

(2018) 01 DEL CK 0101

In the Delhi High Court

Case No : 709 of 2011

M/S THREE-N-PRODUCTS PVT. LTD

APPELLANT

Vs

M/S KAIRALI EXPORTS AND ANR

RESPONDENT

Date of Decision : 03-01-2018

Acts Referred:

[Trade Marks Act, 1999](#), [Section 17\(1\)](#),
[Section 17](#), [Section 17\(2\)](#) - Effect of
registration of parts of a mark - Effect of registration of parts of a mark - Effect of
registrati

Citation : (2018) 01 DEL CK 0101

Hon'ble Judges : Sanjeev Sachdeva

Bench : Single Bench

Advocate : Sharab Sriastava, Manu T. Ramchandran, Poonam Atey, Birendra Mishra

Final Decision : Dismissed

Judgement

IA No.4708/2011 (under Order XXXIX Rules 1 & 2 CPC & IA

No.10589/2011 (under Order XXXIX Rule 4 CPC

1. The plaintiff has filed the subject Suit seeking inter alia the relief of permanent injunction for passing off, infringement of trademark, rendition of account, etc. The plaintiff claims to be the registered proprietor of the mark "AYUR" in various classes. It is claimed that the predecessor of the plaintiff adopted the mark in the year 1984 and has used the same continuously and uninterruptedly. The plaintiff also claims to hold a registration in respect of tissues, (piece goods), bed and table cover, textile article not included in other classes, in class 24 and in respect of clothing including boots, shoes and slippers in class 25. The plaintiff also claims to hold registration in several countries internationally of the trademark "AYUR". In these circumstances, the plaintiff claims to be the proprietor of the mark "AYUR" having used the same continuously since 1984.

2. As per the plaintiff, defendant no. 1 adopted the mark "AYURVASTRA" which is stated to be identical and similar to the plaintiff's trademark "AYUR" in respect of clothes, sarees, dress materials and fabrics, bed sheets and table covers, bleached clothes, textiles and textile piece, readymade garments, clothing, footwear, caps, headgear. As per the plaintiff, it became aware of the use of the trademark "AYUR" by the defendants for the first time in October, 2009, when defendant no. 2 made an application seeking registration of the mark "AYURVASTRA"

3. The plaintiff thereafter claims to have issued a cease and desist notice, consequent to which the defendant no. 2 is alleged to have admitted their improper adoption and agreeing to discontinue the mark "AYUR" and "AYURVASTRA". Believing the representation of the defendants to be correct, the plaintiff treated the matter as closed, however, subsequently once again came across use of the mark "AYURVASTRA"; accordingly, instituted the present suit.

4. The plaintiff seeks permanent injunction against the defendants on the ground that plaintiff is the prior adopter of the mark "AYUR" in respect of its goods and services since the year 1984 and has extensively and uninterruptedly used the same. Plaintiff has substantial reputation and goodwill because of the use of the said mark and has the exclusive right in respect of the mark "AYUR" and its derivatives in respect of goods and services established in classes 24 and 25, the classes in which the defendants' goods fall. The plaintiff enjoys global reputation and goodwill and has made huge sale and has substantial turnover and has substantially advertised the mark "AYUR" through various media - prints as well as electronic, besides making its goods available online through its website. It is contended that the adoption of the mark by the defendant is a colourable invitation of the well-known trademark of the plaintiff, as the same comprises of identical and deceptively similar word element "AYUR". The adoption of the mark by the defendants is malafide and dishonest.

5. It is contended that the mark of the plaintiff "AYUR" is an invented word and has no meaning whatsoever and is associated only with the goods of the plaintiff. The plaintiff relies on the decision of this Court in the case of the plaintiff itself, i.e., M/s Three-N-Products Pvt. Ltd. Vs. Yashwant & Ors. 95 (2002) DLT 271.

6. Defendant no. 1 in its written statement has contended that the marks of the plaintiff as well as defendant are different. The plaintiff has no exclusive right in the word "AYUR" per se as the word "AYUR" is a word of very distinctive character and word "AYUR" being an abbreviation of "AYURVEDA" signifies that the product is of Ayurvedic qualities and in view of Section 17 of the Trademarks Act, the plaintiff cannot obtain exclusive proprietary rights over the word "AYUR". It is contended that the plaintiff has failed to produce any evidence of the use of the mark in respect of the goods in class 25 in which the goods of the defendants fall.

7. Defendant no. 1 claims to be engaged in manufacturing and selling eco-

friendly organic handloom fabric, which is dyed using Ayurvedic herbs. It is contended that the mark "AYURVASTRA" is a composite mark comprising of the word "AYUR" derived from the word "AYURVEDA" and the word "VASTRA" meaning clothes. It is contended that the word "AYUR" per se is publici juris. Defendant no. 1 claims to be using the said mark with a unique logo, which is capable of identifying its own independent source of identity. The said defendants also claim to have spent substantial amounts on promotion on its products under the trademark "AYURVASTRA". Defendant no. 1 relied on the decision, in the case of the plaintiff itself, of the Calcutta High Court in Three-N-Products Private Limited Vs. Emami Limited dated 29.01.2010 in APO No. 248 of 2008 in CS No. 204/2007 to contend that the plaintiff cannot claim exclusive right to the use of the word "AYUR" as the same is a generic word. Reliance is also placed on the order of the Supreme Court dismissing the Special Leave Petition against the said judgment.

8. Defendant no. 2 in its written statement has contended that defendant no. 2 is neither a necessary nor a proper party to the suit. Defendant no. 2 claims to be a society of weavers who make clothes of different types of different agencies including private agencies as well as Central Government and is engaged in the upliftment of the handloom weavers community in Kerala. The handloom weavers have been calling their clothes "AYURVASTRA" since times immemorial as they were doing herbal dying using Ayurvedic medicinal plants. Defendant no. 2 contends that it had initially agreed to the cease and desist notice of the plaintiff because of the pressure from the attorneys of the plaintiff and incorrect legal advice. It is denied that there is any working partnership between defendant no. 1 and defendant no. 2 except few contract based job works.

9. Section 17 of the Trademarks Act, 1999 confers on the proprietor of a mark exclusive right to use of the trademark taken as a whole. Section 17(2) lays down that notwithstanding Section 17(1) where a trademark contains any matter, which is common to trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part or the whole of the trademark.

10. The plaintiff has based its suit primarily on the ground that the trademark of the plaintiff is an invented word and has no other meaning whatsoever. The entire basis of the claim of the plaintiff is that it has invented the word "AYUR" and by extensive use of the word "AYUR" and the association thereof with its goods since 1984, the said mark has acquired distinctiveness and is identified with the goods of the plaintiff alone.

11. The claim of the plaintiff ex-facie appears to be the incorrect. The word "AYUR" finds mentioned in the Hindu Religious Texts i.e. the Vedic Puranas, which has used the word "AYURVEDA". The word "AYUR" signifies healthy life and the word "VEDA" signifies knowledge. The word "AYURVEDA" is a Sanskrit term comprising of two words - "AYUR", which means life or vital power, and "VEDA" - which means science or knowledge. The word "AYURVEDA" signifies knowledge

or science of life. The whole basis of the claim of the plaintiff that word "AYUR" is invented by the plaintiff and adopted for the first time in 1984 is ex-facie incorrect. The word "AYUR" has been used historically and is derived from the Hindu Vedic Texts.

12. The protection of a trademark is dependent on whether the mark adopted is generic, descriptive, suggestive, arbitrary or fanciful. The marks, which are generic, descriptive or suggestive have lower level of legal protectability and the marks, which are arbitrary or fanciful, have higher level of legal protectability. If a person adopts a mark, which is generic or descriptive in nature, he runs the risk of the mark having a lower level of legal protectability. In the present case, plaintiff had adopted the word "AYUR" to describe its products. The word "AYUR" as noticed above is a word derived from the Sanskrit Religious Texts of the Vedic Puranas. The word "AYUR" is neither an arbitrary nor a fanciful mark having a higher level of legal protectability. The Plaintiff thus cannot prima facie claim any proprietorship on the word "AYUR" per se.

13. The plaintiff having adopted a mark, which is generic or descriptive, cannot claim legal protectability for the mere asking. It is not that a generic or descriptive mark will never have any legal protectability but the burden of proof on the person claiming distinctness in favour of a generic or descriptive mark is much higher. The plaintiff not only would have to show that the mark adopted by the plaintiff, because of its extensive use has acquired distinctness and is identifiable only with the goods of the plaintiff but also that the adoption of the mark by the defendants is identical and deceptively similar to the mark of the plaintiff.

14. In the present case, the plaintiff is using the mark "AYUR" as under: "IMAGE OMITTED"

whereas the defendants have used the mark "AYURVASTRA" as under:

"IMAGE OMITTED"

15. Since the plaintiff has adopted the word "AYUR", it runs the risk of lesser level of legal protectability. It is apparent from the mark of the defendants that it is completely distinct and different from the trademark of the plaintiff. The defendants used the mark "AYURVASTRA" in a completely different style, design and getup from that of the plaintiff. The defendants have also rendered an explanation that their trademark "AYURVASTRA" is used on cloth, for the manufacture of which herbal dying process is used, using Ayurvedic medicinal plants. The explanation of adoption of the mark "AYURVASTRA" by the defendants is plausible and reasonable.

16. The decision in the case of Yashwant & Ors. (Supra) relied on by the plaintiff does not help the case of the plaintiff, in as much as, in the said case. The Court held that the trademark of the defendants was an exact replica of the plaintiff's trademark, which could not be a sheer coincidence. The Court held "assuming

that AYUR is a common dictionary word, its adoption by the defendants in exactly the same style, design, getup as that of the plaintiff would prima facie indicate that in doing so the defendants were motivated by the desire to cash on the popularity, goodwill and reputation of the said trademark." In the present case as noticed above, style, design, getup trade dress of the defendants "AYURVASTRA" is not identical to that of the Plaintiffs" but is different and distinct.

17. Prima facie I am of the view that the plaintiff has failed to establish a prima facie case in their favour for grant of an ad-interim injunction. The mere fact that plaintiff claims to be a prior adopter or has substantial turnover and has spent substantial amount on the development is of no consequence. The balance of convenience is not in favour of the plaintiff or in favour to the grant of an ad-interim injunction.

18. The plaintiff has also failed to show that by use of the mark "AYURVASTRA" by the defendant, the public is likely to get deceived or likely to associate the products of the defendants with the plaintiff.

19. In view of the above, the plaintiff is not entitled to grant of an ad-interim injunction. Accordingly, the application being I.A. No.4708/2011 (under Order XXXIX Rules 1 & 2 CPC) is dismissed and I.A. No. 10589/2011 (under Order XXXIX Rule 4 CPC) is allowed. The interim order dated 23.03.2011 is vacated. CS(OS) 709/2011

List before the roster Bench for directions on 10.01.2018.