



\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**  
% ***Judgment Reserved on: 30.05.2025***  
***Judgment pronounced on: 20.08.2025***  
+ **CS(COMM) 85/2018 & CRL.M.A. 4189/2020**

VIKRANT CHEMICO INDUSTRIES PVT LTD .....Plaintiff  
Through: Mr. Saikrishna Rajagopal, Mr. Nitin  
Sharma, Mr. Sohrab Mann,  
Ms. Deepika Pokharia and  
Mr. Abhinav Bhalla, Advocates

versus

SHRI GOPAL ENGINEERING AND  
CHEMICAL WORKS PVT LTD & ORS .....Defendants  
Through: Mr. Peeyoosh Kalra and  
Mr. Yashwant Singh Baghel,  
Advocates

**CORAM:**  
**HON'BLE MR. JUSTICE AMIT BANSAL**

**AMIT BANSAL, J.**

1. By way of the present judgment, I shall decide the suit captioned above.
2. The present suit has been filed seeking the relief of permanent injunction restraining the defendants from infringement of trademark, copyright and passing off along with other ancillary reliefs.

**CASE SET UP IN THE PLAINT**

3. The case set up in the plaint is as follows:
  - 3.1 In 1963, Mr. J.B. Gupta adopted the mark 'DOCTOR BRAND PHENYLE'.



3.2 The plaintiff company, Vikrant Chemico Industries Pvt. Ltd., was incorporated in the year 1972 and is engaged in the business of personal care products, toiletries, pharmaceuticals and chemicals. The plaintiff operates through its head office located in Kanpur, Uttar Pradesh.

3.3 In 1973, Mr. J.B. Gupta was appointed as a director of the plaintiff company. Plaintiff's Managing Director, Mr. J.B. Gupta had two sons – the younger son, Mr. R.K. Gupta is one of the directors of the plaintiff company, and the elder son, Mr. G.K. Gupta is the defendant no.2 herein.

3.4 It is averred in the plaint that in the same year 1973, the trademark 'DOCTOR BRAND GERM TROLL' was adopted by the plaintiff company, which has been used since then for perfumed cleaners.

3.5 In the year 1975, a partnership firm, M/s Shri Gopal Engineering and Chemical Works, was formed in the name of two partners viz., Mr. J.B. Gupta and Mr. G.K. Gupta (defendant no.2).

3.6 In the year 1979, the defendant no.2, Mr. G.K. Gupta, was appointed as a director of the plaintiff company.

3.7 In April, 1981, Mr. R.K. Gupta, also joined the partnership firm, M/s Shri Gopal Engineering and Chemical Works and a partnership deed was signed by three partners, namely Mr. J.B. Gupta and Mr. R.K. Gupta along with the defendant no.2, Mr. G.K. Gupta.

3.8 The said partnership firm applied for and obtained registration for the trademark 'DOCTOR BRAND PHENYLE' (device) bearing application number 445392 in class 5 with effect from 8<sup>th</sup> November 1985.

3.9 In the same year 1985, Mr. R.K. Gupta was appointed to the Board of Directors of the plaintiff company.

3.10 The plaintiff company obtained registration for the word mark



‘CHEMIST’ bearing registration no. 464944 under class 5, with effect from 22<sup>nd</sup> December 1986.

3.11 On 1<sup>st</sup> July 1994, the defendant no.1 company was formed and the plaintiff’s current directors as well as defendants no.2 and 3 were appointed to the Board of Directors of the defendant no.1 company.

3.12 On 18<sup>th</sup> November 1996, the partnership firm signed an assignment deed transferring complete title, registration and goodwill in the ‘DOCTOR BRAND PHENYLE’ trademark/label to the plaintiff company. Thereafter, in 1997, the defendants no.2 and 3 resigned from the board of directors of the plaintiff company.

3.13 On 3<sup>rd</sup> June 1999, the plaintiff company also acquired a copyright registration in respect of the label of ‘DOCTOR BRAND PHENYLE’ *vide* registration no. A56172/99.

3.14 On 1<sup>st</sup> February 2000, the plaintiff company acting through Mr. J.B. Gupta assigned the trademark registration pertaining to the ‘CHEMIST’ mark to the defendant no.1 company.

3.15 At present, under the mark ‘DOCTOR BRAND’, the plaintiff is selling its ‘DOCTOR BRAND PHENYLE’ and ‘DOCTOR BRAND GERM TROLL’ products as well as other products like acid cleaners, window cleaners, naphthalene balls and floor cleaners.

3.16 The plaintiff has filed a C.A. certificate along with the plaint to substantiate its sales figures from the financial year 2009-2010 to 2016-2017. In the financial year 2016-2017, the sales turnover generated by the plaintiff under the mark ‘DOCTOR BRAND PHENYLE’ was to the tune of Rs. 9,95,98,963.

3.17 Disputes arose between the parties in the month of March-July 2015,



when the plaintiff came across phenyl products bearing the marks ‘DOCTOR HAZEL'S BRAND PHENYL’ and ‘CHEMIST BRAND GERM TROLL’.

3.18 Accordingly, the present suit was filed on 25<sup>th</sup> August 2015 seeking the following reliefs:

*“(i) An order and decree for permanent mandatory injunction restraining the Defendants, their officers, servants, agents, partners and all persons, firms, corporations and associations in active concert or participation with the Defendants from, manufacturing, offering / stocking for sale, selling, marketing, advertising, distributing, printing, supplying and otherwise dealing, directly or indirectly in any manner with phenyl or any other goods, under the mark DOCTOR HAZEL'S BRAND PHENYLE, or any other deceptive variant of the Plaintiff's registered label "DOCTOR BRAND PHENYLE", amounting to infringement of the Plaintiff's trademarks as detailed hereinbefore;*

*(ii) An order and decree for permanent mandatory injunction restraining the Defendants, their officers, servants, agents, partners and all persons, firms, corporations and associations in active concert or participation with the Defendants from, manufacturing, offering / stocking for sale, selling, marketing, advertising, distributing, printing, supplying and otherwise dealing, directly or indirectly in any manner with phenyl or any other goods with or without a trade dress that is deceptively similar to the Plaintiff's "DOCTOR BRAND PHENYLE" mark/trade dress, thereby amounting to passing off their goods as those of the Plaintiff's or in any way which suggests a connection or association with the Plaintiff;*

*(iii) An order and decree for permanent mandatory injunction restraining the Defendants, their officers, servants, agents, partners and all persons, firms, corporations and associations in active concert or participation with the Defendants from, manufacturing, offering / stocking for sale, selling, marketing, advertising, distributing, printing, supplying and otherwise dealing, directly or indirectly in any manner with any other goods with or without a trade dress that is deceptively similar to the Plaintiff's "DOCTOR BRAND GERM-TROLL" word mark and/or trade dress, thereby amounting to passing off their goods as those of the Plaintiff's or in any way which suggests a connection or association with the Plaintiff;*



(iv) *An order and decree for permanent injunction restraining the Defendants, their officers, servants, agents, partners and all persons, firms, corporations and associations in active concert or participation with the Defendants from, manufacturing, offering / stocking for sale, selling, marketing, advertising, distributing, printing, supplying and otherwise dealing, directly or indirectly in any manner with phenyl or any other goods which reproduces the Plaintiff's copyright protected packaging artwork for the DOCTOR BRAND PHENYLE product thereby infringing the Plaintiff's copyright in its artistic works;*

(v) *An order and decree for permanent injunction restraining the Defendants, their officers, servants, agents, partners and all persons, firms, corporations and associations in active concert or participation with the Defendants from, manufacturing, offering / stocking for sale, selling, marketing, advertising, distributing, printing, supplying and otherwise dealing, directly or indirectly in any manner with phenyl or any other goods which reproduces the Plaintiff's copyrighted packaging artwork for the DOCTOR BRAND GERM-TROLL product thereby infringing the Plaintiff's copyright in its artistic works;*

(vi) *An order for rendition of accounts of profits, directly or indirectly earned by the Defendant from its infringing activities and wrongful conduct and a decree for the amount so found due to be passed in favour of the Plaintiff's;*

(vii) *An order for delivery up by the Defendant of all finished and unfinished goods, materials, advertising material, blocks, dies etc. bearing the marks /label/trade dress which is in likenesses of the Plaintiff's trademarks/label/trade dress or any other mark identical with or deceptively similar to that of the Plaintiff's, or any other material infringing the trademarks of the Plaintiff, lying in the possession of the Defendant and its principal officers, directors, agents, franchisees, servants etc.;*

(viii) *A sum of Rs. 20,00,200/- for a decree of damages as valued for the purposes of this suit in the preceding paragraph for the purposes of loss of sales, reputation and goodwill of the Plaintiff's trade mark caused by the activities of the Defendant;*

(ix) *An order as to the costs of the proceedings”*



#### **CASE SET UP IN THE WRITTEN STATEMENT OF THE DEFENDANTS**

4. Written statement was filed on behalf of the defendants raising the issue of territorial jurisdiction as well as other defenses on merits.

4.1. The mark 'DOCTOR BRAND GERM TROLL' was adopted in 1983 by the partnership firm, M/s Shri Gopal Engineering and Chemical Works.

4.2. Since 2000, the defendant no.1 company has been selling its phenyle products under the trademark 'CHEMIST BRAND PHENYLE' in a particular packaging/label/color scheme.

4.3. The registered word mark 'DOCTOR HAZEL'S' bearing registration no. 1221775 in class 5 was assigned by one Mr. M. M. Wadhera, trading as Western Electronics in favour of the defendant no.1 company *vide* assignment deed dated 29<sup>th</sup> November 2014. The certified copy of the assignment deed dated 29<sup>th</sup> November 2014 has been exhibited as **Exhibit DW2/19**. Upon acquiring the said trademark, the defendant no.1 was recorded as subsequent proprietor of the trademark 'DOCTOR HAZEL'S' in class 5. The certified copy of TM-24 for recordal of assignment of trademark bearing registration no. 1221775 in class 5 in the name of defendant no.1 company has been exhibited as **Exhibit DW2/20**.

4.4. Keeping in view that the word 'DOCTOR' is generic and is already registered in favor of various entities in class 5 in respect of disinfectants etc., the Registrar of Trade Marks had imposed a condition on the defendant no.1 company's registration to disclaim the word 'DOCTOR' which makes 'HAZEL'S' to be the essential part of the defendant no.1 company's trademark.

4.5. On 19<sup>th</sup> December 2014, the defendant no.1 launched its products under the trademark 'DOCTOR HAZEL'S BRAND PHENYL' with identical



packaging/label/color scheme etc. as used for ‘CHEMIST BRAND PHENYLE’.

4.6. In its replication, the plaintiff has reaffirmed its assertions made in the plaint.

#### **PROCEEDINGS IN THE SUIT**

5. Summons in the suit were issued on 2<sup>nd</sup> September 2015.
6. *Vide* order dated 2<sup>nd</sup> September 2015, this Court granted an *ex parte ad* interim injunction against the defendants restraining them from using the trademarks ‘DOCTOR HAZEL'S BRAND PHENYL’ and ‘CHEMIST BRAND GERM TROLL’. In the same order, a Local Commissioner was appointed to visit the premises of the defendants in Kanpur, Uttar Pradesh.
7. *Vide* order dated 18<sup>th</sup> November 2015, the parties were referred to mediation before the Delhi High Court Mediation and Conciliation centre, however, it did not bear fruit.
8. On 5<sup>th</sup> August 2016, the Court appointed a Local Commissioner to visit Bhopal, Madhya Pradesh where the defendants were allegedly selling the infringing goods.
9. On 25<sup>th</sup> August 2017, while hearing I.A. 9676/2017 filed under Order XXXIX Rule 2A of the Code of Civil Procedure, 1908 (hereinafter, ‘CPC’), this Court appointed a Local Commissioner to visit the two shops in Delhi as well as few shops in the wholesale market in Khari Baoli, Chandani Chowk to check whether the infringing products are available for sale.
10. *Vide* order dated 24<sup>th</sup> January 2018, I.A. 2187/2016 filed under Order VII Rule 11 of CPC was dismissed with liberty to the parties to lead evidence on the issue of territorial jurisdiction. On the same date, the *ex parte ad* interim



injunction order was confirmed till the final disposal of the present suit with a clarification that the defendants would be at liberty to use the mark 'CHEMIST BRAND GERM TROLL'. Further, with the consent of the parties, CS(OS) 2584/2015 was converted into a commercial suit and the same was re-numbered as CS(COMM) 85/2018.

11. *Vide* order dated 9<sup>th</sup> July 2018, following are the issues framed in the present suit:

*"1. Whether the defendants have infringed the plaintiffs trademark, specifically the DOCTOR BRAND PHENYLE trademark? **OPP***

*2. Whether the defendants have infringed the copyright vesting in the labels/artistic work of the plaintiff, specifically the DOCTOR BRAND PHENYLE artistic work and the DOCTOR BRAND GERM TROLL artistic work? **OPP***

*3. Whether the defendants are passing off their goods as that of the plaintiff, specifically the DOCTOR BRAND PHENYLE and the DOCTOR BRAND GERM TROLL goods? **OPP***

*4. If the answers to issues nos. 1, 2 & 3 are in the affirmative, whether plaintiff is entitled to rendition of accounts from the defendants? **OPP***

*5. Whether the plaintiff is entitled to damages? **OPP***

*6. Whether the plaintiff is entitled to delivery up of infringing materials? **OPP***

*7. Whether the plaintiff is entitled to any further costs? **OPP***

*8. Whether this Hon'ble Court has the territorial jurisdiction to entertain the present suit? **OPP***

*9. Whether the suit is bad for mis-joinder for defendants? **OPD***

*10. Relief."*

12. The defendants preferred an appeal against the order dated 24<sup>th</sup> January 2018 passed by this Court, which was dismissed by the Division Bench *vide* judgment dated 3<sup>rd</sup> July 2018. The Division Bench upheld the view taken by





the Single Judge that the issue of territorial jurisdiction would be examined after the parties lead evidence and the interim injunction order shall be confirmed till the final disposal of the suit.

13. *Vide* order dated 8<sup>th</sup> February 2019, the Supreme Court stayed the operation of the Division Bench judgment dated 3<sup>rd</sup> July 2018 and requested this Court to dispose of the present suit within 6 months.

14. *Vide* order dated 28<sup>th</sup> November 2019, Mr. S.M. Chopra, Additional District Judge (Retd.) was appointed as a Local Commissioner to record evidence.

15. Following witnesses appeared on behalf of the plaintiff:

- i. Mr. Shrey Gupta, Son of Mr. R.K. Gupta
- ii. Mr. Sandeep Kumar Gupta

16. Following witnesses appeared on behalf of the defendants:

- i. Mr. Gopal Krishan Gupta, Director of defendant no.1
- ii. Mr. Prince Gupta, Son of Mr. G.K. Gupta

17. I have heard the submissions on behalf of the parties and examined the record of the suit.

18. My issue wise findings are as under:

**Issue no. 8 - Whether this Court has the territorial jurisdiction to entertain the present suit? OPP**

***Submissions of the plaintiff***

19. In support of its contention that this court has territorial jurisdiction to entertain the present suit, the plaintiff has relied on the following:

- i. The defendant no.1's website clearly states that the defendants have been selling their products in various states, including Delhi.
- ii. The defendant no.2 has admitted in his cross-examination that



the defendant no.1 company has been selling its products in various states, including Delhi.

iii. The defendant no.1's products are available for sale on e-commerce platform, [www.indiamart.com](http://www.indiamart.com).

iv. The name of Mr. Prince Gupta is mentioned in the contact details of defendant no.1's page on IndiaMart, which shows that he is actively involved in the functioning of the defendant no.1 company.

v. The Local Commissioner's report dated 11<sup>th</sup> September 2017 specifically records the statement of owners of Chawla General Store in Delhi stating that they had sold 2-3 bottles of 'DOCTOR HAZEL'S BRAND PHENYLE'.

vi. The defendant no.1 had filed trademark application for registration of 'DOCTOR HAZEL'S' mark in Delhi.

vii. The assignment deed dated 29<sup>th</sup> November 2014 through which the defendant no.1 acquired the mark 'DOCTOR HAZEL'S' was also executed in Delhi.

### ***Submissions of the defendants***

20. The defendants have rebutted the aforesaid submissions of the plaintiff in the following manner:

i. The defendant no.1's website only refers to the products selling under the brand 'CHEMIST', and not any other products of the defendants. In any event, the website of the defendant no.1 is a passive one and does not offer any online sale of products.

ii. The plaintiff has not given any details of the shops where the defendants were selling its products in Delhi.

iii. At the time of issuance of summons in the suit on 2<sup>nd</sup> September



2015, the plaintiff prayed for appointment of a Local Commissioner to visit the premises of the defendant no.1 at Kanpur and no request was made to visit any premises at Delhi.

iv. The reliance placed by the plaintiff on the report of the Local Commissioner dated 11<sup>th</sup> September 2017 is misplaced. Even otherwise, the plaintiff would have to establish jurisdiction when the suit was filed on 25<sup>th</sup> August 2015.

v. Defendant no.1 company has neither any distributor/dealer in Delhi, nor does it carry out business operations in Delhi. The plaintiff has also failed to produce any witness, either the shopkeepers or the investigators or any other independent witness to show that the goods of defendant no.1 were sold in Delhi.

vi. It is a settled position of law that filing of an application for registration of trademark in Delhi would not confer jurisdiction upon the Courts at Delhi. Reliance in this regard is placed on ***Dhodha House v. S.K. Maingi***, 2006 (9) SCC 41. If the filing of the application does not confer jurisdiction, the assignment thereof would also not constitute any cause of action at Delhi.

### ***Analysis***

21. It is an admitted position that both the plaintiff and defendants are based out of Kanpur, Uttar Pradesh, which is evident from the memo of parties filed along with the suit. From a reading of the plaint as well as the written submissions filed by the plaintiff, it is clear that plaintiff has invoked jurisdiction of this Court under Section 20(c) of CPC i.e. the cause of action, wholly or in part, arises within jurisdiction of this court.

22. To begin with, I will deal the issue with regard to sale of the defendants'



products in Delhi. The plaintiff has failed to produce any bills/invoices or any other evidence to substantiate its claim that the defendants' products bearing the impugned marks are being sold in Delhi.

23. The plaintiff submits that the defendant no.1's website itself claims that the defendants' goods are available all over India. The printout of the website of the defendant no.1 has been exhibited as **Exhibit PW1/11**. The relevant extracts of the defendant no.1's website on which the plaintiff places reliance has been reproduced below:

After running successfully in the state of U.P., M.P., Uttranchal, Chattisgarh, Haryana, Delhi, Punjab, Rajasthan, Bihar & Himachal Pradesh. Now CHEMIST brand is poised for major expansion programme to launch the products to all across the country and even to the International market.

24. The defendant no.1's website only refers to the products selling under the mark 'CHEMIST' and not the products selling under the impugned mark 'DOCTOR HAZEL'S BRAND PHENYLE'. This fact has also been confirmed during the cross examination of DW-2. The relevant extracts from the cross-examination of DW-2 are set out below:

*"Q68. On your website (www.shrigopal.com) a print out which is Exhibit PW1/11 (denied at the stage of admission denial) you have stated that your products are being marketed all across the country and internationally, is it correct?"*

*Ans. **This website pertains to only 'Chemist Brand products'. There is no website made for 'Doctor Hazel's Products'. We do not sell products all over India.***

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*Q103. Witness has been shown Ex. PW1/11. Has it been mentioned in your website that the Defendant No.1 Company selling their product in Delhi?*

*Ans. **Yes, for Chemist Brand.***

[Emphasis supplied]

25. In addition to this, the plaintiff has placed reliance on the Local Commissioner's report dated 28<sup>th</sup> September 2015, which records that Mr. Prince Gupta (defendant no.2's son) had claimed that the defendant no.1



company sells its products in all 29 states of India.

26. In my view, no reliance can be placed on the statement of Mr. Prince Gupta made to the Local Commissioner to claim territorial jurisdiction. The mandate of the Local Commissioner appointed *vide* order dated 2<sup>nd</sup> September 2015 was only to seize the offending goods and make inventory of the same and subsequently, handover the said goods to the defendants on *superdari* after sealing the same. The mandate of the Local Commissioner was not to question the representatives of the defendants and gather evidence. Hence, the plaintiff cannot claim that the cause of action has arisen in Delhi only on the basis of answers given by Mr. Prince Gupta to the Local Commissioner.

27. It is also the case of the plaintiff that the defendant no.1's website allows the customers to access the contact details of the defendants. Defendants contend that the defendant no.1's website is a passive website which does not allow the customers to place orders. In this context, a reference may be made to the judgment of the Division Bench of this Court in ***Banyan Tree Holding v. A Murali Krishna Reddy***, 2009 SCC OnLine Del 3780, wherein it was held that jurisdiction cannot be created on the basis of a passive website, which does not permit sale and purchase of products. Relevant paragraphs of the said judgment of the Division Bench are set out below:

*"45. This court holds that in order to prima facie establish that the Defendant purposefully availed of the jurisdiction of this court, the Plaintiff would have to show that the Defendant engaged in some commercial activity in the forum State by targeting its website specifically at customers within that State. This is consistent with the law laid down in *Cybersell* and reiterated later in *Toys R Us*. It is also consistent with the application of the 'tighter' version of the 'effects' test which is 'targeting'. In any action for passing off or infringement, it would have to be shown that the Defendant by using its mark intended to pass off its goods as that of the Plaintiffs. A mere hosting of a website which can*



be accessible from anyone from within the jurisdiction of the court is not sufficient for this purpose. Also a mere posting of an advertisement by the Defendant depicting its mark on a passive website which does not enable the Defendant to enter into any commercial transaction with the viewer in the forum state cannot satisfy the requirement of giving rise to a cause of action in the forum state. Even an interactive website, which is not shown to be specifically targeted at viewers in the forum state for commercial transactions, will not result in the court of the forum state having jurisdiction. In sum, for the purposes of Section 20(c) CPC, in order to show that some part of the cause of action has arisen in the forum state by the use of the internet by the Defendant, the Plaintiff will have to show prima facie that the said website, whether euphemistically termed as “passive plus” or “interactive” was specifically targeted at viewers in the forum state for commercial transactions. The Plaintiff would have to plead this and produce material to prima facie show that some commercial transaction using the website was entered into by the Defendant with a user of its website within the forum state and that the specific targeting of the forum state by the Defendant resulted in an injury or harm to the Plaintiff within the forum state. Question no. (ii) is answered accordingly.”

[Emphasis supplied]

28. A reference may also be made to the judgment of a Coordinate Bench in *Indovax v. Merck Animal Health*, 2017 SCC OnLine Del 9393, wherein relying upon *Banyan Tree Holding* (Supra), the plaint was rejected under Order VII Rule 11 of the CPC on the ground of territorial jurisdiction. The Court observed that, “*the plaintiff only states that the goods of the defendants are available for sale in Delhi but this averment is not supported by any documentary evidence*”.

29. Based on the material on record, it is evident that the website of the defendant no.1 is a passive website and mere accessibility of the said website within the jurisdiction of this Court would not amount to specific targeting of the customers in the Delhi. The plaintiff has failed to produce any evidence to



show that a commercial transaction was executed by the defendants through the said website.

30. As regards the contention of the plaintiff that the products of the defendants are available for sale on IndiaMart, which is accessible in Delhi, it is to be noted that the portal of IndiaMart is not a platform for sale and purchase of the products. Therefore, mere listing of defendants' products on the website of IndiaMart would not confer jurisdiction in this Court. The printout of the IndiaMart listing of the defendant no.1 company has been exhibited as **Exhibit DW2/P8**. In this regard, reference may be made to the judgment of this Bench in ***Kohinoor Seed Fields India Private Limited v. Veda Seed Sciences Private Limited***, 2025 SCC OnLine Del 2404, relevant extracts of which are as under:

*“ 42. In the present case, no averments have been made in the plaint, nor have any documents been filed along with the plaint fulfilling the aforesaid criteria laid down by the Division Bench. It is not the case of plaintiff that the defendant has a website for selling its own products. The listings on the e-commerce websites like, “India Mart” and “Kalgudi” have been put by the third-party sellers and not by the defendant. Therefore, even if the defendant's products are shown available on India Mart and Kalgudi, the defendant cannot be held responsible for the same.*

**43. Even though the plaintiff has pleaded that India Mart is a dynamic website that permits communication and placement of orders, there is neither any pleading nor any document produced to show that there has been any communication with the defendant or any order placed for the defendant's products in Delhi.”**

[Emphasis supplied]

31. In the present case as well, despite the IndiaMart listing, there is neither any pleading nor any document produced to show that there has been any communication with the defendants or any order was placed for the



defendants' products in Delhi through IndiaMart.

32. The plaintiff has relied upon cases filed against the defendant no.1 company by the Special Investigation Bureau, Sales Tax and Commercial Tax Department, Uttar Pradesh for selling products without tax invoices to claim that the defendant no.1 has been selling products in Delhi without issuing any invoices. The 'deemed assessment status report' of the defendant no.1 company for assessment years 2014-15 and 2015-16 have been exhibited as **Exhibit DW2/P9** and **Exhibit DW2/P10**. However, there is nothing to suggest from the said documents that the defendants' goods were being sold in Delhi.

33. The plaintiff has also placed reliance on the Local Commissioner's report dated 11th September 2017, wherein it is stated that one of the shopkeepers had sold 2-3 bottles bearing the mark 'DOCTOR HAZEL'S BRAND PHENYLE'. In this regard, the plaintiff has placed reliance on paragraph 4 of the said report, which is reproduced below:

*"4. I enquired whether they are currently selling, or in the past have sold a phenyle under the brand name DOCTOR HAZEL'S BRAND PHENYLE, at their premises, to which they stated that they had sold approximately 2-3 bottles of the said brand about 3 months ago when demand for the product arose. At present they do not have any stock of the aforesaid branded phenyl."*

34. The Local Commissioner who visited the aforesaid shops was appointed during hearing of an application being I.A.9676/2017 under Order XXXIX Rule 2A of the CPC. A reference may be made to the order passed by this Court on 25<sup>th</sup> August 2017 to show the mandate of the Local Commissioner. The relevant paragraphs of the said order are set out below:

*"A perusal of the cash memos reveals that the goods in question were purchased by the plaintiff somewhere in the month of May, 2017, **but none***





of the cash memos mentions the name of the defendants or the mark in dispute.

This Court is also not impressed by the video footage that has been produced by the plaintiff. It seems prima facie to this Court that by clever drafting, jurisdiction of this Court is being invoked.

However, before taking a final view in this matter, this Court considers it appropriate to appoint a Local Commissioner to visit the two shops from which the plaintiff is stated to have purchased the defendants' infringing products as well as a few shops in the wholesale market in Khari Baoli, Chandani Chowk to see if the infringing products are still available for sale and/or whether they were ever available for sale in Delhi in the recent past. A representative of the plaintiff and defendants shall accompany the Local Commissioner."

[Emphasis supplied]

35. In my considered view, the aforesaid report of the Local Commissioner would not constitute sufficient evidence to arrive at a finding that the defendants' products under the impugned marks are sold in Delhi. Firstly, the aforesaid report is based on hearsay evidence, i.e. merely what the shopkeeper has told the Local Commissioner without any document to substantiate the same. Secondly, the shopkeeper in question admitted that he does not have any stock of the said products. In addition to this, the plaintiff has not produced the said shopkeeper as a witness to show that he sold the goods bearing the impugned marks in Delhi. The same Local Commissioner visited multiple other sites, where three other shopkeepers informed him that they have never heard of the brand.

36. Even otherwise, the question of jurisdiction has to be determined when the suit was filed on 25<sup>th</sup> August 2015. No invoice or any other document has been placed on record to show that the defendants' products were selling in Delhi. At that time, the plaintiff only sought appointment of a Local Commissioner to visit Kanpur where he believed the infringing products



would be found and not Delhi.

37. Now, I shall deal with the contention of the plaintiff that the cause of action arises in Delhi since the defendant no.1 applied for trademark registration of the impugned mark 'DOCTOR HAZEL'S' in Delhi. This contention has been rejected by the Supreme Court in *Dhodha House* (Supra).

38. In *Dhodha House* (Supra), the Supreme Court has categorically held that cause of action arises only when a registered trademark is in use and not when the application is filed for registration of a trademark. Therefore, the plaintiff cannot claim jurisdiction on the basis that its marks were registered in Delhi. A natural corollary to this would be that if a trademark registration cannot be relied upon to claim jurisdiction of this Court, then the execution of the assignment deed dated 29<sup>th</sup> November 2014 in Delhi would not automatically confer the jurisdiction of this Court.

39. In light of the discussion above, the plaintiff has failed to establish territorial jurisdiction of this Court to entertain the present suit. Hence, Issue no.8 is decided in favour of the defendants and against the plaintiff.

40. Even though the plaint is liable to be returned on the ground of lack of territorial jurisdiction, in terms of the mandate of Order XIV Rule 2 of the CPC and the judgment passed by the Supreme Court in *Sathyanath v. Sarojamani*, 2022 7 SCC 644, I proceed to adjudicate the remaining issues framed in the suit.

**Issue no. 1 – Whether the defendants have infringed the plaintiff's trademark, specifically the DOCTOR BRAND PHENYLE trademark? OPP**

**Issue no. 2 - Whether the defendants have infringed the copyright vesting in the labels/artistic work of the plaintiff, specifically the DOCTOR BRAND**



PHENYLE artistic work and the DOCTOR BRAND GERM TROLL artistic work? OPP

**Issue no. 3 - Whether the defendants are passing off their goods as that of the plaintiff, specifically the DOCTOR BRAND PHENYLE and the DOCTOR BRAND GERM TROLL goods? OPP**

41. Since, all the aforesaid issues are connected, I shall take them up together for adjudication. First, I shall take up the issue of trademark and copyright infringement as well as passing off in relation to the mark 'DOCTOR BRAND PHENYLE'.

### **Doctor Brand Phenyle**

#### ***Submissions of the plaintiff***

42. The plaintiff claims to be the registered proprietor, prior adopter and user of the trademark 'DOCTOR BRAND PHENYLE', along with its variants under the mark 'DOCTOR'. The trademark registrations granted in favour of the plaintiff are given below:

TM Appl. No.	Trademark	Class	User Claim	Document Pg. No.	Date of application
445392		5	19 <sup>th</sup> December 1963	TM Registration Certificate @ Exhibit PW 1/7 at pg. 1-3, Plt. Document Compilation	8 <sup>th</sup> November 1985



718807		5	Proposed to be used	TM Registration Certificate @ <b>Exhibit PW 1/7 at pg. 4-6 Plt. Document Compilation</b>	14 <sup>th</sup> June 1996
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43. The mark 'DOCTOR BRAND PHENYLE' was originally registered in the name of the partnership firm 'Shri Gopal Engineering and Chemical Works' in class 5 in terms of the trademark application filed on 8<sup>th</sup> November 1985. Subsequently, a Family Settlement took place in 1996, and Shri Gopal Engineering and Chemical Works through its partners executed an assignment deed dated 18<sup>th</sup> November 1996 to assign the aforesaid label mark in favour of the plaintiff company. The original of the assignment deed dated 18<sup>th</sup> November 1996 has been exhibited as **Exhibit PW1/3**.

44. The plaintiff company also acquired a copyright registration in respect of the label of 'DOCTOR BRAND PHENYLE' *vide* registration no. A56172/99. The copyright registration certificate for the label of 'DOCTOR BRAND PHENYLE' has been exhibited as **Exhibit PW1/8**.

45. It is the contention of the plaintiff that the mark adopted by the defendants, i.e. 'DOCTOR HAZEL'S BRAND PHENYLE' is deceptively similar to the plaintiff's mark 'DOCTOR BRAND PHENYLE' in respect of identical goods. The plaintiff contends that the term 'DOCTOR' forms an essential and dominant part of the plaintiff's trademark and the mark used by the defendants uses the dominant/essential feature of the plaintiff's mark 'DOCTOR'.



46. It is the case of the plaintiff that the mark 'DOCTOR' for phenyle/disinfectant liquid is unique and arbitrary. The plaintiff also contends that since the defendant no.1 has also applied for the registration of the mark 'DOCTOR SUPER POWER PHENYLE' and obtained registration for the mark 'DOCTOR HAZEL'S', it cannot claim that the mark 'DOCTOR' is generic. Plaintiff also contends that merely because other third parties have registered the mark 'DOCTOR' or have applied registration for the same in respect of the similar products, it cannot be the basis to defeat the case of the plaintiff against the defendants.

47. The plaintiff has filed a rectification petition for removal of the registered word mark 'DOCTOR HAZEL'S' bearing registration number 1221775 in class 5, which now stands registered in favor of the defendant no.1. The said rectification is still pending before this Court.

48. On the aspect of passing off, the plaintiff contends that on account of its extensive use, the mark 'DOCTOR BRAND PHENYLE' has attained substantial reputation and goodwill. To establish goodwill and reputation, the plaintiff has placed on record a C.A. Certificate, certifying the plaintiff's turnover, advertisement, expenses from the year 2009-2010 to 2016-2017 as also sales invoices from the year 1998. The CA certificate dated 19<sup>th</sup> April 2018 has been exhibited as **Exhibit PW1/6 (Colly)**. The invoices and vouchers evidencing expenses incurred for advertising and promotion of the trademark 'DOCTOR BRAND' and advertisements issued by the plaintiff for its products under the marks 'DOCTOR BRAND PHENYLE' and 'DOCTOR BRAND GERM TROLL' have been exhibited as **Exhibit PW1/5 (Colly)**.

49. It is the case of the plaintiff that the defendants have adopted an identical trade dress and label in a dishonest manner. A pictorial comparison



of the plaintiff's products and defendants' products as filed by the plaintiff along with the plaint is set out below:

Plaintiff's products	Defendants' products
	
	

### *Submissions of the defendants*

50. *Per contra*, it is contended on behalf of the defendants that registration for the mark 'DOCTOR BRAND PHENYLE' granted in favour of the plaintiff, is in respect of a device mark and therefore, the plaintiff cannot claim exclusive rights on the individual components of the mark.



51. It is further submitted that the word ‘DOCTOR’ is generic and common to trade and nobody can claim monopoly over the same. The use of the mark ‘DOCTOR’ in relation to phenyle is clearly laudatory as it alludes to health and safety. The word ‘HAZEL’ is an essential, integral and dominant part of the defendant no.1 trademark and distinguishes the goods of the defendants from those of the plaintiff. No evidence has been produced by the plaintiff to show that the plaintiff’s mark ‘DOCTOR BRAND PHENYLE’ has acquired distinctiveness.

52. Since both the plaintiff and the defendants are registered proprietors of their respective marks, in terms of Section 28 of the Trade Marks Act, 1999, the plaintiff cannot claim an exclusive right to use the registered trademark against the defendant no.1.

53. The defendants had also provided a list of registrations that the Trade Marks Registry has granted in respect of mark ‘DOCTOR’ in relation to disinfectants in class 5.

54. In this regard, the defendants submit that when the defendant no.1 sought registration of the mark ‘DOCTOR HAZEL’S’, the Trade Marks Registry imposed a condition on the defendant no.1 to disclaim the word ‘DOCTOR’. It is clear from the same that the word ‘DOCTOR’ is generic and cannot be monopolised. The trademark registration certificate no. 1221775 for the trademark ‘DOCTOR HAZEL’S’ in class 5 along with renewal certificate and status page has been exhibited as **Exhibit DW2/24 (Colly)**.

55. Furthermore, the words ‘BRAND PHENYLE’ are being used by various competitors of the plaintiff and defendants in Indian market with their main/household brand i.e. ‘GAINDA BRAND PHENYLE’, ‘BLUE CROSS BRAND PHENYLE’, ‘DIAMOND BRAND PHENYLE’, ‘TIGER BRAND



PHENYLE’. This shows that the words ‘BRAND PHENYLE’ are generic and common to trade. Original labels of various phenyle brands which are selling their products in red and yellow packaging with blue cap/identical images of the ants and insects at the label of the bottle in blue and white colour have been exhibited as **Exhibit DW2/36 (Colly)**.

56. At the time of filing the suit, the plaintiff was using a blue and white colour scheme in respect of its packaging. Even the copyright registration obtained by the plaintiff for the label ‘DOCTOR BRAND PHENYLE’ is in a blue and white colour scheme. This fact has been admitted by PW-1 in his cross examination. This is also evident from the packaging of the plaintiff’s phenyle bottle using the ‘DOCTOR BRAND PHENYLE’ label in blue and white color scheme, as on August, 2015. Original label of the plaintiff company’s product 'DOCTOR BRAND PHENYLE' in white and blue color scheme has been exhibited as **Exhibit DW2/10**.

57. On the other hand, defendants have been selling their phenyle products in the colour scheme of yellow, red, blue, green and white since the year 2000 under the mark ‘CHEMIST BRAND PHENYLE’. The same label was used by the defendant no.1 for its products under the trademark ‘DOCTOR HAZEL’S’ when the same was launched on 19<sup>th</sup> December 2014. The original labels of various products under ‘CHEMIST BRAND PHENYLE’ from the year 2003 to 2011 have been exhibited as **Exhibit DW2/21**. The original label of the defendant no.1 company’s product under the trademark ‘DOCTOR HAZEL’S’ has been exhibited as **Exhibit D5**. Therefore, the plaintiff cannot claim any copyright infringement in respect of the label in yellow, red, blue and white colour scheme.





58. To make out a case of passing off and infringement of copyright, the plaintiff has filed documents along with trade dress with a similar colour combination as that of defendant no.1 which was never used by the plaintiff. Insofar as the overall layout was concerned, the same layout was being used by the erstwhile partnership 'Shri Gopal Engineering and Chemical Works' since 1986 in relation to the products under the mark 'CHEMIST' and thereafter by the defendant no.1 since 2000. Therefore, the plaintiff had knowledge of the said get-up since the year 2000. Further, the aforesaid layout is common to trade in the sanitation and disinfectant industry. The defendants have placed on record photographs of various other products available in the market using similar packaging, as given in paragraph 4B of the written statement.

### ***Analysis***

59. Insofar as the case set up by the plaintiff with regard to trademark infringement is concerned, in light of Section 28(3) of the Trade Marks Act, 1999 no infringement action can lie against the defendants in view of the registration obtained by the defendants. Both the plaintiff and defendants are registered proprietors of their respective trademarks, i.e. 'DOCTOR BRAND PHENYLE' (device), and 'DOCTOR HAZEL'S' (word mark), respectively. Reference may be made to a recent judgment passed by the Division Bench of this Court in ***VIP Industries v. Carlton Shoes***, 2025 SCC OnLine Del 4620.

60. Even though it is contended on behalf of the plaintiff that it has filed a rectification petition seeking removal of the registration of the defendants, the same is said to be pending. Therefore, at this stage, no case of trademark infringement would lie against the defendants.



61. It is an admitted position that the words ‘phenyle’ and ‘brand’ are generic and therefore cannot form the dominant part of the mark of either the plaintiff or the defendants.

62. In addition to the aforesaid words, the plaintiff uses the word ‘DOCTOR’ whereas the defendant no.1 uses the mark ‘DOCTOR HAZEL’S’. In my considered view, the addition of the word ‘HAZEL’S’ makes the mark of the defendant no.1 distinguishable from that of the plaintiff.

63. The defendants have placed on record sufficient evidence to show that the mark ‘DOCTOR’ is common to trade and has been registered in favour of various third parties in respect of similar products. Copies of various registrations, trademark applications, Trade Marks Journal pages along with status pages where the word ‘DOCTOR’ is registered in various classes included in class 5 in favour of various other entities by the Trade Marks Registry have been exhibited as **Exhibit DW2/32 (Colly)**.

64. The registration granted in favour of the plaintiff is for the composite device mark ‘DOCTOR BRAND PHENYLE’ and not in respect of the word ‘DOCTOR’. The defendants have obtained registration for the word mark ‘DOCTOR HAZEL’S’. Therefore, in terms of Section 17 of the Trade Marks Act, 1999 the plaintiff cannot claim exclusivity in respect of the word ‘DOCTOR’.

65. In this regard, reference may be made to the judgment of the Division Bench of this Court in *Vardhman Buildtech Pvt. Ltd. v. Vardhman Properties Ltd.*, 2016 SCC OnLine Del 4738, the relevant paragraph of which are set out below:



“8. On a plain reading of Section 15(1), it is evident that where a proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he is permitted to apply to register the whole and the part as separate trade marks. In the present case, the respondent is the proprietor of the label/mark which includes the words ‘VARDHMAN PLAZAS’. The respondent is claiming exclusivity in respect of the word ‘VARDHMAN’. It is clear that he had the option to make an application for registering the word ‘VARDHMAN’ as a separate trade mark. Assuming that he could have had the word mark registered, it is an admitted fact that the respondent made no such application. Section 17 of the said Act makes it clear when a trade mark consists of several matters, as it does in the present case, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole. There is no dispute that the label/mark, taken as a whole, is the exclusive property of the respondent. The learned counsel for the appellants has no quarrel with this at all. The issue arises when the respondent claims exclusive right to a part of the label/mark and particularly to the word ‘VARDHMAN’.

**Section 17(2) is a non-obstante provision [vis-à-vis sub-section(1)], which stipulates that when a trade mark contains any part which is not the subject matter of a separate application by the proprietor for registration as a trade mark or which is not separately registered by the proprietor as a trade mark or 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. In the present case, neither has the respondent separately registered ‘VARDHMAN’ as a trade mark nor has any such application been made. Furthermore, the word ‘VARDHMAN’ is itself of a non-distinctive character and is not only common to this trade but to several other businesses. Consequently, the registration of the label/mark which contains the words ‘VARDHMAN PLAZAS’ does not confer any exclusive right on the respondent insofar as a part of that mark, namely, ‘VARDHMAN’ is concerned.**

[Emphasis supplied]



66. Similar view was also taken by the Division Bench of this Court in ***Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani***, 2022 SCC OnLine Del 3370. The relevant paragraph is set out below:

*“32. It is well settled that a composite trademark or label trademark is not required to be dissected to determine whether there is any deceptive similarity with another trademark. The question whether there is any deceptive similarity between two trademarks has to be ascertained by examining the marks in question as a whole. In South India Beverages India Private Limited v. General Mills Marketing Inc, 2014 SCC OnLine Del 1953, the Division Bench of this Court had explained the ‘anti-dissection rule’ in some detail. The Court reiterated that **“conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their components parts for comparison”**. However, the Court had also observed that **“while a mark is to be considered in entirety, yet it is impermissible to accord more or less importance or ‘dominance’ to a particular portion or element of a mark in cases of composite marks”**.”*

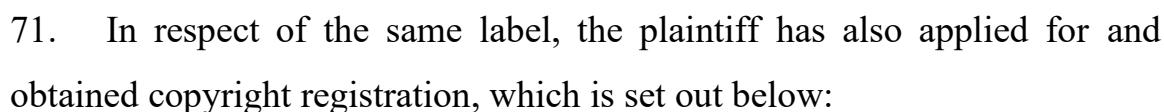
[Emphasis supplied]

67. Since the plaintiff has registration for the label mark ‘DOCTOR BRAND PHENYLE’, the said label has to be considered in its entirety while comparing it with the defendants’ mark. The plaintiff cannot expand the scope of protection granted to the said label mark by claiming that the word ‘DOCTOR’ is the ‘essential’/ ‘dominant’ part of its registered label mark. In fact, when the two competing marks are seen as a whole, it can be concluded that the said rival marks do not bear any visual similarity.

68. Even otherwise, the word ‘DOCTOR’ is a generic and laudatory term used by various entities in respect of disinfectants under class 5. Hence, the plaintiff cannot be permitted to monopolise the term ‘DOCTOR’. This position is further substantiated by the fact that the defendant no.1 obtained registration for the word mark ‘DOCTOR HAZEL’S’ wherein a condition



70. To appreciate this submission, it may be useful to refer to the trademark registration applied for by the plaintiff on 14<sup>th</sup> June 1996 and subsequently, granted in class 5. The same is set out below:

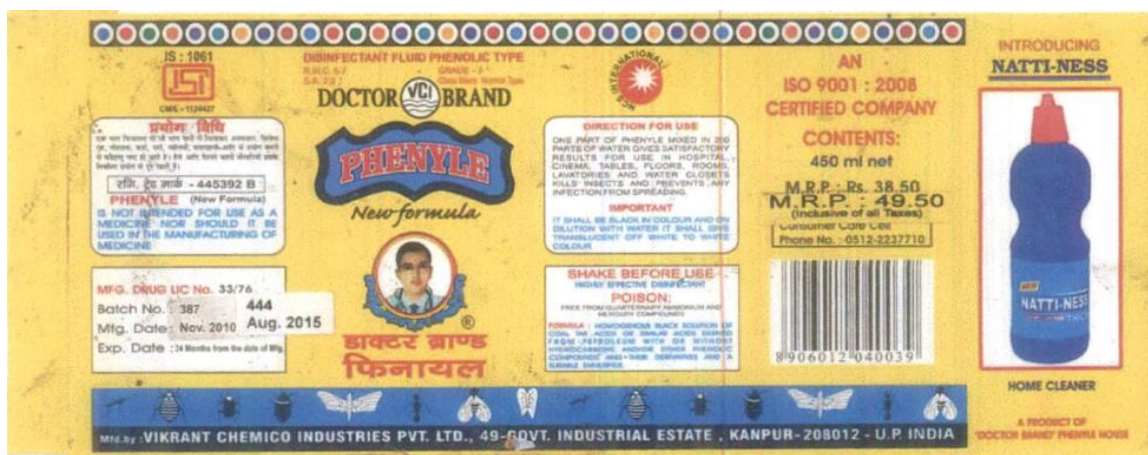




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72. This is in sharp contrast to the label relied upon by the plaintiff in the present suit. For the sake of convenience, the label/package in respect of which the plaintiff alleges passing off as well as copyright infringement is set out below:



73. The counsel for the defendants specifically cross examined PW-1 in this regard. The relevant extracts from the cross examination are set out below:

“Q46. Please see the label being shown to you is this the registered label under Application No. 445392 and also under the copyright Act No. A-56172/99 (the document shown to the witness is given the name Ex. PW1/D2 for the purpose of identification)





*Ans. The label shown to me the part of the label is same under Application No. 445392 and Copy right Certificate. The portion marked A in Ex. PW1/D2 is same as per registration certificate 445392 and the portion marked A, B and B1 are the same as copy right registration certificate.*

*Q47. Ex. PW1/D2 is the label under which the Plaintiff sells its goods as of today. Is it correct?*

*Ans. It is correct.”*

74. Therefore, for the purposes of passing off and copyright infringement a comparison would have to be made between the label of plaintiff in respect of which it obtained registrations and which it had admitted to be using with a label/ products being used by the defendants.

Plaintiff's products and label	Defendants' products and label
	



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75. The comparison above would show that the label used by the defendants is quite distinct from the label used by the plaintiff (**Exhibit PW1/D2**) in terms of colour scheme as well as the font and style. The colour scheme of the plaintiff is blue, red and white, and that of the defendants is primarily yellow with blue, red and green. There are enough distinctive features in the packaging of the defendants to distinguish it from that of the plaintiff. In fact, the word ‘DOCTOR’, for which the plaintiff seeks exclusivity has been written in a font that is different from that of the defendants. Therefore, it cannot be said that there is a possibility of confusion or deception being caused among the customers of the two products.

76. As noted above, the label/packaging adopted by the defendants is quite distinct from the label of the plaintiff. In fact, in the plaint, it is the plaintiff who has tried to adopt a packaging/label that has been used by the defendants over several years in order to substantiate its claim of passing off and copyright infringement.

77. In light of the comparison above, in my considered view, no case of trademark infringement, copyright infringement or passing off has been made out by the plaintiff in respect of its mark ‘DOCTOR BRAND PHENYLE’.

78. Now, I shall deal with the issue of trademark and copyright infringement as well as the passing off in relation to the mark ‘DOCTOR BRAND GERM TROLL’.





## **Doctor Brand Germ Troll**

### ***Submissions of the plaintiff***

79. It is the case of the plaintiff that the mark 'DOCTOR BRAND GERM TROLL' was adopted in the year 1973 and is a distinctive and an original coined mark. It was coined with the intention of conjuring the dual images of catching germs as well as that of a monster, inimical to the existence of germs.

80. The plaintiff claims user of the aforesaid mark from the year 1973.



81. The plaintiff also claims copyright in the distinct label/trade dress adopted by it in respect of the packaging of its product under 'DOCTOR BRAND GERM TROLL'. The said label constitutes an original artistic work within the meaning of Section 2(c) of the Copyright Act, 1957. Photograph of plaintiff's product under the trademark 'DOCTOR BRAND GERM TROLL' has been exhibited as **Exhibit PW1/9**.

82. It is the case of the plaintiff that the defendants started using their mark 'CHEMIST' along with the mark 'GERM TROLL' in the year 2015 and launched the product 'CHEMIST BRAND GERM TROLL' to ride upon the goodwill and reputation of the plaintiff.

83. Even though the defendants claim user of the aforesaid marks since the year 2000, no document in support of such user has been filed.

84. It is the case of the plaintiff that the defendants have adopted an identical trade dress and label in a dishonest manner. The comparison of the plaintiff's bottle/label with the defendants' bottle/label bearing the 'GERM-TROLL' mark as filed by the plaintiff along with the plaint is set out below:



<u>Plaintiff's product</u>	<u>Defendants' product</u>
	

### ***Submissions of the defendants***

85. *Per contra*, the case set up by the defendants is that the term 'GERM TROLL' belonged to the erstwhile partnership firm 'Shri Gopal Engineering and Chemical Works'. When the aforesaid firm was taken over by the defendant no.1, the said mark stood transferred to the defendant no.1 company. Even after the dissolution of the said partnership firm, the defendant no.1 continued the use of trademark 'DOCTOR BRAND GERM-TROLL' till 1996. Therefore, the plaintiff cannot claim any rights in the said mark. It is also the case of the defendants that the term 'GERM TROLL' is a descriptive word, which does not confer any exclusive right upon the plaintiff.

86. Once again it is the case of the defendants, like in the case of 'DOCTOR BRAND PHENYLE', the plaintiff has fabricated the packaging used by it in respect of 'DOCTOR BRAND GERM TROLL' as well. In the trademark



application filed by the plaintiff on 14<sup>th</sup> June 1996, it had applied for registration of 'DOCTOR BRAND PHENYLE' under class 5, and in the said label had made an additional representation of 'DOCTOR BRAND GERM TROLL'. It is the case of the defendants that the bottle and packaging which is the subject matter of the registration is entirely different from the one which is being shown in the plaint. Defendants submit that they have been selling their product 'CHEMIST BRAND GERM TROLL' since the year 2000 in the following packaging:



Original labels of the defendant no.1's products 'CHEMIST BRAND KHUSHBOO' and 'CHEMIST BRAND GERM TROLL' have been exhibited as **Exhibit DW2/34**.

87. To appreciate this submission, it may be useful to refer to the additional representation made by the plaintiff in the trademark registration bearing no. 718807 in class 5. The same is set out below:



88. It is the case of the defendants that the plaintiff has been aware about the defendant no.1 company's use of the trademark 'CHEMIST BRAND PHENYLE' and 'CHEMIST BRAND GERM TROLL' and its label/packaging at least since the year 2000. Hence, the present suit is hit by the principles of laches, delay and acquiescence.

89. As per the defendants, there is no similarity between the packaging in respect of which registration was sought by the plaintiff and the packaging that is used by the defendants since the year 2000. Hence, no case for infringement of copyright or passing off is made out.

### ***Analysis***

90. From the evidence on record, it emerges that the trademark 'GERM TROLL' was adopted by the partnership firm, Shri Gopal Engineering and Chemical Works. In this regard, reference may be made to the cross examination of PW-1, wherein he has admitted that the mark 'DOCTOR BRAND GERM TROLL' was adopted by the partnership firm 'Shri Gopal



Engineering and Chemical Works’ in the year 1973. The relevant extracts from the cross examination are set out below:

*“Q62. In which year the mark (Doctor Brand Germ Troll) was adopted by the partnership firm Shri Gopal Engineering and Chemical Works?*

*Ans. 1973”*

Thereafter, the said firm was taken over by the defendant no.1 company on 1<sup>st</sup> July 1994 along with its assets and liabilities. Reference may be made to the Memorandum of Association filed on behalf of the defendants, which has been exhibited as **Exhibit PW1/D1**.


91. No document has been filed by the plaintiff to show that any right was conferred by the partnership firm upon the plaintiff company to use the ‘GERM TROLL’ mark. Hence, the plaintiff cannot claim any proprietary rights over the said mark.

92. The marks used by the plaintiff and the defendants are entirely different. The plaintiff uses the mark ‘DOCTOR BRAND GERM TROLL’, whereas the defendants use the mark ‘CHEMIST BRAND GERM TROLL’. Clearly, the distinctive part of the defendants’ mark is ‘CHEMIST’, which is absent in the plaintiff’s mark. The mark ‘DOCTOR’ which the plaintiff claims is the distinctive mark, is also absent in the defendants’ mark.

93. Another issue that comes up for consideration is whether the mark ‘GERM TROLL’ is a descriptive word and whether it can attain distinctiveness in respect of the goods of the plaintiff, i.e. phenyle. By using the term ‘GERM TROLL’, the plaintiff is seeking to highlight the positive quality of its product that is ‘searching for/ catching germs’. This leaves no doubt in my mind that the plaintiff is using the mark ‘GERM TROLL’ in a descriptive manner.



94. For the purposes of passing off and copyright infringement, a comparison would have to be made between the label/bottle of plaintiff in respect of which it made an additional representation and the label/bottle used by the defendants.

Plaintiff's products	Defendants' products
	

95. The comparison above would show that the two competing products are quite distinct in terms of the colour scheme, shape as well as the font and style. The colour scheme used by the plaintiff is blue, green and red, and that of the defendants is primarily red and white. There are enough distinctive features in the packaging of the defendants to distinguish it from that of the plaintiff. In fact, the colour scheme of red and white as shown above has been used by the defendants since the year 2000.

96. Therefore, neither a case of passing off nor a case of copyright infringement has been made out in respect of the defendants'



label/packaging/bottle bearing the mark 'CHEMIST BRAND GERM TROLL'.

97. In view of the discussion above, Issues no. 1, 2 and 3 are decided in favour of the defendants and against the plaintiff.

**Issue no. 4 – If the answers to issues nos. 1, 2 & 3 are in the affirmative, whether plaintiff is entitled to rendition of accounts from the defendants? OPP**

**Issue no. 5 – Whether the plaintiff is entitled to damages? OPP**

**Issue no. 6 – Whether the plaintiff is entitled to delivery up of infringing materials? OPP**

**Issue no. 7 – Whether the plaintiff is entitled to any further costs? OPP**

98. In view of the findings given above in Issues no. 1, 2 and 3, the plaintiff is not entitled to the reliefs sought under Issues no. 4, 5, 6 and 7.

99. Hence, Issues no. 4, 5, 6 and 7 are also decided in favour of the defendants and against the plaintiff.

100. Even though no specific issue with regard to permanent injunction has been framed, the plaintiff is not entitled to the relief of permanent injunction against the defendants.

**Issue no. 9 – Whether the suit is bad for mis-joinder for defendants? OPD**

101. No evidence has been led by the defendants in this regard.

102. Hence, Issue no. 9 is decided in favour of the plaintiff and against the defendants.

## **RELIEF**

103. In view of the findings above, the present suit is returned to the plaintiff



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for want of territorial jurisdiction.

104. The pending application stands disposed of.

**AMIT BANSAL  
(JUDGE)**

**AUGUST 20, 2025  
ds**