

(2022) 03 DEL CK 0010

In the Delhi High Court

Case No : Civil Suit (COMM) No. 18 Of 2022?

Soothe Healthcare Private Limited

APPELLANT

Vs

Dabur India Limited ?

RESPONDENT

Date of Decision : 03-03-2022

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39 Rule 1, Order 39 Rule 2
Trade Marks Act, 1999 — Section 9(1)(a), 9(1)(c), 17, 17(2), 28, 29, 30, 30(2)(a),
30(a), 31, 35

Citation : (2022) 03 DEL CK 0010

Hon'ble Judges : Amit Bansal, J

Bench : Single Bench

Advocate : Anant Bhushan, Hemant Singh, Manish Kumar Mishra, Akansha Singh, Shakti Priyan Nair, Srinivas Venkat Ragan?

Final Decision : Dismissed?

Judgement

Amit Bansal, J

I.A. No. 444/2022 (Order XXXIX Rules 1 and 2 of CPC)

1. By way of the present judgment, I propose to decide the application filed on behalf of the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC) for grant of interim injunction pending the disposal of the suit.

2. The plaintiff has filed the present suit seeking permanent injunction against the defendant from infringing/passing off, inter alia, the trademarks of the plaintiff and other ancillary reliefs. In the suit, it has been pleaded that:

(i) Plaintiff company, incorporated in 2012 is in the business of manufacturing, marketing and trading all goods relating to personal hygiene including sanitary preparations and allied products. Since January, 2020, the plaintiff ventured into the manufacturing and trading of diapers.

(ii) Plaintiff has obtained trademark registrations in its favour for the marks 'SUPER CUTESTERS', 'SUPER CUTES' and 'SUPER CUTEZ'. Details of the trademark/device mark/word mark of the plaintiff are set out below:

S.No.

Application

No.

Trademark/Device Mark

Status

1.

4381587

SUPER CUTESTERS

Registered

2.

4440064

Registered

3.

4465892

SUPER CUTES

Registered

4.

4465891

SUPER CUTEZ

Registered

(iii) Trademark application in respect of the trademark/device mark 'SUPER CUTES' is pending registration before the Trademark Registry.

(iv) The plaintiff has given wide publicity to the said trademarks and the products under the said trademarks are identified and associated by the public and trade exclusively with the plaintiff. Famous celebrities have served as Brand Ambassadors in respect of the Plaintiff's products.

(v) The trademarks 'SUPER CUTESTERS', 'SUPER CUTES', and 'SUPER CUTEZ' have gained immense popularity and reputation in relation to the plaintiff's products amongst the plaintiff's consumers and the general public.

(vi) In support of this, the plaintiff has given the sales figures for the period April 2020 to March, 2021 and April, 2021 to December, 2021 and also the advertisement expenditure in respect of the aforesaid trademarks as per the Books of Accounts maintained by the plaintiff.

(vii) The plaintiff is the prior adopter and registered proprietor of various trademarks/device marks/wordmarks as mentioned above and enjoy exclusivity in respect of the said marks.

(viii) In October, 2021, as per the information of the plaintiff, the defendant company ventured into the business of 'baby diapers' adopting a trademark 'SUPER PANTS', which is deceptively similar to the various trademarks of the plaintiff company, in respect of which the plaintiff is a registered proprietor.

(ix) On 2nd April, 2021 and 4th December, 2021, cease and desist notices were issued by the plaintiff to the defendant calling upon the defendant not to use the aforesaid trademark.

(x) On the basis of the aforesaid pleadings, the present suit was filed on behalf of the plaintiff alleging infringement as well as passing off on behalf of the defendant of the trademarks of the plaintiff along with an application under Order XXXIX Rule 1 and 2 of the CPC for interim injunction.

3. The suit along with present application came up for hearing before this Court on 11th January, 2022 when summons were issued in the suit and notice was issued in the application. Pursuant to the said notice, defendant has filed written statement to the suit.

4. Counsel for the plaintiff has made the following submissions:

(i) The trademarks 'SUPER CUTESTERS', 'SUPER CUTES' and 'SUPER CUTEZ' are registered trademarks of the plaintiff and since the defendant is using deceptively similar trademark of "SUPER PANTS" in respect of identical goods i.e., diapers, the plaintiff is entitled to grant of injunction in terms of Sections 28, 29 read with Section 31 of the Trade Marks Act, 1999 (the Act).

(ii) The plaintiff is a prior user of the aforesaid trademarks in relation to diapers, whereas in the trademark application filed on behalf of the defendant for registration of the logo/device mark 'SUPER PANTS', the defendant has stated therein that the aforesaid mark would be on a 'proposed to use' basis.

(iii) No justification has been given by the defendant for adopting the deceptively similar trademarks to that of the plaintiff. Therefore, the adoption by the defendant is not bona fide.

(iv) The essential elements of the plaintiff's trademarks have been copied by the defendant.

(v) The registration granted in favour of the plaintiff has not been opposed by the defendant.

(vi) Reliance has been placed by the plaintiff on the judgments in Cadila Healthcare Ltd. vs. Dabur India Limited, 2008 (38) PTC 617 (Del), Cadila Healthcare Ltd. vs. Gujarat Co-operative Milk Marketing Federation Ltd. MANU/DE/2282/2099, Moonshine Technology Private Limited vs. Tictok Skill Games Pvt. Ltd. 7 ors., decided on 31st January, 2022 in CS(COMM) 331/2021 (DHC), Natures Essence Private Limited vs. Protogreen Retail Solutions Pvt. Ltd. & Ors., decided on 9th March, 2021 in CS(COMM) 581/2020 (DHC).

5. Per contra, counsel appearing on behalf of the defendant made the following submissions:

(i) The word 'SUPER' is a laudatory word and user of the word 'SUPER' by the defendant is in a laudatory and a descriptive manner.

(ii) The plaintiff itself has been using the word 'SUPER' in a laudatory manner. In this regard, reference has been made to the packaging of the plaintiff's product (page 43 of the documents filed by the defendant) where the word 'SUPER' has been used in a laudatory manner, such as: 'Super Soft Feel', 'Super Thin', 'Super Bubble Technology', and 'Super Absorbent'.

(iii) The mark 'SUPER' is common to the trade and is commonly used by various other manufacturers of diapers. In this regard, attention of the Court has been drawn to the packaging of various other manufacturers selling diapers while using the mark 'super'. (pgs. 59, 66, 75 of the documents filed by the defendant).

(iv) Defendant has filed a list of registrations granted in respect of the marks that include the word 'super' (page 532 onwards of the defendant's document) and in respect of some of these registrations, trademark registry has imposed a disclaimer on the use of the word 'super'.

(v) The defendant has not sought registration of the word 'SUPER PANTS'. It has only sought registration in respect of the logo/device mark which includes 'SUPER PANTS' as well as the trademark of the defendant, 'Dabur'.

(vi) The registration has been granted to the plaintiff in respect of the composite mark 'SUPER CUTESTERS', 'SUPER CUTES' and 'SUPER CUTEZ' and not the wordmark 'SUPER'.

(vii) A comparison of the packaging of the plaintiff and the defendant would demonstrate that there is no similarity between them. Therefore, no case for passing off is made out.

(viii) Rights conferred by registration under Section 28 are not absolute and are subject to other provisions of the Act. In terms of Section 9(1)(a) and 9(1)(c), the mark 'super' is not entitled for registration.

(ix) Reliance was placed on Section 30 (2) (a) of the Act to contend that since the word 'SUPER' is being used in a descriptive manner to indicate the quality of the product by the defendant, there is no case of infringement.

(x) In terms of Section 17 of the Act, registration of a composite mark will not confer any exclusive right to the plaintiff in respect of a part of the said composite mark, i.e. 'super' in the present case.

(xi) Reliance is placed on the judgments in Marico Ltd. Vs. Agro Tech Foods Ltd., 2010 SCC OnLine Del 3806, Johnson and Johnson and Ors. Vs. Christine Hoden India (P.) Ltd. And Ors. (Stayfree), AIR 1988 Delhi 249 and Nestle India Ltd. Vs. Moods Hospitality Ltd., 2010 (42) PTC 514 (Del.) (DB).

(xii) Judgments relied upon by the plaintiff are distinguishable.

6. I have heard the submissions of the parties.

7. At the outset, it would be apposite to reproduce a comparative table in respect of the packaging being used by the plaintiff and the defendant:

Plaintiff's Packaging

Defendant's Packaging

8. A comparison of the packaging of the defendant and the plaintiff above shows that other than the word "SUPER" occurring in both the aforesaid packaging, there is no other similarity. The packaging of the defendant includes the trademark of the defendant, 'Dabur' which is prominently displayed. Merely because the word 'Dabur' is written in a slightly smaller font as compared to 'SUPER PANTS', in my opinion, would not make any difference. The fact of the matter is that the word 'Dabur' is prominently displayed on the packaging along with the word 'baby'. The colour scheme of the packaging is also totally different. The colour scheme of the plaintiff is yellow and orange/blue and yellow, and the defendant is primarily green. From the description of the packaging of the defendant's product, it is more than clear that there is enough added material therein to distinguish the defendant's product from that of the plaintiff. Therefore, it cannot be said that there is a possibility of confusion or deception being caused among the customers of the two products. Hence, I am not convinced that the defendant is passing off their goods as those of the plaintiff.

9. The next issue that comes up for consideration is whether word 'super' is a descriptive or a laudatory word and whether it can attain distinctiveness in respect of the goods of the plaintiff. As per the Oxford's Learners Dictionary, the word 'super' means 'extremely good', and as per the Cambridge Dictionary also, the word 'super' means 'excellent or extremely good'. Clearly, as per its dictionary meaning, the word 'super' is a laudatory word of the English Language.

10. There is merit in the submission of the defendant that the word 'super' has been used by the plaintiff itself in a laudatory/descriptive manner. A look at the packaging of the plaintiff clearly demonstrates that the word 'super' has been used at several places in a laudatory manner. To illustrate, the packaging of the plaintiff includes the following phrases: 'Super Soft Feel', 'Super Thin', 'Super Bubble Technology', and 'Super Absorbent', which suggest that the products of

the plaintiff have an extremely soft feel to the body and are extremely absorbent. By use of the word 'super', the plaintiff is seeking to highlight the positive quality/attributes of its diapers. This leaves no doubt in my mind that the plaintiff is using the word 'SUPER' in a laudatory/descriptive manner.

11. A bare look at the packaging/label of the defendant also clearly demonstrates that the defendant has used the word 'SUPER' in conjunction with the words 'PANTS' in a descriptive manner along with the trademark of the defendant 'Dabur'. The word 'PANTS' is used in respect of the diaper and by using the expression 'SUPER PANTS', the defendant is seeking to convey that its diapers are of extremely good quality. Therefore, in my view, the expression 'SUPER PANTS' has been used by the defendant in a laudatory/descriptive manner. Furthermore, the defendant has not sought registration in the mark 'SUPER PANTS', but in respect of the composite device mark of the entire packaging, which includes the mark 'SUPER PANTS' as well as the trademark of the defendant 'Dabur' along with the word 'Baby'. Thus, it cannot be said that the use of the mark 'SUPER PANTS' by the defendant is not bona fide.

12. Counsel for the defendant has taken me through the packaging of various other manufacturers/sellers of diapers to show that the use of the word 'super' is common to the trade. In this regard, reference may be made to the packaging of the other parties selling diapers in the market, using the word 'super' along with their brand name, such as, 'TEDDY' using the words 'Super Baby' (page 52 of the defendant's documents); 'Cuddles' using the words 'Super Pants' (page 59 of the defendant's documents); 'Little Angle' using the words 'Super Plus Diaper Pants' (page 66 of the defendant's documents). This clearly demonstrates that the word 'super' is common to the trade and is being used by different manufacturers/sellers in a laudatory and descriptive manner.

13. In view of the above, I am of the opinion that the mark 'super' is devoid of any distinctive character and not capable of distinguishing the goods of the plaintiff. Therefore, even if the plaintiff has obtained registration in respect of the marks 'SUPER CUTESTERS', 'SUPER CUTES' and 'SUPER CUTEZ', it would not give him exclusive right over the use of the word 'SUPER'.

14. Statutory defenses to an action of an infringement are contained in Section 30 of the Act, which provides the various users of a trademark which would not be considered as infringement. The law with regard to descriptive use of a trademark by a party and Section 30(2)(a) has been laid down in the case of Marico Ltd. vs. Agro Tech Foods Ltd. (supra). The said case relates to a dispute between the plaintiff who was using the trademark 'Sundrop' and the defendant who was using the trademark 'Saffolla' in respect of identical products i.e. cooking oils. The defendant therein was using the expression "low absorb technology" in addition to its trademark 'Saffolla', which was objected to by the plaintiff who had a registration in favour of the expression 'LOWSORB' and 'LO-SORB'. After analyzing the various provisions of the Trademarks Act, the division bench of this Court came to the conclusion that the expression "low absorb

technology” has been used by the defendant in a descriptive manner and therefore, in terms of Section 30(2)(a) of the Act, the plaintiff will not be entitled for injunction. The relevant observations are set out below:

“37. Our conclusion is that we have in fact totally failed to appreciate the argument as raised on behalf of the appellant. Surely, when rights are claimed over a word mark as a trade mark and which word mark is in fact a mere tweak of a descriptive word indicative of the kind, quality, intended purpose or other characteristics of the goods, it is not open to urge that although the respondent is using the descriptive word mark in fact only as a part of sentence as a description (and even assuming for the sake of argument only the descriptive word mark in itself) along with another independent trade mark, yet the use of descriptive words are to be enjoined against. How can it at all be argued that though the respondent is in fact shown to be using the disputed word(s) only with a descriptive intendment, yet, such use should be taken not in a descriptive manner but as a trade mark. If we permit such an argument to prevail then what will happen is that what cannot be directly done will be indirectly done i.e., whereas the appellant is not entitled to succeed in the infringement action because the use by the respondent is in furtherance of its statutory rights of the user of the words which are descriptive of the kind, quality, intended purpose or characteristic of the goods, yet, merely because the appellant states that the respondent is using the same as a trade mark, the same should be taken as infringement of the trade mark of the appellant. Not only the plaintiff has no exclusive rights whatsoever to the trade marks because they are such which fall within the mischief of Section 30(2)(a), the respondent/defendant is always fully justified and entitled to use the descriptive words in any and every manner that it so chooses and pleases to do. If there are no rights of the plaintiff to exclusive user of the trade mark then where does arise the question of disentitlement of a defendant to use the trade mark of the appellant inasmuch as any person who adopts a descriptive word mark does so at its own peril in that any other person will also be fully entitled to use the same in view of a specific statutory rights thereto, and there are various other statutory rights including that under Section 30(2)(a), and which is what is being done by the respondent in the facts of the present case and its rights being further stronger because of the use along with the simultaneous use of its trade mark “Sundrop”.

38. In the facts and circumstances of the present case, Section 30(2)(a) clearly applies in entitling the respondent to use the expression “WITH LOW ABSORB TECHNOLOGY” because that is only a descriptive use by normal English words in the English language indicative of the kind, quality, intended purpose of characteristic of the goods. There is no use of the expression “bona fide” in Section 30(2)(a) as is found in Section 35, and we do not propose to import in Section 30(2)(a) the expression “bona fide” because the subject matters of the two sections i.e. Section 32 (a) and Section 35 are though common on certain limited aspects, however the two Sections do in fact operate in separate fields. Also looking at the issue in another way, “bona fide” aspect can in a way be said

to be very much included in Section 30(2)(a) because the use of words which indicate their relation to the goods for the kind, quality, intended purpose or other characteristics, etc. of the goods, is clearly only a bona fide user of the same and which "bona fideness" does not have to be additionally proved. In fact, there is ordinarily not only no lack of bona fides in using the normal descriptive word, and on the contrary there is in fact mala fides of a plaintiff in adopting otherwise a descriptive word mark and for which adaption there is ordinarily an absolute ground for refusal of registration of the trade mark. There is no mala fides of the respondent as alleged by the appellant because the respondent is using the expression "LOW ABSORB" as part of a sentence in a descriptive manner and the respondent is also prominently using its own trade mark "Sundrop", an aspect we have repeatedly referred to otherwise in this judgment. Merely because the respondent used "TM" earlier after the expression "LOW ABSORB TECHNOLOGY" is not such as to wipe out statutory rights/defences of the respondent."

15. Similar view was also taken by the Division Benches of this Court in Johnson and Johnson and Ors. Vs. Christine Horden India (P.) Ltd. and Ors. (supra) and Nestle India Ltd. vs. Moods Hospitality Ltd. (supra) while declining injunctive relief.

16. It is relevant to note here that the registration that has been granted to the plaintiff is in respect of the word marks "SUPER CUTESTERS", "SUPER CUTES" and "SUPER CUTEZ" and not the mark 'SUPER' per se. Therefore, in view of Section 17(2) of the Act, the plaintiff shall not have any exclusive right in respect of the mark 'super'.

17. The intent behind Section 17(2) is to prevent such an abuse by a person who gets a composite mark registered in its favour, which includes a non-distinctive component. Where there is similarity of non-descriptive/non-essential parts of a mark, injunction cannot be granted. The word 'super', which is being used in a laudatory/descriptive manner cannot be said to be an essential/distinctive part of the trademark of the plaintiff. Therefore, the plaintiff cannot have an exclusive right or monopoly over the right to use the word 'super'.

18. In this regard, reference may be made to the judgment of the Bombay High Court in Ultratech Cement Limited Grasim Industries Limited vs. Dalmia Cement Bharat Limited and Ors, 2016 (67) PTC 314 (Bom). In the said case, the plaintiff was the proprietor of various trademarks containing the word 'Ultra' such as 'UltraTech Concrete', 'UltraTech READY MIX' etc. and the defendant was using the mark 'DALMIA ULTRA' etc. The plaintiff sought an injunction against the use of the word 'Ultra' by the defendant on the ground that the use of the word 'Ultra' established a false nexus of the goods of the defendant with the business of the plaintiff and in view of the fact that the plaintiff was a prior user of the word 'Ultra', injunction should be granted. The court, while observing that 'ultra' is a laudatory and descriptive word commonly used in English language, held that the word 'ultra' cannot be descriptive of the plaintiff's goods.

19. Reliance was also placed on Section 17(2) to deny injunctive relief. The relevant observations of the court in paragraph 12 with regard to Section 17 are set out below:

"12. Even as a matter of statutory rights, under Section 17, when a trade mark contains any "matter" which is of a non-distinctive character, forming only a part of the whole, the registration of the mark does not confer any exclusive right in the "matter". Dr. Tulzapurkar contended that the Plaintiffs having applied for separate registration of the 'part', are entitled to claim such exclusive right with respect to it, the word 'or' in the Section being conjunctive. I am afraid that is not a correct reading of the Section. Sub-section (2) of Section 17 operates notwithstanding anything contained in Sub-section (1). Sub-section (1) provides that when the trade mark consists of several matters, its registration confers on the proprietor exclusive right to the use of the mark 'taken as a whole'. Sub-section (2) is cast in negative terms. It provides that when either of the conditions in clauses (a) (i) or (ii) or (b) obtains, the registration of the mark "shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered." If such "matter" forms only a part of the whole of the trade mark, the registration of such trade mark does not confer any exclusive right in the "matter" to its proprietor. The word "Ultra", as I have explained above, is a part of the whole of the Plaintiffs' registered trade marks; it is of a non-distinctive character, and therefore, the registration of the mark as a whole does not, by reason of Sub-section (2) of Section 17, confer any exclusive right on the proprietor to the use of the word 'Ultra'."

20. In my view, the present case is covered on all fours by the judgments in Marico Ltd. vs. Agro Tech Foods Ltd. (supra) and Ultratech Cement Limited Grasim Industries Limited vs. Dalmia Cement Bharat Limited and Ors (supra). I have already held that the word 'Super' is a descriptive and a laudatory word of the English language. Furthermore, it is common to the trade. Therefore, the plaintiffs cannot have the exclusive right to use the word 'Super' and would not be entitled to grant of injunction in terms of Sections 28, 29 and 30 of the Act. Even otherwise, the word 'Super' is not a distinctive or the essential part of the composite marks registered by the plaintiff. Therefore, in terms of Section 17(2) of the Act, the plaintiff is not entitled to grant of injunction in respect of the word 'Super'.

21. Now, I proceed to deal with the judgments cited on behalf of the plaintiff.

(i) In Cadila Healthcare Ltd. vs. Dabur India Limited (supra), the plaintiff was the registered owner of the mark 'SUGAR FREE' and the defendant was using the word 'SUGAR FREE' in its packaging. Injunction was sought by the plaintiff against the defendants from using the word 'SUGAR FREE' on the ground that expression 'SUGAR FREE' is prominently displayed on the packaging of the defendants which is not a mere description of the characteristics of the product, but is being used to create a link between its products with that of the plaintiff's. The Single Judge denied injunction holding that there is enough added matter in

the packaging of the defendant to distinguish the defendant's product from that of the plaintiff. Judgment of the Single Judge was upheld by the Division Bench vide order dated 12th September 2008.

(ii) In *Cadila Healthcare Ltd. vs. Gujarat Co-operative Milk Marketing Federation Ltd.* (supra), the plaintiff was the registered owner of the trademark 'SUGAR FREE', whereas the defendant was also using the words 'SUGAR FREE' and the grievance of the plaintiff was with regard to the use of the words 'SUGAR FREE' by the defendant in their packaging. The Single Judge denied injunction to the plaintiff, however, directed the defendants to reduce the font size in which the words 'SUGAR FREE' were written. Both the sides filed appeal before the Division Bench. The Division Bench did not agree with the contention of the plaintiff that the expression 'SUGAR FREE' has become distinctive or has acquired secondary meaning to identify the goods of the plaintiff and therefore, merely a descriptive use of the words 'SUGAR FREE' by the plaintiff would not entitle the plaintiff for injunction. In the peculiar facts and circumstances of the case and taking into account the correspondence exchanged between the parties, the judgment of the Single Judge requiring the defendant to reduce the font size of the words 'SUGAR FREE' was not interfered with.

(iii) In *Moonshine Technology Private Limited vs. Tictok Skill Games Pvt. Ltd. & ors.* (supra), the plaintiff was the registered owner of the various trademarks including 'BAAZI', 'BAAZI GAMES', 'POKER BAAZI', 'RUMMY BAAZI', 'BALLE BAZZI', 'BAAZI MOBILE GAMING' etc. Injunction was granted by the court in favour of the plaintiff, after coming to finding that the word 'BAAZI' is not being used in a descriptive manner by the defendant.

(iv) In *Natures Essence Private Limited vs. Protogreen Retail Solutions Pvt. Ltd. & Ors.* (supra), the plaintiff was the owner of the registered trademarks 'NATURE'S INC.' and 'NATURE'S ESSENCE' and injunction was sought against the trademark of the defendants "Nature's Tattva". Injunction was granted in favour of the plaintiff as the mark of the defendant was visually, phonetically and deceptively similar to the plaintiff's marks and conveyed a deceptively similar idea to that conveyed by the plaintiff's mark "NATURE'S ESSENCE" and therefore, the potential of confusing a customer of average intelligence and imperfect recollection. The court did not give any finding whether monopoly can be claimed in respect of the word "Nature".

22. Therefore, none of the aforesaid cases cited on behalf of the plaintiff are applicable in the facts and circumstances of the present case.

23. Keeping in view of the aforesaid, I am of the opinion that the plaintiff's have failed to make a prima facie case for grant of interim injunction.

24. Accordingly, I.A. 444/2022 filed on behalf of the plaintiff under Order XXXIX Rules 1 and 2 of the CPC is dismissed.

25. Any observation or expression of opinion in this order will have no bearing on

the merits of the suit.