
(2009) 02 CAL CK 0041
In the Calcutta High Court
Case No : F.M.A. No. 590 of 2006

Gillette India Limited

APPELLANT

Vs

Harbans Lal Malhotra and Sons Private Limited

RESPONDENT

Date of Decision : 13-02-2009

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, 151

Citation : (2009) 41 PTC 378

Hon'ble Judges : Subhro Kamal Mukherjee, J; Manik Mohan Sarkar, J

Bench : Division Bench

Advocate : Sudipta Sarkar, Hemant Singh, P.G. Das, M. Bhattacharya and C. Dutta, for the Appellant; Gautam Chakraborty, Somendra Nath Mukherjee, Ratnanko Banerjee and I. Karim, for the Respondent

Final Decision : Allowed

Judgement

Subhro Kamal Mukherjee, J.—This is an appeal against Order No. 8 dated April 13, 2006 passed by the learned Judge, Eleventh Bench, City Civil Court, Calcutta, in Title Suit No. 274 of 2006.

2. By the order impugned the learned trial Judge allowed an application for temporary injunction filed by the Plaintiff under Order 39, Rules 1 and 2 read with Section 151 of the CPC in the said suit on contest; the ad interim order of injunction passed by the said court on March 8, 2006 was made absolute till the disposal of the said suit.

3. This appeal arises out of a suit for declaration and permanent injunction. The Plaintiff files the suit for declaration that the use of mark champion as suffix to the mark Mach 3 Turbo by the Defendant is identical and deceptively similar to the registered trade-mark champion of the Plaintiff and hence resulting in an infringement and/or passing off their goods as those of the Plaintiff. The Plaintiff, also, prays for a decree for permanent injunction restraining the Defendant and all persons connected with the Defendants or acting on behalf of the Defendant

from in any way using the trade-mark champion of the Plaintiff in any form either per se or in combination with other marks, which is very identical and deceptively similar to the registered trade-mark of the Plaintiff in respect of safety razor blades, safety razors and allied goods in any manner whatsoever; an enquiry into the loss and damage by the Plaintiff and decree for the amount found due upon such enquiry; delivery and destruction of all the offending goods bearing the trade-mark champion.

4. The Plaintiff states that the Plaintiff is a renowned manufacturer, merchant and exporter, inter alia, of safety razor blades, safety razors, blades and shaving systems. In respect of the safety razors and safety razor blades, the Plaintiff has been and is still using the trade-mark champion since 1962. The Plaintiff is the registered proprietor of the said mark champion since 1964. The registration of the trade-mark is in force, valid and subsisting. The trade-marks of the Plaintiffs have acquired global brand recognition and the Plaintiff has created strongest consumer brands in the country and, also, in abroad. The safety razors and safety razor blades bearing the said trade-mark champion have a large sale and have earned considerable goodwill and imputation amongst the members of the public trade associates and in the market at large. The consumers identify the said mark with the Plaintiff and none else. The Defendant introduces shaving razors bearing the mark Much 3 Turbo champion by prefixing the registered trade-mark of the Plaintiff with the trade-mark of the Defendant, that is, Much 3 Turbo, which is deceptively similar to the trade-mark of the Plaintiff. The mark champion adopted by the Defendant-Company is likely to lead and/or may lead purchasers and/or consumers to believe that the goods under the mark Mach 3 Turbo champion offered for sale by the Defendant has originated from the Plaintiff or that the Defendant has business connection with the Plaintiff and/or the Plaintiff is a subsidiary of the Defendant. The Defendant, also, assured the Plaintiff, in course of negotiations, that the Defendant will not use the registered trade-mark champion of the Plaintiff in relation to double edged conventional blades. The Plaintiff alleges that the action of the Defendant has been tarnishing the image of the Plaintiff and causing huge loss and hampering its business besides such infringement and/or passing off.

5. The said suit is registered as Title Suit No. 274 of 2006 and is presently pending before the learned Judge, Eleventh Bench, City Civil Court, Calcutta.

6. In connection with the said suit, the Plaintiff filed an application for temporary injunction under Order 39, Rules 1 and 2 read with Section 151 of the Code of Civil Procedure, inter alia, seeking an order of temporary injunction restraining the Defendant and persons connected with the Defendant in any way using the trade-mark champion of the Plaintiff in any form either per se or in combination with other marks in respect of safety razor blades and safety razors and allied products. In support of its contention the Plaintiff produces a certificate issued by the Trade-mark Registry, dated August 7, 1968 showing the trade-mark champion is registered in the name of the Plaintiff in respect of safety razor

blades and safety razors.

7. The Defendant contested the application for injunction by filing their written objection. The Defendant denied and disputed each and every allegation made by the Plaintiff in their application for temporary injunction. The Defendant states that it has already challenged the validity of the registration of the trade-mark of the Plaintiff and applied before the Intellectual Property Appellate Board seeking removal and cancellation of the trade-mark registration of the Plaintiff. The Defendant states that the mark champion is commonly used by the members of the trade as a laudatory epithet and bona fide trade description in conjunction with their respective trade-marks. The expression champion is used to proclaim superiority of the quality of particular branded products in comparison to those of other competitors. The term is commonly used by the members of the trade for brand imagery and as a laudatory epithet. The Defendant gives a long list of examples of such common trade use of the mark champion by members of trade as trade description in conjunction with their respective brands so as to proclaim superiority of the quality of their products. The Defendant maintains that no single manufacturer or trader can be allowed in law to monopolize such a laudatory mark so as to deprive other members of the trade from using it. The brand Gillette Mach 3 Turbo is well known and internationally famous household brand and used by the Defendant for years internationally as well as in India in relation to safety razors of the Defendant. The name Gillette is used for over 100 years in relation to razors and blades internationally and in India since 1993. Technically advanced and superior razors Gillette Mach 3 Turbo was globally launched sometime in March/April 2002 in the international market and in India sometime in June 2004.

The Defendant is not using the expression champion as a trade-mark. Like other members of the trade, the Defendant is, also, using champion for brand imagery and as bona fide trade description to laud the quality of its safety razors. Since the Defendant is not using champion as a trade-mark or as part of its trade-mark, there is no infringement committed by it. The expression champion was adopted by the Gillette Company, U.S.A., which is the licensor and parent company of the Defendant, in September 2003 as a laudatory term for brand imagery and used extensively as such in relation to its Gillette Mach 3 Turbo shaving razors packing, which was preceded with a television commercial which featured a person driving a red sports car as a champion whose preference is shown to be for the product of the Defendant, that is, Gillette Mach 3 Turbo shaving razor. The advertisement uses the latest model of a fast sports car to highlight the unsurpassed engineering, unparalleled technology and appealing looks, which are the hallmark of a champion.

The advertisement goes on to create the same imagery for the Defendant's product which, also, employs superlative engineering technology and an appearance, which cannot be compared to any other product. The rationale employed is that most people have a bit of a race driver in them and the imagery

of a champion will, therefore, appeal to them. The produce has been designed to give a look that conveys the speed and achievement of a high performance car. The name champion, therefore, captures the essence of a high performance car. The mark champion is used upon packaging of the Defendant merely to indicate a co-relation between the produce and the television commercial and for brand imagery, that is, a champion brand/a champion product/choice of champions. The said product and television commercial were launched in India in May 2005. The Defendant has spent a sum of Rs. 5.5 crore on the champion television commercial, which is pertaining to Gillette Mach 3 Turbo safety razors. The said product has sold close to Rs. 7 crore since the launched. The use of the mark champion in conjunction with the trade-mark of the Defendant does not dilute the distinctiveness of the trade-mark of the Defendant Gillette Mach 3 Turbo and the source and trade origin indicated and identified by it. The mark champion is used alongwith the trade-mark Gillette Mach 3 Turbo, which is in conformity with the trade practice. There is no confusion or deception between the two trade-marks of the parties.

8. The Defendant annexed a copy of the petition seeking removal/rectification of the trade-mark registration of the Plaintiff filed by the Defendant before the Intellectual Property Appellate Board to the said written objection.

9. By order impugned dated April 13, 2006 the learned trial Judge allowed the application for temporary injunction, inter alia, with the finding that the product produced by the Defendant by using the word "champion" may result confusion in the mind of a buyer of ordinary prudence and memory.

10. Being aggrieved the Defendant has preferred this appeal before this Court.

11. Mr. Sudipta Sarkar, learned senior counsel, appears in support of this appeal. He assails the order passed by the learned trial Judge by submitting that the learned trial Judge ought not to have passed an order of temporary injunction in favour of the Plaintiff when the Plaintiff never manufactured safety razor using the trade-mark champion. He submits that the customers of the Defendant belongs to a different category and are interested in high value expensive products. Therefore, the apprehension of deception of the Plaintiff is wholly misplaced. Mr. Sarkar, further, submits that the Defendant is no way using the trade-mark of the Plaintiff, but only using the expression champion prefixing such expression with well known trade-mark of the Defendant, that is, Gillette Much 3 Turbo. Mr. Sarkar, finally, submits when an application for rectification was pending before the Intellectual Property Appellate Board, the learned trial Judge ought not to have passed an order of temporary injunction in favour of the Plaintiff. Mr. Sarkar cites the decisions in the cases of J.R. Kapoor v. Micronix India 1994 (2) ALR 274 : 1994 (14) PTC 260 (SC) , Chandra Bhan Agarwal and Another Vs. Arjundas Agarwal and Others, R.J. Reynods Tobacco Company Vs. Indian Tobacco Company Ltd., , Pepsico Incorporated v. Express Bottlers Services Pvt. Ltd. and Anr. 1987 IPLR 71 and Vishnudas Trading as Vishnudas Kishandas Vs. Vazir Sultan Tobacco Co. Ltd., Hyderabad and another, .

12. Mr. Gautam Chakraborty, learned senior counsel, appearing on behalf of the Plaintiff/Respondent in this appeal, on the contrary, supports the order passed by the learned trial Judge. Mr. Chakraborty submits that the Plaintiff is the registered proprietor of the trade-mark champion in relation to safety razor blades and safety razors and, therefore, the Defendant cannot use the said mark under the guise that the expression is laudatory. In support of his contention Mr. Chakraborty cites the decision of the Supreme Court of India in the case of Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, . Mr. Chakraborty submits that the appellate court should not interfere with the exercise of discretion of the court of first instance when the learned trial Judge exercised such discretion reasonably and in a judicial manner.

13. The Defendant is well known international firm dealing with shaving systems. The Defendant is the proprietor of the registered trade-mark Gillette Mach 3 Turbo. The brand is internationally famous brand. The trade-mark is used by the Defendant for years in the international market including in India. It is submitted before us that the said trade-mark Gillette has been in use for over 100 years in relation to razors and blades globally. In India the brand was introduced sometime in 1993. Safety razor Gillette Mach 3 Turbo was globally launched sometime in 2002. It came to India sometime in 2004. The Defendant, prima facie, is not using the mark/expression champion as a trade-mark. The mark/expression champion, according to us, prima facie, is used by the Defendant to laud the quality of its product. Gillette safety razors, including Gillette Mach 3 Turbo safety razors, are purchased by the consumers going by the trade-mark Gillette. The use of the mark/expression champion in conjunction with the trade-mark of the Defendant does not dilute the distinctiveness of the trade-mark of the Defendant, that is, Gillette Mach 3 Turbo.

14. In an action for infringement of trade-mark or of passing off, in order to obtain an order of temporary injunction, it is incumbent upon the Plaintiff to show that the goods of the Plaintiff have acquired a distinctiveness and are associated in the mind of general public as goods of the Plaintiff and that the user of the said trade-mark or the trade-name by the Defendant is likely to deceive and cause confusion in the public mind and cause injury to the business reputation of the Plaintiff.

15. Although the Plaintiff is the proprietor of the trade-mark champion in relation to safety razor blades and safety razors, but the Plaintiff never manufactured nor marketed safety razor under the said brand name. Therefore, the apprehension of the Plaintiff that an unwary customer will be deceived or confused or mislead is misplaced.

16. Prima facie, it appears to us the mark/expression champion is; used alongwith the trade-mark Gillette Much 3 Turbo, which is in conformity with the trade practice. The Defendant has shown in its written objection that the said mark/expression is commonly used by the members of the trade for brand imagery and as a laudatory epithet. We are convinced that there is no likelihood

of any confusion or deception between the two marks of the parties. It is not in dispute that the Defendant has invested large sum of money in advertising as well as in promotional campaigns involving the product-in-dispute.

17. In the instant case, the Plaintiff would not suffer any injury if during the pendency of the suit the Defendant is permitted to market its product Gillette Mach 3 Turbo by using the mark/expression champion in conjunction with the Defendant's trade-mark. If the Plaintiff succeeds in the suit, the Plaintiff will be compensated by pecuniary damages. On the contrary, if the Defendant is enjoined from marketing its product, the inconvenience suffered by the Defendant would remain irremediable.

18. The decision cited by Mr. Chakraborty in the case of Kaviraj Pandit Durges Dutt Sharma (*supra*) is distinguishable on facts. In this case, two marks, namely, champion safety razor and champion Gillette Mach 3 Turbo safety razor are not identical and, therefore, *prima facie*, no case of infringement is made out, particularly, when the Plaintiff never manufactured or vendes safety razor with their trade-mark champion. *Prima facie*, the word champion is regularly used in commercial world in conjunction with their respective trade-marks to proclaim superiority of the quality of their respective products.

19. True it is that grant or refusal of injunction is a matter of discretion of the court and no doubt a court of appeal, normally, does not disturb the findings of fact. Nevertheless, we find that the findings were arrived at by the learned trial Judge not on proper consideration of the law on the subject and as such the order is required to be set aside by us.

20. At the same time, we are not unmindful of the interest of the Plaintiff. We, therefore, direct that the Defendant should keep the accounts in respect of manufacture and sale of its product bearing the mark/expression champion.

21. The order impugned, thus, stands set aside, The application for temporary injunction filed by the Plaintiff stands rejected. The appeal stands allowed. However, the Defendant should keep the accounts in respect of manufacture and sale of its product bearing the mark/expression champion during the pendency of the suit.

22. We record that the findings, if any, made by us, in disposing of this appeal against the order granting temporary injunction, cannot in any way take the place of the findings to be arrived at in disposing of the suit now pending before the learned trial Judge. We are of the opinion, on the materials now on record, that the learned trial Judge was wrong in passing the order impugned.

We, however, direct the parties to bear their respective costs in this appeal.