

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

% Judgment delivered on: 31.05.2024

+ **FAO (COMM) 60/2024**

GTZ INDIA PVT. LTD.

..... Appellant

versus

**ARTEK SURFINS CHEMICALS LTD.
& ANR.**

..... Respondents

Advocates who appeared in this case:

For the Appellant : Mr Samrat Nigam, Dr Sheetal Vohra,
Mr Ram Kumar and Ms Simran Dhingra,
Advocates.

For the Respondents : Ms Muskan Arora and Mr Vishal
Shrivastava, Advocates.

CORAM

HON'BLE MR JUSTICE VIBHU BAKHRU

HON'BLE MS JUSTICE TARA VITASTA GANJU

JUDGMENT**VIBHU BAKHRU, J**

1. The appellant (hereafter *GTZ*) has filed the present appeal impugning an order dated 23.02.2024 (hereafter *the impugned order*) passed by the learned Commercial Court allowing the application filed by the respondents (plaintiffs in the suit) under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereafter *the CPC*) in CS (COMM) 153/2023 captioned *Artek Surfin Chemicals Ltd. & Anr. v. GTZ India Private Limited*.



2. The respondents had filed the above-captioned suit, *inter alia*, seeking a permanent injunction, restraining GTZ from selling, distributing, manufacturing, advertising, directly or indirectly dealing in any kind of products bearing the unique combination of a particular numeral along with particular alphabet being “786”, “2048M”, “2048R”, “1085M”, “1085R”, “511A”, “511B”, “511C”, “511 Conditioner”, “511A”, “511B”, “511C”, “1048M” & “1048R” (hereafter *impugned alpha numerals*).

3. The respondents claim that GTZ was passing off its goods by using the impugned alpha numerals, which are unique to the products manufactured and dealt with by the respondents. They also claim damages quantified at ₹25,00,000/- as well as a decree for rendition of accounts and delivery of the offending goods.

4. The respondents claim that the impugned alpha numerals were adopted by them along with the trademarks, in respect of their various products. And, the impugned alpha numerals are viewed by the customers as a source identifier for their products. They claim that GTZ has adopted the impugned alpha numerals in respect of its goods in order to trade on their goodwill and pass off its goods as that of the respondents. Additionally, they claim that the use of the impugned alpha numerals infringes their registered trademarks.

5. GTZ contests the aforesaid claims. GTZ contends that the impugned alpha numerals are used by it, in conjunction with its



trademarks and therefore, there could be no cause to apprehend any confusion. GTZ also contends that the impugned alpha numerals are only a part of the trademarks used by the respondents, and therefore the respondents do not have any exclusive right to use the impugned alpha numerals. GTZ claims that the trademarks used by the respondents are required to be considered as a whole and respondent no.1, which is the registered proprietor of the trademarks, has no separate right in respect of the impugned alpha numerals, which are incorporated as a part of the trademarks.

6. GTZ relies on the anti-dissection rule to contest the action instituted by the respondents. Additionally, GTZ contends that no person has a right to use any specific number and therefore, it is not open for the respondents to appropriate exclusive use of any numerals.

THE CONTEXT

7. GTZ is a company incorporated in India. It claims that it is an Indian arm of the US based business house GETZ Bros & Co Inc, which started trading chemicals in the year 1936. GTZ claims that it is engaged in the production of world class finishing solutions and sells its products under different brands including 'ULTRABRITE' and other formative marks.

8. GTZ also claims that it offers its products on its website <www.gtz.com>. It claims that it has collaborated with companies like



WITCO Corporation USA, which is a world leader in speciality chemicals, and its trademarks are well known.

9. Respondent no.1 is a company incorporated under the provisions of the Companies Act, 1956. Respondent no.2 is a limited liability partnership firm registered under the Limited Liability Partnership Act, 2008 and is an affiliate of respondent no.1. The respondents claim to be a part of the Artek Group of Companies, which is engaged in the business of manufacturing, sale and supply of various chemicals used in the electroplating industry.

10. Respondent no.1 (Artek Surfins Chemicals Ltd.) claims to be the proprietor of various registered trademarks. The details of said trademarks are set out below:

“Trademark	Class	Registration / Application Number	Date of Application	Status
TEKNOBRITE AZ 1085 R	1	5158982	04/10/2021	Registered
 ARTEK MAGNUM 786 BRIGHTNER (DEVICE)	1	3839690	22/05/2018	Registered
TEKNOBRITE AZ 2048 M	1	5158978	04/10/2021	Registered
TEKNOBRITE AZ 1085 M	1	5158980	04/10/2021	Registered
TEKNOBRITE AZ 2048 R	1	515979	4/10/2021	Registered



TEKNOBRITE NCZ 511 A	1	5258227	13/12/2021	Registered
TEKNOBRITE NCZ 511B	1	5258228	23/12/2021	Registered
TEKNOBRITE NCZ 511 C	1	5258229	23/12/2021	Registered
TEKNOBRITE NCZ 511 Conditioner	1	5258230	23/12/2021	Registered
Millennium NCZ 511 A	1	5158981	04/10/2021	Pending
Millennium NCZ 511 B	1	5158983	04/10/2021	Pending
Millennium NCZ 511 C	1	5158984	04/10/2021	Pending
Millennium NCZ 511 Conditioner	1	5158985	04/10/2021	Pending
Teknobrite AZ 1048 M	-	-	-	Prior Use
Teknobrite AZ 1048 R	-	-	-	Prior Use"

11. The said trademarks are used by the respondents and other affiliated concerns in respect of their products (chemicals used in the electroplating industry).

12. According to the respondents, the alpha numeric portion of its trademark (impugned alpha numerals) is used to identify the particular product/chemical. They claim that the said portion has acquired a secondary meaning and is recognised by its customers as identifying the particular chemical/product of the respondents.



13. A comparative tabular statement setting out the trademarks of both the parties, as mentioned in the suit (Artek and GTZ) is set out below:

Plaintiff no.1's Marks	Defendant's Marks	Usage
MAGNUM 786 BRIGHTNER (Trademark Registered)	Ultrabrite 786	Nickel- Plating Brightener
TEKNOBRITE AZ 2048 M (Trademark Registered)	ULTRABRITE 2048M	Zinc Plating Brightener
TEKNOBRITE AZ 2048 R (Trademark Registered)	ULTRABRITE 2048R	Zinc Plating Brightener
TEKNOBRITE AZ 1085 M (Trademark Registered)	ULTRABRITE 1085R	Zinc Plating Brightener
TEKNOBRITE AZ 1085 R (Trademark Registered)	ULTRABRITE 1085M	Zinc Plating Brightener
TEKNOBRITE AZ 1048 M	ULTRABRITE 1048 M	Zinc Plating Brightener
TEKNOBRITE AZ 1048 R	ULTRABRITE 1048 R	Zinc Plating Brightener
TEKNOBRITE NCZ 511 A (Trademark Registered)	ULTRABRITE 511 A	Non Cyanide Alkaline Zinc
TEKNOBRITE NCZ 511 B (Trademark Registered)	ULTRABRITE 511 B	Non Cyanide Alkaline Zinc
TEKNOBRITE NCZ 511 C (Trademark Registered)	ULTRABRITE 511 C	Non Cyanide Alkaline Zinc
TEKNOBRITE NCZ 511 CONDITIONER	ULTRABRITE 511 Conditioner	Non Cyanide Alkaline Zinc



(Trademark Registered)		
Millennium NCZ 511 A (Trademark Pending)	ULTRABRITE 511 A	Non Cyanide Alkaline Zinc
Millennium NCZ 511 B (Trademark Pending)	ULTRABRITE 511 B	Non Cyanide Alkaline Zinc
Millennium NCZ 511 C (Trademark Pending)	ULTRABRITE 511 C	Non Cyanide Alkaline Zinc
Millennium NCZ 511 Conditioner (Trademark Pending)	ULTRABRITE 511 Conditioner	Non Cyanide Alkaline Zinc

14. In their plaint, the respondents stated that the applications filed by respondent no.1 for registration of their trademarks – other than the trademark ‘ARTEK MAGNUM 786 BRIGHTNER (Device)’, which reflects its use from the date 01.04.1991 – inadvertently reflects that the applications were on a “proposed to be used” basis. However, the respondents have been using their trademarks since several years.

15. The respondents issued a cease-and-desist notice dated 02.01.2023 to GTZ claiming that the use of impugned alpha numerals by GTZ infringes respondent no.1’s trademarks.

16. GTZ responded to the said notice by a letter dated 27.01.2023. It claimed that it had conceived and adopted the mark “GTZ ULTRABRITE” in respect of chemicals used in industries in the year 1985. The said trade mark is also registered in Class I (Trade Mark



No.1387146). GTZ claimed that it added some numeric and alphabets to its mark “GTZ ULTRABRITE” to identify the category and variety of wide range of products. The said marks are the additional feature of the prior registered mark “GTZ ULTRABRITE”.

17. Since, GTZ did not desist using the impugned alpha numerals, alongwith its trade mark, the respondents instituted the present action [CS(COMM) No.153/2023] and also sought interim reliefs.

GTZ’S DEFENCE

18. GTZ is contesting the said action. It also contested the respondents’ application for interim relief under Order XXXIX Rules 1 and 2 of the CPC. Its defence is mainly fourfold. First, it claimed that the impugned alpha numerals are common to trade and therefore, the respondents cannot acquire any exclusive right in respect of the impugned alpha numerals. GTZ relied on Section 17(2)(b) of the Trade Marks Act, 1999 (hereafter *TM Act*) and on the strength of the said section contended that where a trade mark contains any matter, which is common to trade, the registration of the trademark would not confer any exclusive right on the matter forming only a part of the trade mark so registered. Second, GTZ claimed that the parties were dealing in business to business (B2B) model and not servicing retail customers. Therefore, there was no likelihood of customers being confused by the use of the impugned alpha numerals. Third, GTZ submitted that the suit was not maintainable as the respondents had clubbed multiple causes of action by filing the single suit for fifteen different trademarks.



Fourth, GTZ claimed that the respondents were aware of its use of the trade mark since 2018 and had approached the Court at a belated stage. The cease-and-desist notice was issued on 02.01.2023 but GTZ had adopted the impugned alpha numerals, in the year 2018.

19. At the initial stage, the learned Commercial Court dismissed the respondents' application by an order dated 08.06.2023 principally on the ground that the respondents could be compensated for their monetary loss. The learned Commercial Court also observed that the impugned alpha numerals appeared to be used for identification of the product rather than as a trade mark of the respondents and thus they might not be accepted as unique identification of their product.

20. The respondents successfully appealed the order dated 08.06.2023 before this Court [FAO(COMM) No.162/2023]. This Court set aside the order dated 08.06.2023 by an order dated 04.08.2023 and remanded the matter to the concerned Commercial Court for a decision on the interim application, afresh.

21. The learned Commercial Court heard the rival contentions and, *prima facie*, did not accept the defence raised by GTZ. The learned Commercial Court rejected the defence that the respondents had acquiesced in GTZ's use of the impugned alpha numerals or had waived any of their rights. It was their case that they had found out about the use of the impugned alpha numerals in the last week of December, 2022 and had taken immediate steps, thereafter. The learned Commercial



Court also did not accept that the impugned alpha numerals were common to trade. GTZ had cited use of only one numeral (that is, 511) used by a third party but was unable to cite any other instance of use of any of the impugned alpha numerals by other entities involved or associated with the trade (chemicals used by electroplating industry). The learned Commercial Court also noted that merely because the respondents had not initiated any action against the use of the numeral 511, it did not preclude the respondents from maintaining the action against GTZ.

22. The learned Commercial Court accepted the contention that the respondents were prior users of the impugned alpha numerals as part of their trade mark notwithstanding that they had applied for registration on a proposed to use basis. The said conclusion was based on the invoices and other materials produced by the respondents.

23. The learned Commercial Court did not accept that the impugned alpha numerals could not be used as trademarks. The learned Commercial Court referred to Section 2(1)(m) of the TM Act, which specifically provides that a mark includes numerals.

SUBMISSIONS

24. Mr. Samrat Nigam, learned counsel appearing for GTZ assailed the impugned order on essentially two grounds. First, he claimed that the respondents could not claim any exclusive right in respect of a part of the trade mark, since, the impugned alpha numerals were not used as separate trade marks but as a part of the trade mark in conjunction with



the coined word ‘TECHNOBRITE’. The respondents did not acquire any exclusive right in respect of the impugned alpha numerals. He relied on the anti-dissection rule.

25. Second, he stated that the respondents’ claim that they have been using the mark since several years is contrary to their application for registration of their trade marks, which indicates that the applications were made on a “proposed to use” basis and thus, the respondents claim of use prior to 2018 was required to be rejected on this ground alone.

REASONS & CONCLUSION

26. At the outset, it is important to note that the respondents’ action is not founded on infringement of their trade mark alone, they also allege passing off. It is the respondents’ case that the impugned alpha numerals are used to identify separate products and are used as a part of their trade mark. The respondents claim that the customers identify their separate products by use of the impugned alpha numerals. There is no serious dispute that a particular alpha numeral is used to identify a particular chemical/product. GTZ also acknowledged in its reply to the cease and desist notice that the impugned alpha numerals are used for identifying the products. It claimed that it had conceived and adopted the trade mark “GTZ ULTRABRITE” in respect of chemicals used in the electroplating industries in the year 1985. However, it had added alpha numerals to identify the category and variety of wide range of products. The relevant extract of the said reply is set out below:



“4. In order to acquire statutory rights as well as common law rights, my Client applied for the registration of the Mark “**GTZ ULTRABRITE**” under **Trade Mark No. 1387146 in Class-01** before the Trade Marks Registry. The said Trade Mark is registered in status and valid till 23/09/2025.

XXX

XXX

XXX

6. After getting the phenomenal success in the trade, my Client, added some numeric and alphabets to the Mark “**GTZ ULTRABRITE**” just to identify the category and variety of its wide range of products. My Client, has been using said Marks, like **GTZ ULTRABRITE 786, GTZ ULTRABRITE 2048M, GTZ ULTRABRITE 2048R, GTZ ULTRABRITE 1085R, GTZ ULTRABRITE 1085M, GTZ ULTRABRITE 511A, GTZ ULTRABRITE 511B, GTZ ULTRABRITE 511C, GTZ ULTRABRITE 511 Conditioner, GTZ ULTRABRITE 511A, GTZ ULTRABRITE 511B, GTZ ULTRABRITE 511C and GTZ ULTRABRITE 511 Conditioner** continuously and extensively in course of trade since 2018. The said Marks of my Client are only the additional feature of the prior registered Mark “**GTZ ULTRABRITE**” under **Trade Mark No.1387146 in Class-01.** ”

27. It is apparent from the above that there is no dispute that the impugned alpha numerals are used to identify the specific product and its category. The alpha numerals are used to identify a particular chemical. As an illustration, a particular alpha numeral could be used in connection with products used for surface conditioning and another



alpha numeral is used in connection with products for acid pickling and brightening.

28. GTZ also claimed (in its response to the cease-and-desist notice) that the alpha numerals are distinctive to its products, as is apparent from the following passage from its reply to the cease and desist notice:

“7. The Marks **GTZ ULTRABRITE 786, GTZ ULTRABRITE 2048M, GTZ ULTRABRITE 2048R, GTZ ULTRABRITE 1085R, GTZ ULTRABRITE 1085M, GTZ ULTRABRITE 511A, GTZ ULTRABRITE 511B, GTZ ULTRABRITE 511C, GTZ ULTRABRITE 511 Conditioner, GTZ ULTRABRITE 511A, GTZ ULTRABRITE 511B, GTZ ULTRABRITE 511C and GTZ ULTRABRITE 511 Conditioner** are solely associated with my Client only. My Client has also incurred a considerable amount towards sales promotions of the said Mark. Due to continuous use and extensive sales promotions since 2018, the said Mark “**GTZ ULTRABRITE**” of my Client has become distinctive.”

29. It is apparent from the above, that it is common ground that the impugned alpha numerals are source identifiers of the particular products. Whilst, GTZ claims that its trade mark along with the relevant alpha numerals are solely associated with its products, the respondents claim that the relevant alpha numerals (which form a part of their trade marks) are exclusively associated with their products.

30. It is important to note that according to GTZ, it had added alpha numerals to its trade mark in the year 2018. However, the respondents claim that their use of the alpha numerals precede the use by GTZ. The



respondents have produced invoices, which indicate that they have been using the respective marks much prior to 2018. A tabular statement, which *prima facie* establishes the respondents' use of their trade mark is set out below:

"Plaintiffs Marks	Defendant's Mark	Usage Since (Plaintiffs Marks)	Earliest Invoice Dated (Plaintiffs Marks)	Product Usage
MAGNUM 786 BRIGHTNER (Trademark Registered)	ULTRABRITE 786	Year 2010 (as per the earliest invoice)	14-04-2010 (at page 110 of Plaintiffs documents)	Nickel-Plating Brightener
TEKNOBRITE AZ 2048 M (Trademark Registered)	ULTRABRITE 2048 M	Year 2006	04-02-2006 (at page 156 of Plaintiffs documents)	Zinc Plating Brightener
TEKNOBRITE AZ 2048 R (Trademark Registered)	ULTRABRITE 2048 R	Year 2006	04-02-2006 (at page 156 of Plaintiffs documents)	Zinc Plating Brightener
TEKNOBRITE AZ 1085 M (Trademark Registered)	ULTRABRITE 1085 M	Year 2000	10-12-2000 (at page 224 of Plaintiffs documents)	Zinc Plating Brightener
TEKNOBRITE AZ 1085 R (Trademark Registered)	ULTRABRITE 1085 R	Year 2000	10-12-2000 (at page 224 of Plaintiffs documents)	Zinc Plating Brightener
TEKNOBRITE AZ 1048 M	ULTRABRITE 1048 M	Year 1999	11-11-1999 (at page 221 of Plaintiffs documents)	Zinc Plating Brightener
TEKNOBRITE AZ 1048 R	ULTRABRITE 1048 R	Year 1999	11-11-1999 (at page 221 of Plaintiffs documents)	Zinc Plating Brightener
TEKNOBRITE NCZ 511 A (Trademark Registered)	ULTRABRITE 511 A			Non Cyanide Alkaline Zinc
TEKNOBRITE NCZ 511 B (Trademark Registered)	ULTRABRITE 511 B			Non Cyanide Alkaline Zinc



TEKNOBRITE NCZ 511 C (Trademark Registered)	ULTRABRITE 511 C			Non Cyanide Alkaline Zinc
TEKNOBRITE NCZ 511 CONDITIONER (Trademark Registered)	ULTRABRITE 511 Conditioner			Non Cyanide Alkaline Zinc
Millennium NCZ 511 A (Trademark Pending)	ULTRABRITE 511 A	Year 2009	15-09-2009 (at page 324 of Plaintiffs documents)	Non Cyanide Alkaline Zinc
Millennium NCZ 511 B (Trademark Pending)	ULTRABRITE 511 B	Year 2009	15-09-2009 (at page 324 of Plaintiffs documents)	Non Cyanide Alkaline Zinc
Millennium NCZ 511 C (Trademark Pending)	ULTRABRITE 511 C	Year 2009	15-09-2009 (at page 324 of Plaintiffs documents)	Non Cyanide Alkaline Zinc
Millennium NCZ 511 Conditioner (Trademark Pending)	ULTRABRITE 511 Conditioner	Year 2009	17-09-2009 (at page 420 of Plaintiffs documents)	Non Cyanide Alkaline Zinc”

31. In view of the material produced by the respondents, *prima facie*, we accept the contention that the respondents have been using the impugned alpha numerals as part of their trade mark to identify their products. As noted above, it is their case that their customers identify their products by the alpha numerals and therefore, the same have acquired a secondary meaning by the exclusive use in connection of their products. The said contention is merited as it is also GTZ’s case that the impugned alpha numerals identify the products. *Prima facie*, the respondents are prior users of the impugned alpha numerals as a part of their trade marks.

32. It follows that the impugned alpha numerals were used in connection with their products, prior to GTZ adopting the same for



similar goods. GTZ must set out a reasonable explanation as to why it has adopted the very same alpha numerals in respect of similar products. However, we find that there is no explanation as to why GTZ has done so. Thus, *prima facie*, we find merit in the contention that GTZ has adopted the impugned alpha numerals to pass off its goods as those of the respondents as the impugned alpha numerals have been used by the respondents continuously in respect of their products.

33. GTZ's contention that the impugned alpha numerals are common to trade is not supported by sufficient material. GTZ has been unable to point out any other instance where the impugned alpha numerals are used by any other dealer, in respect of similar products.

34. It is also material to note that it is the respondents' case that it is a common practice in the industry for manufacturers / dealers to adopt different alpha numerals in respect of their products. Thus, a particular alpha numeral is thus used only in respect of a particular chemical/product of a particular brand.

35. GTZ's contention that the respondents cannot acquire any right in respect of a particular alpha numeral is also unpersuasive. Although, it is correct that a trade mark must be seen as a whole, however, where it is established that a prominent part of the mark is itself a source identifier, the same would present an exception to the anti-dissection rule. In the present case, if the respondents are correct that a particular alpha numeral, used as a part of its trade mark, is unique to its products and has become a source identifier of its products, the respondents



would be entitled to protection in respect of the said alpha numerals notwithstanding that it is not registered as a separate trade mark.

36. In the given facts where it is established that a part of the trade mark is unique and serves as a source identifier, the anti-dissection rule would not preclude the proprietor of the trade mark to maintain an action. The anti-dissection rule is essentially a principle for ascertaining whether the competing marks are deceptively similar. The rationale being that consumers look at a mark as a whole and thus, it is not apposite to dissect marks and compare portions of the same. ***McCarthy on Trademarks and Unfair Competition*** explains the anti-dissection rule as under:

“23.15 Comparing Marks : Differences v. Similarities

[1] The Anti-Dissection Rule

[a] Compare composites as a Whole : Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the “anti dissection” rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, conflicting marks must be compared in their entirety. A mark should not be dissected or split up into its component parts and each part then



compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” The anti-dissection rule is based upon a common sense observation of customer behavior : the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs. In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important than minor points of difference. A court should not engage in “technical gymnastics” in an attempt to find some minor differences between conflicting marks.

However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.



The rationale of the anti-dissection rule is based upon this assumption: “An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the “prominent” feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains.”

[Underlined for Emphasis]

37. The anti-dissection rule does not proscribe examining a dominant part of the trade mark as a preliminary step for determining whether the competing marks as a whole would be deceptively similar. In ***South India Beverages India Private Limited v. General Mills Marketing Inc: 2014 SCC OnLine Del 1953***, the Division Bench of this Court had also observed as under:

“19. Though it bears no reiteration that while a mark is to be considered in entirety, yet it is permissible to accord more or less importance or ‘*dominance*’ to a particular portion or element of a mark in cases of composite marks. Thus, a particular element of a composite mark which enjoys greater prominence vis-à-vis other constituent elements, may be termed as a ‘*dominant mark*’.”

38. The Court referred to a passage from McCarthy on Trademarks and Unfair Competition explaining the anti-dissection rule and observed as under:



“21. The view of the author makes it scintillatingly clear, beyond pale of doubt, that the principle of ‘*anti-dissection*’ does not impose an absolute embargo upon the consideration of the constituent elements of a composite mark. The said elements may be viewed as a *preliminary step* on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, the principle of ‘*anti-dissection*’ and identification of ‘*dominant mark*’ are not antithetical to one another and if viewed in a holistic perspective, the said principles rather compliant each other.”

39. It is apparent that the said anti-dissection rule would not disentitle a proprietor of a trade mark from maintaining an action of infringement and passing off, if it is established that a prominent part of the trade mark has acquired a secondary meaning and the customers identify the product of the proprietor by association with the said dominant part of a trade mark and the said dominant part is used by a competitor. It is important to note that in the present case, it is the respondents’ case that its customers identify a particular product of its brand by the impugned alpha numerals. The impugned alpha numerals not only represent a particular variety or category of chemicals but are also unique to the brand. The relevant alpha numeral is a source identifier for the respondents’ product. In the given circumstances, the respondents would be entitled to restrain other persons from using the same alpha numerals in respect of the similar goods. The competing trade marks ‘ULTRABRITE’ and ‘TECHNOBRITE’ bear a similarity to the limited extent that the trade marks also use the word ‘BRITE’ with less similar



phonetic ring to both the trade marks. The same coupled with the added use of the impugned alpha numerals which are unique to the respondents' product would be sufficient to, *prima facie*, establish a case of infringement.

40. As noted hereinbefore, the respondents' case is also one of passing off. It is founded on the assertion that the use of the impugned alpha numerals misleads the customers into believing that the products of GTZ are that of the respondents. Whilst, GTZ uses the impugned alpha numerals in conjunction with its trade mark 'ULTRABRITE' yet the same may not be sufficient to avoid confusion in the minds of the customers who identify the product by alpha numerals.

41. In *Wander Ltd. & Anr. v. Antox India (P) Ltd.*:1990 Supp Supreme Court Cases 727, the Supreme Court had explained as under:

“An infringement action is available where there is violation of specific property right acquired under and recognised by the statute. In a passing-off action, however, the plaintiff's right is independent of such a statutory right to a trade mark and is against the conduct of the defendant which leads to or is intended or calculated to lead to deception. *Passing-off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation which another has established for himself in a particular trade or business. The action is regarded as an action for deceit.* The tort of passing-off involves a misrepresentation made by a trader to his prospective customers calculated to injure, as a reasonably foreseeable consequence, the business or goodwill of



another which actually or probably, causes damages to the business or goods of the other trader”

(Emphasis Supplied)

42. As noticed above, the question as to why GTZ had adopted the impugned alpha numerals remains unanswered. It is, *prima facie*, established that GTZ had copied the same alpha numerals as used by the respondents in its products. Out of millions of combinations of alpha numerals, the fact that GTZ had chosen to copy those that are used by the respondents, in our view the same is sufficient, at the *prima facie*, stage, to establish that the use of the impugned alpha numerals requires to be protected.

43. In the given circumstances, we find no ground to interfere with the impugned judgment. We are unable to accept that the learned Commercial Court has not exercised its discretion in a reasonable and judicial manner or in disregard of settled principles. The appeal is unmerited and, accordingly, dismissed.

VIBHU BAKHRU, J

TARA VITASTA GANJU, J

MAY 31, 2024
RK/GSR