



2024 : DHC : 2510



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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI****Reserved on: 8 December 2023****Pronounced on: 1 April 2024**

+ CS(COMM) 670/2023, I.A. 18638/2023

JAQUAR AND COMPANY PRIVATE LIMITED ..... Plaintiff  
Through: Mr. Kapil Wadhwa, Ms. Surya  
Rajappan, Ms. Tejasvini Puri and Ms.  
Vasanthi Hariharan, Advs.

Versus

ASHIRVAD PIPES PRIVATE LIMITED ..... Defendant  
Through: Mr. CM Lall, Sr. Adv. with Mr.  
Prashant Gupta, Mr. Karan Singh, Mr. Udit  
Tewari, Ms. Yashi Agarwal and Mr.  
Abhinav Bhalla, Advs.

**CORAM:****HON'BLE MR. JUSTICE C. HARI SHANKAR****J U D G M E N T**

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**01.04.2024**









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### **I.A. 18638/2023 (under Order XXXIX Rules 1 & 2 of the CPC)**



1. The plaintiff, Jaquar & Co Pvt Ltd claims that the use, by the defendant, Ashirvad Pipes Pvt Ltd, of the mark ARTISTRY, both as a word mark as well as in the form of the devices , , infringes the plaintiff's registered trade marks , , , ,  and 'ARTIZE – BORN FROM ART', and that the defendant's mark 'TIARA' infringes the plaintiff's registered trade marks 'TIAARA' and . The use of the impugned marks by the defendant, it is further alleged, results in the defendant passing off its products as those of the plaintiff. The plaintiff, therefore, seeks, by the present suit, an injunction against the defendant using the impugned marks, apart from delivery up, rendition of accounts, costs and damages. An interim injunction, restraining the defendant from using the impugned marks pending disposal of the present suit, is sought in this application.

2. I have heard Mr. Kapil Wadhwa, learned Counsel for the plaintiff and Mr. Chander M. Lall, learned Senior Counsel for the defendant, at length on this application.

### **Facts and Rival Contentions**

#### Initial submissions by Mr. Kapil Wadhwa for the plaintiff

3. Registrations held by the plaintiff and defendant



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**3.1** The plaintiff is the proprietor of the following trade marks, registered under Section 23(1) of the Trade Marks Act, 1999 :

S. No.	Trademark	Application No.	Class	Date of Application
1.		1736192	11	24.09.2008
2		2003072	11	03.08.2010
3		2165292	11	24.06.2011
4		4879936	35	25.02.2021
5		4879937	35	25.02.2021
6	ARTIZE – BORN from art	4879938	11	25.02.2021
7		5250966	11	17.12.2021
8		3603569	11	01.08.2017



**3.2** The defendant is also the proprietor of the following registered trade marks :

S. No.	Trademark	Date of Application	User detail	Classes
1.	ARTISTRY	05.01.2022	Proposed to be used	11,17

**3.3** The defendant has also applied for registration of the following marks as trade marks under the Trade Marks Act, and the applications have cleared the stage of checking for compliance with requisite formalities.

S. No.	Trademark	Date of Application	User detail	Classes
1.	ARTISTRY by ashirvad	10.07.2023	Proposed to be used	11,17 & 24
2.	ARTISTRY by ashirvad	10.07.2023	Proposed to be used	11,17 & 24

**3.4** The plaintiff and defendant admittedly use the rival marks for similar, if not identical, products. Both manufacture and sell bathroom and sanitary fittings such as taps, washers and faucets, under the rival marks.

#### **4. User of the plaintiff's marks**

**4.1** Mr. Wadhwa submits that his client is the prior user and adopter of the marks ARTIZE and TIAARA, having continuously been using them since June 2008 and 2016 respectively. 'ARTIZE', he submits, constitutes the most prominent and essential part of the marks



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, , , ,  and ‘ARTIZE – BORN FROM ART’, which the plaintiff calls “the ARTIZE formative marks”.

**4.2** The mark TIAARA was coined and adopted in May 2015, and is a sub-brand of ARTIZE, as it refers to ARTIZE faucets of a particular minimalist design conceptualized by Michael Foley. By dint of continuous and uninterrupted use, the ARTIZE marks, and TIAARA, it is submitted, have become source identifiers of the plaintiff.

## **5. Reputation of the plaintiff’s marks**

**5.1** To vouchsafe the reputation of the plaintiff, sales figures of products sold under the ARTIZE and TIAARA marks have been provided in the plaint. During the years 2021-2022 and 2022-2023, sales of products bearing the ARTIZE mark earned returns of ₹ 150.4 crores and ₹ 129.51 crores respectively, and sales of products bearing the TIAARA mark earned returns of ₹ 3.55 crores and ₹ 4.9 crores respectively. The Jaquar group of the plaintiff is, submits Mr. Wadhwa, a market leader in the business of bath fittings, with 60% market share. It has seven manufacturing units in India and one in South Korea, with over 12000 employees across the globe. It is claimed that the plaintiff produces over 39 million bath fittings annually.



**5.2** ARTIZE, JAQUAR and ESSCO are brands used for the luxury, premium and value segments of the plaintiff's products. The plaint also refers to various encomiums received by the plaintiff for its ARTIZE and TIAARA branded products. In respect of its ARTIZE brand, the plaintiff also runs an exclusive website [www.artize.com](http://www.artize.com). The plaintiff has also successfully defended its ARTIZE mark against infringement by the mark ARTIS, against which an interlocutory order of injunction has been passed by this Court on 4 May 2023 in CS (Comm) 777/2022 (*Jaquar Company Pvt Ltd v. Villeroy Boch AG*).

**5.3** It is also claimed that the brand ARTIZE has acquired the status of a well known trade mark within the meaning of Section 2(1)(zg) of the Trade Marks Act.

## **6. Plaintiff's trade dress**

Mr. Wadhwa further submits that the plaintiff has, in respect of its ARTIZE range of products, adopted a distinctive blue and gold design for its pack since inception in 2008. Apart from the ARTIZE marks and the mark TIAARA, the trade dress of the plaintiff, with the unique blue and gold colour combination is also stated to be indelibly associated, in the mind of the average consumer, with the plaintiff and is also, therefore, a source identifier.

## **7. Defendant's acts and alleged infringement and passing off**



**7.1** Mr. Wadhwa submits that, in January 2023, the plaintiff came across an advertisement of the defendant in the November 2022 edition of the magazine, Casa Vogue, announcing the launch of the defendant's sanitary ware products under the brands ARTISTRY and TIARA. Following this, the plaintiff came to learn that, on 5 January 2022, the defendant had obtained registration, under the Trade Marks Act, for the device mark **ARTISTRY**, in Class 11 for “sanitary units, sanitary apparatus and installations, fittings for basins, bidets, sanitary waterflushing tanks and apparatus for toilets, fittings, apparatus for sanitary purposes, plumbing fittings, namely bibbs, cocks, traps, valves, water taps, valves, pipes being parts of sanitary installations” and in class 17 for “flexible pipes, not of metal; flexible HDPE, PVC, uPVC, CPVS pipes, connectors, valves, couplings and joints, fittings, not of metal, for flexible pipes, HDPE, PVC, uPVC, CPVC pipes & pipes fittings (non-metallic); SWR (soil, waste & rainwater) pipes & fittings”, on proposed to be used basis. In July 2023, the plaintiff came across applications filed by the defendant for registration of the **ARTISTRY by ashirvad** and **ARTISTRY by ashirvad** marks in classes 11, 17 and 24. The impugned ARTISTRY marks are used by the defendant for plastic pipes and fitting for water management and plumbing systems, bath room and kitchen sanitary-ware, including faucets, showers heads and washers, which, Mr. Wadhwa submits, are cognate and allied to the goods in respect of which the plaintiff uses its ARTIZE and TIAARA marks.

**7.2** The defendant is also using the mark TIARA for similar goods. The use of the mark TIARA, it is submitted, reflects clear intent, on





the part of the defendant, to copy and imitate the plaintiff's TIAARA mark.

**7.3** In these circumstances, the plaintiff has filed an application under Section 57<sup>1</sup> of the Trade Marks Act for rectification of the register of trade marks by removal, therefrom, of the mark ARTISTRY and cancellation of its registration. The plaintiff also addressed a legal notice to the defendant on 12 January 2023, calling upon the defendant to cease and desist from using the impugned mark. The defendant, however, responded on 2 February 2023, asserting that the impugned ARTISTRY and TIARA marks were not similar to the plaintiff's ARTIZE and TIAARA marks and that, therefore, there was no chance of likelihood of confusion in the market.

**7.4** The plaint alleges that the impugned ARTISTRY and TIARA marks are phonetically, visually and structurally similar to the plaintiff's ARTIZE and TIAARA marks. A tabular representation of the features of similarity is thus provided in the plaint:

<b>Similarity of Marks</b>	<b>Plaintiff's Registered Mark</b>	<b>Defendant's Impugned Mark</b>
Structural/Conceptual/ Visual		

<sup>1</sup> 57. **Power to cancel or vary registration and to rectify the register.** –

(1) On application made in the prescribed manner to the High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may make such order for making, expunging or varying the entry as it may think fit.



Phonetic	<u>ART</u> <u>IZE</u>	<u>ART</u> <u>IS</u> <u>TRY</u>
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Similarity of Marks	Plaintiff's Registered Mark	Defendant's Impugned Mark
Structural/Conceptual/ Visual	<u>TIAARA</u> T I A A R A	TIARA
Phonetic	<u>TI</u> <u>AA</u> <u>RA</u>	<u>TI</u> <u>A</u> <u>RA</u>

The mere addition, below the word ARTISTRY, in the defendant's logo, of the words "by Ashirvad", submits Mr. Wadhwa, is not sufficient to mitigate the possibility of confusion, in the mind of a consumer of average intelligence and imperfect recollection, between the ARTIZE mark of the plaintiff and the ARTISTRY mark of the defendant. At the very least, it is submitted that such an unwary consumer would be led to believe, from the similarities between the marks, that there is an association between the defendant and the plaintiff when, in fact, no such association exists. By using the impugned marks, therefore, the defendant is trying to create an illusion of an association between the defendant and the plaintiff and is, thereby, seeking to capitalize on the plaintiff's goodwill and reputation. In such circumstances, it is submitted that likelihood of confusion in the minds of the public is required to be presumed under Section 29(2)(b)<sup>2</sup> and 29(3)<sup>3</sup> of the Trade Marks Act.

<sup>2</sup> 29. **Infringement of registered trade marks.** –

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- (2) 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 because of—
- its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
  - its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or



**7.5** Inasmuch as the plaintiff is the prior adopter and user of the marks ARTIZE and TIAARA, *vis-a-vis* the adoption and use, by the defendant, of the impugned ARTISTRY and TIARA marks, it is submitted that a *prima facie* case of infringement within the meaning of Section 29 of the Trade Marks Act is made out.

**7.6** It is further alleged that the defendant has sought to exacerbate the possibility of confusion by adopting a trade dress with an identical blue and gold colour combination which, to an unwary consumer, would be indistinguishable from that of the plaintiff. The products of the defendants are also packed in rectangular boxes which are similar to the boxes in which the plaintiff sells its ARTIZE products. This has been sought to be demonstrated thus, by way of a tabular comparison:

Plaintiff's 'ARTIZE' trade dress	Defendant's impugned 'ARTISTRY' trade dress
	
	

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

<sup>3</sup> (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.



**7.7** Inasmuch as the plaintiff's and defendant's products are identical or, at least, allied and cognate to each other, available through the same trade channel, advertised through the same media sources (as is apparent from the fact that both the marks were advertised in the Casa Vogue magazine) and cater to the same consumer segment, it is submitted that a *prima facie* case both of infringement and passing off is made out. The use, by the defendant, of the mark TIARA which is all but indistinguishable from the plaintiff's mark TIAARA, and a trade dress which is identical to that of the plaintiff, reflects clear intent to capitalize on the plaintiff's reputation and, thereby, to pass off the goods of the defendant as those of the plaintiff.

**7.8** In such circumstances, it is also contended that the defendant cannot take the benefit of the fact that its mark is registered under Section 28(3)<sup>4</sup> or Section 30(2)(e)<sup>5</sup> of the Trade Marks act as the registration is itself illegal and fraudulent in nature.

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<sup>4</sup> **28. Rights conferred by registration –**

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(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

<sup>5</sup> **30. Limits on effect of registered trade mark. –**

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(2) A registered trade mark is not infringed where –

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(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.



**7.9** In support of his submission, Mr. Wadhwa invokes the principle that, for likelihood of confusion to be found to exist, all that is required to be shown is that, viewed from an initial interest perspective, a consumer of average intelligence and imperfect recollection would, on coming across the defendant's mark or the defendant's product, be placed in a state of wonderment as to whether he has come across the said mark or product earlier.

**7.10** In support of his submission, Mr. Wadhwa has cited

- (i) para 19 of *Automatic Electric Ltd. v. R.K.Dhawan*<sup>6</sup>,
- (ii) *Make My Trip Pvt. Ltd. v. Make My Travel Pvt. Ltd.*<sup>7</sup>,
- (iii) *Paridhi Udyog v. Jagdev Raj Sarwan Ram Dhiman*<sup>8</sup>,
- (iv) para 25 of *Hari Chand Shri Gopal v. Evergreen International*<sup>9</sup>,
- (v) paras 22 and 39 of *Jaquar*,
- (vi) paras 16.1 to 16.4 of *Under Armour Inc. v. Aditya Birla Fashion & Retail Ltd.*<sup>10</sup>,
- (vii) *Dominos IP Holder LLC v. Dominick Pizza*<sup>11</sup>,
- (viii) para 9 of *Corza International v. Future Bath Products Pvt. Ltd.*<sup>12</sup>,
- (ix) para 5 of *Tata Oil Mills Company Ltd. v. Reward Soap Works*<sup>13</sup>,

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<sup>6</sup> 77 (1999) DLT 292

<sup>7</sup> (2019) SCC OnLine Del 10638

<sup>8</sup> 2019 SCC OnLine Del 8293

<sup>9</sup> 2020 (83) PTC 267(Del)

<sup>10</sup> 300 (2023) DLT 573

<sup>11</sup> 2023 SCC OnLine Del 6135

<sup>12</sup> 2023 SCC OnLine Del 153

<sup>13</sup> AIR 1983 Del 286



- (x) paras, 8 10 and 13 of *Laxmikant V. Patel v. Chetanbhai Shah*<sup>14</sup>,
- (xi) para 38 of *M/s. Hindustan Pencils Private Limited v. M/s. India Stationary Products Co*<sup>15</sup>,
- (xii) para 22 of *Avighna Coffee Pvt. Ltd. v. Cothas Coffee Co.*<sup>16</sup>,
- (xiii) para 37 of *New Balance Athletics Inc. v. New Balance Immigration Private Limited*<sup>17</sup> and
- (xiv) para 15 of *Veda Seed Sciences Pvt. Ltd. v. Kohinoor Seed Fields India Pvt. Ltd.*<sup>18</sup>,

apart from the following passages from McCarthy on Trademarks and Unfair Competition:

**“§ 23:115 Defendant’s adoption of mark with full knowledge of plaintiff’s mark—intent to deceive inferred**

Proof that defendant knew of plaintiff’s mark at the time defendant chose its mark has often been relied upon as evidence of bad faith and an intention to trade upon another’s good will. A wrongful intent appears easy to infer where defendant knew of plaintiff’s mark, had freedom to choose any mark, and “just happened” to choose a mark confusingly similar to plaintiff’s mark. In emphasizing the freedom of choice which was open to such a defendant, the courts often make statements like, “At that point he (defendant) had an infinity of names from which to choose.” Or, as the Ninth Circuit stated: “This thought that a newcomer has an ‘infinity’ of other names to choose from without infringing upon a senior appropriation runs through the decisions like a leitmotif.” The classic statement of the freedom of choice open to a newcomer who knows of the senior user’s mark is:

It is so easy for the honest businessman, who wishes to sell his goods upon their merits, to select from the entire material universe, which is before him, symbols, marks and coverings which by no

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<sup>14</sup> (2002) 3 SCC 65

<sup>15</sup> AIR 1990 Del 19

<sup>16</sup> 2016 SCC OnLine Kar 5997

<sup>17</sup> 2023 SCC OnLine Del 3529

<sup>18</sup> 297 (2023) DLT 521 (DB)



possibility can cause confusion between his goods and those of competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them.

Where we can perceive freedom of choice with full knowledge of a senior user's mark, we can readily read into defendant's choice of a confusingly similar mark the intent to get a free ride upon the reputation of a well-known mark. Whether this is called "bad faith," or an "evil intent" or an intent to deceive, such a defendant will have to strive mightily to convince a court that it should not be enjoined.

The Ninth Circuit Court of Appeals regarded "the purpose of taking advantage of the aura of good will which surrounded" plaintiffs mark as the very opposite of "good faith" adoption by a junior user. The court inferred from the fact that the defendant knew of plaintiff's mark (BLACK & WHITE Scotch whiskey) that defendant *must* have intended to take advantage of the good will and recognition which plaintiff had built up, even though defendant might have done so in a good faith belief that it was not illegal to use the mark on beer:

We cannot conclude but that [defendant] deliberately adopted the name knowing that BLACK & WHITE was the name and trademark of [plaintiff] and *they must* have done so with some purpose in mind. The *only possible* purpose could have been to capitalize upon the popularity of the name chosen. This possibility, *they must have* known, would extend to their product because the public would associate the name BLACK & WHITE with something old and reliable and meritorious in the way of an alcoholic beverage.

Such inferences of what defendant *must have* known are often found in the cases:

Consequently, when we find a newcomer in the field claiming to build for himself an identity depending upon subtle associations which in fact impinge upon those already established by the plaintiff, protestations of innocent intent overtax the credulity.

Such inferences of intent are based upon the familiar tort maxim that a person is deemed to intend the natural consequences of his or her actions.

Even if defendant disclaims knowledge of plaintiff's mark as of the time of defendant's initial adoption, such a lack of knowledge may





be rejected as unlikely if plaintiff's mark was well-known and strong. If a well-known and strong mark has been used in identical format by a junior user, it appears reasonable to require the junior user to carry the burden of explanation and persuasion as to his motive in adopting the mark. The junior user's continued use of a mark, after the PTO has refused registration based upon the senior user's own registration, is indicative of bad faith and a likelihood of confusion. Other courts will find no inference of bad faith in such an instance. However, it must be kept in mind that the junior user's mere knowledge or awareness of the senior user's mark is not the same as an intent to confuse customers. As the Second Circuit observed:

[The junior user's] knowledge of [the senior user's] trademark does not necessarily give rise to an inference of bad faith, "because adoption of a trademark with actual knowledge of another's prior registration of a very similar mark may be consistent with good faith." Since the relevant intent is the intent to gain by confusing customers or others, the mere fact that the accused is aware of the senior user's mark does not per se prove that intent. Similarly, the act of copying is not necessarily proof of an intent to confuse. There may be several good faith reasons why the junior user decided to proceed even when aware of the senior user's mark. The most common reason for doing so is a good faith belief that there is no conflict between the marks as used on the junior user's goods or services. Or, for example, the legitimate parodist must know of the senior user's mark in order to make fun of it, but intends comedy, not confusion. Or, in another example, the junior user's use may be a legitimate descriptive "fair use."

### **§23:116 — Intent to come close**

In some cases, there is evidence that the accused infringer intentionally tried to edge close to the mark of the senior user. While there is nothing immoral or illegal about imitating an unprotectable market fad, coming close with the intention to confuse customers into thinking that there is some affiliation or connection is evidence that the junior user succeeded in achieving its goal. This is a fine line to draw. In a case where the attorney for the junior user admitted that the word mark and packaging of junior user's product was designed to "be reminiscent of [senior user] Tylenol," the court found that the junior user was an intentional infringer. And the Eleventh Circuit said that even an intent to "come as close as the law will allow" is an intent to derive benefit from the other party's reputation and "is therefore probative on the likelihood of confusion issue."





**7.11** Further, on the principle of phonetic similarity, Mr. Wadhwa cites the *Pianotist* test, elucidated by Lord Parker in *In re. Pianotist Application*<sup>19</sup>:

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods — then you may refuse the registration, or rather you must refuse the registration in that case.”

He also relies, for phonetic similarity, on the following passages from McCarthy:

**“§ 23:22 Phonetic similarity**

**Research References**

**Trade Regulation 334.1, 385, 347.**

Marks may sound the same, to the ear, even though they may be readily distinguishable to the eye. For example, S.O. and ESSO may be visually distinguishable, but to the ear they are identical. Similarity of sound may be particularly important when the goods are of the type frequently purchased by verbal order. To decide the issue of phonetic similarity, the court may use a sophisticated phonetic analysis. For example in holding BONAMINE to be phonetically similar to DRAMAMINE the Seventh Circuit said:

“DRAMAMINE and BONAMINE contain the same number of syllables; they have the same stress pattern, with primary accent on the first syllable and secondary accent on the third: and the last two syllables of DRAMAMINE and

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<sup>19</sup> 23 RPC 774



BONAMINE The initial sounds of DRAMAMINE and BONAMINE ["d" and "b"] are both what are known as "voiced plosives", and are acoustically similar; the consonants "m" and "n" are nasal sounds and are acoustically similar. The only dissimilar sound in the two trademarks is the "r" in DRAMAMINE. Slight differences in the sound of similar trademarks will not protect the infringer.

In an attempt to avoid phonetic similarity, defendant may argue that, "Improperly pronounced," its mark does not sound the same as plaintiff's mark. For example, in comparing the plaintiff's mark SUAVELLE with defendant's SWAVEL, defendant argued that the correct pronunciation of its mark was "SWA-VEL," with accent on the first syllable. The court rejected this distinction, saying, "It is absolutely impossible for defendant, to control, the pronunciation which the trade would give to the word. Similarly, the issue in pronunciation of a word of French derivation is not the "correct" French pronunciation, but the manner in which the ordinary United States purchaser would say the word. A court need not be concerned with the "correct" pronunciation of a word or a surname. The issue is what is the usual pronunciation used by the public. Applying the rule that there is no "correct" pronunciation of a trademark, the Trademark Board, in an opposition brought by the owner of the famous mark LEGO for toys, rejected the applicant's argument that its mark MEGO for toys would be pronounced as "mee-go," rather than "meg-o," which is closer to opposer's "leg-o. In holding that the marks STEINWAY and STEINWEG for pianos were confusingly similar, the Second Circuit observed that, "Trademarks, like small children, are not only seen but heard. However, phonetic similarity is merely one element to consider in laying out a mosaic of pieces which may or may not add up to a likelihood of confusion as to overall impression.® Even if the marks are phonetically similar, for example, V-8 and VA, other elements of difference may lead to a final finding of no likely confusion."

### Submissions of Mr. Chander M. Lall in reply

#### **8. Monopolization of "ART" prefix**

**8.1** Responding to the submissions of Mr. Wadhwa, Mr. Lall, learned Senior Counsel for the defendant, submits that the plaintiff is



seeking, by the present suit, to monopolise the use of the word “ART” which is the essential feature of the plaintiff’s ARTIZE trade mark. He submits that the only common feature between the plaintiff’s ARTIZE and the defendant’s ARTISTRY marks is the initial “ART”. Sections 9(1)(b)<sup>20</sup> and 30 of the Trade Marks Act, he submits, proscribes claiming of exclusivity over a part of the word which describes the characteristics of a product. This principle would apply despite the anti-dissection rule otherwise contained in Section 17<sup>21</sup> of the Trade Marks Act.

**8.2** Mr. Lall submits that ARTIZE and ARTISTRY are both common English words, of which ART is the essential part and the key to the defendant’s product range. The plaintiff cannot be permitted to monopolise use of the word “ART”, even as a part of the mark. In support of this submission, Mr. Lall cites the judgment of the Supreme Court in *F. Hoffmman-La Roche & Co. Ltd. v. Geoffrey Manners &*

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<sup>20</sup> 9. **Absolute grounds for refusal of registration.** –

The trade marks –

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(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

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shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

<sup>21</sup> 17. **Effect of registration of parts of a mark.** –

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark –

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the 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 of the whole of the trade mark so registered.



*Co Pvt Ltd*<sup>22</sup> (which dealt with the marks PROTOVIT and DROPOVIT) and *J R Kapoor v. Micronix India*<sup>23</sup> (which dealt with the marks MICRONIX and MICROTEL). In *F. Hoffman-La Roche* and in *J R Kapoor*, it was held that the suffix “VIT” and the prefix “MICRO”, respectively, could not be sought to be monopolised, as they were descriptive of the products in respect of which they were used. The plaintiff, according to Mr. Lall, is seeking to do precisely this, by seeking to monopolize, through the Court, the use of the prefix “ART”.

**8.3** Again, apropos the descriptive nature of the prefix “ART”, Mr. Lall submits that, in the case of sanitary bath fittings, especially those catering to the upper end segment of society, the beauty and appearance of the fittings are of considerable importance. It is to emphasize the artistic appearance of the product that the names “ARTIZE” and “ARTISTRY” have been used. This is clear, he submits, even from the fact that one of the marks asserted by the plaintiff is “ARTIZE – BORN FROM ART”. In fact, the only word mark registration held by the plaintiff is for the mark “ARTIZE– BORN FROM ART”. Etymologically, also, he submits, the word “Artize” means “born from art”.

## **9. No infringement action against registered mark – Section 28(3)**

**9.1** Mr. Lall further submits that, as both the plaintiff’s and defendant’s marks are registered, the plaintiff cannot maintain any

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<sup>22</sup> (1969) 2 SCC 716

<sup>23</sup> 1994 Supp. (3) SCC 215



action of infringement against the defendant in view of Section 28(3) of the Trade Marks Act. At the highest, therefore, the plaintiff's claim can only be one of passing off.

**9.2** None of the judgments cited by the plaintiff, points out Mr. Lall, deals with a situation in which the defendant is a registered proprietor of the impugned mark.

#### **10. Re. passing off**

In the case of passing off, the presence of added matter, which would distinguish the plaintiff's product from the defendant, is relevant, as held by the Supreme Court in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*<sup>24</sup>. The added matter, in the case of the defendant's mark, especially in a manner in which it was used on the defendant's product, Mr. Lall submits, is more than sufficient to distinguish the defendant's product from the plaintiff's and avoid any chance of the former being mistaken for the latter.

#### **11. No bad faith adoption**

Mr. Lall refutes the contention of Mr. Wadhwa that the awareness, by the defendant, of the existence of the plaintiff's prior ARTIZE and TIAARA marks, indicated that the adoption, by the defendant, of the impugned ARTISTRY and TIARA marks, was vitiated by bad faith. He submits that mere knowledge or awareness of the existence of a

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<sup>24</sup> AIR 1965 SC 980



prior adopter of a similar mark did not *ipso facto* lead to any presumption of bad faith on the part of the later adopter. Mr. Lall also submits, in this context, that there is no legal restriction to mere copying. He relies, in this connection, on the following passages from McCarthy:

***“§ 23:122 Copying is not per se illegal***

***The First Principle: Freedom to Compete and Copy.***

The first principle of unfair competition law is that everything that is not protected by an intellectual property right is free to copy. In fact, copying is an essential part of the whole fabric of an economic system of free competition. Thus, the act of "copying," far from being intrinsically improper, is essential and should be lauded and encouraged, not condemned. There is absolutely nothing legally or morally reprehensible about exact copying of things in the public domain. For example, evidence that a junior user exactly copied unprotected descriptive, generic or functional public domain words or shapes does not prove any legal or moral wrongs. On the other hand, copying a feature which is the subject of intellectual property owned by another can be an illegal and tortious act. It is essential to keep this distinction in mind.

***Edging Close to Senior User's Mark.*** In some cases, there is evidence that the accused infringer intentionally tried to, if not copy outright, edge close to the mark or trade dress of the senior user. While there is nothing immoral or illegal about imitating an unprotectable market fad, coming close with the intention to confuse customers into thinking that there is some affiliation or connection is evidence that the junior user succeeded in achieving its goal.

***Legitimate Copying is an Essential Part of a Competitive Economy.*** Some of the discussion in legal briefs and judicial opinions is phrased in terms of whether or not an accused imitator has consciously "copied" the senior user. "Copying" is sometimes denigrated as being inherently immoral, unfair and illegal. The popular folklore is that a "copycat" is a pirate and that all commercial copying and imitation must be an illegal form of competition. That is not so. In fact, legitimate copying is a large part of what makes a free market economy work.

The Supreme Court has emphasized that free and legal copying is an essential element of free competition:



[I]n many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying... [C]opying is not always discouraged or disfavored by the laws which preserve our competitive economy... Allowing competitors to copy will have salutary effects in many instances.

The successful competitor who is a second comer offers an identical or equivalent product at a lower price or with greater quality. It is important to emphasize that there is absolutely nothing legally or morally reprehensible about exact copying of things in the public domain.

The Sixth Circuit firmly rejected a plaintiff's argument that a competitor's intentional copying of a functional product shape was evidence of an intent to confuse. Saying that plaintiff's argument revealed a "fundamental misapprehension of the purposes of trademark law", the court remarked that: "[Plaintiff's) argument fails to appreciate that trade-mark law does not prohibit copying as such; that is the province of copyrights and patents.... No harm is done to this incentive structure, however, by the copying of a product design that does not confuse consumers as to the product's source."

**"Copying" is Not Inherently Bad or Illegal.** The motivation for the act of "copying" cannot blithely be assumed to be wrongful in any sense. There are several possible motives for copying, some legal and laudable, some illegal and predatory. For example, as the Ninth Circuit noted in a trade dress case, "competitors may intentionally copy product features for a variety of reasons. They may, for example, choose to copy wholly functional features they perceive as lacking any secondary meaning because of those features' intrinsic economic benefits. Similarly, the Fourth Circuit noted that copying aspects of a competitor's product in order to achieve the functional benefits of those aspects is a legitimate competitive act that does not trigger a presumption that confusion is the likely result. As the Supreme Court observed, copying in order to imitate an unpatented functional aspect of a competitor's product is what free competition is all about: "Where an item in general circulation is unprotected by patent, '[r]eproduction of a functional attribute is legitimate competitive activity.' Similarly, the high court has remarked that: "Allowing competitors to copy will have salutary effects in many instances."

The Second Circuit, observing that there can be valid, pro-competitive reasons for imitating a competitor's product shape or





packaging, noted that "it cannot automatically be inferred" that the copier intends to confuse customers as to source. The court concluded that:

[I]n the absence of evidence, apart from proof of copying, that the defendant sought to confuse consumers, bad faith should not be inferred simply from the fact of copying. On the other hand, if there is additional evidence that supports the inference that the defendant sought to confuse consumers as to the source of the product, we think the inference of bad faith may fairly be drawn to support a likelihood of confusion determination.

If all that happens is that a junior user copies a competitor's trade dress design because it sells better and consumers seem to like it, then this is not evidence of an intent to confuse. "The intent to compete by imitating the successful features of another's product is vastly different from the intent to deceive purchasers as to the source of the product."

As Judge Posner noted:

So far as appears- and it is all that the record supports- [defendant] noticed that [plaintiff's] brooms [with a vertical colored band on the bristles) were selling briskly, inferred that consumers like brooms with contrasting color bands, and decided to climb on the bandwagon. We call that competition, not bad faith, provided there is no intention to confuse, and, so far as appears, there was none.

***Subjective Belief of No Conflict.*** The junior user may have a good faith and reasonable belief that its use of the designation of another is on goods sufficiently distinct as to make confusion unlikely. "The fact that one believes he had a right to adopt a mark already in use because in his view no conflict exists since the products are separate and distinct cannot, by itself, stamp his conduct as bad faith, even after the Patent Office has refused the mark registration."

## **12. Applying the *Pianotist* test – surrounding circumstances and nature of consumers**

**12.1** Also citing the *Pianotist* test, Mr. Lall submits that the Court is required, while comparing word marks, especially while assessing





phonetic similarity, to take into account surrounding circumstances, as well as the type of consumers who would be dealing with the product.

**12.2** Insofar as the surrounding circumstances are concerned, Mr. Lall reiterates his contention that the use of the word “ART” in items such as the plaintiff’s and the defendant’s refer to the artistic character of the product.

**12.3** Apropos the type of consumers who would be dealing with the rival marks and the products on which they are used, Mr. Lall cites the judgment of the Supreme Court in *Amritdhara Pharmacy v. Satya Deo Gupta*<sup>25</sup>, specifically paras 7 to 10 thereof. In that case, submits Mr. Lall, the Supreme Court emphasized the necessity of taking into consideration the type of consumers who would be dealing with the rival marks, while examining the aspect of infringement or passing off. There, the Supreme Court found the chance of likelihood of confusion to be exacerbated by the fact that the consumers dealing with the rival marks (LAKSHMANDHARA and AMRITDHARA) were illiterate village folk who would easily confuse one for the other. As against this, the class of consumers who would be dealing with the plaintiff’s and the defendant’s products bearing the ARTIZE and ARTISRY marks would be those who are interested in purchasing luxury bath fittings and would, therefore, be discerning and capable of distinguishing one mark from the other.

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<sup>25</sup> AIR 1963 SC 449



**12.4** On the aspect of phonetic similarity, and the applicability of the *Pianotist* test, Mr. Lall relies on the judgment of this Bench in *Elyon Pharmaceutical Pvt. Ltd. v. Registrar of Trademarks*<sup>26</sup>, in which this Bench held that the marks “ELMENTIN” and “ELEMENTAL” could not be regarded as confusingly similar to each other.

**13.** “ART” is common to the trade – Section 17(2)(b)

Mr. Lall has drawn my attention to several marks registered in respect of bathroom fittings and sanitary fittings which start with “ART”, such as ARTS, ARTEK, ARTIC and the like. He seeks to point out that he has also placed on record evidence of user of the said marks by their respective proprietors, so that his case is not merely one of a multitude of ART marks being available on the Register of Trade Marks, but of actual user of all such marks. Thus, he submits, the law permits peaceful co-existence of a wide variety of ART- formative marks for bathroom and sanitary fittings. No one mark can seek to dislodge the other from the market.

**14.** Estoppel

Mr. Lall further points out that, in its First Examination Report (FER) in response to the plaintiff’s application for registration of the mark ARTIZE, the Trade Marks Registry cited the pre-existing mark ARTIC as a rival mark which rendered the ARTIZE mark ineligible to

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<sup>26</sup> 2023 SCC OnLine Del 5153



registration in view of Section 11(1)(b)<sup>27</sup> of the Trade Marks Act. having, in its response to the by the Registry of Trade Marks to the plaintiff's application, adopted the stand that the two marks were dissimilar, the plaintiff could not seek to contend that the mark ARTISTRY was confusingly or deceptively similar to the mark ARTIZE.

### 15. No likelihood of confusion

There is, in fact, he submits, no likelihood of confusion between the two marks. In support of his submission, Mr. Lall places reliance on paras 50, 51, 55, 62 and 108 of the decision in *Schering Corporation v. Alkem Laboratories Ltd.*<sup>28</sup>.

### 16. Plea of infringement not maintainable – Section 124

He further relies on the judgment of the Supreme Court in *Patel Field Marshal Agencies v. P.M. Diesels Ltd*<sup>29</sup>, to contend that the plaintiff is proscribed from pleading infringement, as the rectification application filed by the plaintiff against the defendant's ARTISTRY registration is pending as on the date of institution of the suit. In such circumstances, Section 124(1)<sup>30</sup> ordains that it is only if a competent

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<sup>27</sup> 11. **Relative grounds for refusal of registration.** –

(1) Save as provided in Section 12, a trade mark shall not be registered if, because of—

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(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

<sup>28</sup> (2009) 165 DLT 474 (DB)

<sup>29</sup> 2018 (73) PTC 15 (SC)

<sup>30</sup> 124. **Stay of proceedings where the validity of registration of the trade mark is questioned, etc.** –



civil court returns a *prima facie* finding of tenability regarding the plea of invalidity raised by the plaintiff against the defendant's registered trade mark that the plaintiff can plead infringement. Far from any such finding having returned by any competent civil court, Mr. Lall submits that the plaint does not contain any pleading, ground or material on the basis of which the registration, by the defendant, of the impugned ARTISTRY mark can be treated as invalid.

## 17. No trade dress copying

17.1 Mr. Lall also disputes Mr. Wadhwa's contention that the defendant has adopted a trade dress, for its product, which is confusingly similar to that of the plaintiff. The documents filed with the written statement enclose the following photographs of the plaintiff's and the defendant's products, to discredit Mr. Wadhwa's contention of confusing similarity in trade dress:

- 
- (1) Where in any suit for infringement of a trade mark—
- (a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or
  - (b) the defendant raises a defence under clause (e) of sub-section (2) of Section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark, the court trying the suit (hereinafter referred to as the court), shall,—
    - (i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the High Court, stay the suit pending the final disposal of such proceedings;
    - (ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is *prima facie* tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.



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Defendant's Product



Plaintiff's Product

**17.2** Except for the fact that both packs used blue and gold as the main colours, Mr. Lall submits that there is no similarity in appearance between them. He submits that the colours blue and red are normally used to depict cold and hot respectively. Additionally, the colour blue is indicative of royalty and gold of the product belonging to the luxury segment. It is for these reasons that the plaintiff and the defendant have both used blue and gold as the primary colours for their respective packs. He draws my attention, in this context, to para 13 of the written statement filed by way of response to the plaint, which reads thus:

“13. The Plaintiff's allegations *qua* passing off its trade dress/packaging by the Defendant is completely untenable because the Plaintiff's assertion of use of its trade dress/packaging comprising of blue/indigo and gold colour combination since 2008 is false. The Plaintiff has not filed a single document to corroborate this claim. Consequently, no goodwill or reputation has accrued to the Plaintiff's trade dress/packaging with the said colour combination and thus, the Plaintiff cannot claim exclusivity in the same. Even otherwise, presence of multiple distinctive features on the trade dresses/packaging of both parties including the rival house marks are sufficient to distinguish between the two rival trade dress/packaging. Thus, use of blue and gold colour combination by the Defendant does not take unfair advantage or is detrimental to the Plaintiff or its trade dress/packaging. In any event, the Defendant has honestly adopted the colour combination of blue and gold. In this connection, it is pertinent to mention that

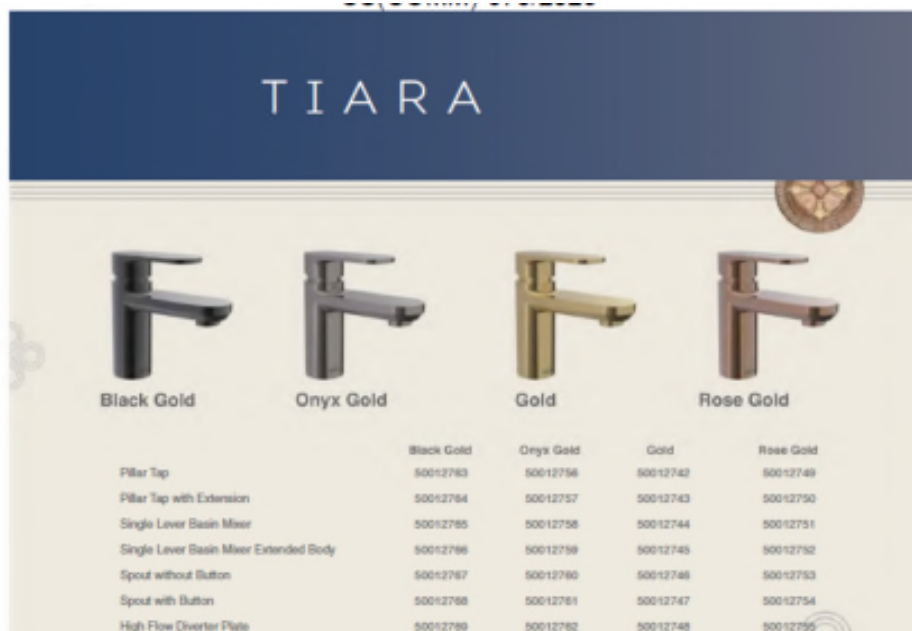


the Defendant's sanitaryware products under the vertical ARTISTRY are categorised into three sub-brands, namely, Swarna (premium segment), Heritage (sub-premium segment) and Classik (value segment). Various range/collection of products are sold under these sub-brands of ARTISTRY such as 'JANA'. Each sub-brand uses different colour combinations. However, colours blue and red are common across the portfolio. This is because in the plumbing and sanitaryware industry red and blue colours are used to denote hot and cold/ regular water, respectively.”

He also cites, to support his submission, para 25 of the decision in *Britannia Industries Ltd. v. ITC Ltd.*<sup>31</sup>.

**18. Re. TIARA**

With respect to impugned mark TIARA, Mr. Lall relies from the following depiction contained on the defendant’s catalogue, filed by the plaintiff along with the plaint:



<sup>31</sup> 240 (2017) DLT 156 (DB)



Thus, submits Mr. Lall, TIARA is only a model number or a product category, and is not used by the defendant as a trade mark. On instructions, Mr. Lall submits that, given six months to dispose of existing stock, the defendant is willing to discontinue use of the word “TIARA” to represent its product category.

Rejoinder by Mr. Wadhwa

**19. Re. trade dress copying**

Mr. Wadhwa commences his submission by way of rejoinder to Mr. Lall’s contention by drawing attention to the following tabular depiction, emphasizing the similarities between the appearance of the boxes of the plaintiff’s and the defendant’s product, to underscore the allegation of trade dress copying:

<b>PLAINTIFF’S PRODUCT “ARTIZE”</b>	<b>DEFENDANT’S PRODUCT “ARTISTRY”</b>
 <p data-bbox="264 1659 715 1727"><b>Top View:</b> Colour combination of Blue and Gold.</p>	 <p data-bbox="772 1671 1331 1738"><b>Top View:</b> Colour combination of Blue and Gold.</p>

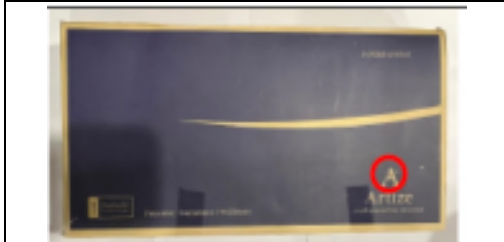




**Top View:** “ARTIZE” in Gold against a Blue background on the right side of the packaging/trade dress.



**Top View:** “ARTISTRY” in Gold against a Blue background on the right side of the packaging/trade dress.



**Top View:** Placement of stylized “A” above “ARTIZE” in Gold against a Blue background on the right side of the packaging/trade dress.



**Top View:** Placement of stylized “A” above “ARTISTRY” in Gold against a Blue background on the right side of the packaging/trade dress.



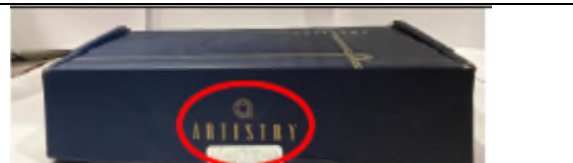
**Top View:** Partially curved horizontal line in Gold against a Blue background.



**Top View:** Partially curved horizontal line in Gold against a Blue background.



**Front View:** “ARTIZE” with stylized “A” in Gold placed on the front.



**Front View:** “ARTISTRY” with stylized “A” in Gold placed on the front.







<b>Back View:</b> “ARTIZE” with stylized “A” in Gold placed on the back.	<b>Back View:</b> “ARTIZE” with stylized “A” in Gold placed on the back.
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**20. Re. monopolization of “ART” and the common to the trade defence**

**20.1** With respect to Mr. Lall’s contention that the plaintiff was seeking to monopolise the prefix ART, Mr. Wadhwa submits that infringement could not be assessed on the basis of a syllable-by-syllable comparison between the two marks. He cites, in this context,

- (i) paras 38 and 40 of *Hamdard National Foundation (India) v. Sadar Laboratories Pvt Ltd*<sup>32</sup>,
- (ii) *Amrutanjan Ltd v. Amarchand Sobachand*<sup>33</sup>, and
- (iii) paras 24, 29 and 31 of the judgment of this Bench in *Institut Europeen D. Administration Des Affaires v. Fullstack Education Private Limited*<sup>34</sup>.

**20.2** Mr. Wadhwa also disputes Mr. Lall’s contention that “ART”, when used as a prefix in the names of the plaintiff’s or defendant’s product, is descriptive. He submits that the word “ARTIZE” is clearly a fanciful adoption on the part of the plaintiff.

**20.3** Apropos the judgments cited by Mr. Lall, Mr. Wadhwa draws my attention to para 9 of the decision in *F. Hoffmman-La Roche* in which the respondent had made a concession before the Court that it was willing to limit the use of the impugned mark DROPOVIT to

<sup>32</sup> 300 (2023) DLT 420 (DB)

<sup>33</sup> 1979 SCC OnLine Mad 145

<sup>34</sup> 2023 SCC OnLine Del 3016



medicinal and pharmaceutical preparations and substances principally containing vitamins. Thus, the judgment was rendered on concession.

**20.4** *J R Kapoor*, he submits, was a case where the prefix MICRO was found to be descriptive of the products of the plaintiff and defendant, both of which were manufactured using micro-technology. Thus, *J R Kapoor* applied only where the common prefix was directly descriptive of the products and not in a case, such as the present, where the common prefix ART cannot be regarded as descriptive either of the plaintiff's or the defendant's products. He points out, from paras 13, 19 and 20 of the judgment of the Supreme Court in *Corn Products Refining Co. v. Shangrila Food Products Ltd*<sup>35</sup>, that the Supreme Court had protected the mark GLUCOVITA from infringement by the mark GLUVITA.

**20.5** Mr. Wadhwa further submits, relying on the defendant's catalogue, that there is nothing artistic about the defendant's taps which are plain and simple taps, with the most basic of designs. As against this, he refers to the photographs of his clients, to submit that the taps made by his client are artistic. The defendant cannot, therefore, be heard to contend that it uses ART as a prefix for its mark ARTISTRY to reflect the artistic nature of the sanitary fittings on which the mark is used.

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<sup>35</sup> AIR 1960 SC 142



**20.6** Referring to McCarthy, Mr. Wadhwa submits that the prefix ART could not be regarded as *publici juris* but is, at the highest, suggestive.

**20.7** Mr. Wadhwa also disputes Mr. Lall's submission that "artize" is a well-known English word and, referring to the new Oxford dictionary, contends that, in fact the word "artize" finds no place therein.

**20.8** Regarding Mr. Lall's submission that there are several other user of marks starting with "ART" for bathroom and sanitary fittings, Mr. Wadhwa submits, relying on *Pankaj Goel v. Dabur India Ltd*<sup>36</sup> and the judgment of this Bench in *Under Armour* that, third party use is relevant only where it is so substantial as to eclipse the plaintiff's use of the asserted trade mark. Else, he submits that it is well-settled that a plaintiff is not expected to sue every infringer.

## **21** Likelihood of confusion

**21.1** Mr. Wadhwa submits that infringement is required to be assessed on the basis of initial interest confusion. If the average consumer is placed in a state of confusion or wonderment at an initial glance at the defendant's mark, a *prima facie* case of infringement is made out.

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<sup>36</sup> (2008) 38 PTC 49 (DB)



**21.2** To emphasise the aspect of deceptive similarity or likelihood of confusion, Mr. Wadhwa has placed reliance on paras 19 and 31 of the judgment of the Division Bench of this Court in *Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt Ltd*<sup>37</sup>.

## **22. Re. TIARA**

**22.1** With respect to the use, by the defendant, of the impugned TIARA mark, Mr. Wadhwa submits that Section 29(1)<sup>38</sup> of the Trade Marks Act covers the plaintiff. He submits, referring to the words “to render the use of the mark likely to be taken as being used as a trade mark” employed in the said sub-section, that mere impression of use of the impugned mark as a trade mark is sufficient to invoke Section 29(1).

**22.2** Relying on invoices issued by the defendant for “Tiara Pillar Tap – Gold”, Mr. Wadhwa submits that the defendant is clearly using the mark TIARA as a product identifier and, therefore, as a trade mark.

## **23. Action for infringement lies against registered trade mark**

Mr. Wadhwa further submits, relying on the judgment of the Division Bench of this Court in *Corza International* – which, in turn, relies on

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<sup>37</sup> 221 (2015) DLT 359

<sup>38</sup> 29. **Infringement of registered trade marks. –**

(1) 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 is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.



the earlier decision, also of a Division Bench, in *Raj Kumar Prasad v. Abbott Healthcare (P) Ltd*<sup>39</sup> – that an injunction can also be sought against a registered trade mark, so long as the invalidity of the defendant’s registration is pleaded by the plaintiff. Inasmuch as the plaintiff had, even before instituting present suit, filed rectification proceedings under Section 57 of the Trade Marks Act, pleading invalidity of the impugned marks, he submits that the plaintiff is entitled to sue the defendant for infringement even by use of its registered trade mark. He further draws attention to para 61 of the plaint in which there is a specific contention that the registration of the defendant’s marks is invalid:

“61. That the Defendant cannot take the benefit of Section 28(3) and 30 of the Trade Marks Act, 1999 as the registration of the Impugned Mark **ARTISTRY** is prima facie invalid as *inter alia*, the Impugned Mark is of such a nature as to deceive the public and cause confusion. That the Impugned Mark ought not to have been registered due to its similarity to the Plaintiffs prior adopted, used and registered trademarks and the identity of the goods. It is submitted that the Plaintiff has accordingly instituted rectification proceedings for the removal of the Defendant’s TM Application No. 5272892 for the Impugned Mark **ARTISTRY** from the Trade Marks Register.”

## 24. Balance of convenience

**24.1** On the aspect of balance of convenience, Mr. Wadhwa draws attention to para 13 of the reply filed by the defendant to the present application:

“13. The Plaintiff has claimed that it came across the Defendant’s use of the mark **ARTISTRY** for the first time in January 2023 through a promotional advertisement published in Casa Vogue India, November 2022 edition. Given that the

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<sup>39</sup> 2014 SCC OnLine Del 7708



Plaintiff's own advertisement for the brand ARTIZE was also published in the same November 2022 Edition of Casa Vogue, India, it is inconceivable that the Plaintiff came to know about the Defendant's advertisement two months later. The Plaintiff is deemed to have been aware of the existence of the Defendant's products under the mark ARTISTRY at least since November 2022. Additionally, the Plaintiff, after having received the Defendant's reply dated February 02, 2023 to its legal notice dated January 12, 2023 did not take any steps to convey to the Defendant that it had any objections to the Defendant's use of the mark ARTISTRY. Be that as it may, apprehending that the Plaintiff may surreptitiously file a suit for infringement against the Defendant before this Hon'ble Court, the Defendant had filed two caveat petitions before this Hon'ble Court on February 10, 2023 and May 01, 2023. However, the Plaintiff, despite being aware of the Defendant's substantial use of the mark ARTISTRY did not convey any objections to the Defendant regarding its use, let alone file a suit to restrain the Defendant from using its mark ARTISTRY. In fact, the Plaintiff did not even oppose the Defendant's application for the mark ARTISTRY dated January 05, 2022 under number 5272892 which was published in the Trade Mark's Journal on February 07, 2022. The Plaintiff's aforesaid conduct led the Defendant to believe that the Plaintiff's concerns were duly addressed. Consequently, the Defendant did not file fresh renew or file fresh caveat petitions and continued to – (a) expand its business under the mark ARTISTRY, the sales whereof are around INR 130 Crores from inception which is equivalent to the Plaintiff's sales of products under the mark ARTIZE in FY 2022-23; and (b) incur substantial expenses to the tune of around 30 crores since inception to promote and market its products under the mark ARTISTRY. It was only in September 2023, after almost one year from its knowledge of the Defendant's use of the mark ARTISTRY that the Plaintiff filed the rectification/cancellation petition against the registration of the Defendant's mark ARTISTRY as well as the present suit. It is trite that if the Plaintiff has laid by and inspite of its rights, by its conduct, encouraged the Defendant to alter its condition by acting upon the faith of encouragement so held out, the Plaintiff loses its claim against the Defendant. In view of the foregoing, it is submitted that the Plaintiff, having given its affirmative consent to the Defendant to expand its business under the mark ARTISTRY, which is writ large from its conduct, cannot now, belatedly cry foul and initiate an action against the Defendant."

**24.2** As such, the adoption, by the defendant, of the impugned mark "ARTISTRY", is of recent vintage. Prior thereto, the defendant was




using the mark “Ashirvad by Aliaxis”. No irreparable loss would, therefore, ensue to the defendant if interim injunction as sought by the plaintiff is granted. On other hand, the continued use, by the defendant, of the impugned mark is resulting in dilution of the plaintiff’s brand especially as the products of the plaintiff and the defendant are sold from the same outlet whether physically or virtually.

25. Mr. Wadhwa, therefore, reiterates his prayer for grant of interim injunction restraining the defendant from using the impugned ARTISTRY and TIARA marks, pending disposal of the present suit.

Mr. Lall in surrejoinder

26. Mr. Lall was permitted to advance submissions in surrejoinder, at his request.

27. The judgments in *F. Hoffmann-La Roche* and *J R Kapoor*, submits Mr. Lall, would apply even if part of the plaintiff’s mark is suggestive. Referring to *J R Kapoor*, he submits that the prefix MICRO, in that case, was actually suggestive and not descriptive, as is ART in the present case. He has referred once again to para 6 of the said decision in this context. He submits, referring to the application filed by the plaintiff for registration of its device mark , that the prefix ART is clearly descriptive of the plaintiff’s product, as is manifest from the slogan “art that performs”.



28. Mr. Lall also cites, with respect to Mr. Wadhwa's contention, that the prefix ART is, at best, suggestive and not descriptive in nature,

- (i) paras 17, 18, 21 and 22 of the decision in *Living Media India Ltd. v. Alpha Dealcom Pvt Ltd*<sup>40</sup> and
- (ii) *Soothe Healthcare Private Ltd v. Dabur India Ltd*<sup>41</sup>.

29. He further cites the following passages from the judgment of the Second Circuit in *Landscape Forms, Inc. v. Columbia Cascade Co.*<sup>42</sup>:

“The Abercrombie (spectrum of distinctiveness) test, thus, permits courts to separate those cases in which similar marks are most likely to mislead consumers from those in which trademark protection would create a "linguistic monopoly" which would stifle competitors' efforts to market similar goods to consumers.”

30. Mr. Lall further cites paras 3, 4, 13, 15 and 16 of *Corn Products Refining Co.* and para 23 of *Shree Nath Heritage Liquor Pvt. Ltd.* Applying the latter decision, Mr. Lall submits that the plaintiff's mark ARTIZE and the defendant's mark ARTISTRY are based on the common idea of the ART prefix. Otherwise, he submits, the facts in *Shree Nath Heritage Liquor Pvt. Ltd.* are completely different from those in the present case.

31. Mr. Lall reiterates that, having contended, in its reply to the FER raised by the Trade Mark Registry which set up the pre-existing registered trade mark ARTIC as a confusingly similar mark to the

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<sup>40</sup> 227(2016) DLT 681 (DB)

<sup>41</sup> AIR 2022 Del 188

<sup>42</sup> 113 F.3d 373, 42 U.S.P.Q.2d 1641 (2d Cir. 1997)





proposed mark ARTIZE, that the marks ARTIZE and ARTIC were not similar, the plaintiff cannot be heard to submit that the marks ARTIZE and ARTISTRY are similar. This, he submits, would amount to approbate and reprobate, which is not permissible, for which purpose he relies on para 40 of the judgment of the Division Bench of this Court in *Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani*<sup>43</sup>.

**32.** Insofar Mr. Wadhwa's contention that, as the plaintiff has, prior to institution of suit, filed an application under Section 57, challenging the registration of the ARTISTRY mark in favour of the defendant, Mr. Lall submits that the only basis cited in the said challenge is priority of user of the plaintiff's mark. He further submits that, even if the rectification petitions were filed prior to institution of the suit, an application under Section 124 of the Trade Marks Act is nonetheless required to be filed by the plaintiff, and the Court, seized of the suit, is required to return a *prima facie* finding that the challenge to the validity of the defendant's registered trade mark is tenable, before the plaintiff could plead infringement by use of the said registered trade mark of the defendant. He draws my attention to paras 25, 29 and 30 of *Patel Field Marshal*. By filing a rectification application prior to institution of the suit, the plaintiff has effectively inhibited this Court from adjudicating on the validity of the defendant's registered trade mark. The plaintiff's case has, therefore, necessarily to be restricted to the plea of passing off. He cites, in this context, para 24 of the

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<sup>43</sup> 2022 SCC OnLine Del 3370



judgment of the Division Bench of this Court in *Rhizome Distilleries P. Ltd. v. Pernod Ricard S.A. France*<sup>44</sup>.

**33.** The decision in *Hamdard*, cited by Mr. Wadhwa, has, according to Mr. Lall, no application as, unlike the prefix ART, the suffix AFZA, in that case, has no reference to the character or quality of the goods in question. He refers, in this context, to paras 26, 38, 40 and 59 of the decision in *Hamdard*.

## Analysis

### **34.** Infringement

**34.1** Before proceeding to the defences advanced by Mr. Lall, it would be appropriate to examine, in the first place, whether a case of infringement or passing off is made out.

**34.2** Of the two, infringement is a statutory tort, whereas passing off is a common law tort.

**34.3** Infringement is said to take place where the facts of the case attract one or more of the sub-sections of Section 29 of the Trade Marks Act. The sub-sections of Section 29 fall into distinct categories. Sections 29(1) to 29(4)<sup>45</sup> apply where the infringer is not a registered

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<sup>44</sup> 2009 SCC Online Del 3346 (DB)

<sup>45</sup> 29. **Infringement of registered trade marks.** –

(1) 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 is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the



proprietor of the infringing mark or a permitted user thereof. Section 29(5)<sup>46</sup> applies in the case of use of a registered trade mark by another as part of the name his business concern dealing in goods or services in respect of which the mark is registered. Section 29(7)<sup>47</sup> applies in the case of a use of a registered trade mark without authorisation for labelling or packing purpose, as a business paper or for advertising. Section 29(8)<sup>48</sup> explains the principle of infringement by advertising of a registered trade mark. Sections 29(6)<sup>49</sup> and 29(9)<sup>50</sup> are more

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trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) 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 because of—

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(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.

<sup>46</sup> (5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

<sup>47</sup> (7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

<sup>48</sup> (8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or
- (b) is detrimental to its distinctive character; or
- (c) is against the reputation of the trade mark.

<sup>49</sup> (6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.



explanatory of the other sub-sections of Section 29. Section 29(6) explains the concept of use of a registered trade mark for the purposes of Section 29. Section 29(9) clarifies that where the registered trade mark is a word, or includes words, infringement could take place either by speaking of the words or by visual representation thereof.

**34.4** Adverting to these individual sub-sections, the applicability of some of them may be ruled out. Sections 29(2)(a), 29(2)(c) and 29(3) apply where the rival marks are identical. Inasmuch as the rival marks in the present case are not identical, none of these provisions apply. Section 29(4) applies where defendant's mark is used in relation to goods or services which are dissimilar from the goods or services in respect of which the plaintiff's mark is used. Inasmuch as, in the present case, the rival marks are used for similar goods, Section 29(4) is also not applicable. Sections 29(5), 29(7), 29(8) and 29(9) are, on their plain terms, inapplicable.

#### **34.5** Relevance of validity of plaintiff's trade mark registration – Section 29 vis-à-vis Section 28(1)

**34.5.1** Before proceeding to examine the applicability of the remaining provisions of Section 29, it is important to note that the validity of the registration of the allegedly infringed trade mark of the plaintiff is *not* a relevant consideration for the purposes of Section 29. Section 29 does not refer, anywhere, to the infringed mark having to

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<sup>50</sup> (9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.



be validly registered. It is only required to be registered. Whether the registration is valid or invalid, if the circumstances envisaged by the sub-sections of Section 29 are satisfied, infringement *ipso facto* has taken place. The court, while examining the aspect of infringement in the backdrop of Section 29 is not, therefore, concerned with the validity of the registration of the plaintiff's trade mark.

**34.5.2** Validity of the registration of the plaintiff's trade mark is, however, a relevant consideration when it comes to obtaining relief against infringement, under Section 28(1). If infringement is found to have taken place, within the meaning of Section 29, then, unless the registration of the plaintiff's trade mark is valid, the plaintiff is not entitled to obtain any relief against infringement. The entitlement to relief against infringement is, statutorily under Section 28(1), dependent on the registration being valid.

**34.5.3** The reliefs which can be granted, where infringement is found to exist, are contained in Section 135(1) and (2)<sup>51</sup> of the Trade Marks Act, and include injunction.

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<sup>51</sup> **135. Relief in suits for infringement or for passing off.** –

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) The order of injunction under sub-section (1) may include and *ex parte* injunction or any interlocutory order for any of the following matters, namely:—

(a) for discovery of documents;

(b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;

(c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.



**34.6** Adverting to the applicable provisions of Section 29, subsection (1) envisages infringement as taking place where a mark which is identical with, or deceptively similar to, a registered trade mark, is used, in the course of trade, by a person who is neither the registered proprietor nor the permissive user of such registered trade mark, in relation to the goods or services in respect of which the trade mark is registered and in such a manner as to render the use of the mark likely to be taking as being used as a trade mark. The subsection may, therefore, be broken up into the following ingredients:

- (i) The plaintiff's trade mark must be registered.
- (ii) The defendant is neither the registered proprietor of the mark nor the permissive user thereof.
- (iii) The mark used by the defendant is either identical to the plaintiff's trade mark or is deceptively similar thereto.
- (iv) The defendant uses the impugned mark in the course of trade.
- (v) The impugned mark is used in relation to goods or services in respect of which the trade mark is registered in favour of the plaintiff.
- (vi) The manner in which the defendant uses the impugned mark is such as to render the use likely to be taken as "use as a trade mark".

**34.7** The expression "use as a trade mark" is neither defined nor explained in the Trade Marks Act. The ambit of the expression has,



therefore, to be understood from the definition of “trade mark” as contained in Section 2(1)(zb)(ii)<sup>52</sup> of the Trade Marks Act.

**34.8** “Trade mark” is defined, in Section 2(1)(zb)(ii), as a mark which, apart from satisfying the other indicia of the said clause, is used “for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services... and some persons having the right, either as proprietor or by way of permitted user, to use the mark”. Simply stated, the use must be for indicating a trade connection between the mark and its proprietor.

**34.9** The expression “deceptively similar” is defined in Section 2(1)(h)<sup>53</sup> as so nearly resembling the other mark as to be likely to deceive or cause confusion. Thus, though there is, etymologically, a difference between confusion and deception, with the latter expression including an element of deceit, Section 2(1)(h) effaces, in a manner of speaking, that distinction. Obviously for the reason that it expands the concept of confusion beyond its normal etymological confines, by parenthesizing it with deception, Section 2(1)(h) is worded as a *deeming* provision. Whether the defendant’s mark is merely confusingly similar to the plaintiff’s mark, or where there is an intent to deceive, the mark would be deemed to be deceptively similar to the

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<sup>52</sup> (zb) “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and—

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(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

<sup>53</sup> (h) “deceptively similar” a mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;





plaintiff's mark. Not much, therefore, turns on the intent of the defendant, in so far as the aspect of whether the defendant's mark is, or is not, deceptively similar to the plaintiff's mark, is concerned.

### **34.10 Can action for infringement lie against a registered trade mark?**

**34.10.1** Before proceeding to Section 29(1), it is also important to note one other significant legal position. One of Mr. Lall's contentions – indeed the very first contention in the written statement filed by him on behalf of the defendant – is that, as the impugned trademarks of the defendant are registered, no action for infringement can lie against them. Reliance has been placed, in this context, on the various sub-clauses of Section 29 as well as Section 28(3), which does not permit a registered proprietor of one trade mark to claim exclusivity against the registered proprietor of an identical or nearly resembling trade mark.

**34.10.2** Though Section 28(3) uses the expression “nearly resembles” as contradistinguished with the various sub-sections of Section 29 which uses the expression “deceptively similar”, this difference may not be regarded as of any particular significance, as the Supreme Court in *S. Syed Mohideen v P. Sulochana Bai*<sup>54</sup>, as also the Division Bench of this Court in *Raj Kumar Prasad*, have regarded the expressions as conveying the same meaning. Where the plaintiff's mark and the defendant's mark are identical, or where the defendant's mark nearly resembles the mark of the plaintiff, what Section 28(3)

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<sup>54</sup> (2016) 2 SCC 683



proscribes is the plaintiff, or the defendant, seeking to interfere with the use, by the other, of the identical or nearly resembling mark, solely on the basis of the registration held by her or him.

**34.10.3** It is necessary to refer, in this context, to the decisions in *Raj Kumar Prasad* and *Corza International*.

**34.10.4** *Raj Kumar Prasad* identifies the issue arising for consideration before the Division Bench as “whether the registered proprietor of a trade mark can sue another registered proprietor of a trade mark alleging deceptive similarity”. In that case, the respondent-plaintiff Abbott Healthcare (P) Ltd. (“Abbott” hereinafter), was the registered proprietor of the trade mark ANAFORTAN, for a pharmaceutical preparation of which the active pharmaceutical ingredient was Camylofin Dihydrochloride. Abbott claimed to have acquired goodwill and reputation in the mark ANAFORTAN. It also claimed to be aggrieved by the manufacture and sale of Camylofin Dihydrochloride by the appellants Raj Kumar Prasad and Birani Pharmaceuticals (collectively “RKP” hereinafter) under the brand name AMAFORTEN.

**34.10.5** RKP had obtained trade mark registration for the mark AMAFORTEN. On the date of filing of the infringement suit by it against RKP, Abbott had yet to challenge the registration obtained by RKP for the mark AMAFORTEN. As in the present case, RKP was also alleged to have copied the trade dress of Abbott for its ANAFORTAN product. In these circumstances, Abbott sought an



injunction against RKP from using the trade mark AMAFORTEN or any other mark which was deceptively similar to ANAFORTAN.

**34.10.6** RKP, in his written statement, invoked Section 28(3) of the Trade Marks Act. It was contended that, as RKP was the registered proprietor of the mark AMAFORTEN, Abbott could not seek to injunct use of the mark by RKP.

**34.10.7** The single Judge of this Court held that a registered proprietor of one trade mark could sue the registered proprietor of another identical or nearly resembling trade mark. Holding that the mark “AMAFORTEN” was phonetically and visually deceptively similar to the mark “ANAFORTAN”, the single Judge granted interim injunction as sought by Abbott.

**34.10.8** The Division Bench, in appeal, noticed the provisions of Sections 28 and 124 of the Trade Marks Act. The manner in which the Division Bench has juxtaposed these provisions and attempted to harmonise them is interesting. Paras 15 to 18 of the report merit reproduction, as under:

“15. It is no doubt true that a reading of sub-Section 1 of Section 28 of the Trademarks Act, 1999 would evidence a legal right vested in the registered proprietor of a trademark to exclusively use the same in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark. It is also true that a mere reading of sub-Section 3 of Section 28 of the Trademarks Act, 1999 would evidence a mutually exclusive right in two or more registered proprietors of trademarks which are identical with or nearly resemble each other to use the trademarks; none being in a position to sue the other, and each being empowered to sue other persons.



16. But what does Section 124 of the Trademarks Act, 1999 say? And in what manner does it affect the rights conferred under Section 28?

17. The guiding star being the principle of law : every attempt has to be made, as long as the language of a statute permits, to give effect to every phrase and sentence used by the legislature, and if there emerges an apparent conflict, the duty of the Court would be to iron out the creases and interpret the provisions harmoniously so that the provisions are given effect to.

18. Sub-Section 1 of Section 124 of the Trademarks Act, 1999 would guide us that it contemplates a suit for infringement of a trademark on the allegation of invalidity of registration of the defendant's mark and even includes a case where a defendant pleads invalidity in the registration of the plaintiffs trademark. In such a situation the legislative intent clearly disclosed is, as per sub-Section 5 of Section 124, to stay the suit, to enable either party to take recourse to rectification proceedings before the Registrar of Trademarks, but after considering what interlocutory order needs to be passed. Sub-Section 5 reads:“The stay of a suit for the infringement of a trademark under this Section shall not preclude the Court for making any interlocutory order including any order granting an injunction direction account to be kept, appointing a receiver or attaching any property, during the period of the stay of the suit”.”

**34.10.9** More importantly, paras 20 and 21 of the report read as under:

“20. Ex-facie there is visual and phonetic deceptive similarity in the trademark ‘AMAFORTEN’ in comparison with the trademark ‘ANAFORTAN’. It has to be kept in mind that the competing goods are pharmaceutical preparations, the class of the goods is the same; the consumer is the same and the trade channel is die same. Concededly through its predecessors-in-interest Abbott has inherited the good will and reputation in its trademark ‘ANAFORTAN’ and would be entitled to protect the same. Whereas through its predecessors-in-interest Abbott is in the market since the year 1988 defendant entered the market somewhere in the year 2012 when the suit was filed. We note that the defendant has consciously not disclosed in the written statement the day it started selling the goods in the market. From the documents filed by the defendants we find that it applied to the Registrar of Trademarks for registration of the trademark



“AMAFORTEW” on June 17, 2009 and was granted registration on July 12, 2011.

21. Tested on the legal principles laid down by the Supreme Court in the decision reported as *Wander Ltd. v. Antox India P. Ltd.*<sup>55</sup> we find no infirmity in the view taken by the learned Single Judge and thus would dismiss the appeal challenging the order dated April 25, 2014 allowing IA No. 23086/2012 filed by Abbott.”

**34.10.10** Thus, the principles that flow from *Raj Kumar Prasad* may be enumerated as under:

- (i) Section 28(1), undoubtedly, conferred, on the registered proprietor of a trade mark, the right to exclusive use of the said mark.
- (ii) Section 28(3) also, undisputedly, read in isolation, evidence a mutually exclusive right in two registered proprietors of trade marks, which were identical or nearly resembled each other to use them, with neither being in a position to sue the other against such use.
- (iii) Section 28(3) had, however, to be read not in isolation, but in conjunction with Section 124 of the Trade Marks Act.
- (iv) Section 124(1) permitted a plaintiff to institute a suit for infringement against the holder of a registered trade mark, pleading that the registration was invalid. Where such a plea of invalidity is raised, Section 124(1) empowers the Court to stay the suit so as to enable the plaintiff to institute rectification proceedings against the defendant’s mark. While doing so, Section 124(5) also empowers the Court to pass interlocutory orders, including interlocutory injunctive orders.

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<sup>55</sup> 1990 Supp SCC 727 : (1991) 11 PTC 1 (SC)



(v) Importantly, rectification proceedings were instituted by Abbott after the filing of the suit against RKP.

(vi) In such circumstances, there was no infirmity in the decision of the learned Single Judge to injunct RKP from using the impugned AMAFORTEN mark, as it was, in fact, phonetically deceptively similar to ANAFORTAN.

**34.10.11** The ultimate outcome of the decision in *Raj Kumar Prasad* is of great importance. Having invoked Section 124, the Division Bench proceeded to uphold the decision of the learned Single Judge to injunct RKP from using the AMAFORTEN mark, pending disposal of the suit instituted by Abbott. No rectification proceedings had been filed by Abbott, assailing the “AMAFORTEN” registered mark of RKP, prior to institution of the suit. Rectification proceedings were instituted only after the suit was filed. Despite this, the Division Bench upheld the decision of the learned Single Judge to stay the use of the impugned “AMAFORTEN” mark by RKP.

**34.10.12** *Raj Kumar Prasad*, being the decision of a Division Bench, binds me.

**34.10.13** The decision in *Raj Kumar Prasad* stands reiterated recently by the Division Bench of this Court in *Corza International* but, before referring to *Corza International*, it is important to note the intervening judgment of the Supreme Court in *S. Syed Mohideen*. Para 27 of the report in that case reads thus:

“27. Sub-section (3) of Section 28 with which we are directly concerned, contemplates a situation where two or more persons are



registered proprietors of the trade marks which are identical with or nearly resemble each other. It, thus, postulates a situation where same or similar trade mark can be registered in favour of more than one person. On a plain stand-alone reading of this Section, it is clear that the exclusive right to use of any of those trade marks shall not be deemed to have been acquired by one registrant as against other registered owner of the trade mark (though at the same time they have the same rights as against third person). *Thus, between the two persons who are the registered owners of the trade marks, there is no exclusive right to use the said trade mark against each other, which means this provision gives concurrent right to both the persons to use the registered trade mark in their favour. Otherwise also, it is a matter of common sense that the plaintiff cannot say that its registered trade mark is infringed when the defendant is also enjoying registration in the trade mark and such registration gives the defendant as well right to use the same, as provided in Section 28(1) of the Act.”*

(Emphasis supplied)

Immediately, thereafter, however, para 28 proceeds in the following vein:

“28. *However, what is stated above is the reflection of Section 28 of the Act when that provision is seen and examined without reference to the other provisions of the Act. It is stated at the cost of repetition that as per this Section owner of registered trade mark cannot sue for infringement of his registered trade mark if the appellant also has the trade mark which is registered. Having said so, a very important question arises for consideration at this stage, namely, whether such a respondent can bring an action against the appellant for passing off invoking the provisions of Section 27(2) of the Act. In other words, what would be the interplay of Section 27(2) and Section 28(3) of the Act is the issue that arises for consideration in the instant case. As already noticed above, the trial court as well as the High Court have granted the injunction in favour of the respondent on the basis of prior user as well as on the ground that the trade mark of the appellant, even if it is registered, would cause deception in the mind of the public at large and the appellant is trying to encash upon, exploit and ride upon on the goodwill of the respondent herein. Therefore, the issue to be determined is as to whether in such a scenario, the provisions of Section 27(2) would still be available even when the appellant is having registration of the trade mark of which he is using.”*

(Emphasis supplied)





**34.10.14** What is stated in para 27 of *S. Syed Mohideen* cannot, therefore, be regarded as redolent of the legal position which emerges from a holistic reading of the Trade Marks Act. The Supreme Court has been cautious to clarify, in the opening sentence of the very next paragraph 28 that the enunciation of the law in para 27 is only on an isolated reading of Section 28 of the Trade Marks Act, without reference to any of the other provisions thereof.

**34.10.15** The position in *Raj Kumar Prasad*, which flows from the conjoint reading of Sections 28(3) and 124, cannot, therefore, be said to have been diluted in any way by *S. Syed Mohideen*.

**34.10.16** *Corza International*, rendered most recently by another Division Bench of this Court, reiterates *Raj Kumar Prasad*. Para 9 of *Corza International* reads thus:

“9. Further, the consistent view taken by this Court is that the registered proprietor of a trademark can sue another registered proprietor of a trademark alleging deceptive similarity and the Courts are competent to grant an *ad-interim* injunction. The Division Bench of this Court in *Raj Kumar Prasad v. Abbott Healthcare (P) Ltd.*, has held as under:—

“14. The question : Whether the registered proprietor of a trademark can sue another registered proprietor of a trademark alleging deceptive similarity keeps on arising in this Court. The consistent view taken by learned Single Judges is that such a suit would be maintainable and thus by way of an interim injunction the defendant can be restrained from marketing goods under the offending trademark. The question has arisen once again in the suit filed by Abbott Healthcare Pvt. Ltd. and the antagonists are Raj Kumar Prasad and Alicon Pharmaceuticals Pvt. Ltd.

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15. It is no doubt true that a reading of sub-Section 1 of Section 28 of the Trademarks Act, 1999 would evidence a legal right vested in the registered proprietor of a trademark to exclusively use the same in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark. It is also true that a mere reading of sub-Section 3 of Section 28 of the Trademarks Act, 1999 would evidence a mutually exclusive right in two or more registered proprietors of trademarks which are identical with or nearly resemble each other to use the trademarks; none being in a position to sue the other, and each being empowered to sue other persons.

16. But what does Section 124 of the Trademarks Act, 1999 say? And in what manner does it affect the rights conferred under Section 28?

17. The guiding star being the principle of law : every attempt has to be made, as long as the language of a statute permits, to give effect to every phrase and sentence used by the legislature, and if there emerges an apparent conflict, the duty of the Court would be to iron out the creases and interpret the provisions harmoniously so that the provisions are given effect to.

18. Sub-Section 1 of Section 124 of the Trademarks Act, 1999 would guide us that it contemplates a suit for infringement of a trademark on the allegation of invalidity of registration of the defendant's mark and even includes a case where a defendant pleads invalidity in the registration of the plaintiff's trademark. In such a situation the legislative intent clearly disclosed is, as per sub-Section 5 of Section 124, to stay the suit, to enable either party to take recourse to rectification proceedings before the Registrar of Trademarks, but after considering what interlocutory order needs to be passed. Sub-Section 5 reads: "The stay of a suit for the infringement of a trademark under this Section shall not preclude the Court for making any interlocutory order including any order granting an injunction direction account to be kept, appointing a receiver or attaching any property, during the period of the stay of the suit.

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20. Ex-facie there is visual and phonetic deceptive similarity in the trademark 'AMAFORTEN' in comparison with the trademark 'ANAFORTAN'. It has to be kept in mind that the competing goods are pharmaceutical



preparations, the class of the goods is the same; the consumer is the same and the trade channel is the same. Concededly through its predecessors-in-interest Abbott has inherited the good will and reputation in its trademark 'ANAFORTAN' and would be entitled to protect the same. Whereas through its predecessors-in-interest Abbott is in the market since the year 1988 defendant entered the market somewhere in the year 2012 when the suit was filed. We note that the defendant has consciously not disclosed in the written statement the day it started selling the goods in the market. From the documents filed by the defendants we find that it applied to the Registrar of Trademarks for registration of the trademark 'AMAFORTEN' on June 17, 2009 and was granted registration on July 12, 2011.

21. Tested on the legal principles laid down by the Supreme Court in the decision reported as *Wander Ltd. v. Antox India P. Ltd.* we find no infirmity in the view taken by the learned Single Judge and thus would dismiss the appeal challenging the order dated April 25, 2014 allowing IA No. 23086/2012 filed by Abbott.”

**34.10.17** In *Raj Kumar Prasad*, as also in *Corza International*, therefore, the Division Bench of this Court has upheld the decision of the Single Judge to grant injunction in favour of the plaintiff and against the defendant, even though the defendant's mark was registered, as the plaintiff had pleaded invalidity of the registration.

**34.10.18** In the present case too, a specific plea, regarding invalidity of the defendant's registration of the mark ARTISTRY has been taken in para 61 of the plaint, reproduced *supra*. As such, applying the law laid down in *Raj Kumar Prasad* and *Corza International*, Mr. Lall's submission that, as the impugned ARTISTRY mark of the defendant is registered, the plaintiff is statutorily proscribed from pleading infringement, has to be rejected.



### **34.11 The aspect of deceptive similarity**

**34.11.1** Before proceeding to the individual sub-sections of Section 29, it is necessary to first examine whether the impugned marks of the defendant are deceptively similar to the asserted ARTIZE and TIAARA marks of the plaintiff. Quite obviously, neither is ARTISTRY identical to ARTIZE nor, for that matter, is TIARA identical to TIAARA. The impugned marks of the defendant are not, therefore, identical to the asserted registered trademarks of the plaintiff.

**34.11.2** It has to be seen, therefore, whether the impugned marks of the defendants can be regarded as deceptively similar to the ARTIZE and TIAARA marks of the plaintiff.

### **34.11.3 The “device mark-to-device mark” argument**

**34.11.3.1** One of the arguments that Mr. Lall advanced was that, as all the plaintiff’s ARTIZE marks are device marks except for the word mark ARTIZE-BORN FROM ART, the comparison has to be device-mark to device-mark and, thus compared, the marks of the defendant and plaintiff are completely dissimilar, with no likelihood of confusion between them.

**34.11.3.2** This argument has outlived its welcome as far back as 1969 with the judgment of the Supreme Court in *K. R. Chinna*



***Krishna Chettiar v. Shri Ambal & Co***<sup>56</sup>. The comparison in that case was between two device marks, which, as is specifically noted in para 7 of the report, had *no visual resemblance*. The two device marks are thus described in the opening passage from the decision:

“1. The appellant is the sole proprietor of a trading concern known as Radha and Co. The respondents Ambal and Co., are a partnership firm. The respondents as also the appellant are manufacturers and dealers in snuff carrying on business at Madras and having business activities inside and outside the State of Madras. On March 10, 1958, the appellant filed Application No. 183961 for registration of a trade mark in Class 34 in respect of “snuff manufactured in Madras”. The respondents filed a notice of opposition. The main ground of opposition was that the proposed mark was deceptively similar to their registered trade marks. The respondents were the proprietors of the registered Marks Nos. 126808 and 146291. Trade Mark No. 126208 consists of a label containing a device of a goddess Sri Ambal seated on a globe floating on water enclosed in a circular frame with the legend “Sri Ambal parimala snuff” at the top of the label, and the name and address “Sri Ambal and Co., Madras” at the bottom. Trade mark No. 146291 consists of the expression “Sri Ambal”. The mark of which the appellant seeks registration consists of a label containing three panels. The first and the third panels contain in Tamil, Devanagri, Telgu and Kannada the equivalents of the words “Sri Andal Madras Snuff”. The centre panel contains the picture of goddess Sri Andal and the legend “Sri Andal””

**34.11.3.3** The Supreme Court addressed the issue of deceptive similarity thus:

“5. Now the words “Sri Ambal” form part of trade mark no. 126808 and are the whole of trade mark no. 146291. There can be no doubt that the word "Ambal" is an essential feature of the trade marks. The common "Sri" is the subsidiary part, of the two words "Ambal" is the more distinctive and fixes itself in the recollection of an average buyer with imperfect recollection.

6. The vital question in issue is whether, if the appellant's mark is used in a normal and fair manner in connection with the snuff and if similarly fair and normal user is assumed of the

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<sup>56</sup> (1969) 2 SCC 131



existing registered marks, will there be such a likelihood of deception that the mark ought not to be allowed to be registered (see *In the matter of Broadhead's Application for registration of a trade mark*<sup>57</sup>). It is for the court to decide the question on a comparison of the competing marks as a whole and their distinctive and essential features. We have no doubt in our mind that if the proposed mark is used in a normal and fair manner the mark would come to be known by its distinguishing feature "Andal". There is a striking similarity and affinity of sound between the words "Andal" and "Ambal". Giving due weight to the judgment of the Registrar and bearing in mind the conclusions of the learned Single Judge and the Divisional Bench, we are satisfied that there is a real danger of confusion between the two marks.

7. There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye. There is a close affinity of sound between Ambal and Andal.

8. In the case of *Coca-Cola Co. of Canada v. Pepsi Cola Co. of Canada Ltd.*<sup>58</sup>, it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that anyone would confuse the word Pepsi with coca. In the present case the word "Sri" may be regarded as in common use. The distinguishing feature of the respondent's mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.

9. *The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device.* The case of *De Cordova & Ors. v. Vick Chemical Co.*<sup>59</sup> is instructive. From the appendix printed at page 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The appendix at p. 226 - shows that the defendants advertised their ointment as 'Karsote vapour Rub'. It was held that the defendants had infringed the registered marks. Lord Radcliffe said: ". . . a mark is infringed by

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<sup>57</sup> (1950) 57 RPC 209, 214

<sup>58</sup> 1942 59 RPC 127

<sup>59</sup> 1951 68 RPC 103



another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features.”

10. Mr Sen stressed the point that the words Ambal and Andal had distinct meanings. Ambal is the consort of Lord Siva and Andal is the consort of Ranganatha. He said that in view of the distinct ideas conveyed by the two words a mere accidental phonetic resemblance could not lead to confusion. In this connection he relied on Venkateswaran Law of Trade and Merchandise Marks, 1963 Ed., p. 214, Kerly Law of Trade marks and Trade Names, 9th Edn., p. 465, Article 852 and the decision *Application by Thomas A. Smith Ltd.*<sup>60</sup>, to Register a trade mark. In that case Neville, J., held that the words “limit” and “summit” were words in common use, each conveying a distinctly definite idea; that there was no possibility of any one being deceived by the two marks; and there was no ground for refusing registration. Mr Sen's argument loses sight of the realities of the case. The Hindus in the south of India may be well aware that the words Ambal and Andal represent the names of two distinct Goddesses. But the respondent's customers are not confined to Hindus alone. Many of their customers are Christians, Parsees, Muslims and persons of other religious denominations. Moreover, their business is not confined to south of India. The customers who are not Hindus or who do not belong to the south of India may not know the difference between the words Andal and Ambal. The words have no direct reference to the character and quality of snuff. The customers who use the respondent's goods will have a recollection that they are known by the word Ambal. They may also have a vague recollection of the portrait of a benign goddess used in connection with the mark. They are not likely to remember the fine distinctions between a Vaishnavite goddess and a Shivaite deity.

11. We think the judgment appealed from is right and should be affirmed. We are informed that the appellant filed another Application No. 212575 seeking registration of labels of which the expression “Radha's Sri Andal Madras Snuff” forms a part. The learned Registrar has disposed of the application in favour of the appellant. But we understand that an appeal is pending in the High Court. It was argued that there was no phonetic similarity between Sri Ambal and Radha's Sri Andal and the use of the expression Radha's Sri Andal was not likely to lead to confusion. The Divisional Bench found force in this argument. But as the matter is *sub-judice* we express no opinion on it.”

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<sup>60</sup> 1913 30 RPC 363





**34.11.3.4** Thus, where the competing marks are device marks but the prominent feature of the device marks in each case is a word, and the words themselves are phonetically, confusingly and deceptively similar to each other, the Court would return a finding of deceptive similarity even if the two device marks, viewed as complete marks, are totally dissimilar. This decision therefore, completely negates Mr. Lall's argument that there is no deceptive similarity in the present case as, comparing device mark to device mark, the ARTISTRY device mark of the defendant is not similar to the ARTIZE mark of the plaintiff. Inasmuch as the word ARTISTRY in one case and the word ARTIZE in the other constitutes the main feature of both the marks, the comparison has to be between ARTISTRY as a word and ARTIZE as a word even if they are used as device marks.

#### **34.11.4** Phonetic similarity

**34.11.4.1** Mr. Wadhwa's contention is that ARTISTRY is phonetically similar to ARTIZE. Mr. Lall contends otherwise.

**34.11.4.2** Phonetic similarity, for the purpose of trade mark infringement has, classically, to be assessed by applying the *Pianotist* test. The Court is required to consider both the marks as whole marks keeping in mind the surrounding circumstances and the consumer base to which the goods cater. Mr. Lall sought to contend that the rival marks are used for luxury sanitary fittings, which are not items of everyday purchase but are intended to be purchased once. He submits



that they cater to a niche and discerning class of consumer who would be aware of the distinction between ARTIZE and ARTISTRY.

**34.11.4.3** At this *prima facie* stage, I have, with me, precious little to accept this contention. The question of whether the consumers who purchased the plaintiff's and defendant's products are so discerning as to be able to distinguish between ARTIZE and ARTISTRY, especially when both are packed in packages bearing a similar indigo and gold colour combination, is at the least highly arguable. It may require evidence. It cannot, in any case, be a predominant consideration for this Court, while examining the deceptive similarity between the marks.

**34.11.4.4** It is important to realise, in this context, that, from the time of *Kaviraj Pandit Durga Dutt Sharma* and *Amritdhara Pharmacy*, that the aspect of likelihood of confusion between rival marks for assessing the existence or otherwise of infringement has to be examined from the perspective of a consumer of average intelligence and imperfect recollection. The words used are important, and have to be accorded their due significance. The consumer's intelligence is *average* and, more importantly, his recollection is *imperfect*. He does not have a photographic memory nor is he intended to be a consumer who is overly familiar with one mark or the other. The classical test to be applied is to view the issue from the perspective of a consumer of average intelligence and imperfect recollection, who comes across the plaintiff's mark at one point of time and at a later point of time, chances on the defendant's mark. The



Court is not to compare the marks by placing them side-by-side. If a consumer who thus chances on the defendant's mark after having seen the plaintiff's mark in an earlier point of time, places proverbial hand on proverbial chin and wonders whether he has seen the same mark or a mark associated with it earlier, that suffices to constitute deceptive similarity. The matter has to be examined from the point of view of initial interest confusion. If, at an initial glance at the defendant's mark, the consumer of average intelligence and imperfect recollection is placed in a state of wonderment as to whether the mark is not the same as the plaintiff's mark, which he has earlier seen, or there is no association between the two marks, deceptive similarity is established. The standard is low rather than high.

**34.11.4.5** There is no reason not to apply this principle to the aspect of phonetic similarity as well. In other words, when examining whether the mark ARTISTRY is phonetically similar to ARTIZE, the Court is not to superficially test whether they sound the same, but to assess whether there is no likelihood of an average consumer of *imperfect recollection*, who chances on the mark ARTIZE at one point of time and, at a later point, comes across the mark ARTISTRY, wondering, even if only initially and briefly, whether he has not heard of, or seen, the mark earlier. If the sound of the words is similar enough to make him so wonder, there is deceptive phonetic similarity.

**34.11.4.6** The submission of Mr. Lall that the word ARTIZE is a word of common English usage cannot be accepted; there are few, if any, dictionaries in which it is to be found, and I, personally, have



never heard the word being used prior to the commencement of the hearing of this case. The New Oxford Dictionary, to which Mr Wadhwa referred, does not contain the word. The online Oxford English Dictionary, on the webpage [https://www.oed.com/dictionary/artize\\_v?tl=true](https://www.oed.com/dictionary/artize_v?tl=true), states that the word is obsolete, and was last recorded “around the early 1600s”. It appears to have been used by John Florio, author and teacher of languages, in 1598. With all due respect to Mr. Lall’s submission, I, certainly, have never earlier come across the word “artize”, and I doubt whether the consumer of average intelligence would have, either.

**34.11.4.7** Not being a word of common English usage, therefore, “artize” may be pronounced either as “ar-ti-ze” or “ar-ti-z”, in the latter case without specifically intoning the final “-e” vowel sound. If pronounced “ar-ti-ze”, the phonetic difference between “artize” and “artistry” would be reduced to the “tr” consonant sound alone, which can hardly be regarded as sufficient to mitigate the possibility of phonetic confusion between the words, especially where the average consumer would probably never have heard, earlier, the word “artize”, before coming across it on the plaintiff’s products.

**34.11.4.8** Viewed thus, it appears, *prima facie*, to me that the phonetic similarity between the ARTIZE and ARTISTRY is sufficient to cause a consumer, who chances upon the defendant’s ARTISTRY mark used on the defendant’s package, after having seen the plaintiff’s ARTIZE mark on the plaintiff’s package some time earlier, to at least



momentarily wonder whether he had not seen it earlier, or whether the two marks are not associated.

**34.11.5** There is, therefore, in my view, *prima facie* deceptive similarity between the marks ARTIZE and ARTISTRY, at least phonetically.

**34.11.6** Insofar as the marks TIAARA and TIARA are concerned, they are phonetically identical. Unless one decides to sing out the words, there is no dissimilarity whatsoever between TIAARA and TIARA. Both would be pronounced “Ti-aa-ra”.

**34.11.7** In the case of TIARA and TIAARA, therefore, there is phonetic identity, not just phonetic similarity, between them.

**34.11.8** Re. the argument that TIARA is not used as a trade mark

**34.11.8.1** Mr. Lall did seek to contend, no doubt, that the defendant was using the mark TIARA not as a trademark but merely as a model number or product category and cannot, therefore, be regarded as infringing the plaintiff’s TIAARA.

**34.11.8.2** The argument is fundamentally misconceived.

**34.11.8.3** Section 2(2)(c)(i)<sup>61</sup> defines the concept of use of a mark by clarifying that in the Trade Marks Act, any reference to the use of a

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<sup>61</sup> (2) In this Act, unless the context otherwise requires, any reference –



mark is to be construed as a reference to the use of the mark upon or in any physical or in any other relation *whatsoever* to the goods.

**34.11.8.4** “Mark”, in its turn, is defined in Section 2(1)(m) as including “a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colours or any combination thereof”.

**34.11.8.5** By this reckoning, TIARA as used by the defendant is definitely used as a mark.

**34.11.9** The test of deceptive similarity is therefore satisfied both in the case of ARTISTRY mark of the defendant *vis-a-vis* the ARTIZE mark of the plaintiff as well as in the case of TIARA mark of the defendant *vis-a-vis* TIAARA of the plaintiff.

**34.12** Adverting, now, to the individual Section 29(1) and 29(2)(b).

**34.13** All ingredients of Section 29(1) are satisfied as the plaintiff’s trademarks ARTIZE and TIAARA are registered; the defendant was using the impugned ARTISTRY and TIARA in the course of trade; the mark ARTISTRY is deceptively similar to the mark ARTIZE; the mark TIARA is nearly identical to the mark TIAARA; and the defendant is using the impugned ARTISTRY and TIARA marks as trade marks.

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- (c) to the use of a mark,—  
(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;



**34.14** Section 29(2)(b) is also *prima facie* satisfied in the present case as:

- (i) the marks ARTISTRY and TIARA are similar to the ARTIZE and TIAARA marks of the plaintiff,
- (ii) both marks are used for and in connection with identical goods and
- (iii) by reason of these circumstances, there is clear likelihood of confusion on the part of the public or of the public presuming an association between the marks.

### **34.15 *Munday* and *Slazenger***

**34.15.1** Where the infringement, by the defendant, of the plaintiff's registered trade marks is found to be egregious in nature, Courts in this country have routinely applied the exordiums of Kekewich J in *Munday v. Carey*<sup>62</sup> and Lindley LJ in *Slazenger & Sons v. Feltham & Co.*<sup>63</sup>.

**34.15.2** Lindley, LJ, observed, in *Slazenger*:

"One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?"

**34.15.3** Kekewich, J. spoke thus, in *Munday*:

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<sup>62</sup> (1905) RPC 273

<sup>63</sup> (1889) 6 RPC 531





"Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity."

**34.15.4** The facts of the present case justify, *prima facie*, invocation of these principles. The material placed on record, including the sales figures of the sanitary fittings sold by the plaintiff under its ARTIZE and TIAARA brands, testify to its goodwill and reputation. The defendant is a later entrant in the same market, and does not dispute the plaintiff's assertion that it was aware, at the time of adopting the impugned marks, of the reputation of the marks of the plaintiff. The adoption, by the defendant, of the mark TIARA, even if it is to be assumed to denote a product range, alongside the pre-existing TIAARA range of the plaintiff for the same goods, viz. taps, is, *prima facie*, too unnerving a coincidence. Coupled with this, the adoption of the mark ARTISTRY, in the foreknowledge of the existence of the plaintiff's ARTIZE range for similar goods, lends *prima facie* credence to Mr Wadhwa's submission that there was a conscious attempt, on the defendant's part, to adopt marks which would be confusingly similar to the marks of the plaintiff.

**34.15.5** The fact that the defendant was, for its product, earlier using the mark "Ashirvad by Aliaxis" and adopted "ARTISTRY" after the plaintiff's ARTIZE mark had gained repute, also indicates, *prima facie*, that there was a conscious attempt to ride on the plaintiff's reputation.



**34.15.6** In such a case, adopting the *Slazenger* and *Munday* tests, the court is, firstly, to presume that the attempt to confuse is successful rather than unsuccessful, and, secondly, to prioritize, while comparing the marks, similarities in features, over dissimilarities.

**34.15.7** This, too, therefore, indicates, on the defendant's part, an act of conscious infringement of the plaintiff's registered trade marks.

**34.16** Additionally, as Mr. Wadhwa correctly submits, the rival marks are deceptively similar to each other, they are used in respect of similar goods which are available and advertised through similar outlets and cater to the same consumer segment. These three factors are conjointly referred to as the triple identity test, and the co-existence of all the three in a particular case *prima facie* indicates the existence of infringement.

**34.17** A *prima facie* case of infringement, within the meaning of Section 29(2)(b) as well as Section 29(1) of the Trade Marks Act, therefore, exists.

## **35. Passing off**

**35.1** Though, once infringement is found to exist, and subject to the defences raised by Mr. Lall, the plaintiff would be entitled to interlocutory injunction, it is necessary, for the sake of completion, to refer to the plea of passing off raised by Mr. Wadhwa as well. The



distinction between infringement and passing off is tellingly drawn in the following passage from *Kaviraj Pandit Durga Dutt Sharma*:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. *The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or*



otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, *if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.*

(Emphasis supplied)

**35.2** Thus, while added features are of importance in examining a plea of passing off, they play no part while examining infringement.

**35.3** Mere intent to pass off its goods as the goods of the plaintiff does not, *ipso facto*, result in commission of the tort of passing off. If, despite a transparent intent on the defendant's part to confuse the consumers by adopting a mark similar to the plaintiff is found to exist, there are, in the defendant's product as it is presented to the consumer, sufficient features which would mitigate the possibility of consumer confusion, the defendant cannot be said to have passed off its goods as those of the plaintiff. On the other hand, even if there is no intent to pass off its products as those of the plaintiff, if the adoption of an infringing mark, or other features similar to those used by the plaintiff, results in the consumer becoming likely to purchase the defendant's goods believing them to be those of the plaintiff, the tort of passing off *ipso facto* stands committed, even if there was no deliberate intent on the defendant's part. Passing off, though classically a tort of deceit, has, as a jurisprudential concept, evolved over time, to a point where



proof of deceitful intent is not a *sine qua non* for establishing passing off.

**35.4** There is, therefore, substance in Mr. Lall's contention that, the fact that the packs of the defendant's product refer to the defendant's brand name and also uses the suffix "by Ashirvad" and the appearances of the containers are also not identical, it cannot be said, *prima facie*, that, by using the impugned marks, the defendant has *succeeded* in passing off its products as those of the plaintiff. The standard to establish, to make out a case of passing off, is much higher than in the case of infringement. Besides, the question of whether the use of the impugned mark by the defendant is likely to result in consumers purchasing the defendant's product mistaking it to be plaintiff's, which is what is required for passing off to be found to exist, is essentially a matter for trial, except in the most blatant of cases.

**35.5** I am not, therefore, inclined to hold at this *prima facie* stage that Mr. Wadhwa has succeeded in making out a case of passing off against the defendant.

### **36. Challenge to validity of the plaintiff's mark**

**36.1** Once infringement is found to exist, Section 28(1) entitles the plaintiff to relief against infringement subject, however, to the registration of the plaintiff's mark being valid. Section 31(1)<sup>64</sup>,

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<sup>64</sup> 31. Registration to be *prima facie* evidence of validity. –



however, proclaims that the very fact of registration of a trade mark *shall be prima facie evidence of* its validity so as to be *prima facie* proof of the validity of the registered mark. At a *prima facie* stage, therefore, it is enough for the plaintiff to show that its mark is registered, to discharge an initial onus of *prima facie* validity caused on him. The initial onus is, therefore, on the defendant, to establish that the plaintiff's trade mark, though registered, is invalid.

**36.2** No attempt, whatsoever, has been made by the defendant to disturb, much less dislodge, the presumption of validity of the registered ARTIZE and TIAARA marks of the plaintiff, conferred by Section 31(1) of the Trade Marks Act.

**36.3** The circumstances in which registration of a trade mark can be refused are contained in Sections 9 and 11 of the Trade Marks Act. Section 9 sets out absolute grounds, and Section 11 sets out relative grounds, for refusal to reject the mark. Without burdening this judgment with the specific circumstances that Sections 9 and 11 envisage, in which registration of a trade mark can be refused, suffice it to state that none of them has been shown to exist in the present case, insofar as the plaintiff's ARTIZE and TIAARA marks are concerned.

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(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.



**36.4** By operation of Section 31(1) of the Trade Marks Act, therefore, the registrations of the ARTIZE and TIAARA marks of the plaintiff are *prima facie* valid.

**37.** The sequitur

The sequitur is that, as the sole additional condition of which Section 28(1) of the Trade Marks Act requires satisfaction for relief against infringement to be available, viz. the validity of the plaintiff's trade mark, being *prima facie* satisfied, the plaintiff would be entitled, as of right, to relief against infringement of its registered ARTIZE and TIAARA trade marks by the defendant.

**38.** The "ART monopolization" argument – Section 17(2)(b)

**38.1** A substantial segment of the submission of Mr. Lall, both at the Bar as well as in his written submissions, revolves around the presumption that the plaintiff is claiming a monopoly over the prefix ART, which is commonly used in the sanitary fittings trade, and the consequent submission that, as the ART prefix is descriptive of the nature of the goods in respect of which the mark containing the prefix is used, the prefix cannot be monopolized. Reference has also been invited to several registered marks used for sanitary fittings, commencing with "ART".

**38.2** The submission is, on the face of it, misconceived. The plaintiff is not seeking to injunct the use of ART as a prefix either for sanitary





fittings or for any other goods or the services. Injunction is sought against the use of any mark which is deceptively similar to the mark ARTIZE. I have already found that, compared as whole marks, the mark ARTISTRY is deceptively similar to the mark ARTIZE. This finding is not based on the common “ART” part of the two marks. The entire argument of Mr. Lall, pivoted on the common “ART” part of the plaintiff’s and the defendant’s mark, therefore, is *prima facie* without substance.

**38.3** Section 17(2) of the Trade Marks Act, which Mr. Lall cites, in fact demonstrates the fallacy of his argument. Section 17(1) grants to the plaintiff, consequent on the registration of the ARTIZE and TIAARA marks, the right to exclusivity over the said marks, taken as whole marks. That is precisely what the plaintiff, in fact, asserts in this suit. Section 17(2) basically proscribes claiming of exclusivity over a *part* of a registered trade mark which is not *itself* separately registered as a trade mark, or which contains any matter which is common to the trade or is otherwise non-distinctive in character. The submission of Mr Lall is that, therefore, the plaintiff cannot claim exclusivity over the ART part of its mark, so as to injunct all others from using it, as the plaintiff neither has any independent registration for ART-, and ART-, as a prefix for sanitary ware, as it is both descriptive and common to the trade.

**38.4** As a proposition, Mr Lall’s submission is unexceptionable. The error lies, however, in the presumption that the plaintiff seeks to monopolize the ART prefix. There is, clearly, no such attempt on the



plaintiff's part. Neither do the prayers in the suit seek any such relief, nor is it Mr Wadhwa's submission at the Bar that there must be an injunction against the use of ART as a prefix, or even a part, of any trade mark, whether for sanitary ware or otherwise.

**38.5** Mr Lall, therefore, is seeking to contest a case which the plaintiff does not seek to set up.

**38.6** The plaintiff is seeking exclusivity, not over the ART prefix, but over the marks ARTIZE and TIAARA, specifically vis-à-vis the defendant's ARTISTRY and TIARA marks. On that, I have already found the plaintiff to be entitled to relief.

### **39. Permissible copying**

**39.1** Mr. Lall sought to submit that copying, *per se*, was not actionable, and make copious reference, in that context, to McCarthy. The proposition does not brook cavil. As with any other misdemeanour – like, to cite the simplest of examples, telling a lie – the misdemeanour becomes an actionable wrong only when it transgresses the law. Telling a lie may be immoral, even reprehensible, but it does not give rise to a remedy in law unless the lie *transgresses* the law as, for example, in the case of perjury. Equally, copying, short of passing off or infringement, is not actionable. I do not find myself in agreement with all that McCarthy says on the advantages of legitimate copying, but I agree with Mr Lall that copying, *per se*, is not actionable in law.



**39.2** The submission does not, however, merit further comment as I have already found that the defendant has, by using the impugned ARTISTRY and TIARA marks, infringed the plaintiff's registered ARTIZE and TIAARA marks. The case is not, therefore, one of plain copying, but of copying in a manner which results in the likelihood of a consumer of average intelligence and imperfect recollection being confused between the marks. Ergo, the defendant must be enjoined.

#### **40. The plea of estoppel**

**40.1** Mr. Lall also sought to submit that, having responded to the FER issued by the Trade Marks Registry objecting to its application for registration of the ARTIZE mark on the ground that there was already, in existence, the mark ARTIC, that the two marks were dissimilar, the plaintiff was estopped from contending that ARTISTRY was deceptively similar to ARTIZE.

**40.2** Para 43 of the decision in *Raman Kwatra v. KEI Industries*<sup>65</sup>, rendered by a Division Bench of this Court, is a complete answer to the submission:

“43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of *Telecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd.*<sup>66</sup> holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be

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<sup>65</sup> 296 (2023) DLT 529 (DB)

<sup>66</sup> 262 (2019) DLT 101



relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. *A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar.* It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.”

(Emphasis supplied)

The plea of estoppel, therefore, applies only where the plaintiff has, in response to an objection raised on the basis of *the impugned mark of the defendant*, sought to contend that the asserted mark of the plaintiff is not similar to *the impugned mark of the defendant*. It is then only that the principle of approbate and reprobate would apply against the plaintiff.

**40.3** The defendant’s ARTISTRY and TIARA marks having never been cited against the plaintiff by the Trade Marks Registry, the plea of estoppel has necessarily to be rejected.

#### **41. The interlocutory troika**

**41.1** Interim injunction can be granted, under Order XXXIX Rules 1 and 2 of the CPC, only if there is cumulative satisfaction of the three conditions, of existence of a *prima facie* case in favour of the plaintiff, the balance of convenience being in favour of grant of such injunction, and the likelihood of irreparable loss resulting to the plaintiff were injunction not to be granted.



**41.2** All three conditions are satisfied in the present case.

**41.3** I have already found a *prima facie* case of infringement, by the defendant, of the plaintiff's registered ARTIZE and TIAARA marks, to exist.

**41.4** In *Midas Hygiene Industries v. Sudhir Bhatia*<sup>67</sup>, the Supreme Court has held:

“5. *The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.*”

(Emphasis supplied)

The very establishment of a *prima facie* case of infringement, therefore, normally requires grant of an injunction against continuance of the tort. That, in fact, is also the statutory imperative contained in Section 28(1) of the Trade Marks Act.

**41.5** Deference to the declaration of the law, as contained in para 5 of *Midas Hygiene Industries*, would, in my view, require the court to presume the satisfaction of the balance of convenience and irreparable loss requirements, once infringement is found to exist. Else, it would amount to reading, into the imperative words contained in the opening sentence in para 5 of the report, a caveat requiring, additionally, independent satisfaction of the balance of convenience and irreparable loss criteria.

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<sup>67</sup> (2004) 3 SCC 90






**41.6** Even if it were to be so, these criteria, too, stand satisfied in the present case. Failure to grant interim injunction would result in permitting continued infringement, by the defendant, of the plaintiff's registered trade marks and resultant denial, to the plaintiff, of the right statutorily conferred on it by Section 28(1) of the Trade Marks Act. The plaintiff would have to suffer continuous and uninterrupted violation of its intellectual property right, conferred by statute, till the suit is decided. It cannot be said that the jeopardizing of the intellectual property right of the plaintiff, and resultant erosion of the brand value of the plaintiff's products and plaintiff's marks, can be adequately quantified and compensated by money. Irreparable loss would, therefore, of necessity result to the plaintiff, were interim injunction, as sought, to be refused by the court.

**41.7** Grant of injunction would, on the other hand, only result in the defendant not being permitted to use the impugned ARTISTRY and TIARA marks. There is no permanent, or even recurring, loss to the defendant's business *per se*. Besides, as the marks are *prima facie* infringing, the defendant cannot claim any legitimate business interest in being continued to be allowed to use them, to the prejudice of the plaintiff's intellectual property rights. The balance of convenience would also, therefore, be in favour of grant, rather than refusal, of interim injunction as sought by the plaintiff.

## **Conclusion**



42. The plaintiff is, therefore, entitled to interim injunction as sought.

43. The defendant, as well as all others acting on its behalf shall, therefore, stand restrained, pending disposal of the present suit, from using, in any manner whatsoever, the impugned ,  and  marks, the word mark ARTISTRY, and the mark TIARA, as also any other similar device or word mark or logo which is confusingly or deceptively similar to the plaintiff's registered trade marks, in respect of the goods, in respect of which the marks are used by the plaintiff or for any other allied or cognate goods or services.

44. The defendant shall also ensure that the impugned marks are removed from all physical and virtual locations within the defendant's control, as well as from all websites, e-commerce platforms and social media pages. The defendant shall also communicate, forthwith, with any e-commerce platform or other website over or through which the goods bearing the impugned marks are sold, to remove the goods from said platforms and websites.

45. IA 18638/2023 stands allowed accordingly.

**C. HARI SHANKAR, J.**

**APRIL 1, 2024**

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