DuxLegis
Attorneys

IP AY ATTENTION

Gateway to IP World

Newsletter | Issue 17 | May 2024

In This Issue

DuxLegis
Attorneys

IP AY ATTENTION
Gateway to IP World

INDIA - BURBERRY'S TRADEMARK VICTORY: SAFEGUARDING IP RIGHTS IS CRUCIAL

By
Adv. Krutarth Sontakke
Trade Mark Attorney

The legal battle between Burberry Limited and M/s Petrol has revealed the ongoing struggle for brand integrity in the luxury goods market. It has shown that how Protecting intellectual property rights, especially trademarks, which is crucial for maintaining brand identity and consumer trust in the evolving global commerce landscape.

BACKGROUND

The present suit is focused on the Burberry's perfume brands that has been harmed by M/S Petrol's deceptively similar Trade Marks. Burberry's marks namely "MY BURBERRY" and "MR. BURBERRY," has gained tremendous goodwill in the realm of luxury brands and has its own style of trade dress and unique identification. The Burberry claimed that M/S Petrol has adopted deceitful practice against the plaintiff and has misused its goodwill and reputation by selling its perfumes under marks namely "My Petrol" and "Mr. Petrol." The defendant has also obtained registration of its deceptively similar marks (Impugned Marks). Furthermore, the defendants have caused a severe harm to Burberry's brand identification by adopting the same trade dress.

FACTS OF THE CASE

Burberry Limited (Plaintiff), a London based prestigious private limited company, established in 2010 has then expanded its operations into India and formed Burberry India Private Limited. The company deals with all ends to end operations from designing to selling the products under the BURBERRY trademark worldwide through its physical stores, online platform, and various third-party wholesale outlets. The plaintiff has established a strong global existence with a good portfolio of trademarks including BURBERRY, device marks, and various formative marks. Burberry has invested for advertising and marketing and so it had a great response in worldwide launch campaign. As a result, the marks MY BURBERRY and MR. BURBERRY have acquired an immense amount of popularity and recognition. The products have become one of the Plaintiff's well-known fragrances and had great commercial achievement. It has been consistently recognised amongst 'The 100 Best Global Brands' by Interbrand, which is a famous independent brand-ranking organization.

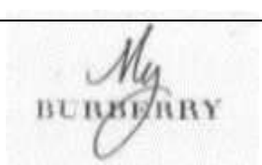
M/S PETROL PERFUME (Defendant), has precedent in the market since 2019 and has been using the impugned marks on identical products, causing confusion and thereby causing harm to the value of the plaintiff's trademarks. The defendant has further imitated the plaintiff's trade dress, and infringed plaintiff's intellectual property rights. The defendant's products have been showing similarity in font, style, colour scheme, presentation, and structure, and deliberately trying to degrade plaintiff's brand identity, mislead consumers, and exploit its established goodwill and reputation.

BURBERRY

SUBMISSION OF THE PARTIES

The plaintiff argues that the defendant's deceitful behaviour regarding the production and distribution of perfumes, fragrances, and associated products bearing their registered trademarks, MR. PETROL and MY PETROL, which are confusingly similar to the plaintiff's marks, are the main cause of the filing suit. Plaintiff also stated that the defendants had adopted the same trade dress, which includes the identical font and writing style, colour scheme, overall appearance, dress, surface pattern, object placement and writing manner, and perfume bottle shape and design (collectively, the "impugned trade dress").

The following is a representation of the contested goods that bear the contested mark, label, or trade dress:

Burberry's Trademarks	M/S Petrol Perfume Trademarks
	
	
	
	

As a result, the Defendants' disputed marks, labels, and trade dress are identical/deceptively similar to the Plaintiff's. Furthermore, because the impugned marks are used for identical products, there is a considerable risk of market confusion and loss of the Plaintiff's marks. In such instances, the Plaintiff has filed this lawsuit to protect their marks. Additionally, it is submitted that the Defendants are habitual infringers and they have adopted this strategy of counterfeiting products and imitating the marks/trade dress of some reputed companies that have already gained market recognition and reputation. This Court has previously restrained similar counterfeiting conduct, and copies of those restraint orders have been submitted with the plaint.

The defendants argued that their registered marks, "MY PETROL" and "MR. PETROL," are distinct from the plaintiffs "MY BURBERRY" and "MR. BURBERRY," as there is no similarity between their prominent parts. The defendants also argued that there is a significant difference in the pricing of their competing products, ensuring no confusion in the market. They also claim that the defendants have adopted their registered marks with bona fide intent, and therefore, no injunction should be granted. The defendants argued that the plaintiff knew about the defendant's existence in the market since 2019.

COURT'S DECISION

The plaintiff's marks "MY BURBERRY" and "MR. BURBERRY" won the initial stage of the legal battle, which restricted the defendants, their representatives, or anyone acting on their behalf from using, manufacturing, marketing, importing, exporting, or engaging in any other manner in the physical or digital marketplace under the dispute marks "MY PETROL" and "MR. PETROL." Additionally, the plaintiffs were prohibited from violating Burberry's copyright/labels, passing off, common law rights, trade dress violations, trade-name rights, and engaging in deception, unfair, and unlawful trade practices that could affect Burberry's rights until further orders after February 28, 2024. Plaintiff's well-earned goodwill and reputation had been negatively impacted by the defendants' activities, which the Court found to be passing off and a violation of the Plaintiff's intellectual property rights, even though the defendants claimed that their mark registration was legitimate.

The Court arrived at the ruling mentioned above based on its prima facie belief that the defendant's choice of font, "MY PETROL" and "MR. PETROL," demonstrates total dishonesty in the mere comparison of the products are identical to Plaintiff's "MY BURBERRY" and "MR. BURBERRY." The further unlawful adoption of trade dress by the defendant is identical to the plaintiff's adopted trade dress; using such deceptively similar marks prima facie shows mala fide on the part of the defendants.

The Hon'ble precedent judgement of Supreme Courts of **S. Syed Mohideen vs P. Sulochana Bai [(2016) 2 SCC 683],** in this judgement the apex court discussed about the requirements to be established for initiating an action on passing off and held as follows,- *"Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage."* The court indicated that

the plaintiff has the option of seeking an interim injunction on passing off, which is a wider common law right, instead of filing an infringement lawsuit. The facts of the case made all the requirements of passing off clear. In light of this, the defendant's acts were prohibited by the court because of passing off and the obvious and unjust benefit that the plaintiff's trademarks, labels, and trade dress represented.

CONCLUSION

This is a legal victory for Burberry, which highlights the importance of trade dress in defining a brand's unique identity in the current competitive marketplace. This decision sets an important precedent concerning the value of trademark enforcement and protection. It clarifies the promise of the brands to maintain their reputation as the leading influence in the premium fashion realm. For the brands that are facing similar challenges when it comes to protecting their intellectual property rights and hard-earned brand reputation, this decision will definitely provide a ray of hope.

WORLD IP DAY CELEBRATION – 2024 & INDIA'S SEMICONDUCTOR MISSION

Adv. Divyendu Verma

WIPO (World Intellectual Property Organization) was established in 1967 and became one of the specialized agencies of the United Nations system in 1974. The main purpose of WIPO is to develop a balanced and approachable international intellectual property (IP) system, which rewards creativity, encourages innovation and contributes to economic development while safeguarding the public interest for all countries associated with WIPO. In 2000, WIPO's member states designated April 26, the day on which the WIPO Convention came into force in 1970, as a day to celebrate World IP Day.

India, a WIPO member since 1998, joins in celebrating World IP Day each year. The theme for World Intellectual Property Day 2024 is "IP and the Sustainable Development Goals (SDGs): Building our common future with innovation and creativity."

World IP Day honors the role of IP in driving global innovation and creativity. Recognizing the link between IP and sustainable development is crucial as countries pursue the United Nations' Sustainable Development Goals (SDGs). Intellectual property rights play a vital role in promoting economic growth, social advancement, and environmental sustainability.

UNDERSTANDING INTELLECTUAL PROPERTY:

Intellectual property encompasses a range of intangible assets, including patents, trademarks, copyrights, and trade secrets. These rights provide creators and innovators with exclusive control over their inventions, artistic works, and brands, incentivizing investment in research and development and rewarding innovation.

THE ROLE OF IP IN ACHIEVING THE SDGS:

ERADICATING POVERTY (SDG 1):

Intellectualproperty can facilitate access to essential resources and technologies, enabling poverty alleviation initiatives. For example, patents on life-saving medicines can incentivize pharmaceutical companies to invest in research and development for diseases prevalent in developing countries.

SUSTAINABLE AGRICULTURE AND FOOD SECURITY (SDG 2):

Patents on agricultural innovations, such as drought-resistant crops or sustainable farming techniques, incentivize investment in agricultural research and development. By protecting intellectual property, farmers and agribusinesses can secure their rights to innovative technologies, leading to increased productivity and food production.

PROMOTING HEALTH AND WELL-BEING (SDG 3):

Patents and trademarks play a crucial role in healthcare innovation and the delivery of medical services. IP rights ensure that inventors and pharmaceutical companies are rewarded for their contributions, encouraging the development of new drugs, vaccines, and medical technologies.

ENSURING QUALITY EDUCATION (SDG 4):

Copyright protection supports the dissemination of educational materials, fostering access to knowledge and promoting lifelong learning. By safeguarding the rights of authors and publishers, IP encourages the creation and distribution of educational resources, including textbooks, online courses, and academic journals.

ADVANCING GENDER EQUALITY (SDG 5):

Intellectual property can empower women entrepreneurs and innovators by protecting their inventions, designs, and creative works. By securing IP rights, women have the opportunity to participate more actively in economic activities and access markets traditionally dominated by men.

CHALLENGES AND OPPORTUNITIES:

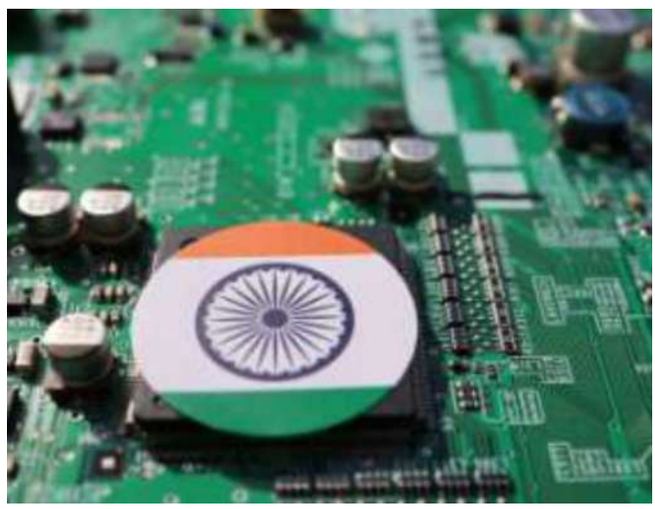
Intellectual property (IP) holds promise for sustainable development but also presents challenges. Restrictive IP regimes, especially in healthcare and agriculture, can impede access to vital technologies and knowledge. Balancing incentives for innovation with equitable access to essential goods and services is crucial. Capacity-building efforts are essential in enabling developing countries to leverage IP for sustainable development, including raising awareness, building institutional capacity, and providing technical assistance.

INDIA'S RESPONSE TO CHALLENGES:

India recently enacted significant amendments to its Patent Rules, effective March 15, 2024, aligning them with global standards to encourage innovation while protecting inventors' rights. These changes are expected to stimulate patent filings nationwide. Domestic patent applications have surpassed foreign ones for the first time, with state of Maharashtra leading in 2023 but the state of Tamil Nadu taking the top spot in 2024. Despite this, Maharashtra remains dominant in overall IP filings, supported by cities like Bengaluru and Hyderabad.

STRATEGIES FOR STATE OF MAHARASHTRA'S SUCCESS:

Maharashtra aims to sustain its IP leadership by embracing initiatives like the India Semiconductor Mission, aligning with India's ambition to become a global semiconductor manufacturing hub. However, challenges remain, highlighted by Taiwan's Minister of Foreign Affairs, Joseph Wu. Streamlining administrative structures, reducing tariffs, and improving infrastructure are crucial to attracting semiconductor investments. Specialized infrastructure, upskilling programs, and collaborations with universities like Dr. Homi Bhabha State University can support Maharashtra's semiconductor industry growth.



CONCLUSION:

India is committed to leveraging IP for sustainable development and economic growth. Through initiatives like the India Semiconductor Mission and strategic investments in semiconductor infrastructure and workforce development, specifically the state of Maharashtra aims to maintain its leadership in IP filings and contribute significantly to India's innovation narrative. Proactive governance and stakeholder collaborations will position the State of Maharashtra as a hub of innovation and a driver of India's technological advancement globally.

CULTIVATING WOMEN LEADERSHIP – WOMEN IN IP – GLOBAL NETWORKING EVENT 2024 IN MUMBAI AT DR. HOMI BHABHA STATE UNIVERSITY MUMBAI HOSTED BY DUXLEGIS ATTORNEYS

DuxLegis is excited to share the highlights from the recent American Intellectual Property Law Association (AIPLA) Women in IP - Global Network Event 2024 in Mumbai, hosted at the Dr. Homi Bhabha State University, Mumbai campus by DuxLegis Attorneys.

We were honored to welcome Prof. (Dr.) RAJANISH KAMAT as our chief guest and speaker, alongside esteemed speakers including renowned political journalist RAHI BHIDE, Social Activist & Founder of Responsible Netism - SONALI PATANKAR, Group General Counsel of ACG Group - RASHMI MISHRA, and GenioBrain IP founder - ASHA HOLE.

होमी भाभा विद्यापीठाचे कुलगुरु रजनीश कामत यांचे मत

महिलांसाठीच्या कार्यक्रमांवर भर हवा!

The theme for this year's event was "Cultivating Leaders". During the discussion, Dr. Kamat emphasized the need to bridge the gap in female representation across all fields. He shared recent statistics from WIPO and IPO on the number of women as inventors and highlighted special programs at his university aimed at promoting women innovators and inventors.

Rashmi spoke about her professional journey and challenges she faced in her career and her efforts to ensure equal participation for women within her organization. Rahi shared insights from her years of advocacy for women's advancement in Indian society and discussed the necessary steps to cultivate more women leaders. Sonali discussed her work in the social sector and her efforts to create inclusive spaces online for people from all walks of life. Asha shared her experiences as a first-generation entrepreneur and outlined the path forward for women leaders in Indian society.

The event provided a truly inspiring experience that reshaped perspectives on leadership and reignited a sense of passion for professional growth and empowerment.
The annual Global Networking Event brings together participants from all walks of life as well as intellectual property practitioners from around the world for a day of networking, education, and meaningful connections.

The event concluded with additional discussions on the topics over evening snacks and coffee.
A heartfelt thank you to everyone who participated, and gratitude to Prof. Kamat for co-hosting the event on his beautiful campus.

Post on LinkedIn:
https://www.linkedin.com/posts/duxlegis_wipne-wipne2024-aipla-activity-7187035847572017152-e_HU?utm_source=share&utm_medium=member_desktop

IP SNIPPETS:

PATENT CASES:

SULZER MIXPAC AG (Appellant) vs. ASSISTANT CONTROLLER OF PATENTS AND DESIGNS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 19/2021
Decided on: April 05, 2024

In the present appeal, the appellant had filed an appeal at Hon'ble Delhi High Court w.r.t the rejection of the patent application by the respondent on the ground of lack of novelty and inventive step under Section 2(1)(j) of the Act. The present application bearing application no. 1329/DEL/2012 entitled "STATIC MIXER". Objections were raised in the First Examination Report (FER) citing four prior art documents D1-D4 to which the appellant submitted the detailed response. Following to which hearing was fixed maintaining the objection, subsequently written submission was filed by the appellant along with amended claims further to which the respondent rejected the invention.

The Appellant argued relying upon a prior art EP1426099B1 and differentiating that the subject invention introduces multiple installation bodies in series, which are connected with the common bar elements running through all the installation bodies and connecting them together. The respondent argued by stating that the appellant is comparing the subject invention with EP1426099B1 and not with their own cited prior arts D1-D4. The respondent also argued that the inventiveness claimed by the Appellant is also disclosed in the prior art documents D1-D4. The Appellant had also argued that the European Patent Search Report categorizes the prior art documents D1-D4 in Category A, defining them as state of art not considered as prejudicial for novelty and inventive steps in the European jurisdiction and, therefore, ought not to have been considered in India itself. To which the respondent argued that the patent search reports are meant for guidance to a patent applicant and are not precluded from being considered and cited as prior art for a patent application.

The Hon'ble Delhi High Court observed the matter and stated that the prior art documents cited by the respondent rightly reveals and teaches the subject invention. The Court also states that the Appellant did not provide any data or comparative assessment w.r.t the prior art document D1-D4 and the comparison was done only with the prior art EP1426099B1. The Hon'ble Court further concludes that patent jurisprudence is territorial in nature and patent applications have to be considered on their own merits within every jurisdiction.

GOOGLE LLC (Appellant) vs. THE CONTROLLER OF PATENTS (Respondents)

Case Number: C.A.(COMM.IPD-PAT) 395/2022
Decided on: April 02, 2024

The current appeal has been filed by the appellant w.r.t the rejection of the patent application, bearing application no. 5429/DELNP/2007 titled *'Managing Instant Messaging Sessions on Multiple Devices'*. on the grounds that the invention lacks novelty and inventive step, and is not patentable under Section 3(k) of the Act..
The Appellant argued that respondent's objections were based on the teaching of only one prior art document (i.e., D1) in which the two main features of the subject patent application were not disclosed. The Appellant also stated that the present application has been granted in USA and Canada. The respondent argued that the Appellant was attempting to obtain a monopoly on the features of receiving of a preference and also the conscious preference of the user to trigger the instant messaging feature i.e. not to mirror the same content in two devices, these functionalities are clearly disclosed in the prior art document. The Court had further discovered that the Appellant has suppressed information about the abandonment of the corresponding European Patent application.
The Hon'ble Delhi High Court observed the following matter and stated that the comparison of the subject patent application to the prior art D1 clearly establishes the lack of inventive step and the patent application is also obvious to a person skilled in the art. The Court rejected the grant of patent application with a view of lack of inventive step. The Hon'ble Court also considered the submissions made by the Appellant regarding the abandonment of the present application before EPO and discovered the fact that the Appellant in the present appeal had not only presented wrong facts to the Court, but also failed to disclose the information regarding the refusal of the EU parent application as also of the divisional application which was filed consequently. The Court further concluded by dismissing the present appeal with a cost of Rs. 1 lakh upon the Appellant. Of which 50% of the costs shall be deposited with the office of CGPTDM and the remaining 50% shall be paid to the ld. CGSC.

DESIGN CASES

PARDEEP KUMAR PROPRIETOR OF T.G. SOLAR PUMP (Appellant) vs. PRAKASH ENTERPRISES & ORS. (Respondents)

Case Number: FAO (COMM) 65/2024 & CMAPPL. 21504-05/2024
Decided on: April 10, 2024

The present appeal has been filed by the appellant for declining the request to restrain the respondents from infringing the appellant's registered designs. The appellant's application under Order 39 Rule 1 & 2 of the Code of Civil Procedure, 1908 (hereafter the CPC) has not been rejected, however his request for ad interim order to the aforesaid effect was not acceded to. The appellant had also filed the application for appointment of the local commissioner under Order 26 Rule 9 of the CPC.

The appellant had filed registered designs in respect of Solar Panel Trolleys (hereafter SPT) and the appellant had claimed that the respondents were fabricating similar SPTs. The appellant had also set out the images for comparison of his SPT constructed in accordance with the registered design with the similar SPT fabricated by the respondents. The appellant had previously filed a police complaint against respondent no. 1 for infringing the appellant's design and to which the respondent no.1 had given an undertaking that he would not infringe the appellant's registered designs. The learned Commercial Court had noted all the points placed on record by the appellant and also that no cease-and-desist notice was issued to respondent no.2. The ad interim order sought by the appellant was also denied on the ground that the appellant did not place any proof establishing that the design manufactured and sold by the respondent no.2 to 6 were not registered. The learned Commercial Court had also noticed that the invoices placed on record by the appellant in respect of the SPTs sold by the respondents did not mention the design or details.

The Hon'ble Delhi High Court observed the following matter and stated they were unable to accept that the ad interim order could be denied on the basis that the appellant did not place any proof indicating that the respondents design were not registered, even though the appellant had provided details of their registered deign and there was no material to indicate that any of the SPTs manufactured by the respondents were based on the design registered in their favour. The Court concluded by stating the learned Commercial Court to consider the matter afresh and in particular the application for the appointment of the local commissioner without issuing any notice to the respondents.

TRADEMARK CASES

GSK CONSUMER HEALTHCARE S.A. (Petitioner) vs CELEBRITY BIOPHARMA LTD. AND ANR. (Respondents)

Case No.: C.O. (COMM.IPD-TM) 154/2021
Decided On: March 22, 2024

Otrivin
Breathe your Best.

The present rectification/cancellation petition was filed by the Petitioner to remove the deceptively and phonetically similar mark of the Respondents. The Petitioner submitted that "OTRINIR" is phonetically, structurally and visually similar to the Petitioner's mark "OTRIVIN", which is likely to cause confusion and deception amongst the general public and trade. The Petitioner is the prior adopter of the mark "OTRIVIN", which has achieved the status of a well-known mark on account of the Petitioner's extensive and continuous use. The Respondent asserted that they have used "OTRI" word which is generic and derived from the different term as a prefix before word "NIR" originates from the name of the director NIRAJ KUMAR NIR. The Respondent further argued that the Court must apply the "anti-dissection rule", which requires marks to be compared in their entirety rather than segmented into parts.

In the present case, Hon'ble Delhi High Court observed that holistic comparison of "OTRIVIN" and "OTRINIR" reveals significant phonetic, structural, and visual similarities that are likely to cause confusion among consumers, who may mistakenly believe the products are associated or originating from the same source.

In view of the above analysis, the Court finds that the registration of the Impugned Mark violates Section 9(2)(a) and Section 11(1), 11(2) read with Section 18 of the Act, and is thus liable to be removed from the Register under Section 57 of the Act.

APL APOLLO TUBES LIMITED (Plaintiff) vs M/S STEEL TRACK & ORS. (Defendants)

Decided On: CS(COMM) 488/2023, I.A. 13246/2023
Date of Decision: April 01, 2024

APOLLO TMT

APL APOLLO STEEL PIPES

The present suit was filed by the Plaintiff against Defendants to restrain infringing and passing off of the mark "APOLO" and its formative versions.

Plaintiff has gained tremendous goodwill among the market and has proved it while claiming the right over the

said mark. While the Defendants contended that they are using the impugned mark for the different goods though it falls under the same class and claimed that the Plaintiff filed the suit with the gross delay, and this shows that Plaintiff has accepted the use of the impugned mark by Defendants.

In the Hon'ble Delhi High Court's prima facie view, there is a remarkable similarity between the goods offered by the Plaintiff and the Defendants. It was further found that if no ad-interim injunction is granted in favour of the Plaintiff then it will suffer an irreparable loss; balance of convenience also lies in favour of the Plaintiff and against the Defendants. If Defendants are permitted to sell products under the Impugned Marks, it is likely to cause irreparable damage and injury to Plaintiff's business and reputation. Hence Hon'ble court retrained the Defendants from using, selling, advertising the goods under the said trademarks.

HALDIRAM INDIA PVT. LTD (Plaintiff) vs BERACHAH SALES CORPORATION & ORS. (Defendants)

Case No.: CS(COMM) 495/2019 & I.A. Nos. 12513/2019, 14284/2019, 2650/2021, 14468/2022
Decided On: April 02, 2024

The present suit has been filed by the plaintiff against the defendants for infringing its mark "HALDIRAM."

Plaintiff's grievance was that defendants initially incorporated a company by the name 'Haldiram Restro Pvt. Ltd.' and when plaintiff conducted a search of the applications filed by defendants, it found that in 2018, Defendant 5, claiming to be the owner of Defendant 1 firm, Berachah Sales Corporation., applied for the 'HALDIRAM BHUJIAWALA' mark in class 43 for services for providing food and drink, temporary accommodation and for marks 'HALDIRAM'S' and 'HALDIRAM HOTELS'. On the other hand, the Defendants argued that there were 36 companies registered under the Companies Act, 2013 with similar names, many operating in the same industry. Since Haldiram did not object to these companies nor contest Berachah's use of the said mark, they argued their use of the name should not be restricted. The bench noted that considering numerous registrations and extensive usage of the mark by Haldiram, coupled with its goodwill, the court granted a permanent injunction in favor of Haldiram. Berachah was instructed to surrender all materials bearing the impugned marks for destruction within one week and further held, *"A decree of declaration declaring the mark 'HALDIRAM', as well as the Oval-shaped mark, as a 'well-known' mark in respect of food items as well as in respect of restaurants and eateries, is granted".* The Hon'ble court ordered Trade Marks Registry.

CROCS INC (Petitioner)vs THE REGISTRAR OF TRADEMARKS NEW DELHI & ANR. (Respondents)

Case Number: C.O. (COMM.IPD-TM) 779/2022 & I.A. 20390/2022
Decided On: April 08, 2024

The Petitioner had filed rectification/cancellation petition for removal of the trademark "CROCSCLUB".

The Petitioner has claimed that its mark has gained substantial goodwill and reputation amongst the market and e-commerce platforms. Despite all attempts of service to Respondent no. 2, there is no appearance on behalf of Respondent no. 2. Since Respondent no. 2 has chosen not to appear.

Hon'ble Delhi High Court observed that, it is undisputed that the petitioner's product using the trademark 'CROCS' has garnered absolute reputation in terms of its product. The court further observed the fact that petitioner's trademark is totally subsumed by the impugned trademark, the likelihood of confusion, plus the risk of association with the petitioner's trademark(s) and goods. Hence by considering the facts, Hon'ble Delhi High Court has ordered to remove the impugned trademark from the register of trademarks and accordingly update the same within 6 weeks of the order.

EMAMI LIMITED (Petitioner) vs HINDUSTAN UNILEVER LIMITED (Respondent)

Case Number: (CS COMM)/189/2024
Decided on.: April 09, 2024

The present petition has been filed by the Petitioner expressing concern about possible trademark infringement and passing off by the Respondent.

The Petitioner is a prominent entity in the skincare industry and has had a strong brand presence for a long time. It is alleged by the Petitioner that the Respondent's use of the mark "Glow and Handsome" constitutes infringement of the petitioner's mark "Fair and Handsome". "Glow and Handsome" is deceptively similar to the petitioner's registered mark. "Handsome" being a prominent, leading, and essential feature of the petitioner's mark, has also acquired distinctiveness and a secondary meaning. On the contrary, the Respondent contended that the mark "Handsome" is purely descriptive

and incapable of any distinctiveness. “Handsome” is a generic term also used by other competitors in the industry. In any event, “Handsome” is not exclusively identified with the petitioner and the petitioner has never used the mark “Handsome” as a standalone mark. The Court observed that the respondent's adoption of the mark “Glow and Handsome,” despite being aware of Emami's brand, suggested an intentional attempt to capitalize on Emami's goodwill. The Court emphasized, “Words and terms which are prima facie descriptive may in certain circumstances by use and reputation acquire a secondary distinctive meaning before they are monopolized.” Hence despite the absence of infringement, the Court ruled in favour of the petitioner on the grounds of passing off, granting them relief in the form of an injunction against respondent.

MALLCOM (INDIA) LIMITED (Plaintiff) vs SHANTI UDYOG WELDSAFE PRIVATE LIMITED & ORS. (Defendants)

Case Number: CS(COMM) 85/2024 & I.A. 5877/2024
Decided on: April 10, 2024

The present suit was filed by the plaintiff against the defendants for seeking protection for its marks.

The Plaintiff contended that the Impugned mark was registered in a dishonest, wrongful, and unlawful manner, arguing that it is identical or deceptively similar to their registered trademark "TIGER". This alleged infringement violates the Plaintiff's long-established trademark rights in the field of safety shoes, thereby potentially misleading consumers and diluting the Plaintiff's brand.

The Hon'ble Delhi High Court observed that the Plaintiff had not only applied for, but also secured registration of the trademark "TIGER" well before the Defendants began using it. This prior registration necessitated that the Defendants should have conducted a thorough search of the trademark register before adopting any mark incorporating the word 'TIGER.' Thus, the plea of honest adoption of arbitrary term 'TIGER' for safety shoes cannot be accepted.

In addition to the above, the Hon'ble Court directed Defendants to takedown the website hosted on the domain name www.cdtiger.com. Further, considering the fact that Defendants' mark was registered since 2014, the court permitted Defendants to reduce their existing stock of goods, which are fully manufactured, bearing the mark “CD TIGER/ ”, within four weeks, and to file an affidavit giving complete details of stock, including batch numbers, of the goods manufactured, within two weeks. It clarified that no further manufacturing shall be undertaken under the impugned mark.

902, Kamdhenu Commerz, Sector - 14, Kharghar, Navi Mumbai - 410210. MH, INDIA
+91 22 46083609 / +91 83739 80620
info@duxlegis.com

www.duxlegis.com

Editorial Board

This Newsletter is published by DuxLegis Attorneys from 902,Kamdhenu Commerz, Sector 14, Kharghar, Navi Mumbai, Maharashtra,India on 6th May, 2024.