

THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Reserved on: 8th November, 2011
Judgment Pronounced on: 17th November, 2011

+ CS(OS) 516/2004

THE PROCTOR & GAMBLE CO. & ANR. Plaintiffs
Through: Mr. Pravin Anand, Adv.
versus

SHIPRA LABORATORIES: Defendants
(Through: Mr Trailesh Patel)
Through: None.

CORAM:-
HON'BLE MR JUSTICE V.K. JAIN

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| 1. Whether Reporters of local papers may be allowed to see the judgment? | No |
| 2. To be referred to the Reporter or not? | No |
| 3. Whether the judgment should be reported in Digest? | No |

V.K. JAIN, J

1. Plaintiff No.1 is a Company registered in USA, whereas plaintiff No.2 is a Company registered in India. Plaintiff No.2 has been licensed by plaintiff No.1 to sell and distribute its products in India. The plaintiff Companies are engaged in manufacture and sale of various products including perfumery, cosmetics, toilet preparations and goods, essential oils, anti perspirants, dentifrices, shampoos, toilet oils, toilet articles etc. and are selling their

products under various trademarks including the trademark 'SAFEGUARD' which is being used in respect of toilet soaps. The trademark 'SAFEGUARD' was registered in USA on 19th May, 1964 and is stated to be registered in 90 other countries including India. In India, the trademark 'SAFEGUARD' is registered in favour of the plaintiff in class 3 vide registration No.867980, with effect from 26th July, 1999. It is alleged that the plaintiff is advertising its products being sold under the trademark 'SAFEGUARD' in magazines such as TIMES, NEWSWEEK, READER'S DIGEST, etc. which have wide circulation in India. It is also alleged that Indians visiting neighbouring countries such as Singapore, Philipines, Japan, Indonesia, Hong Kong, Malaysia, Thailand, Korea, China and Taiwan, are quite often purchasing the product being sold under the trademark 'SAFEGUARD' and distribute them in India. It is also claimed that the plaintiff proposed to introduce Safeguard soap in India on a large scale, through plaintiff No.2 Company. It is also claimed that the soap, being sold by the plaintiff, under the trademark 'SAFEGUARD' is a cleansing product, containing a sanitizer system which is effective against skin germs and bacteria.

Trichlorocarbanilide (TCC) and Triclosan or Irgasan(TCS) which are being used as ingredients while manufacturing the soap being sold under the trademark have anti-bacterial properties.

2. The defendant, which is a partnership firm, is engaged in the manufacture and sale of cosmetics, toilet preparations and goods including antiseptic cream which it is selling under the brand name SAFE GUARD. The case of the plaintiff is that use of the trademark SAFEGUARD by the defendant amounts to infringement of its registered trademark SAFEGUARD and passing off the product of the defendant as that of the plaintiff. This is also the case of the plaintiff that since it is not unusual for manufacturers of cosmetics and toiletry products to market other products falling under the same class, under a common brand, use of the mark SAFEGUARD by the defendant, in relation to antiseptic cream, amounts to a misrepresentation to the purchasing public and is likely to create confusion in the mind of the consumer with respect to the source of the product. It is pointed out for example that soap as well as, antiseptic lotions, shaving cream etc. are being sold under the trademark DETTOL and OLD SPICE, antiseptic cream

and prickly heat power are being sold under the name 'BOROPLUS' and antiseptic cream, tooth paste and tooth powder are being sold under the trademark 'VICCO'. The plaintiff has sought an injunction restraining the defendant from manufacturing, selling or advertising any cosmetic product including antiseptic cream under the name mark 'SAFEGUARD' or any other mark identical with or deceptively similar to the aforesaid mark. Initially, the plaintiff had also sought damages, rendition of accounts and delivery up of infringing material but these reliefs were given up during the course of arguments.

3. The written statement of the defendant is not on record. It, however, appears that copy of the written statement of defendant Shipra Laboratories was supplied to the plaintiffs who also filed a replication to that. A copy of that written statement has been provided to the Court by the learned counsel for the plaintiff on 08th November, 2011. It appears from a perusal of the copy provided by the plaintiffs that the plea taken by the defendant was that it was a partnership firm engaged in the business of manufacturing and marketing Ayurvedic Antiseptic creams under the trademark SAFE GUARD since 1983. It was

claimed that the defendant has been advertising its product through various media, including newspapers having circulation in various part of the country and, therefore, the plaintiffs knew, at least since 1985 about use of the trademark SAFE GUARD by the defendant. It was alleged that the words SAFE GUARD is a highly descriptive word having direct reference to the character and quality of the goods, conveying the meaning “to protect, to guard”. It was also stated that if at all, the plaintiffs can claim monopoly in respect of use of the trademark SAFE GUARD only in relation to their anti bacterial medicated soap and not in relation to any other product. It is also alleged that toilet soaps in respect of which the trademark SAFEGUARD is being used by the plaintiffs are altogether different product from ayurvedic antiseptic cream being manufactured and sold by the defendant. It is also alleged that neither TCC nor TCS is used as an ingredient in the Antiseptic cream being manufactured and sold by the defendant, which is an ayurvedic product.

4. The following issues were framed on the pleadings of the parties, though the fact remains that no written statement was on record at any point of time prior to 08th

November, 2011.

1. Whether the plaintiff No. 1 is the proprietor of trade mark SAFEGUARD in relation to goods mentioned in the plaint?
2. Whether the trade mark SAFEGUARD has lost its primary descriptive connotation and has acquired secondary meaning so as to distinguish goods and business of plaintiff in India?
3. Whether the trade mark SAFEGUARD of the plaintiff has got goodwill In India and if so, in relation to which goods?
4. Whether the defendant had knowledge about the plaintiff's trade mark SAFEGUARD prior to its adoption by the defendants in relation to antiseptic cream of its manufacture and sale?
5. Whether the use of trade mark SAFEGUARD by the defendants in relation to antiseptic cream is bound to cause confusion and deception amongst the public amounting to passing off?
6. Whether the trade mark SAFEGUARD has been used by the defendant No. 2 in relation to antiseptic cream since 1983? OPD
7. Whether the plaintiffs have committed misrepresentations and suppression of material facts?
8. Whether the plaintiffs have suffered any damages on account of use of trade mark SAFEGUARD by the defendants?

9. Whether the plaint has been signed and verified by an authorized and competent person in law?

10. Whether the suit suffers from acquiescence and latches?

11. Relief.

Issue No. 6

5. No evidence has been led by the defendant to prove that the mark “SAFE GUARD” is being used by it since 1983, in relation to antiseptic cream. As noted earlier, even the written statement of defendant is not on record. The issue is decided against the defendant and in favour of the plaintiffs.

Issues No. 7 and 10

6. Since neither any written statement nor any evidence has been led by the defendant, the issue is decided against the defendant and in favour of the plaintiff.

Issues No. 1,2,3,4,5,8,9,11

7. At the time, this suit was instituted on 28th April, 1995, the plaintiffs did not hold any registration in India in respect of the trademark “SAFEGUARD” and, therefore, the case of the plaintiffs was based on passing off. However, during pendency of the suit, the plaintiff No. 1 has been

granted registration of the trademark "SAFEGUARD" vide Registration No. 867980 in Class 3 for bleaching preparations; soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices. The Legal Proceedings Certificate filed by the plaintiff in this regard is Ex.PW-1/10. It is not in dispute that the defendant has been using the trademark SAFE GUARD for sale of antiseptic creams. There is practically no difference between the trademark SAFEGUARD and SAFE GUARD since no person is likely to notice the space between the words SAFE and GUARD. The trademark being used by the defendant-company is, therefore, absolutely identical, besides being deceptively similar to the registered trademark of the plaintiff-company. The case of the plaintiff is that it has been selling soaps in India as well, under the trademark SAFEGUARD though such sales do not appear to be substantial in terms of numbers. In any case, the defendant has no legal right to use the trademark SAFEGUARD or any other mark identical or deceptively similar to this registered trademark of the plaintiff in respect of any of the products for which registration has been granted. Soap being one of such products, the defendant-company has no legal right to sell

soaps in India under the trademark which it is presently using to sell antiseptic ayurvedic cream. Though there is no evidence of the defendant-company actually selling soaps in India under the trademark SAFE GUARD, the apprehension of the plaintiffs that unless an appropriate injunction is granted in this regard, nothing prevents the defendant from selling soaps under the impugned trademark, in order to encash upon the goodwill and reputation which the trademark SAFEGUARD enjoys in a large number of countries, cannot be said to be totally unfounded. In this regard, it has come in the deposition of Mr Amit Vyas, attorney of plaintiff No.2-company that it is not uncommon for the manufacturers selling products such as antiseptic creams to start selling antiseptic bacterial soaps using the same trademark which they have been using in respect of antiseptic cream and/or related products. In this regard, it has been pointed out that soap as well as antiseptic germicidal are being sold under the brand name Dettol, whereas antiseptic cream and prickly heat power are being sold under the brand name BoroPlus. Toothpowder and toothpaste are being sold under a common trademark Vicco, whereas aftershave lotion, talc, hair cream and shaving

cream are being sold under a common brand name Old Spice. Ex.PW-1/20 are the photographs showing soap and antiseptic germicidal under the brand name Dettol. Ex.PW-1/21 is the photograph showing antiseptic cream and prickly heat powder being sold under the trademark BoroPlus. Ex.PW-1/22 is the photograph showing toothpowder and toothpaste being sold under the mark Vicco and Ex.PW-1/23 is the photograph showing aftershave lotion, talc, hair cream and shaving cream being sold under the name Old Spice. In view of the practice prevailing in the trade, as is indicted from various products being sold under the above-referred common brand names, there is a likelihood of the defendant-company starting sale of antiseptic soap in India under the trademark SAFE GUARD so as to encash not only upon the goodwill which the defendant-company enjoys in respect of antiseptic ayurvedic cream being sold by it, but also to take advantage of the tremendous goodwill and reputation which the brand name SAFEGUARD of the plaintiff enjoys. The plaintiffs, therefore, are entitled to an appropriate injunction, restraining the defendant from using the trademark SAFE GUARD in respect of the product for which registration has

been granted to it by Registrar of Trademarks in India. The issues are decided accordingly.

ORDER

During the course of arguments, the learned counsel for the plaintiffs did not press for rendition of accounts, delivery of infringing material and damages and confined his prayer to grant of injunction against use of the mark SAFE GUARD or any other mark identical or deceptively similar to the trademark SAFEGUARD of the plaintiff. A decree for perpetual injunction is, therefore, passed, restraining the defendant from selling, offering for sale or advertising soap or any other product in respect of which registration has been granted to the plaintiff-company vide Registration No. 867980, under the trademark SAFE GUARD or any other mark which is identical with or deceptively similar to the registered trademark SAFEGUARD of the plaintiff-company.

There shall be no order as to costs. Decree sheet be prepared accordingly.

(V.K. JAIN)
JUDGE

NOVEMBER 17, 2011/‘sn’/bg