



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% *Judgment delivered on: 31.01.2026*

+ **CS(COMM) 532/2023**

EMAMI LIMITEDPlaintiff

versus

DABUR INDIA LIMITEDDefendant

Advocates who appeared in this case

For the Plaintiff : Mr. Abhimanyu Bhandari, Senior Advocate with Ms. Roohe Hina Dua, Mr. Harshit Khanduja & Mr. Vinayak Thakur, Advocates.

For the Defendant : Mr. Sandeep Sethi & Mr. Anirudh Bakhru, Senior Advocates with Ms. Kripa Pandit, Mr. Christopher Thomas & Ms. Pranjali Arya, Advocates.

CORAM:

HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

I.A. No. 14557/2023 (u/O XXXIX Rules 1&2 CPC)

1. This is an Application filed by the Plaintiff under Order XXXIX Rules 1 and 2 of Code of Civil Procedure, 1908 (“CPC”).

2. *Vide* Order dated 09.08.2023, the Defendant was restrained from selling its product ‘Cool King Thanda Tael’ (“Defendant’s Product”), in



any manner, in the Trade Dress ‘ ’ (“**Impugned Trade Dress**”) or any other deceptively similar Trade Dress.

3. The Defendant preferred an appeal against the Order dated 09.08.2023. The Division Bench *vide* Order dated 21.08.2023 passed in FAO (OS)(COMM) 171/2023 set aside the Order dated 09.08.2023 on the limited ground that in the circumstances of the present case, the Defendant ought to have been given an opportunity to file its Reply to the present Application before adjudicating on the aspect of interim stay.

4. As recorded in Order dated 29.02.2024, the Plaintiff has confined its submissions on aspect of passing off in this Application subject to reserving the right of the Plaintiff for other reliefs in the Suit.

SUBMISSIONS ON BEHALF OF THE PLAINTIFF:

5. The learned Senior Counsel for the Plaintiff made the following submissions:

5.1 The Plaintiff, established in the year 1974, is the flagship company of the Emami Group of Companies and is engaged in, *inter alia*, manufacturing and marketing of health, beauty, personal care and other allied products, and is one of the leading and fastest growing personal and healthcare businesses in India. The Plaintiff commenced manufacturing ayurvedic



medicine and medicinal preparations in India in the year 1982 and is one of the pioneers amongst the manufacturers of ayurvedic medicines and ayurvedic medicinal preparations in India and has earned the tremendous trust and confidence of millions of people spread all over the country, both within and outside the jurisdiction aforesaid and several other countries to which the Plaintiff has been exporting its products.

5.2 Navaratna Oil (“**Plaintiff’s Product**”) was launched in January 1989, with the catch phrase ‘Thanda Thanda Cool Cool’, and has been in continuous and uninterrupted use ever since. Navratna has been the most trusted and preferred Trade Mark in the therapeutic cooling oil segment for a very long time. The Plaintiff’s Product is the undisputed leader in its therapeutic cooling oil segment providing multi-purpose benefits to its satisfied and ever-growing consumer base. The Plaintiff’s Product has a market share of 66% as of 2022 in the cooling oil segment. The Plaintiff has obtained registrations for the Marks, ‘NAVRATNA’, ‘NAVRATNA OIL’, ‘NAVRATNA AYURVEDIC Tael THANDA’, ‘THANDA THANDA COOL COOL’, ‘COOL COOL’, ‘THANDA THANDA Cool Cool’, and ‘HALKA HALKA COOL COOL’ (“**Plaintiff’s Marks**”), to sell the Plaintiff’s Product. The registration details of the Plaintiff’s Marks used in the Plaintiff’s Product are as under:

S. No.	TRADEMARK	Reg. No.	CLASS	STATUS	DATE OF REGISTRATION
1.	NAVRATNA (LABEL)	785156	03	REGISTERED	06.01.1998
2.	NAVRATNA	785157	05	REGISTERED	06.01.1998



	(LABEL)				
3.	NAVRATNA OIL (RED TRADE DRESS DEVICE)	1068166	05	REGISTERED	20.12.2001
4.	THANDA THANDA COOL COOL (DEVICE)	1305653	03	REGISTERED	27.08.2004
5.	THANDA THANDA COOL COOL (DEVICE)	1305654	05	REGISTERED	27.08.2004
6.	NAVRATNA OIL DEV (RED TRADE DRESS DEVICE)	1677005	05	REGISTERED	16.04.2008
7.	HALKA HALKA COOL COOL	1802168	03	REGISTERED	01.04.2009
8.	THANDA THANDA COOL COOL	2146193	03	REGISTERED	18.05.2011
9.	THANDA THANDA COOL COOL	2146194	05	REGISTERED	18.05.2011
10.	THANDA THANDA	2146195	03	REGISTERED	18.05.2011
11.	THANDA THANDA	2146196	05	REGISTERED	18.05.2011
12.	COOL COOL	2146197	03	REGISTERED	18.05.2011
13.	COOL COOL	2146198	05	REGISTERED	18.05.2011
14.	ZYADA THANDA ZYADA COOL	2259420	05	REGISTERED	30.12.2011
15.	ZYADA THANDA ZYADA COOL	2259421	05	REGISTERED	30.12.2011
16.	NAVRATNA (LABEL)	3079175	03	REGISTERED	14.10.2015



5.3 The Plaintiff's Product is sold in bottles which have their own unique designs ("Plaintiff's Bottle Designs") which are also registered under the Designs Act, 2000 ("Designs Act"). The details of registration of the Plaintiff's Bottle Designs are as under:

S. NO.	TITLE	Reg. No.	STATUS	DATE OF REGISTRATION	IMAGE
1.	NAVRATNA OIL (BOTTLE DESIGN)	253389	REGISTERED	23.04.2013	
2.	NAVRATNA OIL (BOTTLE DESIGN)	279325	REGISTERED	11.01.2016	

5.4 The Plaintiff has further obtained Copyright registrations over the label of the Plaintiff's Product. The details of the Plaintiff's Copyright registrations for the Plaintiff's Product is as under:

S. NO.	TITLE	Reg. No.	STATUS	DATE OF REGISTRATION
1.	HIMANI NAVRATNA OIL (LABEL)	A-58209/2000	REGISTERED	10.01.2001
2.	HIMANI NAVRATNA TEL (LABEL)	A-67884/2004	REGISTERED	01.07.2004
3.	HIMANI NAVRATNA OIL (WITH DEVICE OF SAINT)	A-86299/2009	REGISTERED	23.07.2009



5.5 The Plaintiff has spent a substantial amount of money on promotion and publicity and has advertised the Plaintiff's Marks through all available media, i.e., newspapers, journals, souvenirs, television, hoardings etc., at various places. The Plaintiff has been active in promoting Plaintiff's Product and Plaintiff's Marks since 1989-90. Owing to continuous and extensive use for over three decades, the Plaintiff's Marks have become a household name across the country. The year-wise sales turnover of the Plaintiff in respect of Plaintiff's Product sold under each of Plaintiff's Marks for the financial years 1990-91 to 2021-2022 are as under:

Year	Sales Turnover (in INR Lakhs)
1990-91	14.77
1991-92	119.16
1992-93	150.33
1993-94	165.38
1994-95	281.34
1995-96	441.77
1996-97	973.61
1997-98	1674.19
1998-99	1805.88
1999-2000	2845.65
2000-01	4875.09
2001-02	6081.21
2002-03	5329.02
2003-04	6650.91
2004-05	8049.63
2005-06	10433.91
2006-07	17626.38
2007-08	19866.26
2008-09	11113.42
2009-10	21451.60
2010-11	28501.40



2011-12	34017.30
2012-13	42244.30
2013-14	44033.70
2014-15	51994.90
2015-16	53983.00
2016-17	58116.80
2017-18	57817.20
2018-19	61512.50
2019-20	60546.81
2020-21	55806.14
2021-22	58562.25
TOTAL	727085.81

5.6 The Plaintiff uses a distinctive red packaging to sell the



Plaintiff's Product, ' ' ("Plaintiff's Trade Dress"). The Plaintiff had made minor modifications in the Plaintiff's packaging to keep with the changing times, however, the distinct red Trade Dress of the Plaintiff's Product, which is also in red colour, has remained the same.

5.7 The Plaintiff's Product bearing the Plaintiff's Marks, along with the Plaintiff's Trade Dress has been sold and offered for sale continuously and extensively for over 30 years across India. Owing to the extensive sales, advertisement and promotion and



high quality of Plaintiff's Product sold by the Plaintiff under Plaintiff's Marks, along with the Plaintiff's Trade Dress, the Plaintiff's Marks and Plaintiff's Product have come to be exclusively identified, recognized and associated with the Plaintiff. The Plaintiff's Marks have acquired immense goodwill and reputation and, as a result whereof, are exclusively associated with the Plaintiff.

5.8 The Plaintiff came to learn sometime in June 2023 that the Defendant had recently launched a product similar to the Plaintiff's Product, which was sold in bottles there were similar to the Plaintiff's Bottle Designs, and packed in a red-coloured packaging, similar to the Plaintiff. The Defendant's Product is visually, structurally and phonetically deceptively similar to the Plaintiff's Product inasmuch as the Defendant has wilfully, deliberately and with *mala fide* intentions copied elements from the Plaintiff's Trade Dress to pass off its products as those of the Plaintiff. The Defendant has also adopted the Marks 'THANDA TUEL', 'COOL KING', 'COOL OIL', 'COOL KING THANDA TUEL' and 'NAYA DABUR COOL KING THANDA TUEL' ("**Impugned Marks**"), which are deceptively similar to the Plaintiff's Marks which further leads the consumers to believe that there is an association between the Defendant's Product and the Plaintiff, where none exists. A comparison of the Plaintiff's Product and the Defendant's Product is as under:



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Plaintiff's Product	Defendant's Product
	
	



5.9 The Plaintiff's Product and the Defendant's Product are red in colour and the Defendant is marketing the Defendant's Product in similar transparent bottles, bearing identical shape and configuration as that of the Plaintiff's Bottle Designs. The Defendant is selling the Defendant's Product in the Impugned Trade Dress, which is identical or deceptively similar to the Plaintiff's Trade Dress. Such fact would be evidenced from the colour of the packaging of both the products, the use of the Marks, 'Thanda' and 'Thanda Tael', the use and place of hibiscus / china rose, ice, and ayurvedic herbs on the packaging of the Defendant, as that of the Plaintiff.

5.10 The Defendant's Product comprises of deceptively similar Marks such as 'Cool King' and 'Thanda Tael', and the inset of



the ‘troubled man’, along with the placement of the purported ingredients such as China rose, pudina leaves and ice cubes, packaged and marketed in the bottle and the red and gold trade dress is identical to the Plaintiff’s Trade Dress. The Impugned Trade Dress is deceptively similar to the Plaintiff’s Trade Dress and, hence, is leading to confusion and / or deception.

- 5.11 The effect of the oil in relieving headache, fatigue and stress is depicted in a similar manner on the Impugned Trade Dress, which is similar to the way that the Plaintiff promotes the Plaintiff’s Product.
- 5.12 With the Plaintiff’s Product and the Defendant’s Product placed next to each other, it would be apparent that each and every important feature of Plaintiff’s Product has been copied by the Defendant for the Defendant’s Product. The resemblance in the Plaintiff’s Trade Dress and the Impugned Trade Dress is so close that it can hardly occur except by deliberate imitation. This Court in ***Dabur Ltd. vs Shree Baidyanath***, 193 (2012) DLT 558, held that there is no valid explanation given as why the defendant’s new packaging has similar essential features, get-up, layout, colour combination and placement of features as that of plaintiff’s packaging and concluded that the impugned packaging was not *bona fide* and liable to be restrained.
- 5.13 The slavish imitation of the sachets of the Plaintiff’s Product by the sachets of the Defendant’s Product is more blatant. The Defendant has adopted identical sachets to that of the Plaintiff and the sachet of the Defendant bears the terms ‘Raahat’,



‘Aaram’ and ‘Tarotaazgi’ inscribed in Hindi. A comparison of the sachets of the Plaintiff’s Product and sachets of the Defendant’s Product is as under:



[Plaintiff's Product]



-Defendant's Product]



[Plaintiff's Product]



-Defendant's Product]

5.14 The Defendant’s adoption / use of the Impugned Trade Dress is completely dishonest and *mala fide* and with a clear intention of passing off its products as those of the Plaintiff. The present case satisfies the test of infringement and passing off laid out in *Corn Products Refining Co v Shangrila Food Products Ltd*, AIR 1960 SC 142, *Heinz Italia and Anr v Dabur India Ltd.*, (2007) 6 SCC 1, *Cadila Healthcare Limited v. Cadila Pharmaceutical Limited*, (2001) 5 SCC 73, wherein it has



been, *inter alia*, held that, in an infringement / passing off action, similarities rather than dissimilarities have to be taken note and the colour scheme and overall effect of the packaging have to be seen.

- 5.15 In the judgments of ***Midas Hygiene Industries (P) Ltd. and Another v. Sudhir Bhatia and Others***, 2004 SCC OnLine SC 106 and ***Hindustan Pencils Pvt. Lts. V. India Stationery Products***, 1989 SCC OnLine Del 34, it was held that if a party for no apparent reason adopts a deceptively similar trade mark or a deceptively similar trade dress to another it would be difficult to avoid an order of injunction as the Court assumes that the adoption was dishonest and indicates that the defendant tried to pass off its goods as those of the Plaintiff.
- 5.16 The Defendant has tried to mislead this Court by submitting that the essential features of Plaintiff's Trade Dress are common to trade or incapable of any monopolistic proprietary rights to the exclusion of other members of trade. The Defendant itself takes a contrary stand and supports Plaintiff's contention, as the Defendant avers that the Impugned Trade Dress is distinctive and has also applied for Trade Mark registration of the Impugned Trade Dress on a proposed to be used basis. Such averments establish unequivocal acknowledgement on the Defendant's part that the Plaintiff's Trade Dress possesses inherent distinctiveness and it does not lie in the mouth of the Defendant to conveniently dispute the distinctive character of Plaintiff's Trade Dress, significantly



comprised of the red background and other elements, as has been held by this Court in *Procter & Gamble Manufacturing and Ors. v. Anchor Health & Beauty Care*, Neutral Citation: 2014:DHC:2491. The Impugned Trade Dress is not capable of distinguishing the Defendant's Product as the same is essentially identical to and an imitation of Plaintiff's Trade Dress for the Plaintiff's Product.

- 5.17 A party seeking to rely on third party marks has to prove that those marks had acquired a reputation by extensive use in the market. Mere registration of a mark does not prove its use as has been held by the Supreme Court in *National Bell Vs. Metal Goods*, AIR 1971 SC 898. Further, a proprietor of a trade mark need not take action against an infringer who does not cause prejudice to its distinctiveness as has been held in *Pankaj Goel v Dabur India*, 2008 (38) PTC 49 and *Express Bottlers Services Pvt. Ltd. Vs. Pepsi Inc. & Others* 1989 (7) PTC 14. Further, insofar as the 'few' registrations in the name of third parties are concerned, the same are of no consequence and cannot legitimize the Defendant's adoption / use of the Impugned Trade Dress.
- 5.18 The Defendant has also relied upon its Trade Marks, 'Dabur Lal Tail' with Trade Mark Registration No. 282258 dated 21.08.1972, 'Dabur Himsagar' with Trade Mark Registration No. 1042487 dated 05.09.2021 and 'Dabur Super Thanda Oil', with Trade Mark Registration No. 1823606 dated 21.05.2009 claiming to be prior user of Red Oil.



5.19 The Defendant's claim is unsubstantiated, of no consequence and misleading. 'Dabur Lal Tail' as sold by the Defendant is not an oil in the Cooling Oil segment rather is used for massage oil segment for the infants. Further, the application was filed in 1972 on a proposed to be used basis and the claim of use since 1973 is contradictory, false, and cannot be given any credence or relied upon at any rate. The registrations do not and cannot establish that it is used for red coloured cooling oil, as contended or at all. At any rate, registration of a Mark does not establish its use in the course of trade. The registrations are inconsequential and does not advance or establish the Defendant's case in any manner whatsoever.

SUBMISSIONS ON BEHALF OF THE DEFENDANT:

6. The learned Senior Counsel for the Defendant made the following submissions:

- 6.1 The tort of passing off is established only if the Plaintiff clears the trinity test i.e. the Plaintiff has been able to establish goodwill with respect to the Plaintiff's Trade Dress, there has been a misrepresentation on behalf of the Defendant and the Plaintiff has been incurred or is likely to incur damage as a result of misrepresentation. In the present case the Plaintiff has failed to successfully clear the triple test against the Defendant.
- 6.2 The prominent House Mark of the Defendant, i.e., Dabur, is the distinguishing feature in the Defendant's Product which dispels any possibility of confusion between the Defendant's Product and the Plaintiff's Product. The Defendant adopted the



Impugned Mark, 'SUPER THANDA' in 2006, and the Plaintiff's Annual Report recognises it as a major market player, evidencing the Defendant's Goodwill.

- 6.3 The Plaintiff alleges to have established the use of the Plaintiff's Trade Dress since the year 2017, however, the Sales and Advertising expenses provided by the Plaintiff relate to all their products sold under the brand 'NAVRATNA'. The Plaintiff has multiple variants and products under the brand, 'NAVRATNA', and no specific sale figures nor expenses of any kind for the Plaintiff's Product under the Plaintiff's Trade Dress have been filed in the present Suit. In order to establish goodwill, the Plaintiff must produce sales figures pertaining to the Plaintiff's Product and not the entire 'NAVRATNA' brand. This Court in ***Soothe Healthcare Pvt. Ltd. v. Dabur India Limited***, 289 (2022) DLT 225, held that cumulative sales and advertising expenses of all products under a particular mark without directly pointing out the goodwill of the particular products in question are not sufficient to establish goodwill of a particular product.
- 6.4 It is settled law that in a suit for passing off, in order to establish goodwill for a product, it is necessary for the Plaintiff to prove not only the figures of sale of the said product but also the expenditure incurred on promotion and advertisement of the product as has been held by the Supreme Court in ***Brihan Karan Sugar Syndicate Private limited v. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana***, 2023 INSC 831.



6.5 On a holistic comparison of the Defendant's Product and the Impugned Trade Dress with the Plaintiff's Bottle Design and the Plaintiff's Trade Dress, there are many substantial and inherently dissimilar elements and features. In a case of passing off, the Plaintiff must establish that the Defendant has copied or tried to copy some essential feature of the Plaintiff's Trade Dress, which was distinctive and was associated with the Plaintiff alone. In the present case, the Plaintiff has failed to do so, and the comparison made by the Plaintiff is entirely based on the similarity in the colour of the label, liquid, bottle and outer packaging which uses the colour red. The colour red is functional in nature and a result of the ingredients used in producing the cooling oil and thus the Plaintiff cannot claim any right over it as has been held by this Court in Judgement dated *M/s. M.L. Brothers LLP v. Uma Impact Pvt. Ltd. & Anr.*, CS(COMM) 132 of 2019.

6.6 The features that are alleged copied by the Defendant such as Hibiscus flower, ice blocks, menthol leaves and the use of descriptive words such as 'THANDA', 'COOL', 'COOL TEL', and 'COOLING OIL' are all common / generic in nature and are common to trade. Furthermore, the Plaintiff has only relied on comparative analysis / charts relating to their Trade Dresses and not their outer packaging. When the outer packaging of both the Plaintiff's Product and the Defendant's Product are compared as a whole, the products are dissimilar and can be easily distinguishable. A comparison of the Defendant's outer



packaging and the Plaintiff's Product and outer packaging is provided below:

DEFENDANT'S PRODUCT	PLAINTIFF'S PRODUCT
	
<ul style="list-style-type: none"> The well-known trade mark 'DABUR' brand with its logo/device is prominently displayed with the trademark COOL KING, where a device of a crown is above the word 'King'. Image of the bottle and its cap is clearly visible on the front packaging. Defendant uses the descriptive words ठंडा तेल written in Devnagri Script. There is an illustration of a chill tube running through the centre of the packaging with ice crystals made within the tube. A circular golden coloured device containing the word 'UPTO 8 HOURS COOL relaxation' written in red colour is placed next to the chill tube. 	<ul style="list-style-type: none"> In contrast, the Plaintiff displays the device of a 'Saint/Yogi' in a yellow circular device with snow peaked mountains with the words NAVTRANA AYURVEDIC OIL. The background of the packaging also includes artwork of a vine at the top of the label. The Plaintiff has an arrangement of Amla, ice blocks, white flowers and one Hibiscus flower and green foliage in a horizontal manner in the centre of the packaging. A green and yellow coloured line has been represented running from the left to the right side of the packaging segregating the label into two halves. A lighter shade of red is used as the background above the green and



- The Hibiscus flower is placed on the left side of the chill tube, whilst green mint leaves are placed on the right side of the chill tube.
- The words ‘CHILL TUBE WITH PERMINT AND COOLING CRYSTALS’ is written in bold white coloured font below the representation of the chill tube.

yellow coloured line and a darker shade of red is used as the background below the green and yellow coloured line. The words ‘WITH 9 ACTIVE HERBAL INGREDIENTS’ are represented in white coloured font with a white line below it.

6.7 The Defendant has been selling red coloured oil much prior to the Plaintiff’s claimed use of red colored oil. The Defendant secured registration for the Mark ‘DABUR LAL TAIL’ bearing Trade Mark Application No. 282258 in Class 5 dating back to its use to the year 1973. Additionally, the Defendant subsequently launched another red coloured ‘cooling’ oil in the year 2001 under the Mark ‘DABUR HIMSAGAR’ as is evident from the Trade Mark registration for the Word Mark ‘HIM SAGAR’ bearing Trade Mark Application No. 1042487 in Class 5. Furthermore, the Defendant also became the registered proprietor of the label with the Mark ‘DABUR HIM SAGAR THANDA TEL’ bearing Trade Mark Application No. 1143624 in Class 5 in the year 2002. The Defendant has several advertisement campaigns, which are still available on YouTube. In addition, the Defendant is also the registered proprietor of the Device Mark for ‘SUPER THANDA OIL’ bearing Trade Mark Registration No. 1823606 in Class 5. This Court in *Om Logistics v. SH Mahendra Pandey*, Neural Citation: 2022:DHC:930, held that a party that approaches the



Court for a grant of discretionary relief has to come with clean hands and disclose all material facts which would have a bearing on the merits of the case.

- 6.8 It is evident from the aforementioned registrations and continuous use by the Defendant of red coloured oil and red colouring 'cooling oil over the many years, that the Defendant is not new nor a novice in the Ayurvedic red coloured cooling oil category of goods. The fact, that the Plaintiffs company recognizes and publishes the 'DABUR SUPER THANDA' Oil as a major player in the market in their 2007 Annual Report, makes it abundantly clear, that the present suit and instant application ought to be rejected on account of delay and laches as well as on account of acquiescence on behalf of the Plaintiff.
- 6.9 The Plaintiff is not the first adopter and user of the red-coloured packaging for Cooling Hair Oils, another entity, i.e., Himtaj Medicare adopted the red-coloured packaging in the year 1956 for Herbal Cool Oil. Himtaj Medicare, was the first to adopt and introduce illustration of ice / snow and flowers on their Hair oil packaging. Hence, the association of flowers (ingredients) and the effect of the cooling oil represented through ice or snow has been continuously used by several Cooling Hair Oil sellers / manufacturers for decades in the market. Furthermore, Himtaj Medicare also adopted the descriptive words 'COOL COOL' and 'THANDA THANDA' way back in the year 1956 on their label / packaging in order to describe their cooling Hair Oil.



- 6.10 This Court in ***Zydus Wellness Products limited v. Cipla Health Limited***, Neutral Citation: 2023:DHC: 4344 held that the mere use of the green colour on the pack of the normal variant and the orange colour on the pack of the tangy orange variant may not be treated as imitative, as the use of these colour does appear to be common to the trade even on the basis of the various examples cited in the plaint. Similarly, mere use of the red colour by the Defendant does not make the Impugned Trade Dress similar to the Plaintiff's Trade Dress.
- 6.11 The Plaintiff's entire case is based on their alleged prior registration / use / goodwill in the Plaintiff's Product dating back to the year 1989, However, it is clarified that the Plaintiff's registration / use is only qua the Plaintiff's Mark, 'NAVRATNA' bearing registration number 785156 in Class 03 and not for the Plaintiff's Trade Dress. The Plaintiff's use in the of the red trade dress dates back to the year 2016, however, it is clarified without admitting that the said 2016 label / trade dress is different to the Plaintiff's Trade Dress.
- 6.12 The Plaintiff has also made several inconsistent claims with respect to user details in several Trade Mark Applications before the Trade Mark Registry. Further, the Plaintiff has not disclosed that it had filed an Application No. 1120949 for the label mark in Class 5 wherein the Trade Marks Office has specifically disclaimed all descriptive devices and mailer except "NAVRATNA". The descriptive devices specifically included 'THANDA THANDA COOL COOL' device. In



addition to the inconsistencies claimed by Plaintiff before the Trade Marks Registry, registrations of the Plaintiff for their respective labels / device marks are inherently different when compared to the Plaintiff's Trade Dress as sold in the market today.

6.13 The Plaintiff's claim is that the Plaintiff's Product was launched in January 1989 and is recognized among the members of the trade under the Plaintiff's Trade Dress. But what the Plaintiff fails to clarify is that the Trade Dress adopted in the year 1989, is no longer in use nor is the subject matter of the present Suit. As per the Plaintiff's own admission, the use / adoption of the Plaintiff's Trade Dress only dates back to the year 2017, furthermore, the Plaintiff has not secured any registration in support of the Plaintiff's Trade Dress. The Plaintiff is drawing goodwill and reputation from a Trade Dress and catch phrases that are not only substantially different from what it is currently selling in the market, but is attempting to monopolize the common elements of the device of hibiscus flower, ice blocks and the use of descriptive words 'THANDA', 'COOL', 'COOL TEL', and 'COOLING OIL' which are common to trade in the category of 'Cooling Hair Oil' products. This Court in *Red Bull AG v. Pepsico India Holdings Pvt Ltd.*, 290 (2022) DLT 673, held that when the taglines of both the plaintiff and the defendant are of descriptive nature and comprises of common English words then an injunction against the defendant is not warranted.



REJOINDER SUBMISSIONS ON BEHALF OF PLAINTIFF

7. The learned Senior Counsel for the Plaintiff made the rejoinder submissions as under:

- 7.1. The Defendant has neither pleaded nor demonstrated any cogent or *bona fide* commercial rationale for abandoning its prior presentations and converging upon the Plaintiff's Trade Dress. No functional necessity, design lineage, consumer insight, or independent brand architecture has been disclosed to justify the striking proximity of the Impugned Trade Dress. In such circumstances, an adverse inference arises that the adoption is not honest but calculated to deceive as has been held in *Dabur Ltd.* (*supra*).
- 7.2. The Defendant's Product clearly and evidently replicates the Plaintiff's visual grammar, i.e., colour palette, panel architecture, iconography, and placements so closely that coincidence is implausible and deliberate and dishonest imitation is the only reasonable inference. The Defendant's silence on merits fortifies the presumption of slavish copying and warrants restraint, consistent with the decision in *Baidyanath* (*supra*) which happens to be a case involving the Defendant itself.
- 7.3. The governing principle in *Midas Hygiene* (*supra*) is that, in cases of infringement / passing off an injunction must ordinarily follow; and where, *prima facie*, the adoption itself is dishonest, the grant of injunction becomes necessary. The well-settled test in passing off requires the Plaintiff to establish (i)



goodwill, (ii) misrepresentation leading or likely to lead to deception, and (iii) damage or likelihood of damage, the assessment being from the vantage of a consumer of average intelligence and imperfect recollection and upon the overall commercial impression as has been by the Supreme Court in *Corn Products Refining (supra)*, *Cadila Healthcare (supra)*, and *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, AIR 1965 SC 980.

- 7.4. The Defendant's reliance on use of its House Mark 'DABUR' to dispel deception is untenable in law. Passing off is assessed on the overall impression of the get-up at the point of sale and the affixation of a House Mark does not purge misrepresentation where the Trade Dress is deceptively similar. If such a plea were accepted, any copier / infringer could appropriate a rival's packaging and evade liability by merely pasting its logo which is an antithesis of law of Intellectual Property Right protection.
- 7.5. The Impugned Trade Dress is deceptively similar to the Plaintiff's Trade Dress and without limitation, the salient features of the Plaintiff's Trade Dress such as colour of the bottle, colour of the cap of similar flip type, colour of the liquid, colour of the label and content written thereon, the 'V' shape of the bottle, use of *inter alia* red, white, yellow and gold colour combination, use of the words 'Raahat', 'Aaraam' and 'Tarotaazgi' in the same order, use of the same material and texture for the label, various distinguishing elements on label



thereof, outside rectangular red packaging of same size, and adoption of same quantity of the oil, i.e., 270 ml are replicated in the Impugned Trade Dress.

- 7.6. The law of passing off does not require exact identity or side-by-side comparison. What is relevant is the overall similarity in the idea or impression, assessed from the perspective of a consumer of average intelligence and imperfect recollection as has been held in *Cadila Healthcare* (*supra*). Even from the threshold of the settled test, Trade Marks / Trade Dress are judged as a whole, not by a part-by-part dissection. A holistic view yields one result that the Impugned Trade Dress is deceptively similar to the Plaintiff's Trade Dress. The Defendant has offered no *bona fide* reason for shifting from its earlier Trade Dress to the Impugned Trade Dress.
- 7.7. Where there is a transparent attempt to imitate the essential features of another's product, the principle that was derived in *Slazenger & Sons v. Feltham & Co.*, (1889) 6 RPC 531, that if one is driven to conclude that the defendant intends to deceive if possible, the court should not be astute to assume failure, one may credit the man with occasional success. In such circumstances, the court proceeds on the footing that the attempt is likely to succeed, unless convincingly rebutted should be applied. Further, as held in *Munday v. Carey*, (1905) RPC 273, in cases of deliberate imitation the judicial focus must be on similarities rather than dissimilarities. The law



looks at the overall appearance and first impression, not a meticulous, side-by-side dissection.

- 7.8. Accordingly, the intent to cause confusion is *prima facie* apparent. On the *Slazenger* (supra) approach, the Court is entitled to presume that the Defendant's engineered resemblance will achieve its object with the average consumer. On the *Munday* (supra) approach, the dominant similarities overwhelm any minor differences. The plea that a House Mark or trivial distinctions dispel confusion cannot prevail against a designedly similar ensemble.
- 7.9. The Plaintiff's goodwill is longstanding and formidable which is clear as the Plaintiff's Product is being sold since 1989, it enjoys pan-India presence and sustained advertising and is often considered as the market leader in the relevant segment. The registration of the Plaintiff relied upon by the Defendant, *vide* Trade Mark Application No. 1120949 dated 04.07.2002



for the Trade Mark ‘’ with the disclaimer that “Registration of this Trade Mark shall give no right to the exclusive use of the DESCRIPTIVE DEVICES & MATTER



EXCEPT ‘NAVRATNA’ COLOUR CONDITION.” was granted with use claimed since December 13, 1989. The said registration only advances the case of the Plaintiff that the colour scheme of the product and red colour get-up was treated as a distinctive feature of the Plaintiff’s Mark even in 2002.

- 7.10. The annual sales turnover of the Plaintiff in respect of ‘NAVRATNA’ products for the FYs 1990-91 to 2021-2022 are set out in the Plaintiff. The tremendous success of the Plaintiff’s products under the Mark ‘NAVRATNA’ over the years and the ever-increasing goodwill, reputation and recognition associated therewith is evident from the sales turnover which have increased from a figure of ₹14.77 Lakhs in 1990-1991 to ₹585.6 crores in FY2021-22. Further, to buttress the technical arguments raised by the Defendant, the Plaintiff has placed on record an Additional Affidavit dated 14.10.2025, indicating sales for the Plaintiff’s Product aggregating ₹4,927 crores across FY 2009-10 to FY 2024-25.
- 7.11. At the time of the launch of the Defendant’s Product in 2023, the Defendant’s TV / digital advertisement visibly displayed the bottle of the Plaintiff’s Product and portrayed the Defendant’s Product as a like for like replacement on the shelf. This was not incidental. It is an admission, by words and conduct, that ‘NAVRATNA’ is the category referent and enjoys substantial goodwill. Having publicly benchmarked itself against the Plaintiff’s Product, the Defendant cannot now deny the Plaintiff’s goodwill, the advertisement also evidences an intent



to free-ride on that goodwill and reinforces the likelihood of deception. The advertisement of the Defendant is reproduced hereunder for ready reference:



- 7.12. The Plaintiff claims no monopoly in isolation over red colour, herbs or the words 'cool / thanda'. The grievance of the Plaintiff is to the distinctive combination, arrangement and presentation, the ensemble, which has, over decades, acquired secondary meaning in favour of the Plaintiff's Product. The courts protect such composite Trade Dress even if individual elements are commonplace.
- 7.13. Further, the Defendant's own conduct undermines its plea of genericness. The Defendant's own admissions defeat its case. The Defendant claims that the Defendant's Product has an 'eye-catching' and 'distinctive' label / carton and pleads that the packaging 'was an instant hit'. It also avers that it has applied for registration of the Impugned Trade Dress. Having asserted



distinctiveness and sought statutory protection, the Defendant is estopped from contending that such features are non-distinctive or common as has been held in *Automatic Electric Ltd. v. R.K. Dhawan*, 1999 PTC (19) 81 (Del), that applying for registration acknowledges distinctiveness and estops a plea of generic nature. The Defendant cannot approbate and reprobate.

- 7.14. The Defendant's reliance third-party material does not establish commonness. A large part of what is cited comprises label / device marks, proposed-to-be-used applications, lapsed / unrenewed registrations, or registrations bearing disclaimers, and several pertain to other product lines. Mere registry extracts / screen-shots, without proof of substantial, continuous use, are legally irrelevant and the Plaintiff is not under the obligation to sue every small infringer as has been held in *National Bell* (*supra*) and *Pankaj Goel* (*supra*).
- 7.15. The Defendant seeks to divert the controversy to the use of red oil. The Plaintiff claims protection in the Impugned Trade Dress, not the colour of the oil. The 'red oil' narrative is therefore beside the point. Reliance on 'DABUR LAL TAIL' is erroneous as 'DABUR LAL TAIL' is an infant massage oil, outside the cooling-oil segment. The Trade Mark Registration No. 282258 relied on by the Defendant was filed on 21.08.1972 on a 'proposed to be used' basis, the later claim of use since 1973 is inconsistent with the filing basis and unsupported by underlying record. In any event, it does not advance any case on the Impugned Trade Dress.



7.16. The Defendant's reliance on the use and registration of the Mark 'DABUR HIMSAGAR' is misplaced as it was filed on 05.09.2001, which is subsequent to the launch of the Plaintiff's Product, on a proposed to be used basis and no evidence of use in 2001 is shown. The two YouTube videos of the years 2014 and 2016 cited by the Defendant do not prove commercial use, propagation or sales. The product is not available on major marketplaces such as Amazon and Flipkart or on the Defendant's website. The use of the Mark, 'HIMSAGAR' is thus irrelevant and unproven.

7.17. Reliance on 'DABUR SUPER THANDA' with Label registration No. 1823606 in Class 5 dated 21.05.2009 with use claim 20.03.2009 stands subject to disclaimer 'no exclusive right' over 'SUPER THANDA/THANDAK (and other descriptive matter)' and therefore the reliance of the Defendant is misplaced. The Defendant can claim no Trade Mark exclusivity in those words and cannot rely on them to resist the Plaintiff's claim of passing-off. Accordingly, the Defendant's prior use defence is inapposite to the real controversy and should be rejected. The Defendant's use of the products under the Mark, 'HIMSAGAR' were under a completely different Trade Dress than the Plaintiff's Trade Dress and is not relevant to the present issue.

ANALYSIS AND FINDINGS:

8. The controversy in the present Application is restricted to the question as to whether the Impugned Trade Dress used by the Defendant is passing



off the Defendant's Product as that of the Plaintiff's Product. The Plaintiff has restricted the prayer in this Application only for granting injunction restraining the Defendant from using the Impugned Trade Dress on Defendant's Product on the ground of passing off.

9. The passing off is based on similarities of get-up of packaging used by the defendant that amounts to misrepresentation damaging the plaintiff. The plaintiff must prove that the get-up used by the plaintiff is distinctive and the defendant's get-up is similar enough to deceive, notwithstanding any other differences between the two sets of goods. The plaintiff must make out that the defendant's goods are calculated to be mistaken for the plaintiff's goods, and both the goods unquestionably resemble each other and the features that resemble with each other are not common to the trade. The distinctive nature of the features adopted by the plaintiff must be 'eye-catching' and serve to identify the goods of one particular source. The plaintiff must show that the confusion arises from those features of the get-up, which are distinctive to the plaintiff taken in combination with each other. The plaintiff cannot pick and choose the elements of get-up and must be considered as a whole for comparing it with the get-up of the defendant as a whole, including the features which are not be found in the plaintiff's get-up, including the brand names or other marks.

10. The Plaintiff has submitted that the Plaintiff's Product was launched in January 1989 and has been in continuous and uninterrupted use since then. The Plaintiff has also contended that the Plaintiff's Product has a market share of 66% as of 2022 in the cooling oil segment. The Plaintiff has obtained various trade mark, copyright and design registrations to protect the intellectual property in the Plaintiff's Product. The Plaintiff has also spent a



substantial amount of money on the promotion, publicity and advertisement of the Plaintiff's Product in all available media and has spent considerable amount towards such promotion. The Plaintiff has also considerable turnover in respect of Plaintiff's Product, which is considerably increasing every year since 1990-91 to 2021-22. It has increased from ₹14.77 lakhs in the year 1990-91 to ₹58562.25 lakhs in 2021-22.

11. The above submissions on behalf of the Plaintiff shows that the Plaintiff has built considerable reputation and goodwill for the Plaintiff's Product over the time, which is evident from the sales turnover and the marketing expenses incurred by the Plaintiff.

12. It is the case of the Plaintiff that the Plaintiff's Product uses a distinctive red packaging which has been used to sell the Plaintiff's Product for over 30 years across India with only minor modifications to keep with the changing times. The Plaintiff's Product is identified with the shape of the bottle which has the red packaging containing the images of amla, ice blocks, white flowers, one hibiscus flower and the words 'with 9 active herbal ingredients' in white colour fonts with white line below it. It is submitted by the Plaintiff that the Plaintiff's Trade Dress has come to be exclusively identified with the Plaintiff on account of extensive sales, advertisement, promotion and high quality of Plaintiff's Product.

13. The Plaintiff has contended that the Defendant's Product using the Impugned Trade Dress is a deliberate attempt to imitate the Plaintiff's Trade Dress by copying the elements / features to pass off the Defendant's Product as that of the Plaintiff. It is submitted by the Plaintiff that the Impugned Trade Dress leads the consumer to believe that there is an association between the Defendant's Product and the Plaintiff, where none exists. The



Plaintiff has alleged that both the Plaintiff's Product and the Defendant's Product are red in colour, which are packaged in transparent bottles having identical shapes and configuration. The use and placement of hibiscus, ice and ayurvedic herbs on the packaging of the Defendant's Product is identical and deceptively similar to the Plaintiff's Trade Dress leading to confusion and / or deception in the minds of general public.

14. The Plaintiff has relied upon the case of *Dabur Ltd.* (*supra*) to argue that when there is no valid explanation given as to why the Impugned Trade Dress has similarity of essential features, get-up, layout, colour combination and placement of features with the Plaintiff's Trade Dress, the Impugned Trade Dress is liable to be restrained. The Plaintiff has contended that the Impugned Trade Dress is a slavish imitation of the Plaintiff's Product, which is evident from the comparison of sachets of the Plaintiff's Product and the Defendant's Product. It is also contended by the Plaintiff that the Defendant has adopted identical sachets to that of the Plaintiff by using the same terms 'Raahat', 'Aaraam' and 'Tarotaazgi' in Hindi, which is appearing on the sachets of the Plaintiff's Product.

15. The Plaintiff has relied upon *Corn Products* (*supra*), *Heins Italia* (*supra*) and *Cadila Healthcare* (*supra*) to contend that in passing off action, similarities rather than dissimilarities have to be taken note and the colour scheme and overall effect of the packaging have to be seen. The Plaintiff has submitted that the Impugned Trade Dress is completely dishonest and malafide with the clear intention of passing off the Defendant's Product as that of the Plaintiff. The Plaintiff has also relied upon *Midas Hygiene* (*supra*) and *Hindustan Pencils* (*supra*) to argue that if a party for no apparent reasons adopts a deceptively similar trade dress, it would be



difficult to avoid an order of injunction as it is assumed that the adoption was dishonest and indicates that the defendant tried to pass off its goods as those of the plaintiff.

16. The Plaintiff has submitted that the essential features of the Plaintiff's Trade Dress are not common to the trade and are distinctive. It is also contended by the Plaintiff that the fact that the Defendant has claimed that the Impugned Trade Dress is distinctive and has also applied for the trade mark registration on proposed-to-be-used basis, establishes an unequivocal establishment by the Defendant that the Plaintiff's Trade Dress possesses inherent distinctiveness. The Plaintiff has relied upon *Procter and Gamble* (*supra*) to argue that the Defendant cannot dispute the distinctive character of the Plaintiff's Trade Dress as the Defendant itself has claimed that Impugned Trade Dress is distinctive, when the same is essentially identical to and an imitation of the Plaintiff's Trade Dress.

17. The Plaintiff has submitted that the claim of the Defendant of prior use of red oil is not relevant as the said product of the Defendant is not in the cooling oil segment, but it is used for massage oil segment for the infants.

18. *Per contra*, the Defendant has contended that the Plaintiff has failed to establish the trinity test for seeking relief of passing off as the Plaintiff has not been able to establish goodwill with respect to the Plaintiff's Trade Dress, there has been no misrepresentation by the Defendant and the Plaintiff is not likely to incur any damages. The Defendant has also submitted that the prominent house mark of the Defendant 'DABUR' is the distinguishing feature in the Defendant's Product, which dispels any possibility of confusion between the Defendant's Product and the Plaintiff's Product. Further, it was contended that the Plaintiff has multiple variants and



products under the brand, 'NAVRATNA' and the sales figures provided are not exclusive to the Plaintiff's Product using the Plaintiff's Trade Dress in question in the present Suit. It was submitted that to establish goodwill, the Plaintiff must produce sales figures pertaining to the Plaintiff's Product and not the entire 'NAVRATNA' brand. The Defendant relied upon *Soothe Healthcare* (*supra*) to submit that the cumulative sales and advertising expenses of all products under a particular mark without pointing out the goodwill of the particular product in question is not sufficient to establish the goodwill of that particular product. The Defendant also relied upon the decision of the Supreme Court in *Brihan Karan* (*supra*) to submit that it is necessary for the Plaintiff to provide the expenditure incurred on promotion and advertisement of the Plaintiff's Product to establish goodwill.

19. The Defendant also submitted that on a holistic comparison of the Defendant's Product and the Impugned Trade Dress with the Plaintiff's Trade Dress, there are substantial and inherent dissimilarities in the elements and the features. It was submitted that in the case of passing off, the Plaintiff must establish that the Defendant has copied or tried to copy some of the essential features of the Plaintiff's Trade Dress, which are distinctive and associated with the Plaintiff alone, however, the Plaintiff has failed to do so. It was also argued by the Defendant that the red colour is functional in nature and as a result of the ingredients used in producing the cooling oil and, therefore, the Plaintiff cannot claim any right over it as held in *M/s. M.L. Brothers* (*supra*).

20. It was further argued by the Defendant that the features such as hibiscus flower, ice blocks, menthol leaves and descriptive words such as 'thanda', 'cool', 'cool tel' and 'cooling oil' are all common / generic in



nature and common to the trade. It was argued by the Defendant that when the outer packaging of both the Plaintiff's Product and the Defendant's Product are compared as a whole, the products are dissimilar and can be easily distinguishable. It was submitted by the Defendant that the Plaintiff is not the first adopter and user of the red colour packaging for cooling hair oils. The Defendant relied upon *Zydus Wellness (supra)* to argue that mere use of red colour by the Defendant does not make the Impugned Trade Dress similar to the Plaintiff's Trade Dress.

21. Having heard the learned Counsel for both the Plaintiff and the Defendant and considering the material placed on record, the overall comparison of the Defendant's Product with the Plaintiff's Product shows that there is an attempt to imitate the essential features of the Plaintiff's Trade Dress by the Impugned Trade Dress. The Impugned Trade Dress is deceptively similar to the Plaintiff's Trade Dress as the essential features of the Plaintiff's Trade Dress such as colour of the packaging, colour of the cap, colour of the liquid, shape of the bottle and the use of combination of red, white, yellow and gold with the essential features of ice cubes, hibiscus flowers, ayurvedic herbs are copied in the Impugned Trade Dress along with the use of the words 'Raahat', 'Aaraam' and 'Tarotaazgi' in the same order. The common features in the Plaintiff's Trade Dress and the Impugned Trade Dress does not appear to be a mere coincidence. Even the quantity of the oil, i.e. 270 ml is identical in both the Plaintiff's Product and the Defendant's Product. The overall comparison of the get-up at the point of sale creates an impression that the Impugned Trade Dress is an imitation of the essential features of the Plaintiff's Trade Dress. It is not necessary to have exact identity for side-by-side comparison between the Impugned Trade Dress and



the Plaintiff's Trade Dress. It is sufficient if there is an overall similarity in the idea or impression assessed from the perspective of a consumer of average intelligence having imperfect recollection as held in *Cadila Healthcare* (*supra*). A holistic view of the Impugned Trade Dress appears to be deceptively similar to the Plaintiff's Trade Dress. The Defendant has not offered any explanation or bonafide reason for adopting the Impugned Trade Dress having identical features to that of the Plaintiff's Trade Dress.

22. It is settled law that to determine the passing off, the focus must be on the similarities rather than dissimilarities. The overall appearance at first impression is crucial to identify the passing off. The meticulous side-by-side dissection is not necessary and the trade dress has to be judged as a whole. Based on the overall get-up of the Defendant's Product, it is evident that the same is likely to cause confusion as the dominant similarities between the Impugned Trade Dress and the Plaintiff's Trade Dress overwhelm the minor differences. The argument that a well-known house mark will dispel the confusion, cannot be accepted in view of the overall similarity which is evident from the holistic comparison of the Defendant's Product with the Plaintiff's Product.

23. The Plaintiff has *prima facie* established the goodwill by showing the consistent and uninterrupted use of the Plaintiff's Product since 1989. Considering the sales turnover, it indicates that the Plaintiff has long-standing and formidable reputation.

24. The Defendant's Product was launched in 2023 and there is no dispute that the Plaintiff's Product was well established in the market at the time of the launch of the Defendant's Product. Therefore, the Defendant cannot deny the Plaintiff's goodwill or attempt to have a free ride on the same.



25. The Plaintiff cannot claim monopoly on red colour, herbs, hibiscus flower if they are considered individually. However, the distinctive combination, arrangement and presentation resulting in ensemble, which has been in use for a considerable long period has acquired secondary meaning in favour of the Plaintiff's Product. Even though the individual components of the Plaintiff's Trade Dress are common to the trade, the overall get-up of the Plaintiff's Trade Dress requires protection.

26. The Defendant's reliance on third-party material does not disentitle the Plaintiff as the Plaintiff is not required to sue every small infringer as held in *Pankaj Goel (supra)* and *National Bell (supra)*.

27. The Plaintiff has *prima facie* established distinctiveness in the Plaintiff's Trade Dress whereas the Defendant has not been able to establish any distinction between the Impugned Trade Dress and the Plaintiff's Trade Dress. Accordingly, the Plaintiff has been able to establish the ingredients of passing off as per the settled principles of law.

28. Considering the submissions made by the Parties and the case laws relied upon by them, the Plaintiff is entitled to the relief of injunction, and it is directed that the Defendant is restrained from selling the Defendant's



Product, i.e., 'Cool King Thanda Tael' using the Trade Dress, ' ' or



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any other deceptively similar Trade Dress to the Plaintiff's Trade Dress



being .

29. The Application stands disposed of with the aforesaid directions.

TEJAS KARIA, J

JANUARY 31, 2026/AK/sms