

(2009) 11 DEL CK 0348

In the Delhi High Court

Case No : CS (OS) 675 of 2008 and I.A. No. 4508 of 2008

Colgate Palmolive and Others

APPELLANT

Vs

Capital Overseas Ltd.

RESPONDENT

Date of Decision : 18-11-2009

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 8 Rule 10

Citation : (2009) 11 DEL CK 0348

Hon'ble Judges : S. Ravindra Bhat, J

Bench : Single Bench

Advocate : Vaishali Kakra and Ishani Chandra, for the Appellant; Nemo, for the Respondent

Final Decision : Disposed Off

Judgement

S. Ravindra Bhat, J.

CS(OS) 675/2008

1. The plaintiffs, by way of this suit, seek a decree of permanent injunction against the defendant from using, manufacturing, selling, distributing, advertising, importing, exporting or in any manner dealing in dental and oral care products under the trademark NAVIGATOR or any other mark deceptively similar to the plaintiffs' registered trademark and further in any design that is identical or a colorable imitation of the plaintiffs' registered design for COLGATE 360 degree toothbrush or any deceptively similar design and from doing any other thing leading to passing off an order of delivery-up is also sought.

2. The first plaintiff claims to be a company incorporated under the laws of State of Delaware and having its registered office in New York. The second plaintiff is the Indian subsidiary of the first plaintiff and the licensed user of the first plaintiff's trademarks including COLGATE, COLGATE NAVIGATOR and COLGATE 360 degree. It is stated that the first plaintiff was founded in early 19th century and since inception it has expanded extensively and is now one of the largest

companies in the world, with four core areas of operation, namely Oral Care, Personal Care, Home Care and Pet Nutrition; its products are sold worldwide. Further, COLGATE NAVIGATOR and COLGATE 360 degree are well-known in line of toothbrushes in several countries and in India since September, 2000 (in case of COLGATE NAVIGATOR) and March, 2006 (in case of COLGATE 360 degree). It is claimed that the said products enjoy a substantial market share in Indian toothbrush market with annual sales claimed to be running into crores of rupees; the annual sales turnover of the second plaintiff for the NAVIGATOR is narrated as under:

YEAR SALES (Rs. "000)

2001	45,164	2002	10,896	2003	22,449	2004	19,447	2005	18,559	2006	14,615
2007	3,688										

Huge amounts have been spent on advertising of the said product (NAVIGATOR), to the tune of Rs. 86 Lacs. For the COLGATE 360 degree toothbrush, the plaintiff claims sales revenues to the tune of Rs. 3,72,96,000/- in the year 2006 and Rs. 4,82,42,000/- for the year 2007; it was launched in March 2006.

3. The first plaintiff is the registered proprietor of the trade mark NAVIGATOR in class 21 in respect of toothbrushes under No. 814553, dated 13.08.1998. The said registration has been duly renewed and is subsisting in full legal force. The plaintiffs' COLGATE 360 degree toothbrush is claimed to have a unique and novel shape, configuration and surface pattern; in India it is the subject matter of design registration under No. 194742 dated 10.09.2003, the registration is valid upto 10.09.2008. The said design is registered in the United States of America as well. The plaintiff also claims registered patents for the mechanical aspects of the COLGATE 360 degree toothbrush in the USA and similar applications in India are pending. The unique features of the COLGATE 360 degree toothbrush as stated in the plaint are that it has a unique tongue and cheek cleaner located on the head that helps remove more bacteria than brushing teeth with an ordinary manual toothbrush. The said toothbrush also has specially tapered bristles, a cleaning tip and dentist like polishing cup that helps remove plaque and stains. It is these unique features and scientific design of the said products, which makes it a market leader. The plaintiff relies upon a study conducted by the Compendium of Continuing Education in Dentistry, published in the 10th issue (supplement 2) according to which, in comparison to ordinary toothbrushes COLGATE 360 degree toothbrush reduced plaque by as much as 40% and oral malodor over three times better than the leading manual and battery operated toothbrushes, thus providing upto 10 hours of lasting fresher breath.

4. The plaintiff alleges that the defendant is selling its products under the mark Dr. White NAVIGATOR, which fact was discovered by the plaintiff in August, 2007 and also that the design of the defendant's product is almost identical to the registered design of the plaintiffs' COLGATE 360 degree toothbrush. The defendant is believed to be the manufacturer and/or importer of the said

infringing product. The defendant's use of the mark NAVIGATOR amounts to infringement of the plaintiff's registered trade mark. The plaintiffs have juxtaposed the photographs of their product and that of the defendant in their plaint and have also submitted a comparative chart of the said two products, which is reproduced as under: (Pg. 33 chart).

5. It is the claim of the plaintiffs that the design of the COLGATE 360 degree toothbrush has memorable characteristics due to its uniqueness and that it draws instant connotation with the plaintiffs' said product. The unique design is a key factor influencing the consumers' decision. By replicating the same, the defendant has clearly manifested mala fide intentions obviously with an aim to divert a portion of plaintiffs' sales for the said product in its favour. The representations made by the defendant in this regard are unauthorized and illegal aimed at confusing or deceiving the public at large. The acts of the defendant amount to infringement and passing off. A comparative chart showing feature by feature imitation of the plaintiff's mark and design, is given in Para 13 of the suit.

6. This Court had, at the stage of entertaining the suit, compared the two products visually, and observed that they disclose a very close similarity, if not identity, and that the defendant had copied the plaintiffs' product's essential features, by its order dated 11th April, 2008. After summons were served, an appearance was made on behalf of the defendant; no less than six adjournments were granted, on the ground that the defendant was willing to settle the disputes. However, no settlement was forthcoming, nor did the defendant file any written statement, within the time granted by the Code of Civil Procedure; the defendant did not also seek any extension of time. The defendant was also unrepresented today.

7. In the above circumstances, the Court is left with no option but to invoke the powers under Order 8, Rule 10, which mandates that in the event of no written statement forthcoming by the defendant within the time permitted by the Code, or the extended time granted by the Court, the latter "shall proceed to pronounce judgment" against him (i.e. the defendant).

8. The plaintiffs have in support of their suit, produced the documents, and had also produced the sample of an infringing product of the defendant. A visual comparison, establishes that the defendant's product very closely resembles the plaintiffs' mark and registered design, as to cause deception to the casual and unwary customer about the real identity. The likelihood of confusion is strong, and was so observed by the Court, even on 11th April, 2008. The suit is supported by an affidavit on behalf of the plaintiff. The defendant has, despite service of summons, not cared to render any explanation, plausible or otherwise, about the allegations regarding infringement, made in the suit, by the plaintiffs. In terms of the Trademarks Act, 1999, even shapes constitute "mark" falling within the description of trademarks, capable of protection. In these circumstances, the Court is satisfied that the plaintiffs have established, from the

pleadings, and the materials on record, that the relief of injunction claimed by it should be granted.

9. In this case, the plaintiffs had not sought for appointment of any local commissioner, nor was it granted. In these circumstances, the extent or degree of harm caused to the plaintiffs by such infringing activity by the defendant has not been established. It is possible that the extent of infringement may be severe; equally, it could be otherwise. The plaintiffs have not placed any other materials to show the defendant's market, and customers. In the light of such pleadings, it is not possible for the Court to infer that there has been severe or extensive damage to the plaintiffs which can be quantified in monetary terms, as is sought to be projected in the suit.

10. In view of the above discussion, it is held that the plaintiffs are entitled to injunctive relief, and delivery up. Accordingly, CS (OS) 675/2008 is decreed, in terms of Para 20 (a) to (d), with costs; counsel's fee is quantified at Rs. 50,000/-.