

(2016) 09 BOM CK 0131

In the Bombay High Court

Case No : Notice of Motion (L) No. 2125 of 2015 in Suit No. 32 of 2016

Advance Magazine Publishers

APPELLANT

Vs

M/s. Just Lifestyle Pvt. Ltd.

RESPONDENT

Date of Decision : 19-09-2016

Acts Referred:

Trade Marks Act, 1999 — Section 29(4)

Citation : (2017) 1 MIPR 5

Hon'ble Judges : S.C. Gupte, J.

Bench : Single Bench

Advocate : Ms. Anuradha Salhotra a/w. Mr. Vishal Kanade, Mr. Shrivardhan Deshpande and Ms. Debashree Dey, i/b. Desai and Diwanji, Advocates, for the Plaintiffs; Ms. Manmeet Arora a/w. Ms. Preeti Shah, Mr. Manoj Menda, Ms. Fareha Ahmad Khan, Mr. Apoorva Tripathi, i/b

Final Decision : Dismissed

Judgement

S.C. Gupte, J. - This Notice of Motion is taken out by the Plaintiffs in a trade-mark infringement and passing off suit, seeking a temporary injunction restraining the Defendant from using the word "VOGUE" as part of their impugned trade mark "JUST IN VOGUE" or any other deceptively similar mark or trade name in relation to its goods and services.

2. The Plaintiffs are registered proprietors and users of the trademark "VOGUE" in respect of magazines, which are said to be published and sold in several countries around the world including India. Plaintiff No.1 is a corporation organized under the laws of the State of New York, U.S.A. and is the proprietor of the trade mark "VOGUE", and claims to be using the same in relation to its fashion and lifestyle magazine of the same name since the year 1892. Plaintiff No.2 is a wholly owned subsidiary of Plaintiff No.1 and claims to be a licensed/ permitted user of the trademark in India. Though the Plaintiffs claim to be using the trademark in India through their magazines imported in India since long, the Indian edition of the magazine "VOGUE" was launched only in 2007. The

trademark has, however, been registered in India by Plaintiff No.1 in the year 1976 in class 16 in relation to magazines (publications); and in the year 2004 in class 41 in respect of on-line and electronic publications. Besides, Plaintiff No.1 also holds registrations of marks "VOGUE GIRL" in classes 9 and 16 for electronic publications and magazines etc., and "TEEN VOGUE" in class 41 for on-line and electronic publications. The Plaintiffs have furnished the details of circulation of the Plaintiffs' magazine under the trademark "VOGUE" in India before its launch in India in 2007 in terms of subscriptions and news stands details between the years 2000 and 2007 and sales of their issues of "VOGUE INDIA" since the launch in 2007 and till 2011. The Plaintiffs refer to the reputation of the magazine "VOGUE" in India since 1930, a survey conducted in early 1997 in India about its readership in India, the grand launch of "VOGUE INDIA" in 2007, the quotes of Indian celebrities, publications in reputed international journals as also decided cases of various courts of the United States of America as well as India, in support of their case that trademark "VOGUE" is a well-known mark entitled not only to protection in the classes in which it is registered but also other classes generally. The Plaintiffs' case is that "VOGUE" magazine contains a section called "IN VOGUE" pertaining to new trends in fashion goods, and that the word "IN VOGUE" has also accordingly acquired the characteristics of a trademark by extensive user of the word by the Plaintiffs and forms part of the goodwill of the Plaintiffs.

3. It is the Plaintiffs' grievance that in or around January 2009, the Plaintiffs came to know of the Defendant's application for registration of the trade mark "JUST IN VOGUE" in class 35 in respect of retail stores and sales services, etc. The Plaintiffs thereupon caused a notice of opposition to be filed through their attorneys. Upon making further inquiries, the Plaintiffs claim have learnt of the Defendant's use of the trade mark "JUST IN VOGUE" in relation to retail stores and sales services. Considering particularly the range of merchandise dealt in by the Defendant, which includes various fashion goods and high end products, it is the Plaintiffs' grievance, the Defendant's use of the trademark "JUST IN VOGUE" featuring prominently the word "VOGUE" amounts to an infringement of the Plaintiffs' well-known trademark "VOGUE". The Plaintiffs claim that the adoption by the Defendant of the impugned mark is ex facie deliberate, willful and mala fide with intent to capitalize on the goodwill and reputation of the Plaintiffs and give an impression to the public that the services of the Defendant are associated with or connected to the Plaintiffs. The Plaintiffs claim that the Defendant is thereby not only infringing the Plaintiffs' registered trademark but also passing off its goods and services as those of the Plaintiffs.

4. At the hearing of the Notice of Motion, in her opening address, Ms. Salhotra, learned Counsel for the Plaintiffs, almost exclusively pitched her case for infringement under Section 29(4) of the Trade Marks Act, 1999 ("Act"). Her arguments were premised on the reputation of the registered trade mark "VOGUE" as a well-known mark in India. She argued that having regard to (i) the similarity between the two marks, namely, "VOGUE" for which the Plaintiffs hold

registration and "JUST IN VOGUE" which is an unregistered mark used by the Defendant, (ii) the reputation of the Plaintiffs' registered trade mark "VOGUE" in India, and (iii) the use of the Defendant's impugned mark being without due cause and resulting into unfair advantage of, and detriment to, the distinctive character and reputation of the Plaintiffs' registered trade mark, the Plaintiffs are entitled to an injunction, though the goods and services of the parties are different. Subsequently, in her rejoinder as well as her written submissions, learned Counsel also argued her case under Sections 29(1) and (2) as well as on the tort of passing off. Learned Counsel argued that if the Plaintiffs establish a sufficient trade connection between the Plaintiffs' magazine and the Defendant's services, considering their respective customer base, allied and cognate nature of their goods and services, their source of revenue generation, etc., a case of likelihood of confusion does arise and an injunction must follow. Learned Counsel also submitted that the Plaintiffs are entitled to protection against dilution of their well-known trade mark by user of the Defendant of a deceptively similar mark.

5. Infringement of a registered trade mark, under Sections 29(1) and (2) of the Act, requires identity or similarity (i) between the registered trade mark and the infringing mark and (ii) between the goods or services respectively covered by the two marks. Section 29(4), on the other hand, requires only identity or similarity of the marks and not of the goods or services. We shall, in the premises, first take up the issue of similarity of the goods or services and then consider the aspect of similarity of the two marks, which is common to Sections 29(1) and (2), and Section 29(4) as also to a case of passing off. (Admittedly there is no question of identity of either the goods/services or the marks in the present case.)

6. The Plaintiffs' registration of their trade mark "VOGUE" is in class 16 for "Magazines (publications)" and class 41 for "on-line and electronic publications". The Defendant, on the other hand, provides retail services, which are covered in class 35. The products sold by the Defendant in its retail stores are products of third parties, which come under different brands and trade marks of such third parties. The Defendant claims that its stores, which are run under the name "JUST IN VOGUE", are known largely for the collection and range of watches and writing instruments belonging to reputable brands. Prima facie, without anything else, the goods of the Plaintiffs covered by the registered trade mark "VOGUE" are dissimilar to the goods sold or services offered by the Defendant. We have, however, to see if by reason of the alleged cognate nature of, or connection between, the two trades, namely, fashion magazines and retail sale of fashion goods, or commonality of the customer base or source of revenue generation, or for any other reason, the goods or services can be said to be similar.

7. In the first place, it is contended by Ms. Arora, learned Counsel for the Defendant, that similarity referred to in Section 29 can only be either similarity between goods covered by the registered trade mark and goods covered by the

rival mark or similarity between services offered under the two rival marks. Learned Counsel submits that it cannot be similarity between goods covered under one mark and services covered by the other. She relies on a decision of our court in *Balkrishna Hatcheries v. Nandos International Ltd.* 2007 SCC On line Bom 449 in support of this proposition. Our Court in *Balkrishna Hatcheries* did hold that the similarity or association referred to in Section 29 is "similarity between goods and goods" or "similarity between services and services" and not "similarity between goods on the one hand and services on the other". Strictly speaking what the Plaintiffs sell, in the present case, are goods, namely, magazines, whilst what the Defendant offers are services, namely, retail sales and similarity between the two is not covered by the provisions of Section 29(2). It may, however, be possible to contend that what the Defendant does is "to sell goods"; maybe the goods bear their own brand names or trade marks but they are nevertheless sold by using the rival trade mark, namely, "JUST IN VOGUE". I have, therefore, considered the aspect of similarity also from the standpoint of other indices indicated by me above, namely, nature of goods/services, trade connection, customer base, source of revenue generation, etc. After all we are at a preliminary stage, considering prima facie merits of the rival cases.

8. The objective test for similarity of description of goods/services as held by Lord Wilberforce in *Daiquiri Rum Tm* (1969) R.P.C 600 (House of Lords), and accepted by our Courts, is the "business and practical test". In the leading case of *British Sugar Plc. v. James Robertson & Sons Ltd.* [1996] R.P.C 281 (at page 296), various essential factors which must be considered for such test are noted as follows :

- "(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

Applying these tests, "toffee spread" was not considered as similar to "dessert sauces and syrups" in that case. In other cases, medicated soaps and perfumed soaps on the one hand and hair sprays and shampoos on the other were considered dissimilar (See, *Consort Tm.* [1969] R.P.C. 179); Inboard marine engines of certain descriptions were held not similar to outboard motors of other

descriptions (See, Seahorse Tm. [1980] RPC 250); cycle parts like hand spindles, axels, etc. were held to be dissimilar to cycle tyres and tubes (See, Dunlop v. Remington 1982 PTC 447 (TMR)); Geometry boxes were held not similar to pencils (See, Hindustan Pencils Pvt. Ltd. v. Prem Chand Gupta Laws (DLH)-1984-10-22); and bread was held to be of different description from chocolates (See, Pioneer Bakeries (P) Ltd. v. Kraft Jacobs Suchard Ltd. 1998 PTC (18) 502).

9. There is hardly any dispute between the parties that physically the goods/services are clearly distinct and separate. The respective uses of the goods/services of the Plaintiffs and the Defendant are also distinct and dissimilar. The Plaintiffs' magazines are read by their consumers; the Defendant's services are used for buying goods of reputable third parties. The target users of the Plaintiffs' goods are "intelligent, affluent, well- travelled women in the age group of 26-45 years" (See, Web page of "Vogue India", describing "Vogue" readers, Exhibit-9-Volume I- being part of the additional affidavit in reply by the Defendant). On the other hand, the customers of the Defendant are said to be primarily men from the middle strata of the society (See, paragraph 15(f) of the affidavit in reply, not denied by the Plaintiffs in paragraph 15(f) of the affidavit in rejoinder). There are no common distributors or dealers dealing in these goods/services. The Plaintiffs' magazines are distributed by Living Media Ltd. The consumers subscribe to the magazine mostly directly. The magazine is also sold at news-stands. The Defendant, on the other hand, retails third party goods from its own stores located at various malls and other commercial establishments. There is no commonality in the trade channels of the two. The goods dealt in by the Plaintiffs and the Defendant are hardly likely to be available on the same shelf or in the same stores or outlets for that matter. Moreover, the Defendant sells branded goods in its stores under the name "JUST IN VOGUE". It is absurd to suggest that discerning customers who are expected to buy these branded goods are likely to somehow imagine that these goods or the retail services offered by the Defendant in connection with them have some trade connection or association with the Plaintiffs or their magazine "VOGUE". The goods or services are not in any way competitive. It cannot possibly be suggested that the magazine "VOGUE" competes with either the branded goods retailed by the Defendant or the retail services of the Defendant as such.

10. The thrust of the Plaintiffs' case seems to be the possible suggestion that the branded goods dispensed by the Defendant somehow have the prestige and goodwill of the Plaintiffs' magazine behind them. The Plaintiffs argue that both the Plaintiffs and the Defendant are part of the fashion industry. The Plaintiffs actually promote products of third parties related to fashion, particularly through the "IN VOGUE" section of their magazine; there is also "VOGUE SHOPS" section in their magazine which lists goods (such as watches and writing instruments which are sold by the Defendant) as "Best buys of the month". It is submitted that the Plaintiffs' magazine can be said to be a catalogue of fashion trends; and there is every likelihood of the purchasing public assuming the Plaintiffs'

endorsement of the products sold by the Defendant, so seems to be the suggestion. This is clearly far-fetched. Because the name of the Defendant's stores bears a certain resemblance (which can hardly be described as deceptive similarity, as I have explained later in this order) with a fashion magazine which writes about fashion trends and recommends best buys amongst branded goods, can anyone be reasonably misled into believing that the goods dispensed at the particular stores have a connection with the publishers or owners of the magazine? It is important to note that the trade connection relevant for similarity of goods must imply that the goods/services ordinarily come from the same merchant and not that the goods of one merchant have the endorsement or backing of another. Magazine publishers are not ordinarily known to be retailing fashion goods and hardly is anyone likely to be misled into believing that the magazine and the fashion goods come from the same source. Even otherwise, the suggestion that the goods of the retailer may appear to have the backing of the fashion magazine because of the similarity in names cannot be said to have any realistic bearing on the subject of similarity of goods.

11. The Plaintiffs, thus, do not cross the first hurdle, namely, similarity of goods/services, to make out a case of infringement under Sections 29(1) and (2) of the Act.

12. Similarity of goods, however, is not relevant for a case under Section 29(4). In fact, the very jurisdictional requirement for a case under Section 29(4) is dissimilarity between the goods/services. But then there are three more jurisdictional requirements, namely, (i) reputation of the registered trade mark in India, (ii) use of the infringing mark without due cause and (iii) unfair advantage or detriment caused to the distinctive character or reputation of the registered trade mark, besides identity or similarity between the rival marks which is a common requirement for all cases of infringement or passing off. Let us consider if these are satisfied in the present case.

13. Sections 29(4) and 11(2), which are relevant for our purposes, are quoted below:

"29. Infringement of registered trade marks.-

(4) 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-

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark."

11. Relative grounds for refusal of registration.-

(2) A trade mark which-

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered, if or to the extent, the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark."

14. Section 29(4) along with Section 11(2)(b), which together form a scheme, gives statutory recognition to the modern concept of dilution of trade mark. A registered trade mark, by reason of its extensive reputation, may acquire a distinctive character as a well-known trade mark. Its appearance may instantly evoke a connection with the proprietor as the source of the goods or services. No rival trader by reason of use of an identical or similar mark can be allowed to take an unfair advantage of this distinctive character or reputation of the registered trade mark or cause detriment to the same, even if such use be in relation to dissimilar goods or services. There are two reasons for avoiding such user as the Section itself indicates. One, it enables the rival trader to take an unfair advantage of the distinctive character and reputation of the well-known trade mark. Two, it causes detriment to such distinctive character and reputation. Delhi High Court in the case of *Tata Sons Ltd. v. A.K. Chaudhary* 2009 (40) PTC 54 (Del.) explained the doctrine of dilution thus:

"31. According to the doctrine of dilution, even if a person uses another's well-known trademark or trademark similar thereto for goods or services that are not similar to those provided by such other person, although it does not cause confusion among consumers as to the source of goods or services, it may cause damage to the well-known trademark by reducing or diluting the trademark's power to indicate the source."

15. Even before the new law, which gave recognition to the concept of dilution, the law of trademarks provided for a remedy for such cases under the traditional law towards protection of trade marks for the purpose of preventing confusion. The decision of our Court in the case of *Sunder Parmanand Lalwani v. Caltex (India) Ltd.* AIR 1969 Bombay 24 is a case in point. That was a case under the old Trade Marks Act (Trade and Merchandise Marks Act, 1958) which did not have comparable provisions to either Section 29(4) or Section 11(2)(b) of the present Act. The case arose out of an application for registration of the trade mark "Caltex" by the appellant before the Court. The appellant wanted to use the mark "Caltex" in respect of watches (which came under class 14 as "Horological and other Chronometric instruments and parts thereof" of the schedule as it then existed). The application was opposed by Caltex (India) Ltd., the well-known manufacturer and dealer in petrol and other oil products, who held registration of

the trade mark "Caltex" in classes 4 and 19. The Court was essentially considering whether the appellant was disentitled to registration under clause (a) of Section 11 of the 1958 Act, which prohibited registration of a mark, "the use of which would be likely to deceive or cause confusion". The argument of the appellant was that his goods were totally different from the goods of his opponent Caltex (India) Ltd.; there was no connection in the course of trade nor any common trade channels in respect of the goods; and consequently, there was no danger of deception or confusion. Our Court held that though the goods were totally different, and there was no connection in the course of trade nor any common trade channels, we must still consider the factors, which tend to show that there is a likelihood of creating deception or confusion. The Court considered the fact that the opponents had been using their mark on a very large scale since 1937; their publicity was wide spread and large. Though the goods were different, the potential market for them was similar in the sense that the goods of both the parties were not special goods. They were goods which would be purchased by the common man. The opponents were a large company known by many as having large resources and therefore capable of starting any new industry or trade. The Court held that because of these reasons, there was a great probability of the public believing that any goods with the mark "Caltex" on them would be the goods of the opponents. The Court's conclusion on the basis of the peculiar facts of the case is set out below:

"On the facts of this case, we have no hesitation in holding that a large number of persons, if they see or hear about the mark "Caltex" in connection with watches, would be led to think that the watches were in some way connected with the opponents, or they would at least wonder whether they were in any way connected with the opponents. Persons seeing the mark attached to watches, which is a new class of goods, would assume, or are most likely to assume, that they originated from the proprietor of the mark, namely, the opponents."

The Court also considered the alternative plea of the opponent that allowing the applicant to register the trademark "Caltex" for watches in class 14 would be a fraud on the general public inasmuch as the applicant has been acting dishonestly in selecting the mark "Caltex" with the intention of trading on the wide reputation which that mark enjoyed in India and that the applicant's case was not founded on truth, and that because of these two reasons, the applicant should be held to be disentitled to registration of the mark under the discretionary provisions contained in clause (e) of Section 11 of the 1958 Act. Even infringement cases under the old law would go by the same consideration, namely, whether or not there was a possibility of deception or confusion.

16. Under the new law, i.e. the Act of 1999, in a case of infringement under Section 29(4), it is no longer necessary for the plaintiff to actually show that there is likelihood of any deception or confusion amongst the purchasing public. It is enough to show that continued use by the defendant of an identical or similar trade mark is likely to lead to an unfair advantage on the part of the

defendant, or a detriment on the part of the plaintiff, concerning the distinctive character or reputation of the plaintiff's registered trademark. The plaintiff's mark, by reason of the plaintiff's reputation, distinguishes the plaintiff's goods. This distinctiveness is lost if an identical or similar trademark also distinguishes goods of another trader. Besides, it may cause harm to the reputation of the plaintiff's trademark because of the manner of use of the mark by the defendant. It is pertinent to note, in this behalf, the following observations made by Delhi High Court in the case of *Bloomberg Finance LP v. Prafull Saklecha* 2013 (56) PTC 243 (Del), whilst interpreting the provisions of Section 29(4):

36. In other words, the legislative intent is to afford a stronger protection to a mark that has a reputation without the registered proprietor of such mark having to demonstrate the likelihood of confusion arising from the use of an identical or similar mark in relation to dissimilar goods and services. The words "detriment" in the context of the "distinctive character" of the mark brings in the concept of "dilution" and "blurring". In the context of "repute" they are also relatable to the concept of "tarnishment" and "degradation". The words "takes 'unfair advantage'" refers to "free-riding" on the goodwill attached to mark which enjoys a reputation. The disjunctive "or" between the words "distinctive character" and "repute" is designedly inserted to cater to a situation where a mark may not have a distinctive character and yet may have a reputation."

17. Assuming that the two trademarks in the present case are similar, there would be a case of an unfair advantage to the Defendant or a detriment within the meaning of Section 29(4) only where the Plaintiffs' registered trade mark has acquired a distinctive character or enjoys extensive reputation in India. A word, which is descriptive in nature, is not prima facie capable of distinguishing the goods covered by it. It is possible, however, to acquire a distinctive character as a result of use of the mark in relation to particular goods or services for which the mark is used by the particular trader. This distinctiveness coupled with the reputation of the mark, for the purposes of Section 29(4), must be ascertained with reference to the Indian market. The proprietor of the mark must show the evidence of such distinctiveness and reputation. The lesser the inherent capacity of the mark to distinguish, the stronger the evidence is required to prove any acquired distinctiveness and vice versa. Such evidence will have to cover various factors such as, extent of user of the mark, extent of advertisement, etc. besides the nature of goods/services, competing marks in the market, importance attached to trade marks generally in the particular trade, the channels of trade, class of customers, price of goods, etc.

18. As for the distinctiveness and reputation of the Plaintiffs' mark, in the present case, the Plaintiffs have disclosed the circulation of the magazine "VOGUE" in India between the year 2000 and 2007. Even a bare perusal of the chart reveals that the circulation of the magazine in India, during this period, is hardly significant. Even the sales figures, which have been disclosed only for the period between 2007 and 2011, do not indicate any high or substantial volume of

sales. Ditto for the alleged extensive advertisement of the magazine, for which no details have been furnished by the Plaintiffs. The Plaintiffs have relied upon some laudatory articles to claim that the mark "VOGUE" is well known and enjoys extensive reputation in India. It is pertinent to note that the articles relied upon by the Plaintiffs have been mostly contained in magazines/periodicals published in countries other than India. It is not shown that these periodicals or magazines have significant or, for that matter, any circulation in India. The cut-off date for determining whether by reason of the reputation of the plaintiff's mark the defendant ought to be enjoined from using its rival mark is the date on which the defendant starts using its mark. The Defendant, in the present case, started using the mark "JUST IN VOUGE" during the year 2004. There is hardly any material adduced by the Plaintiffs to show that as of the year 2004 the Plaintiffs' trademark "VOGUE" enjoyed such reputation in India that any use by a rival trader of a similar mark for dissimilar goods would afford any unfair advantage to the rival trader or cause any detriment to the distinctive character or reputation of the mark "VOGUE". On the other hand, the Defendant has relied on material to show that the Plaintiffs have no reputation in India within the meaning of clause (a) of sub-section (4) of Section 29. The Defendant has relied on a survey by Indian Readership Survey, which does not feature the Plaintiffs' magazine in the top 25 magazines of India. So also, a survey conducted by World Wide Media Limited for "Femina" Magazine does not consider "VOGUE" as a competitor of the magazine "Femina". The list of well-known Trade Marks released by the Registrar of Trade Marks does not include the mark "VOGUE". A survey conducted by the very agency "Interbrand", whose survey in the year 1991 is relied upon by the Plaintiffs in support of their case, does not show the mark "VOGUE" as within the top 100 marks in India since the last ten years, i.e. at least since 2004 onwards. The other factors such as nature of goods/services, channels of trade, price of goods, etc. are also against the Plaintiffs. On a balance, there is indeed no prima facie case of a reputation in India of such order as to warrant any relief under Section 29(4).

19. Ms. Salhotra orally argued before this Court the Plaintiffs' case of a cross-border reputation. There must be both pleading and proof (at this stage, prima facie proof) offered by the Plaintiffs of reputation in India based on a cross-border reputation. Both are lacking in the present case. Neither the plaint nor the affidavits filed subsequently contain any specific pleading on this case. There is no objective material placed before the Court in support of such case either. The following observations of Delhi High Court about the argument of international reputation in the case of ROCA Sanitario S.A. v. Naresh Kumar Gupta 12 (2010) SCC Online Del 1135 are instructive to note:

"30. The endeavour of ROCA has been primarily to say that since it is a registered trademark proprietor, and has an international reputation, temporary injunction must follow. Though attractive, a bland and mechanical incantation of such reputation is insufficient. Authorities have clarified that there should be some objective material to show that the brand seeking protection was known to

the Indian consumer public. The clear pointer here is to advertisements. Now, in the case of consumer durables, or even luxury personal items such as toiletries, clothing, liquor, etc. circulation of magazines which are not published in India, can be pointers to use, since international travel has become commonplace with a sizeable section of the people. Nevertheless the availability of such magazines and periodicals and the nature of the product has to be considered by the Court, while evaluating the material, even for the purpose of temporary injunction. Now, in this case, ROCA has undoubtedly placed on the record copies of some magazines. However, curiously, all the magazines are in Spanish or French. ROCA has not shown if these foreign language magazines are readily available, or are accessed by members of the public generally, or even the class of consumers who normally purchase such "niche" goods which it markets. In these set of facts, to solely base a decision on the assumption of such circulation of the magazines in India, would be imprudent and unfeasible. Another aspect that the Court cannot overlook is that ROCA, has not placed any material of significance, showing that till recently it had any substantial presence in the Indian market. It was exporting products, for specific customers, usually hotels, on demand. Its class of customers - as available from the record is perhaps institutional, and corporate. It has also not shown any evidence about the costing of its goods, in India. In these circumstances, it is hard to conclude that it had a presence in the Indian ceramic tiles market, at the relevant time as a brand and occupied a market share. The material does point to a degree of exclusive clientele. Having regard to all these facts, it is held that ROCA has been unable to establish any significant presence in India, much less since 1979. It apparently has established some presence after it invested in Parryware. In the light of these circumstances, it is held disentitled to any injunction at this stage."

In *Skol Breweries v. Unisafe Technologies* 2010(3) MIPR 0037, the Court made the following pertinent observations:

"15. A trade mark denotes a connection in the course of trade between a manufacturer and his goods. It is an identification characterised famously as "a badge of origin". An important aspect here is that the mark should be distinctive; it should be capable of distinguishing the goods and services of one from another. The essence of trade mark protection is premised on protection of consumers, from being misled. An essential condition for protection is that the mark should have acquired some distinctiveness, and the claim for that is not founded on mere continued use. In the case of a trade mark dilution claim, the degree of distinctiveness, in this Court's opinion has to be higher because of the reference to acquisition (by the Plaintiff) of "a reputation in India" -an element not required to be established in trade mark infringement claims in respect of similar goods or products.

17. There is no evidence on record, to establish that the Plaintiff's KNOCK OUT has acquired distinctiveness and association with its product of such nature or fame that the consumer or user only thinks of the Plaintiff's brand of beer on

any reference to the expression, Knock Out. The Court is evaluating the evidence, on the basis of material on record: it is essential that the Plaintiff should rely on materials, which are not conjectual, but based on reality. The Plaintiff has not led any evidence to show that there was likelihood of consumer confusion, or that the Defendant, knowing the Plaintiff's mark, deliberately chose to use it. The Plaintiff was under an obligation to prove confusion, and not rely merely on the averments in the suit, and the documents filed, which it has failed to discharge."

Considering that in a trade mark dilution claim, what is of essence is the distinctiveness of the registered trade mark with particular reference to its "reputation in India", the Plaintiffs cannot hope to simply sustain, on the basis of averments in pleadings, their case of reputation in India by reason of an international reputation. They must actually adduce material to show that the nature and extent of international reputation of their trade mark is such that it can be said to be well-known even in India. I am afraid the Plaintiffs have not managed to do that in the present case.

20. Let us now consider if the adoption of the trade mark "JUST IN VOGUE" by the Defendant can be said to be "without due cause". The Defendant's case is that the adoption is honest, bona fide and with due cause. The word "Vogue" is an ordinary English word which is descriptive. It means fashion or prevalent way or popular usage and is often preceded by "in". (See, Webster's Dictionary.) Being an ordinary descriptive word, insofar as the band of protection afforded to trade marks is concerned, it has per se the lowest potential for protection. It may well be that even a descriptive word, by reason of its exclusive and extensive use by a trader, comes to acquire a secondary meaning and is thereby capable of distinguishing the goods of that trader. But that is not the case here, as I have shown above whilst dealing with the aspect of distinctiveness and reputation of the mark for the purposes of a case of dilution. If a trader dealing in "fashion" ware or publications adopts the word "fashion" or its synonym "Vogue" to describe his product, he must be taken to adopt such word with knowledge that other traders dealing in fashion ware or products are also likely to make legitimate use of the word. The use by others is not legitimate only if the word has come to acquire a secondary meaning or distinctiveness of a high order and their adoption is to take unfair advantage of this distinctiveness. The Defendant is a retailer of fashion goods and is certainly entitled to describe his stores as an outlet which deals in fashionable or trendy goods, that is to say, goods which are "in vogue". It cannot be said that there is any prima facie case of dishonest adoption by the Defendant so as to trade on the reputation or goodwill of the mark. There is no prima facie case of the adoption or use being without due cause within the meaning of clause (c) of sub-section (4) of Section 29.

21. That brings us to the central issue or common thread in all these cases, that is, the case of deceptive similarity between the competing trade marks. If the Plaintiffs do not make out "deceptive similarity" between the two marks, neither

of their cases, whether under Section 29(1), Section 29(2)(c), Section 29(4) or passing off, can succeed. The similarity itself, it is trite to say, may be found in various ways - visual, phonetic and structural, but in either case the marks must be compared as a whole and not broken into parts for a comparison. Besides, when one compares similarities in the various features of the marks, one also must look at the dissimilarities and consider whether the latter outweigh the former. And all this from the standpoint of consumers who are likely to buy the goods or avail of the services.

22. Before we deal with the issue on merits, it is necessary to consider one more aspect, namely, the Defendant's contention that the measure of "similarity" for the purposes of considering a case of infringement under Section 29(4) is different from "similarity" for a case under Sections 29(1) and (2). Ms. Arora submits that the "deceptively" similar standard is conspicuously absent in relation to infringement claims under Section 29(4) and that would imply that a plaintiff claiming dilution under Section 29(4) has to fulfill a more stringent test of proving identity or similarity of marks in order to succeed. She relies on the case of ITC Limited v. Phillip Morris Products Sa in support of her contention. In ITC Limited, a learned Single Judge of Delhi High Court has held that the identity or similarity standard under Section 29(4) is a "notch higher"; that there must be a "near identification" or "closest similarity" between the two marks. And this for the reason that the Parliament has consciously eschewed the "deceptively" similar standard, defined by Section 2, in relation to infringement claims under Section 29(4). With great respect to the learned Judge, I am unable to subscribe to this view. Both sub-section (2) and sub-section (4) form part of Section 29, which in the opening provision, i.e. sub-section (1), uses the expression "identical with, or deceptively similar to" in connection with the two competing marks. Whenever the marks are identical or deceptively similar, a case of infringement would lie. Sub-section (2) explains the case of infringement where identical or similar goods or services are covered under the two marks, whilst sub-section (4) deals with the case of dissimilar goods or services. In case of identical or similar goods, to make out a case of infringement one needs (a) identity between the marks and similarity between the goods/services, or (b) similarity between the marks and identity or similarity of goods/services, or (c) identity between the mark and identity between the goods/services. In case of dissimilar goods, what is needed is identity or similarity between the goods/services. In other words, in both cases, i.e. under sub-sections (2) and (4), the marks themselves have to be either identical or similar, and there is no reason why the expressions "identity" or "similarity", or "identical" or "similar", should have different meanings in the two provisions. There is no reason either from a lexicological standpoint or from a purposive standpoint. An "identity" would simply imply "identity", i.e. self-sameness or absolute sameness. There is no reason to include "near identity" within the expression "identity", since anyway such near identity, as much as "closest similarity", would be subsumed within the expression "similarity". On the other hand, when one considers "similarity",

we already have an accepted and time-tested standard of "deceptive similarity", evolved over a long time, as a relevant standard for testing similarity of competing marks. It is better to use that standard for gauging similarity even in cases of dilution rather than invent a new standard, say, of "closest similarity" as the learned Judge of Delhi High Court seems to suggest. The standard of deceptive similarity is stringent enough to include only such close similarity or near resemblance as would "be likely to deceive or cause confusion". The "degree of resemblance" left hanging simply by the expression "closest similarity" would not do any good, for "what degree of resemblance is necessary is, from the very nature of things, a matter incapable of definition a priori." (See, *Seixo v. Provezende* (1866) LRI Ch 192, used by the Supreme Court in *Amritdhara Pharmacy v. Satya Deo Gupta* AIR 1963 SC 449 (V 50 C 63)). We would still need an objective test to determine the "degree of resemblance" or "closeness of similarity" and there is no better test devised by law so far than the test of "deceptive similarity". I shall proceed accordingly.

23. With the focus of inquiry being thus put firmly in place, let us now consider the aspect of deceptive similarity. It is important to note that whilst the Plaintiffs' registered trade mark is the word "VOGUE", the Defendant in its impugned mark is not using the word simpliciter but in conjunction with two other words, namely, "JUST" and "IN VOGUE". Besides, the Defendant's mark is a device mark, which is rendered in a distinctive style of writing with the word "JUST", which is part of the corporate name of the Defendant, being prominently displayed above the words "IN" and "VOGUE" and in a font size which is significantly larger (said to be four times that of the word "VOGUE" used in the mark). The word "JUST" is further emphasized by an underline below it and is written in Italics. The font and writing style used by the Defendant for the word "VOGUE" are also not similar to the font/writing style used by the Plaintiffs for its trade mark "VOGUE". All this indicates that there is no per se visual, phonetic and structural similarity between the two marks, when they are compared as a whole, that is to say, without breaking them into parts for comparison. Compared to the similarity in the two marks, which is signified only by the use of the word "VOGUE" in both the marks, the word being the whole of the mark in case of one and in a combination of words in the other, the dissimilarities between the two, which are noted above, viewed in their entirety, sufficiently outweigh this singular similarity. In the Plaintiffs' own case decided by the United States Court of Customs and Patent Appeals in *The Conde Nast Publications, Inc. v. Miss Quality, Inc.*, Patent Appeal No.74-554 : 507 F.2d 1404 (1975) the Court refused to grant any relief to the proprietor of the mark "VOGUE" in respect of a competing mark "COUNTRY VOGUES". The Court held that the only similarity between the two marks was that VOGUE was part of the mark "COUNTRY VOGUES" and the dissimilarities between the marks, viewed in their entirety, outweighed the similarity sufficiently to leave no doubt. There is no reason why the same result would not follow in the case of the mark "JUST IN VOGUE" for the same reason.

24. Learned Counsel for the Plaintiffs also contended at the bar that the words "IN VOGUE" are being used by the Plaintiffs for describing a distinct section in their magazine VOGUE, where the Plaintiffs describe new trends in fashion goods, and that the words "IN VOGUE" have also accordingly required distinctiveness and form part of the goodwill of the Plaintiffs. This case has been pleaded for the first time in the plaint. Neither in the seize and desist notice nor in the follow up notice or in the plaint or amended plaint filed before the Delhi High Court have the Plaintiffs taken up such plea. Even otherwise, this plea is a non-starter, since the Plaintiffs' registered trade mark, which alone is entitled to protection under Section 29(4), if any, is VOGUE and not IN VOGUE. Whether or not the words "IN VOGUE" have acquired any distinctive meaning is completely irrelevant insofar the case under Section 29(4) is concerned. Besides, considering the fact that I have come to a conclusion that prima facie there is no reputation of the order requisite for a dilution claim of the magazine VOGUE in India, there is no question of a certain section within the magazine having such reputation or entitling the Plaintiffs to any protection under Section 29(4).

25. In the premises, the Plaintiffs have failed to make out any prima facie case for protection under Section 29(4) either.

26. The Notice of Motion is, in the premises, dismissed. Costs to be the costs in the cause.