

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

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Date of Decision: 08.10.2012

+ CS(OS) 1549/2012

MARICO LIMITED & ANR

..... Plaintiffs

Through: Ms Anuradha Salhotra and Mr Sumit Wadhwa,
Advs.

versus

KAYA KALP AYURVEDA PVT LTD

..... Defendant

Through: None.

CORAM:

HON'BLE MR. JUSTICE V.K.JAIN

JUDGMENT

V.K.JAIN, J. (ORAL)

1. Plaintiff No. 2 is a wholly owned subsidiary of plaintiff No.1-company. Initially, it was incorporated in the name of KAYA Beauty Services Limited which was later changed to KAYA Aesthetics Limited and then to KAYA SKIN CARE Limited. Lastly, the name of plaintiff No. 2 was changed to KAYA Limited on 14.12.2007. It is alleged in the plaint that plaintiff No. 2-company was incorporated primarily with the objective of providing health care, aesthetics, beauty and personal care services and is a pioneer in the field of skin and hair care treatment and products. The word 'KAYA' forms parts not only of the corporate name of plaintiff No. 2, but also of various trademarks being used by it for products

such as sunscreen, moisturizing cream, cleansing gel, etc. as well as in respect of various services related to skin and hair care treatments. Plaintiff No. 2-company claims to be running about 100 clinics in India and abroad under the brand name KAYA SKIN CLINIC and claims to have clientele of over 5 lakh customers. The plaintiff claims to be using the trademark KAYA since 2002. The following trademarks are registered in the name of plaintiff No.1-company:-

S. No.	Trademark	Registration	Class	Goods	Date of Registration
1.	MARICO'S KAYA	1163156	5	Pharmaceuticals, veterinary and sanitary substances, preparations for purification of air, medicated bath preparations, dandruff eradicator, anti-lice preparations, medicinal oils and lotions, medicated pomad and medicated washes for human use, skin care preparations (medicated) health foods and drinks for infants, invalids and convalescing people, pesticides and insecticides, mosquito repellent mat & coil.	31.12.2002
2.	KAYA SKIN CLINIC	1142838	5	Pharmaceuticals, veterinary and sanitary substances, preparations for purification of air, medicated bath preparations, dandruff eradicator, anti-lice preparations, medicinal oils and lotions, medicated pomad and medicated washes for	11.10.2002

				human use, skin care preparations (medicated) health foods and drinks for infants, invalids and convalescing people, pesticides and insecticides, mosquito repellent mat & coil.	
3.	KAYA	1141158	10	Surgical, medical, dental and veterinary apparatus and instruments, article limbs, eyes and teeth, orthopedic articles, suture materials.	04.10.2002
4.	KAYA SKIN CLINIC	1142998	10	Surgical, medical, dental and veterinary apparatus and instruments, article limbs, eyes and teeth, orthopedic articles, suture materials.	14.10.2002

2. The following are the trademarks registered in the name of plaintiff No. 2:-

S. No.	Trademark	Registration	Class	Goods	Date of Registration
1.	KAYA GLOW	1196872	3	Perfumes, perfumery compounds, COSMETICS (non-medicated), essential oils, attars, detergents (not for industrial use), incense and incense sticks, shaving creams and shaving soaps, shoe polish, hair growing preparations, hair oil, hair preserving preparations, hair growing washes, hair	6.05.2003
2.	KAYA SILKY LEGS NITE	1349327	42	Hygienic and beauty care for human beings, hair implantation, hair dressing salons, beauty	06.04.2005

				salons, health care, medical clinics, nursing homes, hospitals, clinical & pharmacy advice, plastic surgery, dress designing, creation hosting & maintenance of websites, design & development of computer software.	
3.	KAYA SKIN TALK	1375462	41	Physical education & health club Services, gymnastic instruction; recreation and entertainment services and information thereof; providing amusements; club services, gaming, providing casino facilities (gambling); rental of sports equipments and stadium equipment (except vehicles), arranging of beauty contests, organization of shows, presentation of live shows; publication of books & texts, publication of electronic books & journals on-line; educational services; event management; studio & theater facilities, all being services included in class 41.	04.08.2005
4.	KAYA BACKLESS NIGHT	1349326	41	Physical education & health club Services, gymnastic instruction; recreation and entertainment services and information thereof; providing amusements; club services, gaming, providing casino facilities (gambling); rental of sports equipments and stadium equipment	06.04.2005

				(except vehicles), arranging of beauty contests, organization of shows, presentation of live shows; publication of books & texts, publication of electronic books & journals on-line; educational services; event management; studio & theater facilities, all being services included in class 41.	
5.	KAYA BACKLESS NIGHT	1349328	42	Hygienic and beauty care for human beings, hair implantation, hair dressing salons, beauty salons, health care, medical clinics, nursing homes, hospitals, clinical & pharmacy advice, plastic surgery, dress designing, creation hosting & maintenance of websites, design & development of computer software.	

3. The plaintiff has also applied for registration of the word mark KAYA in classes 3, 16, 41 and 44 and those applications are stated to be pending before Trademark Registry. The plaintiffs claim to have earned revenue and incurred promotional expenditure, as given in the following table, in respect of products and services being sold under the brand name KAYA.

YEAR	REVENUE INR CRORES	PROMOTIONAL FITURES INR CRORES
2010-2011	108.01	13.21

2009-2010	125.65	22.76
2008-2009	117.97	17.10
2007-2008	81.04	11.10
2006-2007	61.68	6.58
2006-2005	42.77	6.42
2005-2004	18.60	4.84
2004-2003	4.54	1.89

4. The defendant is a company incorporated in March, 2011 and is alleged to be selling various beauty products under the mark Kayakalp/Kaya. One such product is stated to be KAYA SUN SAFE which is a sunscreen lotion. The defendant is also operating a website bearing the domain name www.kayakalpindia.in. It is alleged that the defendant is providing beauty services through their solutions named KAYAKALP POINT, KAYAKALP IMPACT and KAYAKALP INSTITUTE and KAYAKALP AYUSHCHITIKSA. It is alleged that the product and services in relation to which the name KAYA is being used by the defendant are identical and analogous to the products and services which the plaintiffs are selling using their registered trademarks and use of the word/mark KAYA by the defendant is dishonest, intended to take advantage of the reputation and goodwill which the brand of the plaintiff enjoys in the market.

The plaintiff has accordingly sought an injunction, restraining the defendant from using the trading style/corporate name/trademark KAYA or any other mark which is identical or deceptively similar to the plaintiffs' registered trademarks. The plaintiffs have also sought rendition of accounts and delivery up of the infringing material.

5. The defendant was proceeded ex parte vide order dated 31.07.2012 since there was no appearance on his behalf, despite service and no written statement was filed.

The plaintiff has filed two affidavits by way of evidence. In his affidavit by way of evidence, Mr Manoj Sain of plaintiff No. 2-company has supported on oath the case set out in the plaint and has proved various documents relied upon by the plaintiffs. Mr Vikram Raj of plaintiff No. 1-company has, in his affidavit by way of evidence, supported on oath the case set out in the plaint besides proving various documents filed by the plaintiff.

6. Ex.PW-1/3 is the registration of the word mark MARICO S KAYA in favour of plaintiff No. 1 in class 5. Ex.PW-1/4 is the registration of the trademark KAYA SKIN CLINIC in class 5. Ex.PW-1/5 is the registration of the word mark KAYA in favour of plaintiff No. 1 in class 10. Ex.PW-1/6 is the registration of the word

mark and device KAYA SKIN CLINIC in favour of the plaintiff No. 1-company in class 10.

Ex.PW-2/3 is the registration of the word mark KAYAGLOW in favour of plaintiff No. 2 in class 3 in respect of various products, including lotions and creams, shampoos, soaps, talcum powder, moisturizing lotions, skin care preparations, cleaning polishing, scouring, bleaching and abrasive preparations. Ex.PW-2/4 is the registration of the word mark KAYA SILKY LEGS NITE in class 42 in respect of hygienic and beauty care for human beings, hair implantation, hair beauty lotions. Ex.PW-2/5 is the registration of the word mark KAYA BACKLESS NIGHT in class 41 in respect of physical education and health club services, gymnastic instruction, etc. Ex.PW-2/6 in class 42 is the registration of the trademark KAYA BACKLESS NIGHT in respect of hygienic and beauty care for human beings, hair implantation, hair dressing salons, beauty salons, etc.

7. The learned counsel for the plaintiff states that the plaintiff has also applied for registration of the word mark KAYA in class 3 vide application No. 1141156 dated 04.10.2002 in respect of various products, including hair oils, hair lotions, hair tonics, hair creams and hair conditioners and other toilet and toiletry preparations lotions and creams. She further states that the plaintiff has already applied for registration of the word mark KAYA vide application No. 2281355

dated 10.02.2012 in class 44 in respect of medical services, hygienic and medical care for human beings.

8. The plaintiff has also placed on record a bring out taken from the website of the defendant which shows use of the name KAYAKALP by the defendant in respect of beauty treatments, slimming and fitness, panchkarma and male grooming. Ex.PW-2/16 is the visiting card which shows use of the trademark KAYAKALP and use of the corporate name KAYAKALP AYURVEDA PRIVATE LIMITED. The domain name www.kayakalpindia.in has also been printed on the visiting card. Ex.PW-2/17 is a cash memo issued by KAYAKALP with Ayurveda. The trademark KAYAKALP has also been used on this cash memo. Ex.PW-2/18 is a bag being used by the defendant and the trademark KAYAKALP has been printed on this bag. Ex.PW-2/15 is a sunscreen lotion being sold by the defendant under the brand name KAYA SUN SAFE. Another product has been named as KAYA KULP SKIN CARE and is a skin moisturizer.

9. As noted earlier, the plaintiff is the registered proprietor of the trademarks KAYAGLOW, KAYA SILKY LEGS NITE and KAYA BACKLESS NIGHT. Since the plaintiff has separately applied for registration of the word mark KAYA, it is entitled to protection not only of the whole of the trademarks, but also in respect of their various parts. In fact, the word KAYA is the key and most prominent part of the trademarks KAYA GLOW, KAYA SILKY LEGS NITE

AND KAYA BACKLESS NIGHT. These marks are registered in favour of the plaintiffs in respect of the products which include hygienic, beauty care for human beings, hair dressing salons, beauty salons, hair oil, hair growing preparations, hair lotions, hair tonics, hair creams and conditioners, hair gel and other toilet and toiletry preparations, lotions and creams and skin care preparations, as also in respect of services comprising physical education and health club services, hair dressing salons and beauty salons. Anyone seeking to buy the products being manufactured and/or sold by the plaintiff company would ask for KAYA products and if he comes across goods which bear the trademark KAYA, Kaya Kalp Ayurveda, KAYA SUN SAFE etc, he/she is likely to be deceived into believing that the products being offered to him was a product of the plaintiff company and that is why the word KAYA was being used as a part of the trademark. Similarly, a person coming across the outlet bearing the name Kayakalp Point or Kayakalp Impact, Kayakalp Institute, Kaya Kalp Ayushchitiksa is also like to be deceived into believing that the outlet belongs to the plaintiff company or is its franchisee and that is why such a name is being used by the outlet. By using the word KAYA as a part of its corporate name, its trademarks and domain name, the defendant is using the most conspicuous and key component of the trademarks registered in favour of plaintiff No. 2-company. The trademark KAYAKALP is being used by the defendant in respect of products and services which are at least similar to the

products and services being offered by the plaintiff-company. The mark being used by the defendant though not absolutely identical is similar to the registered trademark of the plaintiff on account of use of the word of the word KAYA as part of the trademark. Same is the position with respect to the corporate name and the domain name being used by the defendant. Thus, the plaintiff has been able to establish that a trademark similar to its registered trademarks is being used by the defendant in respect of goods and services which are similar to those which are covered by the plaintiffs registered trademarks. The defendants have, therefore, clearly infringed the trademark of the plaintiff.

10. In **Corn Products Refining Company v Shangrila Food Products Limited** [1960 (1) SCR 968], the Hon'ble Supreme Court observed that absolute identity of the two competing marks or their close resemblance was only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. The Court was of the view that these are independent tests and there is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other.

11. The act of the defendant in using the trademark, corporate name and domain name KAYAKALP, KAYAKALP AYURVEDIC LIMITED and www.kayakalpindia.in and www.kayaherbal.in also amounts to passing off their

goods and services as those of the defendant. The defendant has not come forward to contest the suit and tell the Court as to why they chose to use the name which comprises the word KAYA as a key component. The plaintiffs are large companies and plaintiff No.2 is stated to be running about 100 clinics in India and abroad. The plaintiffs had turnover of Rs.117.97, Rs.125.65, Rs.108.01 crore in the years 2008-09, 2009-10 and 2010-11 respectively from use of the brand name KAYA and have incurred promotional expenditure of Rs 17.10 crore, 22.76 crore and Rs 13.21 crore respectively during these years. Thus, KAYA is now a well-established brand name in respect of care products and beauty skin care clinics. It is obvious that by using the word KAYA as a part of its trade name, domain name and trademark, the defendant is seeking to encash upon the goodwill and reputation which the brand of the plaintiff enjoys in the market. The use of the word KAYA by the defendant as a part of its domain name, corporate name, trademark/trade name besides being injurious to the financial interest of the plaintiffs-companies is also like to deceive the members of the public who may buy the products or avail the services being offered by the defendant under a false impression that they were buying the products/services of the plaintiff-companies. If the quality of the product or the services which the defendant is selling or providing is not as good as those of the products and/or services of the plaintiff, that would substantially

impair the brand value and brand image which the plaintiff-companies enjoy in the market.

12. In **Procter & Gamble Company v Joy Creators & Others** [178(2011) DLT 228, the plaintiff company was using the trademark OLAY, OLAY Total Effect and Total Effects. The defendant was using the mark Joy Ultra Total Effects. An ad interim injunction being sought by the plaintiff against the use of the mark Joy Ultra Look Total Effect, the defendant pleaded that it had given prominence to the word ‘Ultra Look’ on its label and the word JOY had been written above the word Ultra Look. It was pointed out that the word ‘Total Effect’ written below the word ‘Ultra Look’ were much smaller in font size. Rejecting the contention that no infringement or passing off was made out, I, *inter alia*, held as under:

11. In *Corn Products Refining Co. vs. Shangrila Food Products Ltd.* 1960 (1) SCR 968, the Supreme Court observed that the question whether two competing marks are so similar as to be likely to deceive or cause confusion is one of first impression and it is for the court to decide it. The question has to be approached from the point of view of a man of average intelligence and imperfect recollection.

13. It is not necessary that in order to constitute infringement, the impugned trademark should be an absolute replica of the registered trademark of the plaintiff. When the mark of the defendant is not identical to the mark of the plaintiff, it would

be necessary for the plaintiff to establish that the mark being used by the defendant resembles his mark to such an extent that it is likely to deceive or cause confusion and that the user of the impugned trademark is in relation to the goods in respect of which the plaintiff has obtained registration in his favour. It will be sufficient if the plaintiff is able to show that the trademark adopted by the defendant resembles its trademark in a substantial degree, on account of extensive use of the main features found in his trademark. In fact, any intelligent person, seeking to encash upon the goodwill and reputation of a well-established trademark, would make some minor changes here and there so as to claim in the event of a suit or other proceeding, being initiated against him that the trademark being used by him, does not constitute infringement of the trademark, ownership of which vests in some other person. But, such rather minor variations or distinguishing features would not deprive the plaintiff of injunction in case resemblance in the two trademarks is found to be substantial, to the extent that the impugned trademark is found to be similar to the registered trademark of the plaintiff. But, such malpractices are not acceptable and such a use cannot be permitted since this is actuated by a dishonest intention to take pecuniary advantage of the goodwill and brand image which the registered mark enjoys, it is also likely to create at least initial confusion in the mind of a consumer with average intelligence and imperfect recollection. It may also result in giving an unfair advantage to the infringer by creating an initial interest in the customer, who

on account of such deceptive use of the registered trademark may end up buying the product of the infringer, though after knowing, either on account of difference in packaging etc. or on account of use of prefixes or suffixes that the product which he is buying is not the product of the plaintiff, but is the product of the defendant.

14. As held by the Supreme Court in *Amritdhara Pharmacy v. Satyadeo Gupta*, AIR 1963 SC 449, whether a trade name is likely to deceive or cause confusion by its resemblance to another mark already registered is a matter of first impression and the standard of comparison to be adopted in judging the resemblance is from the point of view of a man of average intelligence and imperfect recollection. What is important to keep in mind that the purchaser does not have both the marks lying side by side for comparison and, therefore, chances of deception are rather strong.

16. ..The words TOTAL EFFECTS are an essential and integral component of plaintiff's registered trademark OLAY TOTAL EFFECTS. The defendants have virtually lifted two of the three words out of the registered word trademark OLAY TOTAL EFFECTS of the plaintiff-company and are using those two words as part of their trademark JOY ULTRA LOOK TOTAL EFFECTS. It is, therefore, difficult to dispute that the defendants by use of the words TOTAL EFFECTS as an essential part of their trademark JOY ULTRA LOOK TOTAL EFFECTS have infringed the registered trademark OLAY

TOTAL EFFECTS of the plaintiff. It is true that words TOTAL EFFECTS are only a part of the composite trademark of the defendants, but, that to my mind would make no difference since an essential and integral part of the plaintiff's registered trademark is being used by them for selling their product. Neither deletion of a part of a registered trademark nor the prefix or suffix of another word to it would validate the use of the registered mark by an unlicensed user, once it is shown that the part used by the infringer is an essential part of the registered trademark.

Another important aspect in the case before the Court is that the words TOTAL EFFECTS use the last two words in the mark of the plaintiff as well as of the defendant, which in turn, indicates that adoption and use of these two words from the mark of the plaintiff was deceptive, intended to confuse the consumer and encash upon the goodwill enjoyed by plaintiff's trademark OLAY TOTAL EFFECTS. The trademark JOY ULTRA LOOK TOTAL EFFECTS, on account of incorporation of the words TOTAL EFFECTS in it has become deceptively similar to the registered trademark OLAY TOTAL EFFECTS of the plaintiff company.

13. For the reasons stated hereinabove, the defendant is hereby restrained by way of a perpetual injunction from using the corporate name KAYA KALP Ayurveda Pvt. Ltd and the trademarks/ tradenames KAYA SUN SAFE KAYAKALP, KAYAKALP AYURVEDIC LIMITED, Kaya Kalp Institute and any other trademark/trade

name/corporate name/ domain name, of which the word Kaya constitutes a part. The defendant is also restrained from using the domain names www.kayakalpindia.in. and www.kayaherbal.in. The defendant, however, is given four weeks time to change its corporate name and two weeks to change the domain names. No other relief is pressed by the learned counsel for the plaintiff. Decree sheet be drawn accordingly.

V.K.JAIN, J

OCTOBER 08, 2012
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