



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

**INTERIM APPLICATION (L) NO.28667 OF 2025
IN
COMMERCIAL IP (L) NO.28094 OF 2025
WITH
LEAVE PETITION (L) NO.28708 OF 2025**

Marico Limited

...Applicant/
Ori. Plaintiff

In the matter between

Marico Limited

vs.

M/s. Minolta Natural Care and Others

...Respondents/
Defendants

VISHAL
SUBHASH
PAREKAR

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VISHAL SUBHASH
PAREKAR
Date: 2025.12.09
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Mr. Hiren Kamod a/w. Mr. Nishad Nadkarni, Mr. Aasig Navodia, Ms. Khushboo Jhunjhunwala, Ms. Rakshita Singh, Ms. Jaanvi Chopra i/b. Khaitan & Co., for the Applicant/Plaintiff.
Mr. Anil Goel, for Defendant No. 3.

CORAM : SHARMILA U. DESHMUKH
RESERVED ON : NOVEMBER 18, 2025
PRONOUNCED ON : DECEMBER 9, 2025

ORDER :

1. This is an action for infringement of trade mark, copyright and passing off. By the present application, the Plaintiff seeks interim restraining orders against the Defendants from infringing the Jasmine registered marks, Hair & Care registered marks, by using the impugned Jasmine logo and Hair Protection logo and the impugned labels/packaging or the impugned bottles/containers or anything identical or similar to the Jasmine and Hair & Care registered marks and

Hair & Care registered marks including the logos, packaging/labels and trade dress or any features thereof.

2. The Plaintiff's hair oil products are marketed under the trade mark 'Parachute Jasmine'/ 'Parachute Advanced Jasmine', which was an extension of its house mark "Parachute" since the year 2000. The Plaintiff created a unique and stylized representation of its trade mark



Parachute Jasmine i.e. *Jasmine* called as Jasmine Logo stated to be an original artistic work in which the copyright subsists in the Plaintiff. The Plaintiff has secured trade mark registrations in respect of its device marks Parachute Jasmine/ Parachute Advanced Jasmine set out in paragraph 21 of the plaint and the registration certificates are appended to the plaint. Over period of time, the Plaintiff revised the trade dress by introducing slight variations while retaining its distinctive and essential features, its unique packaging/ label as well as the essential features of the Jasmine artwork and packaging. The specimen table depicted the Plaintiff's labels/packaging as enhanced over the years is set out in paragraph 16 of the plaint. It is submitted that even post the introduction of the revised Logo/Device/ Labels, stocks of the Plaintiff's product sold under the initial packaging/ labels continue to be available and are in circulation in the market to the public at large. It is

submitted that the Plaintiff's Jasmine packaging/ label has been recognized as a well known trade mark by the Bombay High Court.

3. The infringement is also claimed of the Plaintiff's Hair & Care product. It is submitted that the Hair & Care trade mark adopted in the year 1990 for use in respect of hair oils and personal wellness product. In or around the year 2003, the Plaintiff created a distinctive stylized representation of its mark Hair & Care, the copyright in which subsists in favour of the Plaintiff. As in case of the Jasmine products, even the Hair & Care trade dress was modified from time to time while retaining its distinctive and essential features. The copyright in the original artwork subsists in favour of the Plaintiff. In paragraph 36 of the Plaint, the details of the registrations obtained in respect of the word mark as well as the device marks of the Hair & Care trade mark are set out. In order to demonstrate the goodwill and reputation the sales turn over duly certified by the Chartered Accountant has been set out. An indicative list of awards bestowed on the Plaintiff has been set out in paragraph 5 of the Plaint.

4. It is pleaded that in or about July, 2016, the Plaintiff came across the oil products manufactured and marketed by Defendant Nos. 1 and/or Defendant No 3 under the mark "Sangini" bearing labels/trade

dress/packaging which infringed the the Plaintiff's intellectual property rights in respect of its various products including 'Parachute Jasmine/ Parachute Advansed Jasmine" and "Hair & Care".

5. A cease and desist notice was issued on 16th July, 2016 to the Defendant Nos. 1 and 3. The Defendant No.3 indicated its willingness to modify the trade dress of the impugned product and proposed to amicably resolve the matter pursuant to which meeting was held as regards revision of the impugned label/ trade dress. However, there was disagreement between the parties and the settlement talks did not fructify. In and around January, 2021, the Plaintiff once again came across the impugned mark "Sangini Hair Protection" in the market and investigation revealed that Defendant Nos. 1, 3, 4 and 5 are involved along with the Defendant Nos. 7 and 8 in manufacturing and marketing of the impugned product. On 23rd February, 2021, the Defendant No. 6 and the Plaintiff's erstwhile attorneys had a telephonic discussion in which the Plaintiff was informed that the Defendant Nos. 1, 3, 4 and 5 are no longer manufacturing the impugned product. However, the Plaintiff found that the Defendants were continuing with marketing of the products. There was subsequent exchange of correspondence between the parties in which assurances were given for amicable resolution of the dispute.

6. In or about August, 2025, the Plaintiff came across the two impugned hair oil products of the Defendants i.e. "Sangini Jasmine" and Sangini Hair Protection" which according to the Plaintiff infringed the Plaintiff's statutory and common law rights in respect of its product sold under its trade marks Parachute Jasmine/ Parachute Advansed Jasmine and Hair & Care respectively. Hence, the suit came to be filed.

7. The written submissions raise objections as to the territorial jurisdiction and limitation. It is contended that under section 17 of the Trade Marks Act, 1999 the generic or non distinctive element within a composite mark cannot be monopolized individually and the prayers seek relief against infringement of the word "Jasmine" and "Hair & Care", whereas the Plaintiff has no registration in the word "Jasmine" "Hair & Care" per se. It is further contended that Defendant No. 3 uses the word "Jasmine" in the descriptive sense. The essential and distinctive features of the rival packaging of Parachute and Sangini are sufficient to distinguish the respective goods. It is submitted that the word "Jasmine" is *publici juris* and common to the trade and presence of shared or generic work in both marks does not justify finding of deceptive similarity. There is no phonetic, visual or structural resemblance in the rival marks. It is stated that the placement of elements, designs of labels, font styles and emblems differ in material

respects. It is further stated that the Plaintiff has suppressed the fact that various third parties are using Jasmine and Hair & Care in respect of their oil products and that the Defendant No. 3 is the owner of the registered trade mark 'Sangini'.

8. Mr. Kamod, learned counsel for the Plaintiff has taken this Court through the registration certificates in respect of the Plaintiff's registered trade marks, as well as the pleadings pertaining to the registration of trade marks and copyright in the original artwork. He would point out the unique and distinctive trade dress in which the products are marketed under the registered trade marks depicted in stylised distinctive manner which is associated with and identified by the members of the trade as proprietary to the Plaintiff. He would submit that the original artwork in respect of the Jasmine products and Hair and Care products is created at the instance of the Plaintiff and is in use since last several years. He submits that the even the modified packaging/ label of the Plaintiff's products have retained the essential and leading features of the Plaintiff's registered trade marks. He submits that the Defendant's infringing activity were noticed in July, 2016 pursuant to which three cease and desist notices were issued pursuant to which there were discussion between the parties in which repeated assurances were given by the Defendants that they would

cease their wrongful activities. He submits that it is for that reason no immediate action was taken by the Plaintiff and it is only in August, 2025 the Plaintiff came across the impugned product of the Defendants 'Sangini Jasmine ' and the 'Sangini Hair Protection' that the present suit has been filed.

9. He would draw a comparison between the rival products to contend that the impugned products unauthorizedly bear the impugned marks/ Jasmine logo/Hair and Care logo which in overall context of things is identical to the Plaintiff's registered marks depicted in a pirated artwork.

10. As to the objections on jurisdiction, Mr. Kamod points out Section 134 of the Trade Marks Act and Section 62 of the Copyright Act which confers jurisdiction of this Court. He submits that the suit is not barred by limitation as the infringing activities are continuing in nature giving rise to continuous cause of action. He would submit that the delay by itself is no defense to an infringement action.

11. He submits that there is no explanation or justification given by the Defendants for adoption of the deceptively similar impugned marks/ logos / trade dress. He would further submit that there is no bar

under section 17(2) of the Trade Marks Act to seek protection of the leading and essential features of the registered mark and the Defendants have not shown that the essential features are non-distinctive. He would further submit that the Defendants have sought to contend that the mark "Jasmine" is *publici juris* and common to the trade without demonstrating its extensive use. He submits that the Defendant's use of the word Jasmine is not descriptive as the manner of use of the mark on the impugned product makes it evident that the Defendants are using the same in trade mark sense. He would further submit that the Defendants are using the descriptive phrase at the bottom of the pack i.e. 2X Jasmine/Coconut which demonstrates that the mark Jasmine used in isolation depicted on the product is used in trade mark sense.

12. He would further point out the details of Defendants trade mark registrations set out at paragraph 67 of the Complaint to contend that there is no suppression. He would submit that the contention that 'Sangini' is leading and essential feature is sufficient to distinguish the Defendant's product to that of the Plaintiff is false and incorrect as the manner of use by Defendant shows that prominence is given to the word "Jasmine" and Hair Protection and the presence of the word 'Sangini' is not sufficient to distinguish the Defendant's product from that of Plaintiff.

13. He submits that the impugned products adopts almost all features of the registered marks/labels/containers of the Plaintiff in respect of identical goods which shows an intent to ride upon the Plaintiff's goodwill and reputation. He would further submit that Plaintiff is the registered proprietor of the word mark 'Hair & Care' which has been registered since 2016 with the user claim of 1991. He submits that disclaimer in respect of some of the Plaintiff's registrations does not limit the rights of the Plaintiff to sue from infringement. He would submit that the Plaintiff has demonstrated *prima facie* case, long standing user and the balance of convenience is in favour of the Plaintiff. He submits that irreparable harm, loss and injury would be caused as there is dishonest adoption in use of the impugned marks/ labels and tilts the balance of convenience in favour of the Plaintiff. In support, he relied upon the following decisions :

(1) Colgate Palmolive Company and Anr. vs. Anchor Health and Beauty Care Pvt. Ltd.¹

(2) Tata Tea Limited vs. Suruchi Tea Company and Anr. ²

(3) Sky Enterprise Private Limited vs. Abaad Masala & Co.³

(4) Pidilite Industries Limited vs. S.M. Associates and Ors.⁴

(5) Jagdish Gopal Kamath and Ors. vs. Lime & Chilli Hospitality

1 2003 SCC OnLine Del 1005.

2 2003 Vol. 105 (3)Bom L.R. 241.

3 2020 SCC OnLine Bom 750.

4 2003 SCC OnLine Bom 143.

Services⁵

(6) Dr. Ashok M. Bhat vs. Sandeep Udai Naraian Gupta and Anr.⁶

(7) Ultra Tech Cement Limited vs. Alaknanda Cement Private Limited and Another⁷

(8) Marico Limited vs. Zee Hygiene Prodcuts Pvt. Ltd. & Ors.⁸

(9) Pidilite Industries Limited vs. Riya Chemy⁹

(10) Encore Electronics Limited vs. Anchor Electronics & Electricals Private Limited¹⁰

(11) Bengal Waterproof Limited vs. Bombay Waterproof Manufacturing Co. & Anr.¹¹

(12) Amritdhara Pharmacy vs. Satya Deo Gupta¹²

(13) Skol Breweries Limited vs. Som Distilleries & Breweries Limited and Another¹³

(14) Midas Hygiene Industries (P) Ltd. vs. Sudhir Bhatia and Ors.¹⁴

(15) Pidilite Industries Limited vs. Zar Metamorphose Combine Pvt. Ltd.¹⁵

5 2015 SCC OnLine Bom 531.

6 2025 SCC OnLine Bom 2177.

7 2025 SCC OnLine Bom 783.

8 2025 SCC OnLine Bom 2541.

9 2022 SCC OnLine Bom 5077.

10 2007 SCC OnLine Bom 147.

11 (1997) 1 SCC 99.

12 1962 SCC OnLine SC 13.

13 2011 Vol. 113(5) Bom. L.r. 3257.

14 (2004) 3 SCC 90.

15 2020 SCC OnLine Bom 2382.

(16) Pidilite Industries Limited vs. Innovation Coatings Pvt. Ltd.¹⁶

(17) Pidilite Industries Limited vs. Jubilant Agri & Consumer Products Ltd.¹⁷

(18) Laxmikant V. Patel vs. Chetanbhai Shah and Anr.¹⁸

(19) Abdul Rasul Nurallah Virjee and Anr. vs. Regal Footwear¹⁹.

14. Mr. Goel, Learned counsel for the Defendant No 3 submits that this Court would not have the territorial jurisdiction to enter into the present proceeding as the Defendants are located in Delhi. He would submit that the ad-interim relief is sought after a period of 9 years as it is an admitted case of the Plaintiff that in 2016 the Plaintiff came to know about the existence of the Defendants. He would submit that there is no urgency and time be granted to file reply affidavit. He would further point out the prayer clause in the Interim Application and would submit that the injunction is sought against the word “Jasmine” and pointing out to the disclaimer issued by the Registrar while registering the device mark, he submits that the Plaintiff does not have any exclusive right to use the word “Jasmine” as the same is generic. He would further submit that similarly in the case of ‘Hair & Care’ product

16 2025 SCC OnLine Bom 1543.

17 2014 SCC OnLine Bom 50.

18 (2002) 3 Supreme Court Cases 65.

19 2023 SCC OnLine Bom 10.

the registration of the word mark 'Hair & Care' comes with a disclaimer that the registration given any right to any exclusive use of the word 'Hair & Care'. He submits that the case has been made out by the Plaintiff in the plaint is of user since 2022 in respect of Jasmine product and in respect of Hair & Care of adoption in or about March, 2024. He submits that the Defendant No 3 is using the mark since 2016 and is a prior user. He would further submit that the Defendant No 3 is using the mark 'Sangini Jasmine' which is distinct and separate from 'Parachute Jasmine'/'Parachute Advanced Jasmine' and the added features are sufficient to distinguish the goods of the Defendants from that of the Plaintiff. In support he relies upon the decision of ***Pernord Ricard India Private Limited vs Karanveer Singh Chhabra (2025 SCC OnLine SC 1701)***

15. In rejoinder, Mr. Kamod submits that what is sought is restraining order from infringing the Jasmine registered mark, the Jasmine logo, the impugned label/ packaging/ impugned bottle containers which is deceptively similar and also in respect of Hair & Care against the infringement of the Hair & Care registered trade mark. He would submit that the use of the Jasmine registered mark as well as Hair and Care product is not from 2022 and 2024 respectively as is erroneously sought to be contended, as the plaint demonstrates the minor modifications in

the trade mark from time to time for the purpose of comparison.

16. I have considered the submissions and perused the record.

17. Dealing first with the Leave Petition, the Petition seeks leave under Clause XIV of Letters Patent for combining the cause of action of passing off with the cause of action for infringement of trade mark and copyright. The Petition pleads that the Petitioner carries on its business in Mumbai and has its head office and principle place of business in Mumbai. It is further pleaded that the impugned products are being advertised and offered for sale within the jurisdiction of the Court through e-commerce websites and even if the impugned products have not entered the Mumbai markets, leave may be granted.

18. The Defendant has not filed its reply affidavit and has only tendered the written submissions without any documents annexed thereto. It is submitted that the Defendants are neither residing nor working nor has any shop, office or dealer in Maharashtra and no invoice has been placed to show that the impugned products are sold in Maharashtra.

19. In so far as the action for infringement of trade mark and

copyright is concerned, Section 134 of the Trade Marks Act, 1999 and Section 62 of Copyright Act, 1957 gives jurisdiction to the Court within the local limits of whose jurisdiction, the person instituting the suit or proceedings actually and voluntarily resides or carries on business or personally works for gain. The Plaintiff's head office is situated in Mumbai, which gives this Court the jurisdiction to entertain and try the suit for infringement of trade mark and copyright. In so far as the action of passing off is concerned, the same is a common law remedy and jurisdiction lies with the Court where cause of action has arisen or Defendant resides or carries on business. Clause XIV of Letters Patent (Bombay) permits the joinder of causes of action in one suit in case of several causes of action. The Defendant is required to show why the several causes of action i.e. the cause of action for infringement of trade mark/copyright and passing off should not be joined together in one suit. From the submissions, I do not find any reason as to why the causes of action should not be joined together as the proceedings arise out of same set of transaction. Declining leave under Clause XIV would result in the suit for infringement of trademark and copyright to be entertained by this Court and the suit for passing off to be instituted in the Court where the cause of action arises or Defendant resides or carries on business. There is no requirement of obtaining leave under Clause XII of Letters Patent (Bombay). The proceedings arise out of

same set of transactions and artificial splitting of causes of action is undesirable. In view thereof, Leave under Clause XIV of Letters Patent(Bombay) is granted for combining the cause of action for passing off with the cause of action for infringement of trade mark and copyright.

20. Mr. Goel has opposed taking up the interim application for final disposal on the ground that there is no urgency and considering that writ of summons has not yet been served upon Defendants, the reply Affidavit could not be filed. The previous orders would indicate that the Defendant No 3 has caused appearance through an Advocate on 29th September, 2025 and had sought time for exploring the possibility of settlement. The said order records that if there is no amicable resolution as a whole of the Suit, the Interim Application shall be taken up for final hearing. The matter was thereafter adjourned from time to time and on 7th October, 2025, learned counsel for Defendant No. 3 sought time to file affidavit in reply which was permitted to be filed on or before 14th October, 2025. Despite time being granted for filing affidavit in reply, there is no affidavit in reply which has been filed. I am therefore not inclined to grant any time for filing of reply affidavit when the parties were put to notice that the application would be taken up for hearing.

21. The defence of formal service of writ of summons is not available to a party who has caused appearance on its own in the proceeding way back on 29th September, 2025. Even at the commencement of the hearing, it was made clear that the interim application would be taken up for final hearing and extensive submissions were canvassed. It is no longer open for the Defendant No 3 to contend that in the absence of formal service of summons, there cannot be said to be any notice to Defendant No. 3. Once the appearance has been caused by Defendant No. 3, formal service of writ of summons is not mandatory.

22. Getting the aspect of the suit being barred by limitation out of the way first, the infringement of trade mark, copyright and passing off gives rise to recurring cause of action to the Plaintiff. [***See Bengal Waterproof Limited vs Bombay Water proof Manufacturing Company & Another***(supra)]

23. Coming to the Interim Application filed under Order 39 Rule 1 and 2 of CPC, the relief sought in prayer clause (a) and (b) is against the infringement of the Jasmine and Hair & Care registered marks and from using the impugned marks/logos/labels/packaging /bottles/containers. The prayer clause in the interim application makes a broad reference to the Jasmine registered marks and Hair and Care registered marks, which

is required to be read in the context of the pleadings. There are detailed pleadings in the plaint about the origin of the trade marks “Parachute Jasmine/Parachute Advansed Jasmine” , the Jasmine logo which is an original artistic work, the trade mark “Hair & Care”, the Hair and Care logo, the unique and distinctive trade dress and bottles/containers depicting the distinctive logos/device marks. Paragraph 62 of the plaint pleads that the Defendant’s impugned products unauthorizedly bear the impugned mark Jasmine and Hair Protection which mark/logo is, including in the overall context of the things, identical to the Plaintiff’s registered logos as well as its stylized representation and also unauthorizedly bears devices/labels/packaging/trade dress which is identical/deceptively similar and a substantial reproduction of the Plaintiff’s registered marks, logos, artwork, packaging/labels including the features thereof, the distinctive bottles/containers, unique colour scheme etc.

24. As I read the prayer clauses, the Plaintiff assails the infringement of the registered trade marks of which the words Jasmine and Hair & Care respectively forms the essential and leading feature depicted in a distinctive trade dress comprising of distinct colour scheme and marketed in unique shaped bottles/containers. It is the totality of the device marks of Parachute Advansed Jasmine and Hair & Care device

marks which is stated to be infringed and not any individual element thereof.

25. There is no debate about the proprietary right of the Plaintiff's trade marks Parachute Jasmine Advansed and Hair & Care which is *prima facie* demonstrated by the registration certificates placed on record. There is no challenge to the validity of these registrations and Section 30 of the Trade Marks Act, 1999 provides for the registrations to be *prima facie* evidence of the validity thereof. Unless the registrations are demonstrated to be invalid, the statutory protection is required to be extended to the registered trade marks giving the Plaintiff the exclusive right to use the registered trade marks and to obtain relief against the infringement. There is no submission canvassed to dispute the Plaintiff's copyright ownership in the original artworks.

26. Broadly summarizing the aspects to be considered while adjudicating an action for infringement of trademark, copyright and passing off, in an action for infringement of trade mark, what is required to be shown is that the impugned mark is identical/deceptively similar to the registered trade mark and is used in course of trade by the Defendant in a manner as to render the use of the mark likely to be taken as being used as trade mark which is likely to cause confusion or

likely association with the registered trade mark. Once it is shown that there is deceptively similarity, the registration by itself affords the right to seek protection and no further evidence of confusion or deception is necessary. For an action of copyright infringement, It is sufficient to *prima facie* establish that the impugned trade dress/label/packaging is substantial reproduction of the Plaintiff's label and there is no necessity of the impugned artwork being a replica of the original artwork.

27. For passing off action the classic trinity test requires proof of existence of goodwill and reputation in the mark, misrepresentation by the Defendant and likelihood of damage to the Plaintiff's goodwill is required.

28. The requirements as indicated above overlap to a certain extent and deceptive similarity assists the case of infringement as well as passing off with the distinction that if the Defendant is able to show that the added material is sufficient to distinguish the Defendant's product from that of the Plaintiff, no relief of passing off can be granted. It is well settled that the consideration of aspect of deceptive similarity requires comparison of the marks as wholes i.e. the anti-dissection rule. It is therefore necessary for a comparative visual analysis of the rival marks for a *prima facie* finding of deceptive

similarity of the kind which would have the propensity of misleading or confusing an average consumer with imperfect recollection. Whilst doing so it is also necessary to bear in the mind the Cadilla principles that minor differences may be insufficient if the overall impression conveyed by the marks is likely to deceive or cause confusion. The applicable test is not one of exact or absolute similarity, but whether the essential and distinctive features of the Plaintiff's mark have been appropriated by the Defendants in a manner likely to mislead or confuse the average consumer.

29. With these principles in mind, the rival products are reproduced hereinbelow for sake of comparison:

Plaintiff's products	Defendants' products
	



30. *Prima facie* comparison of rival products would indicate that in so far as Parachute Advanced Jasmine product is concerned, the Plaintiff's product is marketed in unique shaped transparent bottles with the colour scheme of white and blue and the container having a blue cap. The Plaintiff's product bears the house mark of Parachute with the palm tree in flag device with the words 'Advanced' written under the said mark and the word 'Jasmine' written prominently in a unique stylized form. The product depicts the face of a model with string of Jasmine flowers on the left side of the bottle in semi circular shape, two half coconuts and the words 'non-sticky coconut hair oil' written at the base of the bottle.

31. The Defendant's identical goods i.e. hair oil is marketed in a similar shaped transparent bottle having white and blue colour scheme and the container having a blue cap. The mark 'Sangini' is depicted on the bottle in negligible font with the word 'Jasmine' written in deceptively similar stylized manner prominently below the mark 'Sangini'. The product depicts the face of a model with a string of Jasmine flowers on the right side of the bottle in circular motion with three half coconuts and the words "2X Jasmine Coconut Oil" written next to the half coconuts. The Defendants also markets its product in a slightly modified trade dress containing the identical colour combination in identical bottle with face of model and the word Jasmine written prominently with two half coconuts and the words "2X Jasmine Coconut Oil" written next to the half coconuts.

32. The Plaintiff depicts its registered trade mark i.e Parachute Advanced Jasmine in a unique manner with each word of its registered trade mark written one below the other. By this manner of use, what immediately strikes the eye is the word Jasmine written prominently in a distinctive stylized font . The Defendants have copied this manner of use of the mark and usage of the word Jasmine is *prima facie* in a manner which can only be considered as an attempt to come as close as possible to the Plaintiff's registered trade mark.

33. In so far as the Hair & Care product is concerned, the Plaintiff's product is marketed in unique shaped bottle with a green cap depicting the face of model on the uppermost part of the bottle followed by coloured stripes beneath which Hair & Care is written in a stylized manner whereas the Defendant's identical product of hair oil is depicted in similar shaped bottle with green cap with the face of the model on the upper part of the bottle followed by colour stripes below which the word 'Sangini' is written followed by the mark 'Hair Protection'. The word "Hair" is written in identical stylized manner with prominence given to the word "Hair" and the word "Protection" written in negligible font. In respect of this product also, the Defendants uses another trade dress where the only difference is that the face of the model is depicted on the lower portion of the bottle followed by the colour stripes.

34. The manner in which the marks are used by the Plaintiffs makes the word Jasmine and Hair & Care its leading, essential and prominent feature which deserves protection.

35. According to Kerly's Law of Trade Marks and Trade (9th edition, paragraph 838) which was noted by the Hon'ble Apex Court, in the case of **Parle Products Private Limited vs. J. P. & Co.**,²⁰

"Two marks, when placed side by side may exhibit many and

²⁰ 1972 1 SCC 618.

various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark and not having two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, in the belief that he was dealing with the goods which having the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark will show the players in different dress, and in very different position and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that person dealing with trade mark goods and relying, as they frequently do, upon marks, should be able to remember the exact details of the mark upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impression or by some significant detail, then by any photographic recollection of the whole.” .

36. The learned author has captured the essence of the trade mark law, when it considers the aspect of infringement from the point of view of an average consumer as marks are remembered by general impression rather than by photographic recollection. This is especially applicable in case of daily use products as the relevant consumers base may not pay particular attention to each and every component of the marks and is most likely to be swayed by the general impression conveyed by the marks. The average consumer who may not be well informed is likely to look at the striking features of the mark, the overall trade dress and connect the same with the known product. In such circumstances, in my view, there is *prima facie* likelihood of confusion being caused by reason of deceptive similarity. In the present case, the

rival products will be traded through the same trade channels and will be displayed in the same segment in the shops and likely to be bought off the shelf. The purchasers of these kind of products transcend all strata of society and considering the overall deceptive similarity is likely to be confused when confronted with the rival products.

37. The written submissions though state that there are number of distinguishing features on the pack of the Defendant's product, none are set out in specific details. The depiction of the different brands i.e. parachute and sangini is not capable of distinguishing the rival products firstly for the manner in which the house mark is displayed on the product and secondly that a granular comparison of the trademarks is not contemplated and what applies is the test of first impression. The Hon'ble Apex Court in ***Pernod Ricard India Private Limited vs Karanveer Singh Chhabra*** (supra) has held that an intent to deceive is not a necessary element in either infringement action or passing off action, however, passing off action requires proof of likelihood of confusion or deception and actual deception or damage need not be proved. *Prima facie* upon comparison of the rival products and by applying the overall similarity test and the anti dissection rule, in my view, the impugned marks are deceptively similar to the Plaintiff's marks and are depicted in trade dress/layout which is substantial

reproduction of the Plaintiff's original artwork. The placement of the elements of the label mark, the colour combination, the stylized representation of the mark are deceptively similar and likely to cause confusion amongst the relevant consumer base.

38. The goodwill and reputation of the Plaintiff is demonstrated from the sales figure of Parachute Advanced Jasmine which for the year 2017-2018 was Rs 28,347,00,000/ and the advertisement expenses were 3,404,00,000/. Whereas the sales figure of Hair and Care product for the financial year 2016 was Rs 17,093,00,000/ and promotional expenses were 2,422,00,000/.

39. There is no explanation tendered by the Defendants for adopting the deceptively similar mark in an artwork which is substantial reproduction of the Plaintiff's original artwork and gives a *prima facie* impression that the Defendant has attempted to come as possible to the Plaintiff's products. In an action for passing off, the Defendant is required to prove that the added material is sufficient to distinguish the goods of the Defendants from that of the Plaintiff which is not demonstrated in the present case. The contention that Sangini is the leading and essential feature which is sufficient to distinguish the Defendant's product from that of the Plaintiff, is unacceptable in view

of the manner in which the house mark Sangini is displayed on the packaging which is in a smaller font as compared to the word Jasmine and Hair Protection which are depicted prominently and has been designed in a manner so as to be strikingly visible to the consumer. An average man with imperfect recollection is likely to look at the product as a whole and would not be in a position to discern the minor differences in the rival marks/packaging. The depiction of the house mark in negligible font is insufficient to distinguish the rival products when considered in the scheme of overall similarities of the rival marks/artworks. The attempt to come as close as possible to the Plaintiff's registered mark/trade dress *prima facie* constitutes misrepresentation.

40. The value of a distinctive trade mark and trade dress is its ability to be a brand identifier and be able to stimulate sales which is likely to be impacted by use of deceptively similar trade mark/trade dress/label. It is a matter of commercial honesty that no trader shall be permitted to sell its products as that of other trader. Such conduct of business is likely to cause damage to the Plaintiff's reputation and goodwill and impact its sales. Being late entrant in the market, the Defendants cannot be permitted to ride upon the Plaintiff's reputation and goodwill. Though it is sought to be contended by the Defendant No 3,

that the Plaintiff's products were introduced in the year 2022 and 2024, the submission is misconceived as the adoption and use is prior in point of time. It is only the labels which have been revised from time to time while retaining the essential features of the registered trade marks.

41. The assertion of the Plaintiff's rights in its registered trade marks is sought to be opposed on the ground of disclaimers in the registrations. The earliest registration of the Parachute Jasmine device mark was secured by the Plaintiff on 11th November, 2005. The registration was granted with the disclaimer which reads thus : "Registration of this trade mark shall give no right to the exclusive use of no exclusive to use logo". The meaning of such disclaimer is incomprehensible. The subsequent registration of Parachute Jasmine device mark applied on 14th August, 2000 was of the revised device mark, which was registered with the disclaimer that the registration of this trade mark shall give no right to the exclusive use of the words "Jasmine" and "Flower". The device marks upon being modified was again submitted for registration on 25th February, 2000 and was granted registration with the disclaimer that the registration of this trade mark shall given no right to the exclusive use of 'Jasmine Dev', which again appears to be erroneous as there is no word "Dev" in the Plaintiff's mark. The device mark was revised again by the Plaintiffs in the year

2011 which was granted registration without any disclaimer.

42. Similarly, in respect of Hair & Care registered mark, the registration the year 1997 of the device mark of Hair & Care contains similar disclaimer against the right of exclusive use of the word 'Hair & Care'. The revised label of Hair and Care was applied in the year 2003, which was granted registration with the disclaimer that registration shall give no right to the exclusive use of all other descriptive matter appearing on the label. In respect of Plaintiff's Hair & Care registered mark, the registration numbers 3429323 as well as 2309799 which include the logo 'Hair & Care' does not contain any disclaimer.

43. The position is that some of the Plaintiff's marks were registered with disclaimers which led to the defence that no exclusivity can be claimed in the word "Jasmine" and "Hair & Care" per se. Firstly the word "Hair & Care" per se has been granted registration. While considering the impact of the disclaimers, it would be relevant to note the decision of the Co-ordinate Bench of this Court in the case of **Pidilite Industries Limited vs. S.M. Associates** (supra) where the Court was considering the rival marks "M Seal vs. S M-Seal. The submission canvassed in that case was that as there was disclaimer of the word "Seal", the word

“Seal” must be ignored. The Court held that despite a disclaimer in respect of the word ‘Seal’, what has to be considered is the whole of the Plaintiff’s mark including the disclaimed matter while deciding the question of infringement. It noted that there would remain an equal degree of possibility of deception and confusion, as the public, being oblivious to the disclaimer would not analyze the marks. It noted the observation from Granada Trade Mark 1979 (13) RPC 303 that a disclaimer does not affect the significance which a mark conveys to other when used in course of trade. Disclaimers do not go into the market place, and the public generally has no notice of them. The matter which is disclaimed is not necessarily disregarded when question of possible confusion or deception of the public, as distinct from the extent of proprietor’s exclusive rights, are to be determined.

44. Similarly, in the case of **Pidilite Industries Limited vs. Riya Chemy** (supra), the Co-ordinate Bench following the decision in the case of **Pidilite vs. S. M. Associates** (supra), noted that while comparing the rival marks, attention is to be given to the common features rather than the differences in essential features and that trivial and non distinctive matters do not sufficiently distinguish the rival mark.

45. No law to the contrary has been shown to persuade thie Court

that by reason of disclaimers in some of the registrations, the overall similarity test is required to be applied by disregarding the disclaimed word.

46. The next defence is under Section 17 of Trade Marks Act by contending that in respect of composite marks, no exclusivity can be claimed in part of the mark which is not separately registered. Section 17(1) of the Trade Marks act provides that when a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trademark taken as a whole. Sub Section 2 of Section 17 provides that notwithstanding anything contained in sub-section (1) when a trade mark contains any part which is not subject of separate application for registration as trade mark or which is not so separately registered or contains any matter which is common to the trade or is otherwise of a non distinctive character, the registration shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

47. The provisions of Sub Section 2(a) (i) and (ii) and Sub Section 2(b) of Section 17 were considered in the decision of ***Ultratech Cement Ltd vs Alaknanda Cement Pvt Ltd*** (supra), where the rival marks were Ultratech Cement vs Ultratuff Cement. The Court held that the

registration of the Plaintiff's mark without any disclaimer shows that the word Ultratech is distinctive mark and though Ultratech is not separately registered, the same being distinctive is not hit by Section 17(2). The Court noted the finding in **Three-N-Products Private Ltd vs Emami Ltd** which had held in paragraph 35 as under:

" 35. The words "the registration thereof shall not confer any exclusive right" towards the end of Section 17(2) have to be understood in the context. The import of such words is that the registration of the composite mark will not ipso facto confer any exclusive right as to the parts of the composite mark. But if the owner can establish exclusivity aliunde, the owner can assert the exclusivity. The registered owner is entitled to protection of its goodwill in such prominent feature as in action for passing off unless the registered owner seeks to rely on Section 17(2)(b) of the Act in respect of distinctive matter not common to the trade."

48. In case of **Pidilite Industries Limited vs Jubilant Agri & Consumer Products Limited** (supra), the use of word marine was common to the rival marks and defence taken was that the word marine is descriptive. The Co-ordinate Bench held that there is no absolute/total or complete bar to the registration of a common word and the correctness of the registration has been conceded leading to grant of interim relief.

49. In case of **Pernord Ricard India Pvt. Ltd. vs Karanveer Singh Chhabra**(supra), the Hon'ble Apex Court held in Para 32.3 as under:

“Consequently, in dispute involving composite marks, the mere presence of a shared or generic word in both marks does not, by itself, justify a finding of deceptive similarity. Courts must under take a holistic comparison examining visual, phonetic, structural and conceptual elements, to assess whether the overall impression created by the rival marks is likely to mislead an average consumer of ordinary intelligence and imperfect memory. If the marks, viewed in totality convey distinct identities, the use of common element particularly if it is descriptive or laudatory, will not by itself amount to infringement.”(Emphasis supplied).

50. The Hon’ble Apex Court has held that the mere presence of generic words taken in isolation will not justify a finding of deceptive similarity. The Plaintiff’s case of infringement is based on the totality of impression conveyed by the rival marks and not the use of the words Jasmine and Hair & Care by itself. The registration of the Plaintiff’s marks without disclaimers *prima facie* imparts distinctiveness to the marks.

51. The Defendants have not placed any cogent material on record to show that the marks are non distinctive and common to the trade. There is not even a Reply Affidavit on record so to speak. The written submissions *sans* any material is insufficient to prove such extensive use of the word Jasmine and Hair and Care that by reason of that wide usage, the words have passed into the realm of generic to the extent that they can no longer be said to describe any particular purveyor or

user. **[See Jagdish Gopal Kamath & Ors vs Lime & Chilli Hospitality Services** (supra)]. The defense of the marks, being *publici juris* and common to the trade dis-entitling the Plaintiff to seek any exclusive right in view of Section 17 of the Trade Marks Act, 1999 must fail.

52. The next defense that the word Jasmine being *bonafide* description of the character and quality of the goods of the Defendant No 3 based on Section 35 of the Trade Marks Act is unacceptable as the word "Jasmine" is not used by the Defendants in descriptive sense. The word Jasmine appears prominently on the impugned product below the house mark of Sangini which is depicted in smaller font. The manner in which and the prominence with which the Jasmine is depicted on the packaging indicates that the same is used in the trade mark sense. The fact that the Defendant uses the words 2X Jasmine/Coconut at the bottom of the pack in addition to the mark Jasmine, indicates that the word Jasmine is used in a trade mark sense.

53. In so far as the issue of delay is concerned, it is well settled that delay by itself is not a defence to an infringement action. The plaint has set out the entire sequence of events that had taken place after acquiring knowledge of the Defendant's infringing activities. Several communications were exchanged between the parties resolving to

amicable settle the issue, revised labels were exchanged for approvals etc. Apart from the fact that delay is not a defence *per se* in infringement action, the pleadings *prima facie* demonstrates that the Plaintiff after being aware of the infringing activities has not remained idle and had taken steps by issuing of cease and desist notices, conducting meetings for settlement etc. [(***See Midas Hygiene Industries P Ltd vs Sudhir Bhatia and Others. (supra)***).

54. The well settled legal principles governing the grant of injunction are making out a *prima facie* case, likelihood of confusion, relative merits of the parties claims, balance of convenience, risk of irreparable harm and public interest. Applying these well settled principles to the facts of the present case, the Plaintiff's prior adoption and registration of the trade marks have been *prima facie* proved. The impugned marks are *prima facie* deceptively similar to the registered trade marks and are depicted in artworks which are substantial reproduction of the original artworks. There is no acceptable explanation tendered for adoption of the deceptively similar trade marks depicted in pirated artwork for this Court to come to a finding of honest and bonafide adoption and indicates misrepresentation. The Plaintiffs have made out a *prima facie* case for grant of injunction. The Hair and Care and Jasmine marks have been adopted by the Plaintiffs in the year 1990 and 2000 respectively.

The Defendants being in the same trade ought to have knowledge about the Plaintiff's registered trade marks/ trade dress and ought to have exercised caution before adopting the deceptively similar impugned trade marks. The overall comparison of the rival marks conveys an impression of deceptive similarity which is likely to cause confusion amongst the relevant consumer base.

55. The Plaintiff's goodwill and reputation is demonstrated from its sales figures, advertising expenses as well as the awards bestowed on the Plaintiffs. The balance of convenience is in favour of the Plaintiff and the usage of the infringing marks are likely to harm the Plaintiff's goodwill and reputation.

56. In light of the above, Interim application is allowed in terms of prayer clauses (a) to (f).

(SHARMILA U. DESHMUKH, J.)