146291. *There can be no doubt that the word "Ambal" is an essential feature of the trade marks. The common "Sri," is the subsidiary part, of the two words*



*"Ambal" is the more distinctive and fixes itself in the recollection of an average buyer with imperfect recollection.*

6. *The vital question in issue is whether, if the appellant's mark is used in a normal and fair manner in connection with the snuff and if similarly fair and normal user is assumed of the existing registered marks, will there be such a likelihood of deception that the mark ought not to be allowed to be registered (see **In the matter of Broadhead's Application for registration of a trade mark**<sup>42</sup>). It is for the court to decide the question on a comparison of the competing marks as a whole and their distinctive and essential features. We have no doubt in our mind that if the proposed mark is used in a normal and fair manner the mark would come to be known by its distinguishing feature "Andal". There is a striking similarity and affinity of sound between the words "Andal" and "Ambal". Giving due weight to the judgment of the Registrar and bearing in mind the conclusions of the learned Single Judge and the Divisional Bench, we are satisfied that there is a real danger of confusion between the two marks.*

7. *There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye. There is a close affinity of sound between Ambal and Andal.*

8. *In the case of **Coca-Cola Co. of Canada v. Pepsi Cola Co. of Canada Ltd.**<sup>43</sup>, it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that any one would confuse the word Pepsi with coca. In the present case the word "Sri" may be regarded as in common use. The distinguishing feature of the respondent's mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.*

9. *The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device. The case of **De Cordova & Ors. v. Vick Chemical Co.**<sup>44</sup> is instructive. From the appendix printed at page 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered*

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<sup>42</sup> (1950) 57 RPC 209, 214

<sup>43</sup> 1942 59 RPC 127

<sup>44</sup> 1951 68 RPC 103





trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The appendix at p. 226 - shows that the defendants advertised their ointment as 'Karsote vapour Rub'. It was held that the defendants had infringed the registered marks. Lord Radcliffe said : ". . . a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features."

10. Mr. Sen stressed the point that the words Ambal and Andal had distinct meanings. Ambal is the consort of Lord Siva and Andal is the consort of Ranganatha. He said that in view of the distinct ideas conveyed by the two words a mere accidental phonetic resemblance could not lead to confusion. In this connection he relied on Venkateswaran's Law of Trade and Merchandise Marks, 1963 Ed., page 214, Kerly Law of Trade Marks and Trade Names, 9th Edn., p. 465, Article 852 and the decision *Application by Thomas A. Smith Ltd., to Register a trade mark*<sup>45</sup>. In that case Neville, J. held that the words "limit" and "summit" were words in common use, each conveying a distinctly definite idea; that there was no possibility of any one being deceived by the two marks; and there was no ground, for refusing registration. *Mr. Sen's argument loses sight of the realities of the case. The Hindus in the south of India may be well aware that the words Ambal and Andal represent the names of two distinct goddesses. But the respondent's customers are not confined to Hindus alone. Many of their customers are Christians, Parsees, Muslims and persons of other religious denominations. Moreover, their business is not confined to south of India. The customers who are not Hindus or who do not belong to the south of India may not know the difference between the words Andal and Ambal. The words have no direct reference to the character and quality of snuff. The customers who use the respondent's goods will have a recollection that they are known by the word Ambal. They may also have a vague recollection of the portrait of a benign goddess used in connection with the mark. They -are not likely to remember the fine distinctions between a Vaishnavite goddess and a Shivaite deity."*

(Emphasis supplied)

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<sup>45</sup> 1913 30 RPC 363



**56.5.4** From the afore-extracted passage of the decision of the Supreme Court, the following principles emerge:

- (i) “Ambal” and “Andal” are the essential parts of the marks “Shri Ambal” and “Shri Andal”.
- (ii) The question to be addressed was, therefore, whether, if both the marks were used in a fair and normal manner, there was likelihood of confusion.
- (iii) The marks were to be compared as a whole keeping in mind the distinctive and essential features thereof.
- (iv) There was such striking phonetic similarity between “Ambal” and “Andal” as to result in a real danger of confusion.
- (v) The two marks were visually completely dissimilar. The absence of visual similarity was, however, irrelevant in view of the striking phonetic similarity between “Ambal” and “Andal”.
- (vi) The copying of essential features of the plaintiff’s mark was sufficient to hold the defendants’ mark to be infringing. The fact that the pictorial devices in conjunction with which the two marks were used were different, was irrelevant in such circumstances.

## **56.6 *Ruston & Hornsby Ltd*<sup>7</sup>**



**56.6.1** Ruston & Hornsby Ltd. (“RHL”, hereinafter) was the proprietor of the trade mark “RUSTON” in respect of internal combustion engines, which it sold in India under the said mark. The respondent Zamindara Engineering Company (“ZEC”, hereinafter) was also manufacturing and selling internal combustion engines under the trade mark “Rustam”. RHL addressed a legal notice to ZEC calling upon it to desist from continuing to use the trade mark “RUSTAM” on its engines, claiming that the use of the said marks infringed the plaintiff’s registered trade mark “RUSTON”. ZEC, in reply, denied the allegations of infringement and pointed out, *inter alia*, that the mark used by the ZEC was “RUSTAM INDIA”. RHL instituted a suit against ZEC restraining ZEC from infringing the trade mark “RUSTON”. The suit was dismissed by the Additional District Judge *vide* judgment dated 3 January 1958 holding that there was no phonetic similarity between “RUSTON” and “RUSTAM”.

**56.6.2** RHL carried the matter to the High Court of Allahabad. The High Court of Allahabad *vide* judgment dated 23 November 1965, reversed the decision of the learned ADJ and restrained ZEC from using the trade mark “RUSTAM”. However, so long as the mark of the defendant was used in conjunction with India, as “RUSTAM INDIA” the High Court held that no infringement could be said to exist, as RHL’s engines were manufactured in England and ZEC’s engines were manufactured in India. As such, the High Court permitted ZEC to use the mark “RUSTAM INDIA”. RHL appealed, thereagainst, to the Supreme Court.



### 56.6.3 The Supreme Court decided the issue thus:

*"3. The distinction between an infringement action and a passing off action is important. Apart from the question as to the nature of trade mark the issue in an infringement, action is quite different from the issue in a passing off action. In a passing off action the issue is as follows:*

*"Is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods?"*

*But in an infringement action the issue is as follows:*

*"Is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trade mark"*

*4. It very often happens that although the defendant is not using the trade mark of the plaintiff, the get up of the defendant's goods may be so much like the plaintiff's that a clear case of passing off would be proved. It is on the contrary conceivable that although the defendant may be using the plaintiff's mark the get up of the defendant's goods may be so different from the get up of the plaintiff's goods and the prices also may be so different that there would be no probability of deception of the public. Nevertheless, in an action on the trade mark, that is to say, in an infringement action, an injunction would issue as soon as it is proved that the: defendant is improperly using the plaintiff's mark.*

*5. The action for infringement is a statutory right. It is dependent upon the validity of the registration and subject to other restrictions laid down in Sections. 30, 34 and 35 of the Act. On the other hand the gist of a passing off action is that A is not entitled to represent his goods as the goods of B but it is not necessary for B to prove that A did this knowingly or with any intent to deceive. It is enough that the get-up of B's goods has become distinctive of them and that there is. a probability of confusion between them and the goods of A. No. case of actual deception nor any actual damage need be proved. At common law the action was not maintainable unless there had been fraud on A's part. In equity, however, Lord Cottenham L.C. in **Millington v. Fox**<sup>46</sup> held that it was immaterial whether the defendant had been fraudulent or not in using the plaintiff's trade mark and granted an injunction accordingly. The common law courts, however, adhered to their view that fraud was necessary until the Judicature Acts, by fusing*

<sup>46</sup> 3 My & Cr 338



law and equity, gave the equitable rule the victory over the common law rule.

6. The two actions, however, are closely similar in some respects, As was observed by the Master of the Rolls in *Saville Perfumery Ltd. v. June Perfect Ltd.*<sup>47</sup>.

*"The Statute- law relating to infringement of trade marks is. based on the same fundamental idea as the law relating to passing-off. But it differs from that law in two particulars, namely (1) it is concerned only with one method of passing-off, namely, the use of a trade mark, and (2) the statutory protection is absolute in the sense that once a mark is shown to offend, the user of it cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the registered proprietor. Accordingly, in considering the question of infringement the Courts have held, and it is now expressly provided by the Trade Marks Act, 1938, Section 4, that infringement takes place not merely by exact imitation but by the use of a mark so nearly resembling the registered mark as to be likely to deceive."*

7. *In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause" confusion. But where the alleged infringement consists of using not the exact mark on the Register, but something similar to. it, the test of infringement is the same as in an action for passing off in other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions.*

8. *In the present case the High Court has found that there is a deceptive resemblance between the word "RUSTON" and the word "RUSTAM" and therefore the use of the bare word "RUSTAM" constituted infringement of the plaintiff's trade mark "RUSTON". The respondent has not brought an appeal against the judgment of the High Court on this point and it is, therefore, not open to. him to challenge that finding. If the respondent's trade mark is deceptively similar to. that of the appellant the fact that the word 'INDIA' is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark."*

(Emphasis supplied)

<sup>47</sup> 58 RPC 147 at 161





**56.6.4** Resultantly, the Supreme Court reversed the decision of the High Court and permanently restrained ZEC from infringing RHL's trade mark "RUSTON", *inter alia*, by use of the mark "RUSTAM" or "RUSTAM INDIA".

**56.6.5** The following principles emerge from the decision of the Supreme Court:

- (i) There was a clear distinction between infringement and passing off. The question to be asked, in a passing off action was:

"Is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods ?".

As against this, the question to be asked in an infringement action was:

"Is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trade mark ?"

- (ii) It was possible that passing off took place even if the rival marks were different, because of the similarity in the get up of the two marks. Equally, it was possible that the rival marks were the same but that the get up of the product was so different that no passing off could be alleged, as there was no possibility of deception to the public.



(iii) Even in such latter case, however, so long as the two marks were identical or deceptively similar to each other, infringement would exist and an injunction would follow.

(iv) Establishment of the intent of the defendant was not necessary for substantiating an allegation of passing off. It was enough for a plaintiff to show that

- (a) the get up of the plaintiff's goods were distinctive of the plaintiff and
- (b) there was a possibility of confusion between the goods of the plaintiff and the defendant if both the marks were permitted to be used.

(v) There was no need to prove actual confusion or actual damage.

(vi) Thus, two important distinctions between infringement and passing off were that

- (a) infringement was concerned only with one method of passing off, i.e. passing off by use of the trade mark of the plaintiff and
- (b) the statutory protection available under Section 29 of the Trade Marks Act in the case of infringement was absolute, and additional distinguishing material existing outside the infringing mark could constitute no defence for the infringer.



(vii) In a case of infringement, if the rival marks were found to be identical, the court would not enquire further into the likelihood of deception or confusion. Where, however, the marks were not identical but only similar, the test to be applied for infringement and passing off was the same, i.e., the likelihood of deception or confusion arising from the similarity of the two marks.

(viii) Inasmuch as the mark “RUSTAM” was deceptively similar to “RUSTON”, the addition of the suffix “INDIA” in the former case would make no difference.

## **56.7 Parle Products<sup>8</sup>**

**56.7.1** Parle Products (P) Ltd. (“Parle”, hereinafter) manufactured and sold biscuits. They were the registered proprietors of the word mark “Gluko” as well as a device mark constituting the wrapper of their product “Parle’s Gluko Biscuits”, which was of buff colour, with the said name printed on the wrapper, depicting a farmyard with a girl in the centre carrying a pail of water and cows and hens around her with a background of a farmhouse and trees. Parle sued JP & Company (“JP”, hereinafter) alleging that JP was selling biscuits in a wrapper which was deceptively similar to the wrapper which constituted the registered trade mark of the Parle, and was, thereby, infringing Parle’s registered trade mark.



**56.7.2** JP denied the allegation, contending that the designs of the two wrappers were considerably different in appearance. It was pointed out that, unlike Parle's wrapper, JP's wrapper contained the picture of a girl supporting, with one hand, a bundle of hay on her head and carrying a sickle and a bundle of food in the other. It was also contended that the cows and hens as well as the buildings on JP's wrappers were unlike the cows and hens and buildings on Parle's wrapper.

**56.7.3** The learned trial court, before whom the suit was filed by Parle, opined that the dissimilarities between the wrappers of Parle and JP's outnumbered the similarities and that, therefore, there was no likelihood of the JP's biscuits being passed off as Parle's.

**56.7.4** This decision was affirmed by the High Court, which also held that, even if the broad features of the two wrappers were taken into consideration, they could not be regarded as similar, or at any rate, as so similar as to deceive an ordinary purchaser of biscuits.

**56.7.5** The matter travelled to the Supreme Court, at the instance of Parle.

**56.7.6** The Supreme Court held thus:

*"7. To decide the question as to whether the plaintiffs' right to a trade mark has been infringed in a particular case, the approach must not be that in an action for passing off goods of the defendant as and for those of the plaintiff. According to this, Court in **Durga Dutt v. Navaratna Laboratories**<sup>4</sup>:*

*"While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing*



*off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark, in relation to those goods (vide Section 21 of the Act). The, use, by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement."*

In the above case the Court further pointed out;

*"In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade mark or' in different from that of the registered proprietor of the mark would be material; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."*

8. According to Kerly's Law of Trade Marks and Trade Mark Names (9th Edn. para 838):

*"Two marks, when placed side by side, may exhibit many and various differences yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade marked goods, and relying, as they frequently do, upon marks, should be able to remember the*





*exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own."*

9. *It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the color scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluco Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in, our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the bar as in our view each case will have to be, judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it.*

10. *It was argued before us that as both the trial court and the High Court had come to the same conclusion namely, that the defendants' wrapper was not deceptively similar to the plaintiffs', the finding is one of fact which should not be disturbed by this Court. Normally, no doubt this Court does not disturb a concurrent*



finding of fact. But where, as here we find that the finding was arrived at not on proper consideration of the law on the subject it is our duty to set the same aside on appeal.”

(Emphasis supplied)

**56.7.7** On the basis of the aforesaid reasoning, the Supreme Court allowed the appeal of Parle and decreed the suit instituted by it, thereby restraining JP from using wrappers, for their biscuits, which were similar to the registered trade mark of Parle.

**56.7.8** From the afore-extracted passages, the following principles emerge:

(i) At the outset, the Supreme Court has reiterated the distinguishing features between the passing off and infringement, as outlined in *Kaviraj Pt Durga Dutt Sharma*<sup>4</sup>.

(ii) While assessing infringement, the two marks are not to be kept side-by-side. It is sufficient if the customer of average intelligence and imperfect recollection, who comes across the defendant's product at one point of time, is deceived into believing that the mark is identical or similar to the mark of the plaintiff which he has seen earlier in point of time.

(iii) A customer of average intelligence and imperfect recollection is not expected to remember the exact details of the marks. Marks are normally remembered by general impression or by significant detail rather than by a photographic recollection of the entire mark.



(iv) An ordinary purchaser is not credited with the ability of Sherlock Holmes.

(v) Thus viewed, the overall similarity between the defendant's and the plaintiff's marks were sufficient to mislead the customer, thereby justifying the prayer for injunction as raised by Parle.

### **56.8 *Heinz Italia v. Dabur India Ltd*<sup>48</sup>**

**56.8.1** The asserted mark in this case is the same as that with which we are concerned, i.e., Glucon-D, though asserted by Heinz Italia SRL ("Heinz", hereinafter), the original proprietor of the said trade mark and the predecessor-in-interest of the present plaintiff. The trade mark "Glucon-D" was initially registered in the name of Glaxo on 21 May 1975 and subsequently assigned to Heinz *vide* Assignment Deed dated 30 September 1994. Heinz claimed to have been using the trade mark Glucon-D and the distinctive packaging of the said product – which is the same as the prior packaging in the present case – from 1994 till 2002 uninterruptedly.

**56.8.2** Heinz sued Dabur India ("Dabur", hereinafter) for launching a similar product under the name "Glucose-D" in a similar packaging. Dabur contended, in its written statement, *per contra*, that "Glucose" was a generic expression of the product being sold and that no one could claim monopoly over the words "Glucose". It was additionally

<sup>48</sup> (2007) 6 SCC 1



submitted that there was no similarity between the marks “Glucon-D” and “Dabur Glucose-D” and that the packagings were also dissimilar.

**56.8.3** The learned trial court, *vide* order dated 11 December 2003, held that “Glucose” was a generic expression and that Heinz could not, therefore, claim that the use of the word “Glucose-D” violated the registered trade mark “Glucon-D”. The packaging’s of the two products was also held, by the learned trial court, to be dissimilar.

**56.8.4** An appeal preferred thereagainst before the High Court of Punjab and Haryana having failed, Heinz carried the matter to the Supreme Court.

**56.8.5** The relevant passages from the judgment of the Supreme Court are as under:

“15. We have also considered the arguments with regard to the prior user of the trademark “Glucon-D” and the specific packaging. *It is the admitted case that the term “Glucose-D” has been used by the respondent from the year 1989 and that the packaging which is the subject matter of dispute in the present suit has been in use from the year 2000.* In ***Century Traders v. Roshan Lal Duggar & Co.***<sup>49</sup> it has been held that in an action for passing off, the plaintiff has to establish prior user to secure an injunction and that the registration of the mark or similar mark in point of time, is irrelevant. This Court in ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.***<sup>50</sup> case also laid down the tests in the case of passing off and observed as under:-

*“In other words in the case of unregistered trade marks, a passing off action is maintainable. The passing off action depends upon the principle that nobody has a right to represent his goods as the goods of some body. In other words a man is not to sell his goods or services under the pretence that they are those of another person. As per Lord*

<sup>49</sup> AIR 1978 Del 250

<sup>50</sup> (2001) 5 SCC 73 : 2001 PTC 300



*Diplock in **Erwen Warnink BV v. J. Townsend & Sons**<sup>51</sup>, , the modern tort of passing off has five elements i.e. (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trade (in the sense that this is a reasonably foreseeable consequence), and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so."*

16. Likewise, it has been repeatedly held that *before the use of a particular mark can be appropriated it is for the plaintiff to prove that the product that he is representing had earned a reputation in the market and that this reputation had been sought to be violated by the opposite party.* In **Corn Products**<sup>3</sup> case it was observed that the principle of similarity could not to be very rigidly applied and that *if it could be prima facie shown that there was a dishonest intention on the part of the defendant in passing off goods, an injunction should ordinarily follow and the mere delay in bringing the matter to Court was not a ground to defeat the case of the plaintiff. It bears reiteration that the word "Glucon-D" and its packaging had been used by Glaxo since 1940 whereas the word "Glucose- D" had been used for the first time in the year 1989.*

17. In **Cadila Healthcare**<sup>50</sup> case, it has also been held that *in the case of a passing off action the similarities rather than the dissimilarities have to be taken note of by the Court and the principle of phonetic "similarity" cannot be ignored and the test is as to whether a particular mark has obtained acceptability in the market so as to confuse a buyer as to the nature of product he was purchasing. We observe that the both Glucon-D and Glucose-D are items containing glucose and to us it appears that there is remarkable phonetic similarity in these two words.*

18. We have also examined the packaging of the product and specifically Annexure P.6 (colly). Item D of Annexure P-6 is the packaging in dispute. *It will be seen that the colour scheme of Glucose-D and Glucon-D is almost identical with a happy family superimposed on both. Mr. Chandra has however pointed out that in Glucose-D the happy family consisted of four whereas in the case of Glucon-D the family was of three and as such the two were dissimilar. We are of the opinion however that the colour scheme and the overall effect of the packaging has to be seen. We have also examined Item D individually which is the exclusive*

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<sup>51</sup> 1979 (2) All ER 927





packaging for Glucose-D; the one on the extreme left being the packaging in the year 1989, the one in the middle being the one for the year 2000 (which is impugned in the present suit) and the third on the extreme right which is the subject matter of the suit in Calcutta which has been stayed on the application made by respondent. *We are of the opinion that the packaging of Glucose-D and Glucon-D is so similar that it can easily confuse a purchaser.* We also feel that mere fact that the respondents have time and again made small changes in their packaging is an attempt to continue to mislead the purchaser and to make it more difficult for the appellants to protect their mark, which the record shows has acquired an enviable reputation in the market which is sought to be exploited by the respondent.

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20. We accordingly set aside the order of the trial court dated 11-12-2023 and the order of the High Court dated 27-10-2005. However, as this order is confined only to the limited question of an ad-interim injunction, any observation made in this order would not bind the trial Judge in the proceedings in the suit. The application for ad-interim injunction is accordingly allowed in terms of prayer clause (ii) of the application.”

(Emphasis supplied)

**56.8.6** It would be seen that the Supreme Court finally granted an injunction in terms of prayer clause (ii) in the Order XXXIX application filed by Heinz. The prayer clause (ii), however, is not forthcoming either in the judgment of the Supreme Court or in the judgment dated 27 October 2005 of the High Court of Punjab and Haryana in FAO 233/2004<sup>52</sup>, from which the matter travelled to the Supreme Court. A reading of the afore-extracted passage from the judgment of the Supreme Court discloses that the Supreme Court dealt only with the aspect of passing off and did not address the aspect of infringement.

<sup>52</sup> Manu/PH/0618/2005



**56.8.7** The Supreme Court has endorsed the ingredients of passing off as delineated in its earlier decision in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*<sup>50</sup> (*Cadila-I*) Having distilled the principles applicable to passing off, the Supreme Court has, in para 18 of the decision, returned findings on facts, after examining the rival packs. It has held the colour scheme of the two packs to be almost identical with a happy family superimposed in both, though the number of members of the family were different. In that view of the matter, the Supreme Court has held that the trade dress of the two products was such that they could easily confuse a purchaser. Additionally, it has been held that there is remarkable phonetic similarity between the marks “Glucon-D” and “Glucose-D” and that both are items containing glucose. Though a specific contention was advanced, before the Supreme Court, that “Glucose”, being a descriptive mark, could not be injuncted, the Supreme Court has not returned any finding thereon, as it has proceeded on the premise of passing off.

## **56.9 Marico<sup>10</sup>**

**56.9.1** Marico Ltd. (“Marico”, hereinafter) was a proprietor of the registered trade mark “LOSORB” and “LO-SORB” for oil, ghee, etc. in class 29 w.e.f. 28 May 2001. The use of the mark “LOSORB” and “LO-SORB” was intended to convey the message that the edible oil, with respect to which the marks were used, contained an ingredient/anti foaming agent by which less or low oil was consumed by the product made by using the said edible oil.



**56.9.2** Agro Tech Foods Ltd. (“Agro”, hereinafter) was selling sunflower oil under the trade mark “Sundrop”. As the oil sold by Agro also contained an anti-foaming agent, which retarded absorption of the oil during the process of frying, Agro’s packaging also contained the slogan “WITH LOW ABSORB TECHNOLOGY”.

**56.9.3** Marico contended that the expression “LOW ABSORB”, used by Agro, was deceptively similar to the registered mark “LOSORB” and “LO-SORB” of Marico and that, thereby, the tort of infringement stood committed by Agro. Marico, therefore, sued Agro and, with the suit, filed an application under Order XXXIX of the CPC, seeking interlocutory injunction. The application for injunction was dismissed by a learned Single Judge of this Court vide judgment dated 23 April 2010, against which Marico preferred an appeal which stands disposed of, by the Division Bench, by the judgment under discussion.

**56.9.4** The Division Bench identified the two principles issues arising for consideration thus:

“7. Two basic issues arise for decision in the present appeal along with incidental and related issues. The *first* issue is on the aspect of infringement i.e. whether the appellant’s registration gives it exclusive right to use the subject trademarks “LOSORB” and “LO-SORB” and consequently whether an action for infringement is maintainable if a person such as the respondent uses a trademark which is deceptively similar or nearly identical or identical to the registered trademarks. Included in this first issue is the aspect of whether registration only confers prima facie validity and thereby does not prevent the court from denying the injunction in spite of registration. Further, assuming that registration is final would the appellant be entitled to the reliefs of injunction with regard to its claims of infringement once the respondent lays out a valid defence under the applicable provisions of the Trademarks



Act, 1999 (hereinafter referred to as the "Act") which inter alia, include Section 30(2) (a) and Section 35 thereof i.e. the use of the words by the respondent, which words are claimed by the appellant as its trademarks are statutorily permissible as the use is only in a descriptive manner. The second issue is the issue with regard to claim of the appellant pertaining to passing off and the issue is whether the respondent's user of the expression "LOW ABSORB TECHNOLOGY" in relation to its edible oil product amounts to passing off the goods of the appellant which uses the unregistered trademark "LOW ABSORB".

**56.9.5** The Division Bench first addressed the issue of passing off and, at the outset, cited, with approval, an earlier decision of a Division Bench of this Court in *Cadila Healthcare Ltd. v. Gujarat Cooperative Milk Marketing Federation Ltd*<sup>53</sup> (*Cadila-II*).

**56.9.6** In *Cadila-II*<sup>53</sup>, the mark asserted by Cadila was "Sugar Free" used by it as an artificial sweetener and substitute for natural sugar. The Division Bench of this Court held that the expression "Sugar Free" was descriptive and generic, and could not be said to be coined. Even if the mark "Sugar Free" had acquired distinctiveness in the hands of the appellant, Cadila could, nonetheless, not seek to injunct others from using the mark "Sugar Free", as it was purely descriptive and lacked distinctiveness. The following passage from *Cadila-II*<sup>53</sup>, which was entirely endorsed and re-affirmed by the Division Bench in *Marico*<sup>10</sup>, sets out the legal position in that regard:

"8. In our view, at this juncture i.e. at the interim stage, even assuming distinctiveness claimed by the appellant in its favor qua its artificial sweetener, the appellant has rightly been declined an injunction by the learned Single Judge since it is evident and has indeed been found by the learned Single Judge that the use of the term "Sugar Free" by the respondent is not in the trademark sense but as a common descriptive adjective. The learned Single Judge has found and in our view rightly that the respondent has not used

<sup>53</sup> 2009 (41) PTC 336 : 2009 (8) AD (Delhi) 350



the expression in a trademark sense but only in a descriptive sense in the following passage: -

“54. It is important to be borne in mind that use of a descriptive expression as a trademark by a trader, irrespective of the said trademark having acquired a secondary meaning and distinctiveness in relation to the trader's products, does not entitle such trader from precluding other traders from using the said expression for the purposes of describing the characteristic features of their products. I have no hesitation in stating, albeit without prejudice to the rights and interests of the plaintiff in the present suit, that by adopting such a purely descriptive and laudatory expression 'Sugar Free' as its trademark, the plaintiff must be prepared to tolerate some degree of confusion which is inevitable owing to the wide spread use of such trademark by fellow competitors. Simply because the plaintiff claims to be using the expression 'Sugar Free' as a trademark much prior to the launch of the defendant's product Pro Biotic Frozen Dessert in the market does not give this Court a good ground for imposing a blanket injunction on the defendant from using the expression 'Sugar Free', especially when the defendant intends to use this expression only in its descriptive sense and not as a trademark, and even otherwise, when the use of this expression is widespread in relation to foods and beverages”.

**56.9.7** The Division Bench further endorsed paras 9 to 11 and 14 of *Cadila-II*<sup>53</sup>, which read thus:

“9. We are unable to hold that the appellant's trade mark 'Sugar Free' is a coined word; at best it is a combination of two popular English words. The mere fact that the appellant's product cannot be directly consumed or eaten and merely is an additive does not detract from the descriptive nature of the trade mark. Once a common phrase in the English language which directly describes the product is adopted by a business enterprise, such adoption naturally entails the risk that others in the field would also be entitled to use such phrases provided no attempt is made to ride on the bandwagon of the appellant's indubitably market leading product 'Sugar Free'. In this connection, merely because the attributes of 'sugar free' can be described by other phrases cannot detract from the common usage of the phrase 'Sugar Free' as denoting products which do not contain sugar and any trader





*which adopts such mark in the market place, does so with the clear knowledge of the possibility of other traders also using the said mark. That is precisely the reason for the denial of protection to such marks by refusing registration as envisaged by Sections 9, 30 and 35 of the Act.*

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*Thus, it is clear that the mark or indication which serves to designate the quality of the goods of the appellant, which indeed the phrase 'Sugar Free' does, would be an absolute ground for refusal of registration of a mark unless it has acquired a distinctive character. The expression can at best be said distinctive qua the artificial sweetener of the appellant and mere starting of the marketing of the drink 'sugar free D'lite' cannot give the appellant the right to claim distinctiveness in the expression 'Sugar Free' in relation to all the food products.*

10. The learned Senior Counsel for the appellant has relied upon a plethora of judgments including the decision of the European Court of Justice in **Baby Dry**<sup>54</sup> to claim that the expression 'Sugar Free' is a coined word and is distinctive in nature. Apart from the fact that the law laid down in the case of **Baby Dry**<sup>54</sup> is not binding on us, it is also relevant to notice that in the said case the Court permitted the registration on the basis of the categorical findings that the expression 'Baby Dry' was a syntactically unusual juxtaposition of two independent English words and was not a familiar expression in the English language. *In our view, the expression 'Sugar Free' is neither a coined word nor an unusual juxtaposition of two English words especially when such expressions are commonly used, both in written, as well as spoken English, for example, 'hands-free' (for mobile phones) and 'fat free' (for food articles) and thus cannot be permitted exclusive use for only the appellant's product.*

11. The appellant has relied upon the case of **Godfrey Philips India Ltd. v. Girnar Food & Beverages (P) Ltd.**<sup>55</sup> wherein it was held that a descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or has been from a particular source. It is also relevant to mention here the judgment of **Home Solutions**<sup>56</sup> was also relied upon by the respondents, wherein it was held that the expression 'HOMESOLUTIONS' is inherently incapable of becoming distinctive of any single person with respect of any single product

<sup>54</sup> (2002) RPC 17

<sup>55</sup> 2005 (30) PTC 1 (SC)

<sup>56</sup> 2007 (35) PTC 697



or service. It is generic and publici juris. It describes the nature of services offered. *Thus, in our view, the mark 'Sugar Free' is inherently incapable of becoming distinctive of the product of the appellant and hence the ratio of Godfrey Philips would thus not be applicable. Even if it is assumed that the mark of the appellant has become distinctive qua the artificial sweetener, however, the protection to the mark qua the product artificial sweetener cannot be extended to all the food products of any competitor in the market. We also affirm and reiterate the view taken by the learned Single Judge that the appellant's product is a sweetener/sugar substitute, and sweeteners are generally understood in their functional sense, that is, in terms of utility when added to foods and beverages. To an average consumer, a sweetener is known to exist only when added to food and beverages, and its own identity gets merged in the food and beverages to which it is added. Thus, the expression 'Sugar Free' when used in relation to a sweetener may really describe a sweetener in the sense of its generic meaning, and what it connotes is the specific nature and characteristics of the product.*

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14. In consonance with the above view we are also not in a position to agree with the appellant that the word 'Sugar Free' has become so distinctive of the sugar substitute and has acquired such a secondary meaning in the sugar substitute market that it cannot refer to any other food product except the appellant's sugar substituted product labelled 'Sugar Free'. *There cannot be any doubt that the word 'sugar free' is not inherently distinctive and is clearly descriptive in nature. In fact, the word 'Sugar Free' in essence clearly only describes the characteristics of the appellant's product and therefore, cannot afford it the protection sought in the plaint by restraining the respondent from using the phrase 'sugar free'. 'Sugar Free' prima facie has not attained any distinctiveness, as alleged by the appellant outside the field of sugar substitute artificial sweeteners and the appellant would not be entitled to exclusively claim the user of the expression 'sugar free' in respect of any product beyond its range of products and the respondent cannot be restrained from absolutely using the expression 'Sugar Free', particularly in the descriptive sense. A mere descriptive usage of the expression 'Sugar Free' by the respondent may thus blunt the edge of claim of distinctiveness by the appellant. However, we make it clear that if any party enters into the domain of artificial sweeteners with the trade mark 'Sugar Free' the appellant may have a just cause in seeking restraint."*

(Emphasis supplied)



**56.9.8** Applying the principles which emanated from the decision in *Cadila-II*<sup>53</sup> *supra*, the Division Bench proceeded in para 10 to 19 of its decision, to deal with the aspect of passing off, thus:

“10. In view of the judgment of the Division Bench in the *Cadila Healthcare Ltd.*<sup>53</sup>, and with which we respectfully agree, the appellant in the facts of the present case can have no exclusive ownership rights on the trade mark “LOW ABSORB”. The expression “LOW ABSORB” is quite clearly a common descriptive expression/adjective. The expression “LOW ABSORB” is not a coined word and at best it is a combination of two popular English words which are descriptive of the nature of the product as held by the Division Bench in *Cadila Healthcare Ltd.*<sup>53</sup> (*supra*) case that such adoption naturally entails the risk that others in the field would also be entitled to use such phrases. Low Absorb is not an unusual syntax and the same can almost be said to be a meaningful part sentence or phrase in itself. The expression “LOW ABSORB” surely and immediately conveys the meaning of the expression that something which absorbs less, and when used with respect to edible oil, it is descriptive in that it refers to less oil being absorbed or low oil being absorbed. Similar to the expression “Sugar Free” being not an unusual juxtaposition of two English words the expression “LOW ABSORB” equally is not an unusual juxtaposition of words in that the same can take away the descriptive nature of the expression. The expression “LOW ABSORB” is used in the functional sense for the character of the product viz. edible oil. With respect to the unregistered trade mark “LOW ABSORB” we are of the firm opinion that in essence the expression “LOW ABSORB” only describes the characteristic of the product edible oil and ordinarily/normally incapable of being distinctive. We are also of the view that it is high time that those persons who are first of the blocks in using a trade mark which is a purely descriptive expression pertaining to the subject product ought to be discouraged from appropriating a descriptive expression or an expression which is more or less a descriptive expression as found in the English language for claiming the same to be an exclusive trade mark and which descriptive word mark bears an indication to the product's kind, quality, use or characteristic, etc. This in our view is in accordance with the spirit of various subsections of Section 9 and Section 30 besides also Section 35 of the Act. The very fact that in terms of Section 9 of the Act, in cases falling therein, there is an absolute ground for refusal of registration of the trade mark, the same clearly is an indication of ordinarily a disavowal from claiming exclusive ownership of a descriptive expression as a trade mark. We are in this entire



*judgment for the sake of convenience only using the expression 'descriptive expression' or 'descriptive word' or 'descriptive trade mark' 'descriptive', etc. but these expressions are intended to cover cases with respect not only to a descriptive word mark used as a trade mark but to all word marks used as trade marks which refer to kind, quality, intended use or other characteristics, etc. of the goods, and also other ingredients of Sections 9(1)(b) and Section 30(2)(a).*

11. *The aforesaid observations are made by us mindful of the proviso of Section 9 as per which on account of distinctiveness, the absolute bar against registration is removed, but, we are for the present stressing on the intendment of the main part of the section and which is to basically prevent descriptive terms from being registered as trade marks. The proviso no doubt does state that such marks can be registered as a trade marks, however, the Act itself also contains provisions for cancellation of registered trade marks including Section 57 whereby registration obtained is cancelled being violative of the applicable provisions of the Act. Our belief is further confirmed by the provision of Section 31(1) which clearly states that registration is only prima facie evidence of the validity of registration. It is only when cancellation proceedings achieve finality of the same being finally dismissed can it be said that a mark for which ordinarily there is an absolute ground for refusal of registration that it has acquired a distinctive character i.e. a secondary meaning or is a well known trade mark. Section 124 of the Act is also relevant in this regard. Sub Section 5 of Section 124 clearly provides that in spite of registration, the Court before which an action is filed seeking protection of the trade mark is not precluded from making any interlocutory order it thinks fit in spite of the registration and also the fact that the suit may have to be stayed till decision of the rectification/cancellation proceedings before the Registrar/Appellate Board filed in terms of Section 57 of the Act. This aspect of Section 124(5) and related aspects are dealt in details in the following portions of this judgment. The facts of the present case are not such that a cancellation proceeding has been dismissed and that which dismissal has obtained finality and it cannot be said that the validity of registration has been finally tested.*

12. *An important aspect with respect to the issue of passing of is that the respondent is selling its product with a prominent trade mark "Sundrop" and which appears on the packaging of the respondent in a very prominent size, much larger than the size of the expression "LOW ABSORB TECHNOLOGY". The colour scheme of the respective packaging is also wholly different. Appellant's colour scheme is orange and the respondent's blue.*



*Merely because, the consumers are same and the trade channel same, it cannot be said that in the facts and circumstances of the case, there is a possibility of confusion, because there are more than enough differentiating features on the packaging so as to avoid any issue of the respondent passing of its goods as that of the appellant. For the sake of convenience the three packages in colour are reproduced below:*

(“Photos of packages omitted”)

13. Thus the conclusion of the above is that, even though the two respective products of the parties are identical viz. edible oil, it cannot be said that the respondent is passing of its goods as that of the appellant-plaintiff.

14. *The question now remains is whether in spite of the trade mark of the appellant “LOW ABSORB” being a descriptive trade mark, has the appellant established its case at this interlocutory stage of its trade mark becoming so distinctive that it can claim exclusive right and monopoly in the same by virtue of the proviso to Section 9. There are two important parts of this aspect/issue. The first part is what is the meaning to be ascribed to the expression ‘distinctive’ as found in the proviso to Section 9 and the second aspect is whether the Trade mark of the appellant has in fact become distinctive.*

15. The word ‘distinctive’ is not directly defined in the Act. However meaning of distinctive is indicated in the definitions of ‘trade mark’ [Section 2(zb)] and ‘well known trade mark’ [Section 2(zg)]. The word has been explained in a plethora of judgments. *Distinctive has been explained to mean such use of the trade mark with respect to the goods of a person that the public will immediately and unmistakably co-relate the mark with the source or a particular manufacturer/owner thereof. The real issue which however arises is what should be the meaning of the expression ‘distinctiveness’ in the situation when the trade mark is a word mark of descriptive nature. When a trade mark, which is a word mark, is arbitrarily adapted and is such having no co-relation to the goods in question, then in such a case distinctiveness is achieved by normal and ordinary use of the trade mark with respect to the goods and it has been repeatedly held that such trade mark is entitled to the highest degree of protection. However this is not and cannot/should not be so for a trade mark which is a descriptive word mark. Some colour has to be taken for the word ‘distinctive’ as found in the proviso to Section 9 from the expression ‘well known trade mark’ which follows the distinctiveness aspect as found in the said proviso. Courts should*





*ordinarily lean against holding distinctiveness of a descriptive trade mark unless the user of such trade mark is over such a long period of time of many many years that even a descriptive word mark is unmistakably and only and only relatable to one and only source i.e. the same has acquired a secondary meaning. A case in point is the use of 'Glucon-D' for 60 years in the recent judgment in the case of **Heinz Italia**<sup>48</sup>. A period of 60 years is indeed a long period of time and thus distinctiveness of the descriptive word mark used as a trade mark was accepted, albeit in a tweaked form of the normal descriptive word 'Glucose'. Therefore, when the descriptive trade mark is used only by one person undisturbed for a very long period of time, without anyone else attempting to use the trade mark during this long period time, a case can be established of a descriptive word having achieved distinctiveness and a secondary meaning.*

16. We must hasten to add that merely because the person first of the blocks in adapting a descriptive trade mark files legal actions and temporarily prevents or seeks to prevent others from using the descriptive trade mark cannot mean that there is undisturbed user of the trade mark. Once others claim a right to the descriptive trade mark before the end of the long period essential for a descriptive trade mark to become distinctive then the original user of a descriptive trade mark cannot ordinarily establish "distinctiveness".

17. *Ultimately everything will turn on the facts of each individual case and in some cases the facts may be wholly clear even at the interim stage of deciding an interlocutory application, in other cases (which are bound to be in a majority) a decision on distinctiveness can only be made after evidence is led by the parties.* This is also so held by the Supreme Court in the 'Super Cup' case **Godfrey Philips India Ltd.**<sup>55</sup>, that distinctiveness is an issue to be established or examined in the facts of each particular case i.e. the evidence has to be evaluated in the facts of each individual case.

18. When we turn to the facts of the present case, we find that user is only of about seven years since 2001 and which user even as per the stated sales cannot be said to be such user qua a descriptive expression 'LOW ABSORB' that it can be said that the appellant has got such distinctiveness to claim exclusive monopoly of the same as a trade mark keeping in mind the observations made above of discouraging appropriation of descriptive words and expressions. Also, the extent of sales i.e. value of sales can sometimes be deceptive in cases such as the present where the appellant also uses other trade marks such as 'Sweekar' & 'Saffola'. It would be a moot point, to be decided after trial, that



what is the extent of sales relatable to “LOW ABSORB” only (and even for the registered marks “LOSORB” and “LOSORB”) and not because of the trade marks ‘Sweekar’ and ‘Saffola’. *We, therefore, at this stage of interim injunction reject the case of the appellant that it has achieved such distinctiveness that it can claim the benefit of the proviso to Section 9 with respect to the subject word mark which is a descriptive trade mark.*

19. *The result of the aforesaid is that the learned Single Judge was justified in declining the relief of injunction on the ground of passing off. Additionally as stated by us above, in the facts of the present case there is no question of claiming any exclusive ownership right in the expression “LOW ABSORB” and therefore, consequently, there arises no question of successfully maintaining a passing of action on that basis. There are also other added factors and circumstances, as narrated above, to hold that there is no question of passing of in the present case.*

(Emphasis supplied)

**56.9.9** The Division Bench, thereafter, proceeded to deal with the aspect of infringement. At the outset, relying on *N.R. Dongre v. Whirlpool Corp*<sup>57</sup>, the Division Bench held that registration was only *prima facie* evidence of validity of a trade mark and that the presumption in that regard was rebuttable. Thereafter, in paras 23 and 24, the Division Bench has dealt with the import of the expression “if valid” as contained in Section 28 of the Trade Marks Act, thus:

“23. *The right conferred by registration for exclusive use of the trademark in relation to goods is if the registration is valid and which flows from the expression "if valid" occurring in Section 28. The expression "if valid" has been inserted for the purpose that post registration an aggrieved person is entitled to apply for cancellation under Section 57 of the Act even if no suit is filed alleging infringement of the registered trademark. In case a suit is instituted, the court, once there is already a pending action seeking cancellation of the trademark, will stay the suit till the final disposal of the cancellation/rectification proceedings. The court however is still entitled to, in spite of registration, pass any interlocutory order as it deems fit, including but not limited to, granting the injunction or dismissing the prayer for injunction. If*

<sup>57</sup> 1995 (34) DRJ 109 (DB).



*no cancellation proceedings are pending as on the date of filing of a suit for infringement if the court is satisfied with regard to the plea of invalidity of registration (this language of Section 124(1) (a) (i) co-relates to the expression "if valid" as occurring in Section 28) then the court may raise an issue in the suit and adjourn the case for three months after framing the issues in order to enable the defendant to apply to the Appellate Board for rectification of the register. Even in the circumstances where the court stays the suit for three months and permits a party to apply for cancellation/rectification, the court can pass any interlocutory order as it thinks fit under sub-section 5 of Section 124."*

24. *In view of the co-relation between Section 28 and different sub-sections of Section 124, it becomes clear that the entitlement to claim invalidity of registration on the ground of the expression "if valid" as found under Section 28 only arises if the defendant in his written statement in a suit alleging infringement of a registered trademark takes up the plea with respect to registration of trademark being "invalid" or has already applied for cancellation of the registered trademark before the suit alleging infringement is filed.*

(Emphasis supplied)

**56.9.10** Thereafter, in paras 27 to 32, 34, 36 to 41, **Marico**<sup>10</sup> held thus:

“27. In the facts of the present case, we find that the injunction application was disposed of at a stage when the defendant filed an application for vacation of the injunction and no written statement of the defendant was on record. *As already discussed hereinabove, the stage of challenging the validity of registration by the defendant arises only when the written statement is filed, because it is only in the written statement that the plea of the registration being invalid would be taken up in furtherance of the expression “if valid” as found in Section 28 and also similar language as found in Section 124(1)(a). This also flows from the fact that under Section 31(1) registration is only prima facie evidence of validity and not conclusive evidence. Registration would only be conclusive evidence of validity if the rectification/cancellation proceedings filed for cancellation of the registered trade mark do not finally succeed. We are, therefore of the view that in the facts of the present case since the issue of invalidity of registration is to be taken up only in a written statement for an issue to be framed with respect thereto in terms of Section 124(1)(a)(ii) and the written statement was yet to be filed when the impugned order was passed, where such an issue would/could be raised, the learned Single*



*Judge was justified in looking into the aspect of prima facie validity of the registration of the trade mark and it cannot be the stand of the appellant that the plea of invalidity of registration cannot be looked into because there is no such plea in the written statement inasmuch as the written statement was yet to be filed in the suit.*

28. The learned Single Judge was fully entitled to look into the aspect of validity of registration in the facts of the present case by reference to the expression “if valid” as occurring in Section 28 and the related provisions of Section 31 and the different sub-sections of Section 124. *The learned Single Judge applied his mind and considered this issue of prima facie validity of registration of trade mark for deciding the interlocutory application and which is very much permissible and in fact so provided under Section 124(5).*

29. Now let us examine the issue of prima facie validity of registrations of the appellant for deciding the aspect of grant of injunction in the facts of the present case. *When we look at the facts in the present case, we find that when the application was filed for registration of the trade marks “LOSORB” and “LO-SORB”, the applications clearly stated “proposed to be used”. Quite clearly therefore on the date of registration there was no user at all of the trade mark, much less such use of it so as to give the trade mark a distinctive character as a result of use made of it or the same being a well known trade mark. Clearly therefore, the registration of the trade mark “LOSORB” and “LO-SORB” were prima facie invalid because the said trade marks basically are a minor variation of a descriptive expression “LOW ABSORB” which is not an unusual juxtaposition of words in the English language and no evidence existed before the Registrar of distinctiveness because the marks were sought to be registered not on proof of actual user so as to make the same distinctive on the date of filing of the application for registration but only on “proposed to be used” basis. The expression “LOW ABSORB” conveys the same meaning as “ABSORBS LOW”. Such descriptive word marks are clearly such for which there is an absolute ground for refusal of registration by virtue of Section 9(1)(b) of the Act because clearly the said word marks are in fact clear indications of designation of the kind, quality, intended purpose or other characteristics of the goods of which the trade mark is applied. The registrations being prima facie invalid no action for infringement would thus lie. On the issue of acquiring distinctiveness subsequent to the making of the application for registration, we have already dilated at length in the earlier part of this judgment while dealing with the issue of passing off that it cannot be said that the mark*



*“LOW ABSORB” has acquired a secondary meaning by user of a few years.*

30. We will now examine the issue whether the expressions “LOSORB” or “LOSORB” have achieved a secondary meaning even if “LOW-ABSORB” may not have. On this aspect one immediately feels that it is an aspect of concern with respect to the claim of the plaintiff that *if partly tweaked descriptive words and expressions of English language are claimed to be coined words, the same would result in a grave and absurd situation because a non-tweaked word being a completely descriptive word will in fact be deceptively similar to the tweaked descriptive English language word or expression of which registration is obtained. Meaning thereby that because of success in getting registered a minor modification of a descriptive word or expression of the English language, a person who gets registration can prevent a purely descriptive use of a normal word or expression as found in English language dictionary on the ground that it would be identical with or deceptively similar to a registered trade mark—a position which is found in the present case. Such a position, in our opinion, cannot at all be countenanced and must be struck down with a heavy hand.*

31. When we see the facts and circumstances of the present case, we find that both the parties claim to have an ingredient in their product namely edible oil an antifoaming agent which results in lower oil being consumed while frying the food. In such a case scenario, it cannot be claimed at this interim stage that there is a secondary significance by user up to registration to such coined words “LOSORB” and “LO-SORB” keeping in view the fact that such coined words have a clear reference to an indicative of the kind, quality, intended purpose, characteristic, etc. of the goods and are not ordinarily entitled to registration. We have, while on the issue of passing off, already adverted to the aspect of whether the sales are related to the trade marks “LOSORB/LO-SORB” or to “Sweakar/Saffola”, being a moot point. Having expounded on the law as above, we may again add that in a particular case, it is possible that a descriptive word mark on account of its such extensive user over a great length of time, when no other person has been shown to use the same, the same may in fact become a well known trade mark or a trade mark which has achieved such distinction by user that it can be registered. Where the combination of words forming a trade mark is an unusual juxtaposition of words or part words the distinction may be achieved more easily than where the user of words put jointly is not an unusual syntax and also especially when the adaption is arbitrary with respect to the goods/trade. There can be a case where a coined word would be entitled to trade mark protection where the coined word is the





*result of joining of one or two or few normal non descriptive English words of the dictionary or one word out of the two or more words forming a coined word is an arbitrary adaption. As already stated, therefore, in trade marks matters, every case necessarily turns upon and is decided on its own facts including but not limited to the trade mark, goods in question, customers, use and all other factors and their intense co-relation in each case.*

32. Thus, looking at the issue of entitlement of the learned Single Judge to question the validity of the registration of the trade mark for the purpose of deciding *the interlocutory application*, we find that the same was also justified because firstly no evidence was filed of distinctiveness of the trade marks at the time of registration since the same did not exist because admittedly the applications were filed for registration of the trade marks on a “proposed to be used basis” and secondly so far as the evidence of user we have already held that the user in the facts of the present case is not such as to confer distinctiveness amounting to a secondary meaning for the word marks which are in fact just a tweaked form of ordinary descriptive words in not an unusual syntax.

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34. The aforesaid emphasized portions of the three sections clearly bring out the different situations which are envisaged in the three different provisions and obviously there is no conflict between any of the three provisions. As per the proviso to Section 9(1) of the Act, ordinarily, evidence to make the trade mark distinctive by use has to be on the date of the application. The provision of Section 31(2) provides for an additional/bonus period so to say, to entitle the registration of the mark, and this bonus period is from the date of the application to the actual date of registration. Meaning thereby, ordinarily, the evidence of the distinctiveness by use has to be on the date of the application, but Section 31(2) allows evidence of distinctiveness post the making of the application up to the date of registration. There is a hiatus between the date of the application and the date of registration because after an application is made for registration of a trade mark, a detailed procedure has to be followed including of publication inviting objections and deciding the said objections before grant of registration. During this intervening period, from the date of the application to the actual date of registration, ordinarily evidence would not have been looked at for registration of the mark because the proviso to Section 9(1) requires evidence only of distinctiveness by use as on the date of making of the application, however, Section 31(2) relaxes the rigour of the



*proviso to Section 9(1) in that evidence of distinctiveness by use can be looked into of the period up to the actual date of registration. Therefore, there is no conflict between the proviso to Section 9(1) and Section 31(2). There is also no conflict between the proviso to Section 9(1) of the Act and the provision of Section 32.* On the first blush there may appear to be conflict because Section 32 seems to apply to all legal proceedings, and which would include infringement proceedings. However, the doubt is removed/cleared by the expressions “declared invalid” and “challenging the validity of such registration” as appearing in Section 32 of the Act. A declaration as to invalidity of the registration of the mark can only be given by the Registrar/Appellate Board and not by the civil Court. The declaration of invalidity of registration is on an application for cancellation of the registered trade mark which is filed under Section 57 of the Act. Therefore, the evidence with regard to the distinctiveness to justify registration, in terms of Section 32 can only be in the proceedings before the Registrar/Appellate Board in cancellation proceedings and not in the proceedings in the civil Court where an infringement action is filed. Thus, a conjoint reading of the three provisions being the proviso to Section 9(1), Section 31(2) and Section 32 brings forth the position that ordinarily evidence of distinctiveness by use ought to be as available on the date of the filing of the application for registration, however, there is a relaxation by extending this period which ordinarily is only up to the date of the application to the actual date of registration by virtue of Section 31(2). The evidence to show distinctiveness of the trade mark even post-registration is available only in proceedings where the trade mark is sought to be declared invalid i.e., in the cancellation proceedings under Section 57 of the Act. Therefore, it is not possible to argue and contend that even though no evidence was filed of distinctiveness by use of the trade mark up to the date of registration, yet evidence can be looked into on distinctiveness by use post the date of registration of the trade mark up to the date a suit is filed for infringement proceedings. The evidence in the period post registration of the trade mark can only be looked into in proceedings to declare the trade mark invalid under Section 57 of the Act and not in a civil suit in a civil Court where infringement action of a registered trade mark is filed. In the facts of the present case to justify the validity of the registration of the trade mark at best evidence of distinctiveness could be looked into from the year 2001 when the application for registration was filed upto the year 2005 when the mark was registered, i.e., evidence of distinctiveness by use cannot be looked into from the year 2005 till the year 2009 when the suit was filed. We have already held above that in fact even if there is user up to 2009, yet, descriptive trademarks have not become prima facie distinctive at



the stage of interim injunction. We have also adverted to the aspect of discouraging the entitlement of grant of distinctiveness to purely descriptive word marks. Therefore, the infringement action in this Court cannot be supported on the basis of evidence showing distinctiveness by user from 2005 to 2009 and that would be clearly be violative of the intendment of the provisions of Section 31(2) and Section 32 read with the proviso to Section 9(1) of the Act. We, therefore, decline to look into the evidence of distinctiveness by user of 2005 to 2009 and therefore thereafter till date to justify the validity of registration and therefore the claim of grant of injunction on the basis of distinctiveness by user on account of use of the registered trade marks from the year 2005 to 2009 when the suit was filed.

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36. It has been contended on behalf of the respondent that respondent is selling its edible oil in a package which clearly shows its trade mark as “Sundrop”. The respondent states that it is not using the expression “LOW ABSORB TECHNOLOGY” as a trade mark and the same is only being used as a descriptive expression, and as a part of a sentence, with respect to the product in question, namely, edible oil. The appellant, however, counters to say that the expression “LOW ABSORB TECHNOLOGY” is being used as a trade mark. *We have already referred to the fact that the trade mark “Sundrop” is used by the respondent in a very prominent manner in its packaging by the respondent and that undoubtedly is the trade mark of the respondent. The defendant is using the expression “LOW ABSORB” not independently but only as a part of a sentence which reads on the packaging as “WITH LOW ABSORB TECHNOLOGY”.*

37. Our conclusion is that we have in fact totally failed to appreciate the argument as raised on behalf of the appellant. *Surely, when rights are claimed over a word mark as a trade mark and which word mark is in fact a mere tweak of a descriptive word indicative of the kind, quality, intended purpose or other characteristics of the goods, it is not open to urge that although the respondent is using the descriptive word mark in fact only as a part of sentence as a description (and even assuming for the sake of argument only the descriptive word mark in itself) alongwith another independent trade mark, yet the use of descriptive words are to be enjoined against. How can it at all be argued that though the respondent is in fact shown to be using the disputed word(s) only with a descriptive intendment, yet, such use should be taken not in a descriptive manner but as a trade mark. If we permit such an argument to prevail then what will happen is that what cannot*



*be directly done will be indirectly done i.e., whereas the appellant is not entitled to succeed in the infringement action because the use by the respondent is in furtherance of its statutory rights of the user of the words which are descriptive of the kind, quality, intended purpose or characteristic of the goods, yet, merely because the appellant states that the respondent is using the same as a trade mark, the same should be taken as infringement of the trade mark of the appellant. Not only the plaintiff has no exclusive rights whatsoever to the trade marks because they are such which fall within the mischief of Section 30(2)(a), the respondent/defendant is always fully justified and entitled to use the descriptive words in any and every manner that it so chooses and pleases to do. If there are no rights of the plaintiff to exclusive user of the trade mark then where does arise the question of disentitlement of a defendant to use the trade mark of the appellant inasmuch as any person who adopts a descriptive word mark does so at its own peril in that any other person will also be fully entitled to use the same in view of a specific statutory rights thereto, and there are various other statutory rights including that under Section 30(2)(a), and which is what is being done by the respondent in the facts of the present case and its rights being further stronger because of the use along with the simultaneous use of its trade mark "Sundrop".*

38. *In the facts and circumstances of the present case, Section 30(2)(a) clearly applies in entitling the respondent to use the expression "WITH LOW ABSORB TECHNOLOGY" because that is only a descriptive use by normal English words in the English language indicative of the kind, quality, intended purpose or characteristic of the goods. There is no use of the expression "bona fide" in Section 30(2)(a) as is found in Section 35, and we do not propose to import in Section 30(2)(a) the expression "bona fide" because the subject matters of the two sections i.e. Section 32(a) and Section 35 are though common on certain limited aspects, however the two Sections do in fact operate in separate fields. Also looking at the issue in another way, "bona fide" aspect can in a way be said to be very much included in Section 30(2)(a) because the use of words which indicate their relation to the goods for the kind, quality, intended purpose or other characteristics, etc. of the goods, is clearly only a bona fide user of the same and which "bona fideness" does not have to be additionally proved. In fact, there is ordinarily not only no lack of bona fides in using the normal descriptive word, and on the contrary there is in fact mala fides of a plaintiff in adopting otherwise a descriptive word mark and for which adaption there is ordinarily an absolute ground for refusal of registration of the trade mark. There is no mala fides of the respondent as alleged by the appellant because the respondent is using the expression "LOW ABSORB" as part of a sentence in a*



descriptive manner and the respondent is also prominently using its own trade mark “Sundrop”, an aspect we have repeatedly referred to otherwise in this judgment. Merely because the respondent used “TM” earlier after the expression “LOW ABSORB TECHNOLOGY” is not such as to wipe out statutory rights/defences of the respondent.

39. *We are also of the opinion that once the person, against whom a suit is filed on the ground of infringement of a trade mark which is in fact a descriptive word, then, if a defendant is using his own word mark as a trade mark prominently in addition to the descriptive word mark which the plaintiff claims to be his trade mark, nothing further is required to show the bona fides of the defendant against whom infringement of a registered trade mark is alleged. In the facts of the present case, we have already adverted to in detail the prominent use by the respondent of its independent trade mark “Sundrop”, and, the fact that the expression “LOW ABSORB” is being used only as part of the sentence which reads “WITH LOW ABSORB TECHNOLOGY”.*

40. *We may however note that when two identical trade marks are used by two parties in the market, or that a use of a descriptive word by a defendant can be confused with the trade mark of a plaintiff, then a Court is always entitled to ensure that such distinction is brought or conditions are imposed qua the two identical or deceptively similar trade marks by imposing such conditions of use on both or either of the parties so that a third vital/important stake holder in these Intellectual Property Rights (IPR) disputes viz. the public, is not in any manner deceived/confused and whose rights are not prejudicially affected. This has been held by us in a recent judgment in **Cadila Healthcare Ltd. v. Diat Foods (India)**<sup>58</sup>, decided on 29.9.2010, in which this Court (speaking through Sanjay Kishan Kaul, J) has relied upon another Division Bench judgment of this Court in the case of **Goenka Institute of Education and Research v. Anjani Kumar Goenka**<sup>59</sup>, as also Section 12 of the Act and held the entitlement of a Court to issue directions to ensure that there is no confusion in the public with respect to two separate products which are sold under identical or deceptively similar trade marks. Of course, in this case of **Cadila Healthcare Ltd.**<sup>53</sup> use by the respondent/defendant was not as a trade mark but only in the descriptive sense, and yet, to avoid confusion to the public, directions were issued. Similar would be the entitlement of a Court afortiori when two parties use same or deceptively similar descriptive word marks as trade marks.*

<sup>58</sup> 173 (2010) DLT 141 (DB)

<sup>59</sup> AIR 2009 (Delhi) 139 : 2009 (160) DLT 417





## CONCLUSIONS

41. The following conclusions thus emerge:

*(i) A mark which is sought to used as a trade mark, if, is one falling under Section 9(1)(a) to (c), then the same ordinarily ought not to be afforded protection as a trade mark.*

*(ii) Before the marks which fall under Section 9(1)(a) to (c) are given protection as a trade mark, the distinctiveness must of an undisturbed user of a very large/considerable number of years, with the emphasis being on discouragement on appropriation of such marks which fall under Section 9(1)(a) to (c). (iii) A civil Court in a suit filed for infringement of a registered trade mark is entitled (if there is no earlier judgment which has achieved finality in cancellation proceedings) to consider the validity of registration for the purpose of passing an interlocutory order including of grant or refusal of an interim injunction—once the objection as to invalidity of registration is taken up in the pleading/written statement*

*(iv) A trade mark which falls under Section 9(1)(a) to (c) cannot be registered on proposed to be used basis. Evidence on distinctiveness with respect to trade marks falling under Section 9(1)(a) to (c) should be the evidence of user evidencing distinctiveness as on the date of application for registration or at the best of evidence up to the date of registration.*

*(v) In infringement actions the Court is entitled to consider the evidence of distinctiveness up to the date of registration for the purpose of passing any interlocutory order and not evidence showing distinctiveness post registration. However, in cancellation proceedings evidence of distinctiveness post registration of the trade mark can also be considered.*

*(vi) Even if there is finality to registration of a trade mark, yet the defendant in infringement action can take statutory defences under Sections 30 to 35 to defeat the infringement action.*

(Emphasis supplied)



**56.9.11**A reading of the aforesaid passages from *Marico*<sup>10</sup> delineates the following propositions:

(i) At the outset, *Marico*<sup>10</sup> has affirmed the following principles which emanate from the earlier decision of the Division Bench in *Cadila-II*<sup>53</sup>:

(a) The mark “Sugar Free” is descriptive and generic and cannot be treated as a coined expression. Even if the trade mark has acquired distinctiveness in the hands of the plaintiff, Cadila cannot claim exclusivity in respect thereof, if the defendant uses the mark in a descriptive fashion and not as a trade mark, or if the use of the mark is widespread in respect of food and beverages.

(b) This is one of the risks of adopting a descriptive or laudatory expression as a trade mark. A person who uses a descriptive or laudatory expression as a trade mark runs the risk of others using the same expression in a descriptive sense, and being unable to injunct such use, thereby resulting in some amount of confusion amongst the public.

(c) The registration of a purely descriptive mark is itself proscribed unless it has acquired distinctive character.



(d) “Sugar Free” being a merely descriptive combination of two common English words is inherently incapable of being distinctive of the product of Cadila.

(e) However, if “Sugar Free” had actually attained distinctiveness in the hands of Cadila with respect to artificial sweeteners, then perhaps, Cadila would be entitled to seek a restraint against the use of the same expression “Sugar Free” for artificial sweeteners.

(ii) These findings, it was held, applied *mutatis mutandis* to the mark “LOW ABSORB”.

(iii) Section 31(1) of the Trade Marks Act, while ordaining that registration of a trade mark was *prima facie* evidence of its validity, remained, nonetheless, only *prima facie*, and became conclusive evidence only if proceedings under Section 57 had been initiated against the mark and failed.

(iv) Where there were distinguishing features in the packaging of the two products, there was no chance of passing off.

(v) The expressions “distinctive”, in the proviso to Section 9(1) of the Trade Marks Act, implied immediate and unmistakable correlation by the public, of the mark in question with its source/owner. The proviso, by its very nature, would



not apply where registration of a mark was sought on “proposed to be used” basis.

(vi) Where the mark in question was descriptive, the court ordinarily was required to lean against holding the mark to be distinctive and, thereby, extending to it the benefit of the proviso to Section 9(1), except where distinctiveness had actually been acquired by dint of user over a long period of time of “many many years”.

(vii) In a majority of cases, acquisition of distinctiveness was a matter of evidence, as held by the Supreme Court in ***Godfrey Phillips India Ltd.***<sup>55</sup>.

(viii) Where such distinctiveness, of the descriptive mark, had not been *prima facie* established, no case of passing off could be said to exist.

(ix) The expression “if valid” in Section 28, was intended to preserve and protect the right of an applicant who desired to seek revocation or cancellation of the mark in proceedings under Section 57. The benefit of the expression would be available only if the defendant had applied under Section 57 before the filing of the suit by the plaintiff or the defendant had taken the plea of invalidity in its written statement. If, however, the court was deciding the application for interlocutory injunction under Order XXXIX before a written statement was



filed, the court could look into the validity of the plaintiff's mark.

(x) Sections 30 and 35 operated as complete exceptions, conferring immunity from Sections 28 and 29.

(xi) The marks "LOSORB" and "LO-SORB" were *prima facie* invalid, as they were only minor variations of "LOW ABSORB" which was descriptive in nature and had no secondary significance. It was not permissible to allow descriptive words to be partly tweaked and claimed to be coined words. However, if there was an unusual juxtaposition or artificial adaptation of the words or parts of words, it was possible to achieve distinctiveness more easily.

(xii) Distinctiveness was required to be shown to exist, under the proviso to Section 9(1) read with Section 31(2) of the Trade Marks Act at or before the date of grant of registration of the mark.

(xiii) Inasmuch as "LOW ABSORB", as used by Agro was purely descriptive, Agro was entitled to the benefit of Section 30(2)(a) for the mark "Sundrop" with the additional slogan "WITH LOW ABSORB TECHNOLOGY".

(xiv) If the defendant was using its own mark prominently along with the descriptive mark, no further evidence of *bona fides* was required.





### **56.10 A cumulative assessment of the propositions that emerge**

The following principles, therefore, stand enunciated in the aforementioned decisions:

(i) A passing off action addresses the question – “Is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff’s goods?”, whereas an infringement action addresses the question – “Is the defendant using a mark which is the same or a colourable imitation of the plaintiff’s registered trade mark?”

(ii) Infringement would stand established immediately upon the impugned mark being found to be identical or deceptively similar to the asserted mark, irrespective of distinguishing features surrounding the marks, such as pictorial aspects of logos, where the marks are part of such logos, or the manner in which the goods are packed or presented, even if they indicate a different trade origin. Infringement affects the proprietorial right to exclusivity over a registered trade mark, either by use of the said mark itself, or a colourable imitation thereof.

(iii) As against this, such distinguishing features may make all the difference while examining an allegation of passing off. Differences in the physical appearance of the goods, or the



manner in which they are packed, may be sufficient to discountenance any plea of passing off.

(iv) Passing off could, therefore, take place even if the rival marks were different.

(v) If the rival marks are the same, or the defendant's mark is deceptively similar to the plaintiff's, infringement would exist, but passing off may still be found not to take place if the get up, or other features, of the two products are noticeably distinguishable.

(vi) *Mens rea* was not a necessary ingredient of passing off.

(vii) The marks are not to be seen side by side.

(viii) "Confusion" refers to the state of mind of a customer who, on seeing the defendant's mark, thinks that it differs from the plaintiff's mark on goods which he has previously bought but is doubtful whether the impression is not due to imperfect recollection. Confusion can be said to exist where the customer, of average intelligence and imperfect recollection, who purchases the defendant's product some time after purchasing the plaintiff's, is likely to have a somewhat vague recollection that he had purchased a similar product or a product with a similar name at an earlier point of time.



(ix) Possibility of confusion or deception has to be assessed on the basis of the first impression that the impugned mark, seen *vis-à-vis* the asserted mark, conveys to the customer of average intelligence and imperfect recollection.

(x) The marks have to be compared as a whole, also including parts which are common to the rival marks. By doing so, where the marks have a common suffix, such as “Amritdhara” and “Lakshmandhara”, the Court is not, thereby, granting the plaintiff a monopoly over the common “dhara” suffix but is only taking it also into account as part of the whole marks which are required to be compared. A customer of average intelligence and imperfect recollection is not likely to dissect or split the mark which he sees. Nor can such a customer be attributed with a photographic recollection of the mark. Customers remember marks by their essential details or features. Where the marks are not identical, the aspect of infringement has to be decided by identifying the essential features of the rival marks. If the essential features of the asserted mark have been copied in the impugned mark, the impugned mark infringes. Identification of essential features is a question of fact.

(xi) The etymological meaning of the rival word marks, or any similarity or difference therein, may also be of little significance, as the average customer does not go by the etymological significance of the mark.



(xii) A trade mark is likely to deceive or cause confusion by resemblance to an earlier trade mark if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders. The Court has to examine whether, if the two marks are used in a fair and normal manner, there is any chance of confusion.

(xiii) Similarity to be phonetic, visual, structural, or in the idea conveyed by the rival marks. Where, however, phonetic similarity is striking, infringement would be found to exist, even if the marks are visually dissimilar.

(xiv) Similarity between word marks has to be determined by applying the *Pianotist*<sup>40</sup> test.

(xv) This impression has to be gathered by the Court.

(xvi) Where the rival marks are identical, the Court would not enquire further into the likelihood of confusion or deception. However, if the marks are not identical but only similar, likelihood of confusion or deception must be shown to exist.

(xvii) There can be no objective standards or criteria to determine the extent of similarity which would be required to make out a case of likelihood of confusion or deception.



(xviii) At the stage of application for registration, the onus to establish that the mark, of which registration is being sought, is not likely to deceive or cause confusion, is on the applicant seeking its registration. Post registration, however, the mark would be entitled to statutory presumption of validity under Section 31(1) of the Trade Marks Act, and the onus to prove that the mark is not valid would be on the party questioning its validity.

(xix) As the assessment of infringement, or passing off, is fact-based, precedents are generally of value only insofar as they identify the principles to be applied.

(xx) English cases cannot be regarded as of much relevance in assessing the possibility of phonetic similarity between the rival marks.

(xxi) A purely descriptive mark cannot be registered, unless it has acquired distinctiveness in the hands of the applicant. Nor could a plaintiff/applicant claim distinctiveness by merely tweaking a descriptive word. However, an unusual arrangement of common words could become distinctive in a given case.

(xxii) No exclusivity can be claimed over descriptive or generic marks, if they are used by the defendant in a descriptive manner, even if they have acquired distinctiveness in the hands of the plaintiff. If, however, the defendant uses the mark as a





trade mark, the plaintiff may be justified in seeking an injunction.

(xxiii) “Distinctiveness”, in the proviso to Section 9(1), implies an immediate and unmistakable correlation, by the public, of the mark with its source/owner. In a majority of cases, this would be a matter of evidence.

(xxiv) By virtue of the proviso to Section 9(1) read with Section 31(2), distinctiveness, if pleaded by the applicant/plaintiff, had to be shown to exist on or before the date of grant of registration to the asserted mark.

(xxv) Courts are ordinarily to lean against holding descriptive marks to be distinctive, except where distinctiveness has in fact been acquired by user “over many many years”.

(xxvi) The proviso to Section 9(1) would, therefore, not apply where the registration of the mark was sought on a “proposed to be used” basis.

(xxvii) The presumption of validity of a registered trade mark, conferred by Section 31(1), was only *prima facie*. It became conclusive only if the registration was challenged, and the challenge failed.

(xxviii) The right to defend an infringement action by questioning the validity of the asserted mark would be available only to a defendant who had either initiated a rectification



proceeding under Section 57 prior to the filing of the suit or had taken, in the written statement, a plea that the asserted mark was invalid.

(xxix) If the application under Order XXXIX was being considered before a written statement was filed, the Court would consider the validity of the asserted mark, if a plea in that regard was urged by the defendant.

(xxx) Sections 30 and 35 operate as complete exceptions to Sections 28 and 29.

(xxxi) Thus seen,

- (a) “Gluvita” was held to be deceptively similar to “Glucovita”, with the central “co” syllable, as the only distinguishing feature, being insufficient to dispel the possibility of confusion,
- (b) “Lakshmandhara” was found to be deceptively similar to “Amritdhara” when used for identical products,
- (c) the device bearing the logo “Sri Andal” was found to be deceptively similar to the device bearing the logo “Sri Ambal” though the devices themselves were otherwise totally dissimilar, where both were used for identical products,
- (d) “RUSTAM INDIA” was found to be deceptively similar to “RUSTON”,
- (e) “Sugar Free” was not registerable when used for artificial sweeteners, and could not justify a claim for



injunction against others who desired to use the expression in a descriptive fashion, and

(f) “LO-SORB” and “LOSORB” were held to be descriptive when used in respect of oil to indicate that it was not significantly absorbed while cooking.

**57.** Once the legal position is thus properly understood, all that remains is to apply the law to the facts at hand, and the submissions advanced by learned Senior Counsel, and let the chips fall where they may.

**58.** I proceed, therefore, to address the issues that arise, seriatim. Needless to say, all findings would be *prima facie*, as this judgment merely disposes of the application filed by the petitioner under Order XXXIX Rule 1 and 2 of the CPC.

**59.** Whether the defendants’ marks infringe the plaintiff’s registered trade marks?

**59.1** The plaintiff possesses registrations, in its favour, of the word marks “GLUCON-C” and “GLUCON-D”. At the outset, I may note that the plaintiff would be entitled to assert not only the mark “GLUCON-D” but also the mark “GLUCON-C”, though the said mark has not been used by the plaintiff for a considerable amount of time. The mark “GLUCON-C” has not been abandoned by the plaintiff and continues to be a valid and subsisting registered trade mark. Though non-use is a ground on which cancellation of a



registered trade mark may be sought, no such application has been preferred by anyone, against the mark “GLUCON-C”. That being so, the plaintiff would be entitled to the benefit of Section 28(1) in respect of both the marks “GLUCON-C” and “GLUCON-D” and, consequently, to protect both the marks against infringement under Section 29.

**59.2** Mr. Sibal has sought to contend that the defendants’ mark is not “Gluco-C” or “Gluco-D” but “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++”. This contention cannot merit acceptance, as “Gluco-C” and “Gluco-D” constitute the essential features of the marks “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++”. Even as reflected on the face of the pack of the defendant’s product, it is seen that “Gluco-C ++” and “Gluco-D ++” are prominently visible in a much larger lettering and font than the mark “Prolyte”. The intent to project the “Gluco-C ++” and “Gluco-D ++” parts of the defendants’ mark is therefore apparent. If, therefore, “Gluco-C” and “Gluco-D” parts of the defendants’ marks are actually infringing of the plaintiff “GLUCON-C” and “GLUCON-D” marks, the defendants cannot seek amnesty on the ground that their marks are “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++”.

**59.3** Insofar as the comparisons between the marks “GLUCON-C” and “Gluco-C” or “GLUCON-D” and “Gluco-D” are concerned, it is *ex facie* apparent that the marks “Gluco-C” and “Gluco-D” are deceptively similar to the marks “GLUCON-C” and “GLUCON-D” respectively. The decision in *Heinz*<sup>48</sup> would apply, *mutatis mutandis*,



and on all fours, to the present case. In that case, the court was concerned with a comparison between the marks “GLUCON-D” and “Gluco-D”. It was found that the two marks were deceptively similar. The same conclusion would necessarily follow when one compares the marks “GLUCON-D” *vis-a-vis* “Gluco-D” and “GLUCON-C” and *vis-a-vis* “Gluco-D”.

**59.4** *Prima facie*, therefore, the defendants’ marks “Prolyte Gluco-C ++” and “Prolyte Gluco D ++” infringe the plaintiff’s registered marks “GLUCON-C” and “GLUCON-D”, especially as they are used for identical products.

**60.** Whether the trade dress of the defendants’ product is confusingly or deceptively similar to the trade dress of the plaintiff’s product ?

**60.1** Mr. Lall sought to contend that the defendant has, for their products “Gluco-C ++” and “Gluco-D ++”, both for the general and for the tangy orange flavours, adopted trade dresses which are similar to those of the plaintiff. As against this, Mr. Sibal has staunchly refuted the allegations, pointing out that the two trade dresses are completely dissimilar.

**60.2** Though the earlier trade dress of the plaintiff’s “GLUCON-D” is registered as a trade mark in favour of the plaintiff, there is no registration with the plaintiff of the present trade dress which is asserted in the plaint. Inasmuch the present trade dress is not registered as a trade mark in the plaintiff’s favour, there can, *stricto*





*sensu*, be no sustainable allegation, against the defendants, of “trade dress infringement”.

**60.3** What the court has, however, to examine is whether, by adopting a trade dress, in respect of the impugned trade marks “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++”, which are deceptively similar to the trade dress adopted by the plaintiff for the asserted trade marks “GLUCON-C” and “GLUCON-D”, the defendants has increased the likelihood of confusion or deception in the minds of the customer of average intelligence and imperfect recollection.

**60.4** I am inclined, at this stage, to grant the benefit of doubt to the defendants on this aspect. There are features, of the trade dress adopted by the plaintiff, which also figure in the trade dress adopted by the defendants. The only two such prominent features are, however, in my view, the two-battery motif and the inclined side panel with the words “INSTANT ENERGY” on a yellow background. As against this, Mr. Sibal points out correctly that the three features of the plaintiff’s pack which have been identified as its essential features in para 14 of the plaint, namely, the inverted white triangle, the happy family of a husband, wife and child, and the bar at the lower edge of the front face of the pack depicting its contents, are all absent in the defendant’s pack.

**60.5** It is true that, five paras later in para 19, the plaint asserts that there are two more essential features of the appearance of the



plaintiff's pack, i.e., the colour of the pack, and the two battery motif, used to depict the comparison between that product and ordinary energy drinks. It is also true that the two battery motif has been used by the defendants on their pack as well. It has been pleaded in para 29(D) of the written statement and also contended by Mr. Sibal during arguments that the use of the two battery motif is not distinctive, but merely descriptive and laudatory in nature, as what was intended to be conveyed was that, by consuming the product in question, the individual would be fully charged, like a fully charged battery, as compared to normal individuals who had not had the chance of consuming the said product and were, therefore, in a depleted state.

**60.6** The submission has merely to be noted to be rejected. The defendants have not, in the pleadings, taken a stand that the use of the two battery motif was common to the trade. Nor have they cited any other examples in which the two battery motif has been used. The contention that the plaintiff has not been able to establish distinctiveness in respect of the two battery motif is also completely misconceived. On the face of it, the representation of the energy state of the person consuming the product, *vis-a-vis* an ordinary individual, by using the two battery motif, is creative and cannot be regarded as ordinary or lacking in distinctiveness. The submission, to that effect, in the written statement, and as urged by Mr. Sibal during arguments, therefore, deserves to be rejected.

**60.7** I must confess that, given these various features, arriving at a conclusion, even *prima facie*, regarding whether there is confusing



trade dress similarity between the plaintiff's and the defendants' product has not been easy. The idea of the two battery motif, to represent the energy-inducing effect of the product, has apparently been lifted by the defendants from the plaintiff's pack.

**60.8** I am, however, in agreement with Mr. Sibal that the mere use of the green colour on the pack of the normal variant and the orange colour on the pack of the Tangy Orange variant may not be treated as imitative, as the use of these colours does appear to be common to the trade even on the basis of the various examples cited in the plaint and reproduced hereinabove. Similarly, though Mr. Lall also stressed the use of the word “tangy” along with “orange” for the orange variant, it is difficult to hold that the mere use by the defendants of the words “tangy orange” can be treated as imitative of the plaintiff's packing.

**60.9** Viewed thus, if one were to compare the whole packs of the plaintiff and the defendants, it is difficult to hold, *prima facie*, that a customer, even of average intelligence and imperfect recollection, would be confused into mistaking the defendants' pack for the plaintiff's. The inverted white triangle and the picture of the happy family are prominent features of the plaintiff's pack, which had become source identifiers over a period of time. The plaint, too, candidly acknowledges this position in para 14. Neither of these figure on the defendants' pack. Instead of an inverted triangle, the words “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++” figure on a background resembling a lightning flash. The overall arrangement of



colours on the defendants' pack is also clearly distinguishable from the arrangement of colours on the plaintiff's pack.

**60.10** Copying may neither be wholesome, nor in keeping with good trade practice, but, so long as it stops short of infringement or passing off, is not actionable at law. So long, therefore, as there is no likelihood of confusion or deception to the public, as represented by the mythical consumer of average intelligence and imperfect recollection, copying cannot invite injunctive action. Imitation, after all, is one form of flattery. The law frowns only when the act of imitation, by the imitator, entrenches on the intellectual property right of the person imitated. It is true that, in *Slazenger & Sons v. Feltham & Co.*<sup>60</sup>, exhorted thus:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?”

The *Slazenger*<sup>60</sup> exhortation cannot, however, substitute for the plain impression that the Court would gather on seeing the rival products, marks, or trade dresses. The aspect of confusion, or the likelihood thereof, has to be examined from the point of view of a customer of average intelligence and imperfect recollection, not an amnesiac. If the rival packs are so dissimilar, or the features of dissimilarity are so numerous that, seen as a whole and as they would appear to a customer of average intelligence and imperfect recollection, there is little or no chance of one being confused for the other, the Court

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<sup>60</sup> (1889) 6 RPC 531



cannot, piggybacking on *Slazenger*<sup>60</sup>, return a finding of confusion or deception. Even if one were, following the aphorism in *Munday v. Carey*<sup>61</sup>, to concentrate on the similar, rather than the dissimilar, features of the “Glucon-D” pack of the plaintiff and the “Gluco-D ++” pack of the defendants, it is *prima facie* difficult to hold that a customer who is aware of the plaintiff’s pack and has an even imperfect recollection of its essential features, would confuse the defendants’ pack for the plaintiff, if he comes across it at a later point of time. Though the use of the two battery motif may have been imitative, that by itself, in my view, cannot justify a finding of likelihood of confusion in the mind of such a customer, especially as the two battery motif is not reflected on the face of the packs but either on their rear or side panels.

**60.11** *Prima facie*, therefore, it cannot be said that the trade dress of the defendants’ product is deceptively similar to that of the plaintiff’s product.

**60.12** That, however, does not detract from the aspect of infringement, by the defendants’ marks “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++”, of the plaintiff’s marks “GLUCON-C” and “GLUCON-D”.

**61.** Effect of disclaimer of the suffixes “C” and “D” by the plaintiff

**61.1** Mr. Sibal sought to contend that, as the plaintiff has disclaimed exclusivity over the suffixes “C” and “D”, while obtaining

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<sup>61</sup> (1905) 22 RPC 273





registrations of the trade marks “GLUCON-C” and “GLUCON-D”, the aspect of infringement would have to be examined only by comparing the prefixes “Glucon” with “Gluko”, omitting from consideration the disclaimed suffixes “C” and “D”.

**61.2** I do not agree. The disclaimer, by plaintiff, of the suffixes “C” and “D”, only means that the plaintiff cannot plead infringement against the defendants solely on the ground that the defendants’ mark also uses the suffixes “C” and “D”. The suffixes “C” and “D”, therefore, cannot be a basis to claim exclusivity, so as to allege infringement by the mark of another person. The disclaimer of exclusivity in respect of the suffixes “C” and “D” does not, however, mean that, while comparing the marks of the plaintiff and the defendants, the said suffixes would be left out of consideration. It is well settled that the marks have to be compared as wholes. While comparing the marks as wholes, the suffixes “C” and “D”, though disclaimed, have also to be taken into consideration. The court cannot, therefore, restrict its examination to assessing similarity between “Glucon” and “Gluko” as Mr. Sibal would seek to urge. The comparison has necessarily to be between “Glucon-C” and “Glucon-D” on the one hand and “Gluko-C” and “Gluko-D” on the other.

**61.3** This plea of Mr. Sibal, therefore, stands rejected.

**62.** Whether the marks “GLUCON-C” and “GLUCON-D” were not entitled to registrations in view of Section 9(1)(a) and (b) of the Trade Marks Act ?



**62.1** Inasmuch as a specific challenge to the validity of the registration of the “GLUCON-C” and “GLUCON-D” trade marks has been taken in para 18 of the written statement filed by the defendant, the court is inclined to examine the matter, *prima facie*.

**62.2** The main contention of Mr. Sibal, in this context, is that the marks “GLUCON-C” and “GLUCON-D” are descriptive. He has placed reliance, in this regard, on the reply filed by the plaintiff to the objections of the Registry of Trade Marks while seeking registration of the mark “GLUCON-D”. Mr. Sibal points out that, in the said reply, the plaintiff has categorically acknowledged that, in the mark “GLUCON-D”, the prefix “Glucon” represented glucose and the suffix “D” represented Vitamin D, as the two constituents of “GLUCON-D”. In the face of this acknowledgement, Mr. Sibal submits that the mark “GLUCON-D” has necessarily to be treated as merely descriptive of the constituents of the product in respect of which the mark is used. The mark was, therefore, he submits, not entitled to registration. Mr. Sibal also relies, in this context, on the judgment in *Marico*<sup>10</sup>, in which the marks “LOSORB/LO-SORB” were held to be descriptive.

**62.3** Mr. Lall submits, *per contra*, that the marks “GLUCON-C” and “GLUCON-D” cannot be treated as descriptive. He submits that the mark “Glucon” is itself descriptive, as it has no etymological meaning. Moreover, he submits that the mere using of a hyphenated suffix “-C” or “-D” with “Glucon” would not invariably inform an unwary



customer of average intelligence and imperfect recollection that the product contains Vitamin C or Vitamin D.

**62.4** Having considered the submission of learned Senior Counsel, I am inclined to agree with Mr. Lall. The present case cannot, in my view, be analogised to situation which obtained in *Marico*<sup>10</sup>, in which the court was concerned with the mark “LO-SORB”, in the context of edible oil, to indicate that the oil was of low absorbing quality, when used in cooking. The relation between the mark, in *Marico*<sup>10</sup>, and the nature of the product in respect of which it was used is, in my opinion, far more direct than the relation between the mark “GLUCON-C” and “GLUCON-D” and the product in respect of which they were used by the plaintiff.

**62.5** When used in the context of edible oil, the quality of low absorption of the oil in the food preparation which is made using it is, unquestionably, a desirable quality. A customer of average intelligence, who notices the mark “LOSORB”, in respect of edible oil, is, therefore, likely to infer that the mark represents low absorbing quality of the oil. As against this, it cannot legitimately be said that a customer of average intelligence would, on espying the mark “GLUCON-D”, immediately come to the conclusion that the product is a combination of glucose and Vitamin D.

**62.6** Even if, *arguendo*, the suffix “GLUCON” were to be presumed to suggest the presence of glucose in the product, it would, in my opinion, be stretching things too far to hold that the suffix “-D” would



also, equally, suggest the presence of Vitamin D in the product. Mr. Lall submits that a mere suffix “-D” or “-C” cannot inform a customer of average intelligence that the product contains Vitamin “D” or Vitamin “C” as the case may be, and I am inclined to agree with him.

**62.7** Mr. Lall has argued, with justification, that “GLUCON-D” can be regarded, at best, as suggestive, not descriptive. In *T.V. Venugopal v. Ushodaya Enterprises Ltd*<sup>62</sup>, the Supreme Court observed thus:

“While determining the nature of the mark - for the purpose of registration or for the purpose of passing-off/infringement, the first inquiry which the court ought to carry out is to determine whether the applicant's/Plaintiff's mark is invented, arbitrary/suggestive, descriptive or generic. The nature of the mark is always determined with respect to the Plaintiff's/applicant's goods.”

Of the four categories of marks identified in the above passage from *T.V. Venugopal*<sup>62</sup>, invented and arbitrary/suggestive marks are registerable, whereas descriptive and generic marks are not. The Supreme Court itself further noted, in this decision, thus:

“The line between suggestive marks and descriptive marks is very thin. Various commentaries including McCarthy have laid down the imagination test to determine as to whether a mark is descriptive or suggestive.”

The characteristic of a suggestive mark, as would distinguish it from a descriptive mark, was thus explained by a coordinate bench of this Court in *Telecare Network India Pvt Ltd v. Asus Technology Pvt Ltd*<sup>63</sup>:

“The category of suggestive marks refers to those marks which are neither exactly descriptive on the one hand, nor truly fanciful on the other. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. If a

<sup>62</sup> (2011) 4 SCC 85

<sup>63</sup> 262 (2019) DLT 101



term is suggestive, it is entitled to registration without proof of secondary meaning. For instance, as pointed out in *Abercrombie & Fitch Co.*<sup>64</sup> the word "Ideal" when used for hair brushes, is in no sense indicative or descriptive of the qualities or characteristics or merits of a brush. It is therefore not descriptive. However, the word "Ideal" for hairbrushes does suggest that the product meets the very highest ideal mental conception of what a hair brush should be and is therefore suggestive.”

**62.8** Applying the above test, in my considered view, extrapolating the name “GLUCON-D” to understand it to refer to a product combining glucose and Vitamin D would require “imagination, thought and perception”. While, therefore, the name could be said to *suggest* the presence of Glucose and Vitamin D, it cannot be said to *describe* it. Section 9(1)(b) forbids *description*, not *suggestion*.

**62.9** Interestingly, the exact word used in Section 9(1)(b) is not even “describe”, but “designate”. “Designate” is an expression which is even more direct, in its etymological connotation, than “describe”. “Designate” is defined, in P. Ramanatha Aiyar’s Law Lexicon, as “to call by a distinctive title; to point out a thing by distinguishing it from others; to express or declare; to “indicate by description or by something known and determinate; to point out, or mark by some particular token; to specify”.

**62.10** It cannot, therefore, be held that the marks “GLUCON-C” or “GLUCON-D” designated, or were descriptive of, the contents of the product in respect of which they were used, or indicated that the products contained glucose with vitamin C or Vitamin D respectively.

<sup>64</sup> 537 F.2d 4, 9 (2nd Cir. 1976)





**62.11** No independent argument, regarding want of distinctiveness in the marks “GLUCON-C” or “GLUCON-D” was advanced by Mr. Sibal, beyond the contention that the marks were descriptive of the contents of the product.

**62.12** As such, I am unable to agree with Mr. Sibal that the marks “GLUCON-C” and “GLUCON-D” were ineligible for registration by virtue of Section 9(1)(a) and (b) of the Trade Marks Act.

**63.** Re: Proviso to Section 9(1) and Section 32 of the Trade Marks Act

**63.1** In view of my finding that the marks “GLUCON-C” and “GLUCON-D” cannot be treated as descriptive within the meaning of Section 9(1) (b) of the Trade Marks Act, no occasion arises for me to examine the applicability of the proviso to Section 9(1).

**63.2** Insofar as Section 32 of the Trade Marks Act is concerned, Mr. Lall’s contention was that, even if the marks “Glucon-C” and “Glucon-D” were to be treated as descriptive, he would be entitled to the protection of Section 32 of the Trade Marks Act. To my mind, Section 32 really does not arise for consideration. Section 32 proscribes declaration of a trade mark as invalid even if it is registered in violation of Section 9(1) of the Trade Marks Act, if, by the date of institution of a challenge against its validity, the mark has acquired distinctiveness by dint of continuous use. There is, *prima facie*, substance in Mr. Lall’s contention that, in view of Section 32, and



keeping in mind the fact that the marks “GLUCON-C” and “GLUCON-D” were registered as far back as in 1975 and, at least insofar as the mark “GLUCON-D” is concerned, it has attained distinctiveness over decades of use and cannot, therefore, be declared invalid at this point of time, even if its registration was in violation of Section 9(1)(a) and Section 9(1)(b).

**63.3** That said, the registration of the marks “GLUCON-C” and “GLUCON-D” are not, in my view, violative of Section 9(1)(a) and Section 9(1)(b) of the Trade Marks Act.

**64.** Whether the defendant would be entitled to the benefit of Section 30(2) (a) or Section 35 of the Trade Marks Act ?

**64.1** Section 30(2)(a) of the Trade Marks Act, to the extent it is relevant, applies where the impugned trade mark is used by the defendant to indicate the kind, quality, quantity, intended purpose or other characteristics of the goods or services of the defendant. Applying this provision, the Division Bench of this Court held, in *Marico*<sup>10</sup>, that where the expression “LOW ABSORB” was used by the defendant, in that case, as part of the phrase “WITH LOW ABSORBING TECHNOLOGY”, the use of the expression was purely descriptive and could not, therefore, be enjoined by plaintiff. Section 30(2)(a) is a complete exception to Section 29. Even if a registered trade mark is copied by the defendants or used by the defendants as it is, such use cannot be enjoined by the proprietor of the registered



trade mark, if the use of the mark by the defendants is purely descriptive in nature.

**64.2** Even on the pleadings in the written statement, as well as the submissions orally advanced by Mr. Amit Sibal, the defendants cannot be held to be entitled to the benefit of this provision, insofar as the impugned marks are concerned. The pleadings in the written statement, as well as the submissions advanced at the bar by Mr. Sibal, are to the effect that, while the impugned marks are not “Gluko-C” or “Gluko-D” but “Prolyte Gluko-C ++” and “Prolyte Gluko-D ++”, the “Gluko-C” and “Gluko-D” parts of those marks are descriptive in nature. The benefit of Section 30(2) (a) of the Trade Marks Act is not available to a part of the mark. The benefit enures only if the entire mark of the defendants, impugned in the suit, is used in a descriptive fashion. Mr. Lall has correctly pointed out that, in the written statement, as well as during arguments advanced at the Bar, the defendants have chosen to contend, to contest the charge of infringement, on the one hand, that their marks are not “Gluko-C” and “Gluko-D” but “Prolyte Gluko-C ++” and “Prolyte Gluko-D ++”, and, on the other, to obtain the benefit of Section 30(2)(a), that “Gluko C” and “Gluko-D” are descriptive in nature. This, he submits, is impermissible, and I entirely agree. Once the defendants adopt a stand that their marks are “Prolyte Gluko-C ++” and “Prolyte Gluko-D ++”, they can seek the benefit of Section 30(2)(a) only if they contend that *the entire mark* “Prolyte Gluko-C ++” or “Prolyte Gluko-D ++” is used in a descriptive fashion. There is no such contention in the written statement; neither has it been so argued by Mr. Sibal at the



Bar. Even if, therefore, it were to be assumed that the “Gluko-C” or “Gluko-D” parts of the marks “Prolyte Gluko-C ++” and “Prolyte Gluko-D ++” were descriptive, that cannot save the marks “Prolyte Gluko-C ++” or “Prolyte Gluko-D ++” themselves from the taint of infringement.

**64.3** There is another aspect of the matter. Mr. Sibal’s contention, predicated on Section 30(2)(a) is not restricted to the “Gluko-C” and “Gluko-D” parts of the defendants’ mark, but extends to “Gluko-C ++” and “Gluko-D ++”. His contention is that the two ++s refer to calcium and the flavour of the product in each case. Mr. Lall sought to disabuse this contention by stating that the presence of calcium and the flavour of the product were separately indicated on the packs. I do not deem it necessary to enter into this factual controversy. Suffice it to state that it cannot, by any stretch of imagination, be held that representing calcium and the flavour of the product by two + signs is descriptive. Even for this reason, the attempt, of Mr. Sibal, to resort to Section 30(2)(a) of the Trade Marks Act must necessarily fail.

**64.4** I may note, here, that, on the face of the packs of the defendant’s products, the following recitals figure:

Re: Prolyte Gluko C ++

“Vitamin C for immunity +  
Calcium for bone health +  
Tangy flavor”

Re: Prolyte Gluko D ++



“Vitamin D for immunity +  
Calcium for bone health +  
Regular flavor”

If one were, therefore, to be educated by what is depicted on the pack of the product, the customer would become aware that the two + signs refer to the presence of calcium and the flavour of the product. The benefit of Section 30(2)(a), however, has to be examined on the basis of the mark *per se*, and not on the basis of the mark seen in the backdrop of recitals contained on the pack on which the mark is used. *De hors* the additional information contained on the face of the packs of the defendants’ product, it cannot be said that a customer of average intelligence would be educated into understanding that one of the + signs represent calcium and the other represents the flavour of the product.

**64.5** In fact, it is precisely because the marks “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++” are *not* by themselves descriptive of the product that the defendants were compelled to indicate separately on the face of the pack that the two + signs denoted the presence of calcium and the flavour of the product. The representation on the defendants’ packs, therefore, themselves belie the contention of Mr. Sibal that the defendants would be entitled to escape an injunction on the basis of Section 30(2)(a) of the Trade Marks Act. At the cost of repetition, there can be no comparison between a mark such as “Prolyte Gluco-C ++” with which we are concerned and “WITH LOW ABSORB TECHNOLOGY”, with which the Division Bench was





concerned in *Marico*<sup>10</sup>. *Marico*<sup>10</sup> cannot, therefore, come to the rescue of Mr. Sibal.

**64.6** *Mutatis mutandis*, this position would also obtain in respect of Section 35 of the Trade Marks Act. Section 35, to the extent it is relevant, proscribes interference with bonafide use, by a person, of “any bonafide description of the character or quality of his goods or services”. The discussion afore-noted clearly indicate that the marks “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++” cannot be regarded as descriptions of the character or quality of the goods of the defendants. The defendants cannot, therefore, seek the benefit of Section 35 of the Trade Marks Act either.

## **65. Conclusion: Re: Infringement**

**65.1** Thus, on the aspect of infringement, the defendants’ mark “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++” *prima facie* infringe the plaintiff’s registered marks “GLUCON-C” and “GLUCON-D” respectively. The submission of Mr. Sibal that the marks “GLUCON-C” and “GLUCON-D” were not entitled to registration by virtue of Section 9(1)(a) and 9(1)(b) of the Trade Marks Act does not, *prima facie*, merit acceptance. The defendants are also not entitled to the benefit of Section 30(2)(a).

## **66. Re: Passing off**



**66.1** In view of my finding, hereinabove, that the trade dress of the defendants' product cannot be treated as deceptively similar to that of the plaintiff, insofar as a customer of average intelligence and imperfect recollection is concerned, the allegation of passing off, levelled by the plaintiff against the defendants, cannot, *prima facie*, sustain. The differences in the trade dresses and appearance of the packs of the plaintiff's GLUCON-D and the defendants' Gluco-C, or Gluco-D, are sufficient to negative, at a *prima facie* stage at least, any possibility of the defendants being able to pass off their product as that of the plaintiff. Equally, it cannot be said that, by using the mark "Prolyte Gluco-C ++" or "Prolyte Gluco-D ++" in conjunction with a trade dress which is not deceptively similar to that of the plaintiff, the defendants are seeking to pass off its product as that of the plaintiff. The fact that, on the face of the product of the defendants, the defendants' identity "Cipla Health Care" is also depicted is an additional factor in that regard.

**66.2** The allegation of passing off, therefore, *prima facie*, cannot sustain.

## Conclusion

**67.** In view of the aforesaid discussion, the plaintiff would be entitled to an injunction against the use, by the defendants, of the mark "Prolyte Gluco-C ++" or "Prolyte Gluco-D ++", as they infringe the plaintiff's registered mark "GLUCON-C" and "GLUCON-D" respectively.



**68.** Accordingly, pending disposal of the suit, the defendants as well as all others acting on their behalf shall stand restrained from using the marks “Gluko-C” or “Gluko-D” either by themselves or as part of the marks “Prolyte Gluko-C ++” or “Prolyte Gluko-D ++” or as part of any other mark which would be deceptively similar to the plaintiff’s registered marks “GLUCON-C” or “GLUCON-D” respectively, in respect of any product which is identical or allied to the products in respect of which the plaintiff uses the registered trade marks “GLUCON-C” and “GLUCON-D” respectively.

**69.** The application stands allowed to the aforesaid extent.

**JULY 3, 2023**

*dsn*

**C. HARI SHANKAR, J.**

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