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IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.1159 OF 2011

IN

SUIT NO.760 OF 2011

Benden Limited

...Plaintiff

V/s.

Hindustan Unilever Limited

...Defendant

.....

Mr. Shoaib I. Memon for the Plaintiff.

Mr. Himanshu Kane a/w Rahul Kadam, Nikhil Sharma i/b. W.S. Kane & Co. for the Defendant.

.....

CORAM : A. K. MENON, J.

DATE : 8TH DECEMBER, 2015.

PC.:

This is an application for injunction in a suit is filed alleging infringement of the plaintiff's trade mark "Perfect Radiance Fairness Cream". It is the plaintiff's case that the plaintiff is a company registered in the United Kingdom and has been manufacturing a fairness cream named Perfect Radiance and holding a registered trade mark "Perfect Radiance Fairness Cream". That the defendants have infringed upon the plaintiff's trade mark. The plaintiff came registration under class 3 under the registered trade mark no.1676156 dated 15th April, 2008 and they have relied upon the certificate of registration of the trade mark issued

under the Act. According to them the plaintiff's goods have been widely used throughout Africa and the plaintiff intended to enter the Indian mark. In anticipation thereof, the plaintiffs have applied and obtained registration of a mark "Perfect Radiance" under class 3 and have intended the same in the year 2004.

2] The plaintiffs after registering the said trade mark were all set to launch their exclusive range of Perfect Radiance products in India when the plaintiffs learnt that the defendants had already "stolen" their trademark and launched a range of beauty products under the name of Lakme Perfect Radiance Fairness range and inter alia launched products such as face wash, fairness cream etc. It is the plaintiffs' case that they approached the defendant in April 2010 and requested them to cease and desist from using the plaintiffs registered trademark but they failed to comply. As a result of the aforesaid request to cease and desist, the plaintiffs filed a Caveat in this Court thereafter on 13th September, 2010 in which the defendant contended prior usage of the mark since about 2004. According to the defendant they have been in use of the mark Perfect Radiance for their launch to fairness cream right from 2004.

3] Mr. Memon, the learned counsel appearing for the plaintiffs

states that the contention of the defendant that the mark has been since about 2004 is wrong. He relies upon the admission by the defendant in their affidavit in reply of this notice of motion paragraph 6 wherein the defendants have stated thus:-

*“ I say that **since the year 2010** the defendant has been using the said expression Perfect Radiance along with the defendant's said well known trade mark LAKME upon and in relation to its Fairness Day Cream, Fairness Day Lotion and other cosmetics.”*
(Emphasis supplied)

4] Relying upon the said admission on behalf of the plaintiffs Mr. Memon contends that plaintiffs' trade mark has obviously being registered with effect from 4th November, 2009 pursuant to an application made by them as of 15th April, 2008. According to Mr. Memon in view of the statement made in paragraph 6 it is obvious that the defendants have been using mark prior to 2010. On this basis Mr. Memon learned counsel contends that the defence set up is not genuine and is set up only for the purposes of misuse the mark for their own benefit.

5] Mr. Kane the learned advocate appearing for the defendants has demonstrated how this contention is incorrect. H submits that the plaintiffs have conveniently omitted to mention that in paragraph 5 of the

same affidavit the deponent has stated that the defendant has actually and independently concealed and adopted the expression Perfect Radiance for use along with defendants well known trade mark “fair and lovely”. The mark “fair and lovely” is proprietary to the defendants the fact that is admitted by the plaintiffs.

6] However according to Mr. Menon the admission in paragraph 6 must prevail and on that basis the plaintiffs are entitled to the reliefs prayed for in the notice of motion. In the course of the submissions I enquired to Mr. Memon as to the relevance of the documents annexed at Exhibit A and A-4 which are representative packages used by the defendants for their product for Perfect Radiance face wash and a copy of invoice dated 24th June, 2005 setting out sales and units of the Perfect Radiance product. The invoice is issued by the defendants to one of its distributors in Goa. This and other documents at Exhibit B-1 and B-2 , B-3 were indicative of prior use ,at least prior to 2010 However, Mr. Memon sought controvert these and contended that there is no evidence of the mark actually being in use at the relevant time. When we refer to the affidavit in rejoinder which is filed on 3rd December, 2012, in paragraph 2 all that the plaintiffs have stated is that the sales figures provided in the affidavit in reply in the year 2004 are false therefore there is no evidence

of the prior use of the mark Perfect Radiance by the defendant. In paragraph 3 the plaintiffs have dealt with the tax invoice at Exhibit C-17 to C-20 which is for the period 2010 however they have not dealt with the invoice for the period prior to 2010 including the one at Exhibit B, D, A-4.

7] Mr. Kane also pointed out that in relation to the mark there is a proceeding already pending before the Intellectual Property Appellate Board notice of which has been issued to the plaintiffs as early as 17th August, 2010. Mr. Memon however denied any knowledge of the said proceeding although copy of the notice addressed to the plaintiffs is annexed as Exhibit E-1 to the affidavit in reply to this notice of motion. Mr. Kane makes a statement that the IPAB proceeding is still pending and that the same has been served upon the representative of the plaintiffs, one H.P. Associates. According to Mr. Kane in respect of the mark in question the plaintiff has been exclusive use of the same firstly by virtue of the registration made by the plaintiff itself has reflected in the advertisement issued before acceptance under section 20 of the Act and the copy of which appears at Exhibit D that registration of this mark shall give no right to the exclusive use of the word "Perfect". He relies upon the provisions of section 17 and states that the plaintiffs cannot claim exclusive use of the words "perfect radiance" which are non-distinctive in

character. He relies upon the description of these words in support of non-distinctiveness set out in paragraph 8 of his affidavit in reply.

8] Having considered the factual matrix as well as the submissions I am of the view that the plaintiffs have failed to effectively deal with the defence set up by the defendants of prior use. The plaintiffs have failed to effectively meet the defendant's contention of prior use and although the affidavit in reply was filed in August 2011 the plaintiffs do not appear to have taken or even sought inspection of the document relied upon by the defendants. In the circumstances, I am of the opinion that the plaintiffs are not entitled to any reliefs in this notice of motion. Accordingly, I pass the following order:-

- i) Notice of motion is dismissed.
- ii) No orders as to costs.

(A. K. MENON, J.)