IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION [L] NO. 33099 OF 2024
IN
COMMERCIAL IP SUIT [L] NO. 32952 OF 2024

Marico Limited. ...Plaintiff.

Versus

Zee Hygine Products Pvt Ltd and Others. ...Defendants.

Hiren Kamod i/b Nishad Nadkarni, Aasif Navodia, Khusbhoo Jhunjhunwala, Jaanvi Chopra and Rakshita Singh for the Plaintiff.
Harsh Desai for the Defendants.

Coram : Sharmila U. Deshmukh, J.
Reserved on : June 16, 2025
Pronounced on : June 25, 2025.

ORDER :

1. This is an action for infringement of Plaintiff's trade mark and copyright and passing off and the interim application has been moved after notice to Defendant seeking interim reliefs. Though the interim application seeks relief in respect of passing off, in the absence of leave being granted under Clause XIV of Letters Patent(Bombay) which application is still pending, the Court has considered the submissions on infringement of trade mark and copyright.

FACTUAL MATRIX:

2. The Plaintiff has come with the case of infringement of the

Plaintiff's three registered trade marks/trade dress, copyright in the artistic work and passing off of three products i.e. "PARACHUTE", "PARACHUTE ADVANSED" AND "PARACHUTE JASMINE/PARACHUTE ADVANSED JASMINE".

3. It is submitted that in the year 1948, the Plaintiff's predecessor adopted the mark "PARACHUTE" which has been used openly and extensively since then. The Plaintiff's edible coconut oil product is sold under the trade mark "PARACHUTE" in a unique and distinctive packaging / trade dress in distinctive shaped bottles/containers of distinctive shade of blue with distinctive flag device inside which the mark "PARACHUTE" is written, a distinctive drop device engraved on the bottle and with the device of broken coconut. The Flag device with green border against blue background with device of coconut tree in green with "PARACHUTE" written in a distinctive font in white colour was introduced in the year 1997. The device mark was thereafter evolved to introduce the device of white broken coconut depicting coconut oil oozing out of it with the words 100% coconut oil written on the lower portion. The Plaintiff states that it is the registered proprietor of the mark "PARACHUTE" and the device marks having obtained registrations under the Trade Marks Act, 1999. The Plaintiff is the owner of all copyrights subsisting in the original artistic works being Flag Device, Parachute Tree Device as well as Broken Coconut

Device. The Flag Device has been declared as well known trademark as published in the Trade Marks Journal on 24th February, 2024.

4. The Plaintiff's hair oil containing coconut oil is sold under the "PARACHUTE ADVANSED" trade mark which was adopted as formative mark since the year 2007 and another variant being "PARACHUTE ADVANSED GOLD" was introduced in the year 2019 with the unique distinctive artistic work retaining the essential features. The Plaintiff is the registered proprietor of the device mark and the registration certificates have been annexed to the plaint.

5. In the year 2000, the Plaintiff launched its product under the brand "PARACHUTE JASMINE" with a stylised representation of the logo mark "JASMINE". The product was marketed in distinctive trade dress with distinctive colour combination of blue and white, the flag device with jasmine flowers scattered on the label in a specific placement and layout. The artwork was revised in the year 2005-2006 by inclusion of broken brown coconut on the label while retaining the essential features thereof. In 2009-2010, the Plaintiff introduced the enhanced version of "PARACHUTE JASMINE" under the brand "PARACHUTE ADVANSED JASMINE" with the distinctive trade dress with slight modification including the introduction of Plaintiffs mark ADVANSED. In 2010-2011, the Plaintiff decided to adopt and extend the use of its Jasmine soap label for its hair oil product sold under the

brand “PARACHUTE ADVANSED JASMINE” with slight modifications in the label including depiction of two halves of a broken brown coconut, the image of a model and the jasmine flowers in a unique string pattern starting from the base of the label and partly encircling the model in an upward curvature. The bottle/container was a transparent bottle with distinctive blue cap. There has been subsequent variations in the label/trade dress while retaining the essential features. The Plaintiff has obtained registrations for the label mark and is the owner in the copyrights subsisting in the original artistic works.

6. To demonstrate the goodwill and reputation earned by the Plaintiff, the sales turn over for the year 2023-24 is stated to be about Rs.2,037 crore and promotional expenses are about Rs.13 crore. An indicative list of awards bestowed on the Plaintiff are set out in paragraph 5 of the plaint. The Plaint contains the indicative list of the Plaintiff’s registration in Class 3 and 29 in respect of the word mark, device mark/label with the registration certificates appended thereto.

7. It is submitted that in or about April 2010, the Plaintiff came across a trade mark application filed by Defendant No. 1 in Class 29 for the mark “UNIQ-PURE-COCO” with the user claim from 1st October 2007. The said application came to be opposed by the Plaintiff and no counter statement was filed and accordingly the said Application was deemed to be abandoned as the Plaintiff did not come across actual

products of the Defendant at that time and the application did not proceed further. In paragraph 75 of the plaint, the details of the Defendant No.1's various applications for registration is set out and out of nine applications, four applications are abandoned, three are withdrawn including "Jasmine" mark and two device marks are registered which are not relevant to the present subject mark.

8. In or around September 2017, the Plaintiff came across another trade mark application filed by Defendant No. 1 in Class 5 for the mark "COCO-PLUS" with the user claim form 1st April 2005 which is opposed by the Plaintiff and pending adjudication. In or about February 2021, the Plaintiff came across range of oil products manufactured and marketed by Defendant No.1 bearing the mark "COCOPLUS", "COCO PLUS JASMINE" and "COCOPLUS AMLA" bearing the marks/labels/ packaging and overall trade dress which was in blatant violation of the Plaintiff's registered trade marks / labels / bottles / containers/ trade dress. On 18th February 2021, a cease and desist notice was issued to Defendant No. 1 and in view of the pandemic prevailing circumstances, the Plaintiff was not in a position to ascertain whether the Defendant had complied with the Plaintiff's requisition. On 17th April 2021, second notice was issued to the Defendant to which there was no response. It is submitted that upon discreet preliminary investigation, the Plaintiff became aware that the Defendant Nos.2 to 4 were

manufacturing and supplying the impugned bottles / containers to the Defendant No. 1 for the sale of impugned products and hence cease and desist notice was issued to the Defendant Nos.2 to 4 on 15th March 2021 to which there was no response.

9. It is submitted that the Plaintiff was unable to ascertain whether the Defendant's aforesaid products were available in market or not as it did not come across the products even though the websites seem to depict them as the effects of pandemic continued. In or around September 2024, the Plaintiff once again came across the impugned products sold by the Defendant No. 1 in violation of the Plaintiff's proprietary rights in its mark / labels / packing/ bottles/ containers and trade dress leading to the filing of present suit. It is submitted that prior to the filing of suit, the Plaintiff conducted search on the website of Trademarks Registry which revealed that the Defendant No.1 has fraudulently obtained registration of a device mark.

10. The affidavit-in-reply states that the Defendant is involved in the same business since 1994 and since 2005 is promoting its product under the brand "COCOPLUS" which is registered with user claim since 2005 and is subject matter of challenge in rectification application filed by the Plaintiff after institution of the instant suit. The combined turnover of the Defendant in respect of "COCOPLUS Jasmine Hair Oil", "COCOPLUS Amla Hair Oil" and COCOPLUS Coconut Hair Oil" is set out

in paragraph 8. It is stated that the Defendant's mark of COCOPLUS has no similarity with the Plaintiff's marks and there is no copying of the Plaintiff's label/trade dress/packaging and if there is any, the same is merely coincidental and generic in nature. It is submitted that balance of convenience is in favour of the Defendant as the cease and desist notice was sent in February, 2021 nearly a year into the pandemic restrictions. It is submitted that the Defendant has suffered irreparable loss as its goodwill and reputation has been damaged.

11. The affidavit-in-rejoinder reiterates the earlier pleadings and specifically pleads that the registration of the Defendant's mark is *ex facie* illegal, fraudulent and of such a nature as would shock the conscience of the Court and that the label/packaging used by the Defendants is different from its registered trade mark. It is stated that the Defendant is a habitual infringer by pointing out the Defendant's other products which are blatant copies of trademark of other parties.

SUBMISSIONS:

12. Mr. Hiren Kamod, learned Counsel appearing for the Plaintiff has taken this Court through the rival products to point out the essential features of the Plaintiff's trade mark i.e. flag device, tree device, two broken coconuts, the drop device, colour combination of blue, green and white and would submit that the Defendant has blatantly copied the Plaintiff's device mark/trade dress/packaging. He points out the

sale figures and invoices from the year 1993 and the advertisement material to demonstrate the goodwill and reputation enjoyed by the Plaintiff. To demonstrate the vigilance in protecting its trade mark, compilation of Court orders have been tendered. He submits that the arbitrary adoption of colour scheme is unique and distinctive and the Defendant has copied the Plaintiff's trademarks / labels / packaging and the over all trade dress as well as the shape of bottles and containers which were unique to the Plaintiff's products. He submits that defence of word "COCO-PLUS" being different from Plaintiff's brand name is immaterial as the labelmark and trade dress have been copied. He submits that the defence of section 28(3) of the Trade Marks Act, 1999 is not available to the Defendant as the same is *ex facie* illegal and in violation of Section 11 of the Act which provides for relative ground for refusal of registration in respect of trade mark which is identical or similar to earlier trade mark which will result in confusion on the part of public. He would submit that though rectification Application is pending, under Section 124(5) of Trade Marks Act, the interlocutory application can be taken up for hearing. He points out that most of the Defendant's applications for registration have been withdrawn or abandoned. He submits that invoices produced by the Defendant do not indicate prior user. He submits that the submission of similarity being mere coincidence and

generic in nature cannot be accepted as in passing off action, intention is immaterial. He submits that Defendant claims that balance of convenience is in his favour on account of delay, which cannot be accepted in view of the settled position in law that the delay is not a ground available in infringement action. In support, he relies upon following decisions :

- ***Xotik Frujus Pvt Ltd v. Bubalus Beverages[1] ;***
- ***Pidilite Industries Ltd. v. S. M. Associates[2] ;***
- ***Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt. Ltd[3].***
- ***S. Syed Mohideen v. P. Sulochana Bai[4] ;***
- ***Pidilite Industries Ltd. v. Pom a-Ex Products[5] ;***
- ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia[6] ;***
- ***Jagdish Gopal Kamath v. Lime & Chilli Hospitality Services[7] ;***
- ***Pidilite Industries Ltd. v. Riya Chemy[8]***
- ***Schering Corporation v. Kilitch Co. (Pharma) Pvt. Ltd[9].***
- ***Skol Breweries Ltd. v. Som Distilleries & Breweries Ltd and Shaw Wallace & Co., Ltd[10].***

13. *Per contra* Mr. Desai, learned Counsel appearing for the Defendants submits that balance of convenience is in favour of the

1 IA (L) No. 24055 of 2021 in COMIP Suit No. 448 of 2021.
2 2003 SCC OnLine Bom 143.
3 2003 SCC OnLine Del 1005.
4 (2016) 2 SCC 683.
5 2017 SCC OnLine Bom 7237.
6 (2004) 3 SCC 90.
7 2015 SCC OnLine Bom 531.
8 2022 SCC OnLine Bom 5077.
9 1990 SCC OnLine Bom 425.
10 2011 Vol. 113 (5) Bom. L.R. 3257.

Defendants and irreparable damage has been caused to the Defendants due to filing of suit. He submits that the goodwill and reputation built by the Defendants has been damaged by reason of impleading the manufacturers of Defendants and has caused irreparable loss and prejudice to the Defendants. He would further submit that Court orders relied upon by Mr. Kamod are *ex parte* orders. He submits that word mark and the device mark of palm tree, broken coconut device and word mark JASMINE are purely descriptive. He submits that the Defendant has been using the trade mark / trade dress/device mark since the year 2008 which is common to the trade. He would further submit that the broken coconut device is not on every bottle/container of Defendant and there is no slavish imitation of Plaintiff's trade dress. He submits that there is delay which militates against the grant of interim relief as the notice was sent in the year 2021 and no further steps were taken by Plaintiff. He submits that the Defendant is not a fly-by-night operator and has presence in the market since the year 2008. In support, he relies upon following decisions :

- ***Charak Pharmaceuticals (India) Ltd. v. Glenmark Pharmaceuticals Ltd***[11]***. ;***
- ***Wander Ltd. v. Antox India P. Ltd***[12]***.***

11 2007 SCC OnLine Bom 1192.

12 1990 (Supp) SCC 727.

14. In rejoinder, Mr. Kamod would submit that balance of convenience is an unusual proposition in infringement matter. He submits that despite notice in the year 2010, Defendant continued with the use of mark and therefore cannot claim irreparable damage.

REASONS AND ANALYSIS:

15. The Plaintiff seeks to assert its proprietary right of exclusive use of the trade mark / trade dress and the artistic work in "PARACHUTE", "PARACHUTE ADVANCED" and "PARACHUTE JASMINE / PARACHUTE ADVANCED JASMINE" and to restrain the Defendant from use of the same.

16. In view of the Defendant being the registered proprietor of device mark "Cocoplus",it would be beneficial to refer to the relevant statutory provisions. Under Section 28 of Trade Marks Act, the registration of the trade mark, if valid, gives to the registered proprietor of trade mark the exclusive right to use of the trade mark. In the instant case, the Defendant is the registered proprietor of trade mark "COCOPLUS' under registration number 1557617 in Class 29 which is pending adjudication of the rectification application filed by the Plaintiff. Section 28(3) deprives the exclusive right to use the trade marks where two or more persons are registered proprietors of trade marks which are identical with or nearly resemble each other against the other party. Section 29 which deals with infringement of

registered trade mark provides that registered trade mark is infringed by a person who not being the registered proprietor uses an identical or deceptively similar trade mark. Though not stated in so many words, the defence appears to be Section 30(2)(e) of Trade Marks Act which puts limits on effect of registered trade mark where the use of the registered trade mark is in exercise of the right to use the same given by registration under the Act.

17. The Plaintiff has raised the plea of invalidity of the Defendant's registered trade mark by drawing support from Section 11 which provides the relative grounds available for refusal of registration under Section 11, i.e., its identity with an earlier trade mark and similarity of goods and services covered by the trade mark by reason of which there exists a likelihood of confusion and likelihood of association with earlier trade mark.

18. Before venturing into the aspect of invalidity of the Defendant's mark which is a heavy burden to be discharged by the Plaintiff, it would be apposite to first consider whether the defence of Section 30(2)(e) is available to the Defendants. For the said purpose, the Defendant's registered mark and the rival marks will have to be compared as under:

DEFENDANTS REGISTERED MARK:

RIVAL MARKS OF PLAINTIFF AND DEFENDANT:

Plaintiff's products	Defendants' products
	

    	   
	

Jasmine™	Jasmine

19. Let us begin by examining the Defendant's registered device mark which embodies a colour scheme of blue, green and white colours. The device mark has blue background with flag device in green boundary within which is the device of two coconut trees in green colour with the word Cocoplus written inside the boundary of flag device. The device of full green coconut is depicted in the lower portion and two half coconuts spilling drop of coconut oil on the left hand portion with the words Cocoplus coconut oil in white rectangle against black background.

20. Now coming to the rival marks set out in the plaint, *prima facie* what is actually used by the Defendant as trademark is not its registered device mark. The Defendant has deviated from its registered mark and instead uses as part of its mark, the device of two broken coconuts with oil oozing out which is deceptively similar to that of the Plaintiff's trade mark. It is *prima facie* evident that the Defendant's products are marketed under the trade mark which is different from the registered trade mark. The device mark used by the Defendants as disclosed in the plaint is not disputed by the Defendant. The defence under Section 30(2)(e) of Trade Marks Act protecting the

use of identical or similar trade mark which is registered is not available to the Defendant to escape the liability of infringement. Further in respect of user of the device mark of "JASMINE" , there is no such defence even available to the Defendant as the application for registration has been withdrawn by the Defendant which is not disputed by the Defendant.

21. In ***M/s. Siyaram Silk Mills Ltd. Vs. M/s. Shree Siyaram Fab Pvt. Ltd***[13] it is held that Section 29 of the Trademarks Act, 1999 does not prohibit the filing of a suit for infringement merely because Defendant's mark is also registered. The Co-ordinate bench held that since the Defendant was manufacturing and marketing its product on a label different than the registered trade mark and had blatantly copied the registered trade mark of Plaintiff, the Defendant is not entitled to seek any protection of its trade mark having been registered. In the present case, there is no justification for marketing its products under a different trade mark which borders close to the Plaintiff's trade mark. In that view of the matter, the position that *prima facie* emerges is that the Defendant is not the registered proprietor of the actual trade mark which is used by him.

22. The proprietary right of Plaintiff in the trade mark has been

13 2012 (5) BomCR 306.

prima facie established from the certificate of registration and is not disputed by Mr. Desai. The proprietary right having been established and as the action is for infringement of the same, under Section 29 of Trade Marks Act, the burden is upon the Plaintiff to *prima facie* demonstrate that the Defendant is using in course of trade an identical or deceptively similar trade mark in relation to goods or services in respect of which the trade mark is registered. There is no dispute about the identity of the goods in respect of which the trade mark is used.

23. A comparison of rival marks re-produced above *prima facie* indicates that the Plaintiff's trade mark bears a distinct hue of blue unconnected with the product i.e. oil. The mark "PARACHUTE" is stylized representation in white colour written inside the flag device having green boundary and single green coconut tree. The label contains device of two broken coconuts with coconut water oozing out of the same with the words 100% pure coconut oil written below. The Plaintiff's product is marketed in a distinct and unique shaped bottle/container. The Defendant's product is marketed in identical shade of blue and bears the word "Cocoplus" in white written inside a flag device having green boundary against a blue background with two coconut trees and device of two broken coconuts with coconut oil oozing out of the same.

24. As far as the product "JASMINE" is concerned, Plaintiff's product is marketed in a transparent bottle having unique shape that tapers upwards from a flat base with blue cap and bearing the flag device with the face of a model and two half coconuts with jasmine flowers. The Defendant's product is also marketed under the mark "JASMINE" in a similar transparent bottle with blue cap having the face of a model.

25. It would be useful to note the observations of Delhi High Court in ***Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt. Ltd.*** (supra) in the context of rights over the colour scheme and it is held in paragraphs 53, 54, 55, 56 and 57 as under :

> "53. It is the overall impression that customer gets as to the source and origin of the goods from visual impression of colour combination, shape of the container, packaging, etc. If illiterate, unwary and gullible customer gets confused as to the source and origin of the goods which he has been using for longer period by way of getting the goods in a container having particular shape, colour combination and getup, it amounts to passing off. In other words if the first glance of the article without going into the minute details of the colour combination, getup or layout appearing on the container and packaging gives the impression as to deceptive or near similarities in respect of these ingredients, it is a case of confusion and amounts to passing off one's own goods as those of the other with a view to encash upon the goodwill and reputation of the latter.
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> 54. The plaintiffs have succeeded *prima facie* in showing from the look of trade dress of the two articles, one manufactured by the plaintiff and another by the defendant from the point of view of not only unwary, illiterate customer/servants of the household but semi-literate also as the trademarks "Colgate" and "Anchor" are written in English language cannot be distinguished by ordinary customer of a country where bare literacy level is abysmally low. There is every likelihood of confusion as to the source on account of the similarity of substantial portion of the container having particular colour

> combination and also shape of the container which alone helps in determining the allegations of passing off despite stripes in the same colour or in different colour. The criteria is the overall impression from the look of packaging/container containing the goods and articles that can legitimately injunct its rival. Such an action on the part of infringing party also has an element of unfair competition.
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> 55. May be, no party can have monopoly over a particular colour but if there is substantial reproduction of the colour combination in the similar order either on the container or packing which over a period has been imprinted upon the minds of customers it certainly is liable to cause not only confusion but also dilution of distinctiveness of colour combination. Colour combination, getup, layout and size of container is sort of trade dress which involves overall image of the product's features. There is a wide protection against imitation or deceptive similarities of trade dress as trade dress is the soul for identification of the goods as to its source and origin and as such is liable to cause confusion in the minds of unwary customers particularly those who have been using the product over a long period.
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> 56. The difference in the style of the words appearing on the container or packing identifying its manufacturers by way of style, colour combination or textures or graphics is certainly significant or relevant for determining the overall imitation of the container but if a product having distinctive colour combination, style, shape and texture has been in the market for decades as in this case it is in the market since 1951 it leads to ineluctable inference of having acquired secondary meaning on account of its reputation and goodwill earned at huge cost.
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> 57. It is not the diligent or literate or conscious customer who always remain conscious to the quality of goods he has been purchasing which determines an offence of passing off. It is the unwary, illiterate and gullible persons who determine by arriving at a conclusion whether the infringed goods are confusingly similar in colour combination, getup, layout printed over the container or packing. If it is not so then the offence of passing off will cease to have its existence once the guilty party chooses a different trade name."

26. It is well settled that the test of infringement lies in copying of its essential features. It is necessary to first ascertain what are the essential features of the Plaintiff's product and then to compare the

same with the Defendant's product to see whether the same has been copied. Upon perusal of Plaintiffs mark what immediately catches the eye is the distinct hue of blue, flag device having green boundary blue background and and the device of two broken coconut oozing coconut oil. The Defendant's product when compared, it is *prima facie* evident that essential features of Plaintiff's trade mark which is flag device with the coconut tree and two broken coconuts with coconut water oozing out of it and the distinct colour combination of blue, green and white has been slavishly copied by the Defendant in such a manner so as to come as close as possible to the Plaintiff's mark. The adoption of similar shape of the containers would also indicate a dishonest attempt blatantly copy every aspect of the Plaintiff's trademark/trade dress. The colour combination is an arbitrary adaption unconnected with the product and the contention of Defendant that the same is coincidental and generic in nature cannot be accepted. There is absolutely no justification given by the Defendant as to why in respect of a similar product, Defendant has chosen the similar trade dress/packaging/label when its registered mark is different. It is no answer to say that the deviation from the Defendant's mark is not consistent and every bottle does not have the device of two broken coconuts and certainly no material to justify such explanation.

27. The trade mark is a whole thing and there might be slight

differences in parts of each mark. It has been held that what is important to consider is the mode in which the parts are put together to judge whether the dissimilarity of the parts is enough to make the whole dissimilar. Applying the said test to the facts of the present case, it is *prima facie* established that the minor variations in the Defendant's product does not make the whole mark dissimilar. It makes no difference that the Defendant uses the name"Cocoplus" inside the flag device.

28. Under Section 29(2)(a) of the Trade Marks Act, 1999, the registered trade mark is infringed by the person who not being the registered proprietor or permitted user, uses in the course of trade a mark which because of its similarity to the registered trade mark and identity or similarity of the goods and services covered by such registered trade mark is likely to cause confusion on the part of public or which is likely to have an association with the registered trade mark. The words "likely to deceive" is definitely a question of first impression and it is not necessary to prove any intention on the part of the Defendant. The test is substantially based on an appeal to the eye. When so judged, the Plaintiff's device marks / word marks / labels / packaging / trade dress is structurally and visually similar to that of the Defendant. In the present case, use of the mark by the Defendant is in the nature of use of a trade mark and the Plaintiff has *prima facie*

established that the Defendant's mark is deceptively similar to that of the registered trade mark and comes as close as it can be to cause confusion among the public and indicate association with the Plaintiff.

29. In an action for infringement, the defences available to the Defendant is cancellation of the registration under Section 57 of the Trade Marks Act, 1999 or the defences under Sections 30, 32 to 35 of the Trade Marks Act. The defence of Section 30 is not available to the Defendant as discussed above. The Defendant has not raised the defences under 33, 34 and 35 of the Trade Marks Act and has confined his submissions to balance of convenience, irreparable damage, common to trade use, delay and the comparison of the products to contend that it is not a slavish copy of Plaintiff's trade mark.

30. One of the defence is of user since the year 2008 and user which is common to trade. Section 17(2)(b) of the Trade Marks Act, 1999 provides that when the trade mark contains any matter which is common to trade or is otherwise of non distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered. What is therefore required to be established is the habitual use in the trade of the mark or part of the mark asserted by the Plaintiff which the Defendant claims to have become common to the trade. The Defendant who claims that mark is common to the trade, must show

use by the trade is extensive. None of these ingredients have been satisfied by the Defendant even *prima facie* at this stage and it is not sufficient to merely contend with substantiating the contention.

31. The defence taken that the device mark consisting of palm tree, broken coconut device and jasmine are descriptive of the product and no monopoly can be claimed in respect of the same cannot be accepted in view of Section 31 of the Registration Act which confers *prima facie* validity on the registration. The contention of Defendant borders on the plea of invalidity and if the contention of Defendant that there could not be any registration of the trade mark as the same is devoid of any distinctive character and/or description, it is necessary for the Defendant to demonstrate that the registration is *ex facie* illegal and fraudulent and is of such a nature so as to shake the conscience of the Court. That apart, the defence may be available in an action for cancellation of registration but while considering the issue of infringement of trade mark, at the *prima facie* stage, the same is immaterial unless it satisfies the principles laid down in ***Lupin Ltd vs Johnson and Johnson***[14]***.***

32. As regards the aspect of delay, upon a query by this Court, Mr. Desai, learned Counsel for the Defendant would submit that there is no submission of acquiescence by the Plaintiff and the submission is

14 2015(1) MhLJ 501

confined only to delay. The submission on delay has its foundation in the cease and desist notice issued to the Defendant in the year 2021 and the lapse of about three years in filing the instant suit. In the case of ***Jagdish Gopal Kamath v. Lime & Chilli Hospitality Services*** (supra) this Court in the context of infringement of trade mark considered the submissions of delay and balance of convenience. The Co-ordinate bench held that in such cases, delay on its own, unaccompanied by acquiescence, is no answer to an application for an injunction in an action in infringement and passing off. The Co-ordinate bench noted the decision in the case of ***Medley Pharmaceuticals Ltd v Twilight Mercantiles Ltd***[15] which noted the decision of Delhi High Court in ***Hindustan Pencils Pvt. Ltd. v. India Stationery Products***[16] in paragraph 33 which was as under :

> "Similarly on the issue of delay, the Delhi High Court in Hindustan Pencils (P) Ltd. vs. India Stationery Products Co. & Anr. : AIR 1990 Delhi 19 has also held that delay by itself is not a sufficient defence to such an action especially where the use by the defendants is fraudulent. ... ... ……..In Hindustan Pencils, the Delhi High Court considered the question of acquiescence and held that, in law, the question arises where the proprietor of a mark, being aware of his rights, and being aware that the infringer may be ignorant of them, does some affirmative act to encourage the infringer's misapprehension so that the infringer worsens his position and acts to his detriment. A mere failure to sue without a positive act of encouragement is no defence and is no acquiescence. A defendant who infringes the plaintiffs' mark with knowledge of that mark can hardly be heard to complain if he is later sued upon it. A defendant who begins an infringement without searching the trade

15 (2014) 60 PtC 85(Bom).

16 AIR 1990 Del 19.

> marks register is in no better a position. One who does take a search, finds the plaintiffs' mark and nonetheless continues his act of infringement is, however, certainly much worse off. Certainly he cannot allege acquiescence. That door is closed to him."

33. The doctrine of delay was held by itself not to be sufficient defence to an action for infringement especially where the use by Defendant is fraudulent. It held that mere failure to sue without a positive act of encouragement is no defence and is no acquiescence. In the present case, Defendant's Application for registration of mark in the year 2010 was opposed by the Plaintiff, which proceedings were thereafter abandoned by the Defendant. The Defendant was therefore well aware of Plaintiff's registered trade mark being in existence and having infringed registered trade mark with full knowledge of the mark, the Defendant cannot be heard on the question of delay. There is no defence of acquiescence and delay by itself without acquiescence cannot constitute valid defence in an action for infringement.

34. In ***Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia***[17], the Apex Court has held that in case of infringement either of trade mark or copyright, normally injunction must follow and mere delay in bringing the action is not sufficient to decline the grant of injunction in such cases.

17 (2004) 3 SCC 90.

35. In the case of ***Schering Corporation v. Kilitch Co. (Pharma) Pvt. Ltd.*** (supra), it was held that once it is established that there is visual and phonetic similarity, and once it is established that the defendants' adoption of the trade mark is not honest or genuine, then the consideration of any plea as to delay must be on the basis of a consideration whether there has been such delay in the matter as has led the Defendants to assume that the Plaintiffs have given up their contention and/or whereby the defendants have altered their position so that it would be inequitable to grant interim relief to stop them from using the trade mark until the suit is decided. In the present case, apart from stating the relative dates on which the cease and desist notice was issued by the Plaintiff to the Defendant and the date of filing of suit, there is nothing to demonstrate that by reason of lapse of time, the Defendant's position was so altered to make it inequitable to grant interim relief nor any equities have been shown for which the Defendants are required to be protected.

36. The use by the Defendant of Plaintiff's trade mark cannot be said to be an honest adoption for the simple reason that though having a registered trade mark, the Defendant has deviated from the mark and has adopted a mark which is deceptively similar to the Plaintiff's registered trade mark. Such conduct by the Defendant with knowledge of the Plaintiff's registered mark cannot be said to be a honest

adoption. In the case of ***Skol Breweries Ltd. v. Som Distilleries & Breweries Ltd*** (supra) it was held that it is only in unusual circumstances that balance of convenience should play a part in the matter where Plaintiff is the owner of registered trade mark. In the instant case, even assuming *arguendo* of the Defendant's use since the year 2008, the same will not tilt the balance of convenience in favour of the Defendant particularly when the Plaintiff is *prima* facie shown to be prior user. It is also not the Defendant's case that he had inspected the trade mark Registry and did not notice the Plaintiff's mark. On the contrary, the fact that in the year 2010, the Plaintiff had opposed the registration of Defendant's mark, put the Defendant to notice about the registered trade mark of the Plaintiff and the balance of convenience cannot be said to be in favour of the Defendant.

37. It is well settled that in case of infringement of trade mark which is already in existence, the subsequent user has obligation to avoid unfair competition and become unjustly rich by encashing on the reputation and goodwill of the prior user.

38. As far as the decision on ***Charak Pharmaceuticals (India) Ltd. v. Glenmark Pharmaceuticals Ltd.*** (supra) which has been relied upon by Mr. Desai is concerned, the same turned on the facts of the case where there was clear case of inaction on the part of Plaintiff. In that case, the prayer was for ad-interim relief and the motion was listed for

hearing to be decided on its own merits, uninfluenced by the observations. In that case, prayer of the Plaintiff for grant of ad-interim relief was rejected on the well settled principles and the motion was listed for hearing. The said decision does not assist the case of Defendant. The proposition of law laid down in the case of ***Wander Ltd. v. Antox India P. Ltd.*** (supra) are well settled in the context of grant of interim injunction.

39. In the present case, the Plaintiff has made out a *prima facie* case of infringement of trade mark and the use by the Defendant of the trade mark which is so deceptively similar to that of the Plaintiff's trade mark which is likely to cause confusion in public and show association with the Plaintiff's product. Considering the rival marks, the consumer base of the products is likely to be confused as the distinctive colour/trade mark/trade dress/packaging adopted by the Plaintiff has been copied by the Defendant going as far as copying the shape of the bottles/containers. *Prima facie,* the first impression which is created upon a visual of both the products would indicate structurally and visually similarity which is likely to cause an association of Defendant's product with that of the Plaintiff. It is not only necessary to protect the Plaintiff's proprietary rights in the registered trade mark but also to protect the consumers. In event the interim relief of infringement of trade mark and copyright is not granted, the

Plaintiff will suffer irreparable harm, loss and prejudice. It is open for the Plaintiff to apply for interim relief in terms of passing off after leave has been obtained.

40. In the light of above, application is allowed in terms of prayer clauses (a) to (f), which read thus :

> (a) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the Parachute Registered Marks of the Plaintiff bearing nos. 1033844, 2425321, 2425322, 2425320, 2423236, 2423238, 3481083, 2878146, 2926904, 363235 and/or 737894 in any manner and from using in relation to impugned products or any other goods for which the Parachute Registered Marks are registered or any goods similar thereto, the impugned marks/devices or the impugned mark  or the Impugned Labels/Packaging or the impugned bottles /containers (including those depicted at Exhibit JJ-1) or any other marks / labels/ devices/ packaging/trade dress / bottles/ containers which are identical with or similar to the Parachute Registered Marks of the Plaintiff (including the Parachute Packaging/Labels and trade dress or any features thereof, the Distinctive Parachute Bottles/Containers, the Flag Device, the Parachute Tree Device, the Broken Coconut Device), and from manufacturing, selling, offering for sale, advertising or dealing in such goods or any other goods bearing the impugned marks/ labels/ packaging or the impugned bottles /containers or any marks / labels / devices / packaging / bottles /containers or trade dress (including those depicted at Exhibit JJ-1) identical with or similar to the Parachute Registered Marks (including the Parachute Packaging/ Labels, Distinctive Parachute Bottles/Containers as the case may be or any features including the colour combination thereof thereof);
>
> (b) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained

by an order and injunction of this Hon'ble Court from infringing in any manner the Parachute ADVANSED Registered Marks of the Plaintiff bearing nos. 1033842, 1547619, 399592, 977885 and/or 1444617 in any manner and from using in relation to impugned products or any other goods for which the Parachute ADVANSED Registered Marks are registered or any goods similar thereto, the impugned marks/devices or the impugned mark  or the Impugned Labels/Packaging or the impugned bottles /containers (including those depicted at Exhibit JJ-1) or any other marks / labels/ devices/ packaging/trade dress / bottles/ containers which are identical with or similar to the Parachute ADVANSED Registered Marks of the Plaintiff (including the Parachute ADVANSED Packaging/Labels (to the extent registered) and trade dress or any features thereof, the Distinctive Parachute Bottles/ Containers, the Flag Device, the Parachute Tree Device, the Broken Coconut Device) and from manufacturing, selling, offering for sale, advertising or dealing in such goods or any other goods bearing the impugned marks/labels/packaging or the impugned bottles /containers or any marks / labels / devices / packaging / bottles /containers or trade dress (including those depicted at Exhibit JJ-1) identical with or similar to the Parachute ADVANSED Registered Marks (including the Parachute ADVANSED Packaging/Labels, Distinctive Parachute Bottles/ Containers as the case may be or any features thereof including the colour combination thereof);

(c) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the JASMINE Registered Marks of the Plaintiff bearing nos. 1398440, 947770, 906080, 2195475, 2195474, and/or 5277072 in any manner and from using in relation to impugned products or any other goods for which the JASMINE Registered Marks are registered or any goods similar thereto, the impugned mark/logo  and the Impugned devices/Labels/Packaging or the impugned bottles /containers (including those depicted at Exhibit JJ-2) or any other marks / labels/ devices/ packaging/trade dress / bottles/ containers which are identical with or similar to the JASMINE Registered Marks of the Plaintiff (including the Jasmine Logo, JASMINE Packaging/Labels and trade dress or any features thereof), and from manufacturing, selling, offering for sale, advertising or

dealing in such goods or any other goods bearing the impugned marks/devices/labels/packaging or the impugned bottles /containers or any marks / labels / devices / packaging / bottles /containers or trade dress (including those depicted at Exhibit JJ-2) identical with or similar to the JASMINE Registered Marks (including the Jasmine Logo, JASMINE Packaging/Labels) and trade dress or any features thereof including the colour combination thereof, as the case may be;

(d) Pending the hearing and final disposal of the suit, the Defendants, their directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the Plaintiff's copyrights in the artistic works comprised in/reproduced on its Parachute Packaging/Labels including the Flag Device, Parachute Tree Device and the Broken Coconut Device, and from reproducing/ copying the said artistic works or any substantial part of the said artistic works (as set out at Exhibits B-1 and B-2) on any of the impugned products of the Defendants (including those depicted at Exhibit JJ-1 to the Plaint) or any bottles, cartons, packaging material or advertising material, literature or any other substance and from manufacturing and selling or offering for sale products upon or in relation to which the said artistic works have been reproduced or substantially reproduced or by issuing copies of such works to the public;

(e) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the Plaintiff's copyrights in the artistic works comprised in/reproduced on its Parachute ADVANSED Packaging/Labels including the Flag Device, Parachute Tree Device and the Broken Coconut Device, and from reproducing/ copying the said artistic works or any substantial part of the said artistic works (as set out at Exhibits I-1 and I-2) on any of the impugned products of the Defendants (including those depicted at Exhibit JJ-1 to the Plaint) or any bottles, cartons, packaging material or advertising material, literature or any other substance and from manufacturing and selling or offering for sale products upon or in relation to which the said artistic works have been reproduced or substantially reproduced or by issuing copies of such works to the public;"

(f) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the Plaintiff's copyrights in the artistic works comprised in/reproduced on its Jasmine Packaging/Labels or any features thereof, Jasmine Artwork and the Jasmine Logo and from reproducing/ copying the said artistic works or any substantial part of the said artistic works (as set out at Exhibit N, P-1, P-2, Q, R-2, S-1 and S-2) on any of the impugned products of the Defendants (including those depicted at Exhibit II-6 to the Plaint) or any bottles, cartons, packaging material or advertising material, literature or any other substance and from manufacturing and selling or offering for sale products upon or in relation to which the said artistic works have been reproduced or substantially reproduced or by issuing copies of such works to the public"

[Sharmila U. Deshmukh, J.]

41. At this stage, request is made for stay of the present order for a period of four weeks. The said request is opposed by learned Counsel appearing for the Plaintiff. As the interim application stands finally decided by the present order, the same is stayed for a period of four weeks.

[Sharmila U. Deshmukh, J.]