

MP/RB

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION (L) NO. 1445 OF 2015**

IN

SUIT NO. 612 OF 2015

GARWARE POLYESTER LIMITED

a Company incorporated and registered under the Companies Act, 1956 having its registered office at Western Express Highway, Vile Parle (East), Mumbai – 400 057

...Plaintiff

versus

1. 3M COMPANY

a company incorporated under the laws of the United States of America having its registered office at 3M Corporate Headquarters, 3M Centre, St. Paul, MN 55144-100 Kegal

2. 3M INDIA LIMITED

a Company incorporated and registered under the Companies Act, 1956, and the Indian subsidiary of Defendant No. 1, having its registered office at Concorde Block, UB City, 24 Vittal Mallya Road, Bangalore-560001

...Defendants

APPEARANCES

FOR GARWARE

Mr. V.V. Tulzapurkar, Senior Advocate,
a/w Mr. Dipin Vora & Ms. Priya
Thakkar i/b Jehangir Gulabbhai &
Bilimoria & Daruwalla.

**FOR DEFENDANTS
NOS. 1 & 2**

Dr. V. V. Tulzapurkar, Senior Advocate,
a/w Mr. Ramesh Gajria, Mr. C. A.
Brijesh & Ms. Deepa Hote i/b Gajria
& Co.

CORAM : G.S.Patel, J.

JUDGMENT RESERVED ON : 28th June 2016

JUDGMENT PRONOUNCED ON : 12th July 2016

JUDGMENT:

1. This is a suit in trade mark infringement and passing off in relation to —I shall use as neutral a description as I am able — window films for sun protection. Garware (“**Garware**”) claims that the Defendants’ (“**3M Co**” and “**3M India**”, respectively; collectively, “**3M**”) use of the expression ‘**SUNCONTROL**’ or ‘**SUN CONTROL**’ in their mark in relation to polyester or plastic films used for this purpose infringes its device marks **SUN CONTROL**, **SUN CONTROL CLASSIC**, **SUNCONTROL**, and **GARWARE SUNCONTROL**, all registered in Class 17, and **SUN CONTROL CLASSIC**, registered in Class 16.

2. Garware manufactures and sells a range of polyester and plastic films, including reflective, non-reflective, safety, privacy, specialty and decorative films. It manufactures dyed polyester films

using a process for which it has a patent in 15 countries. Its first plant was established in Aurangabad in 1976. Garware has won many awards and received recognition for excellence in innovation. In 1982, Garware adopted the marks **SUN CONTROL** and **SUNCONTROL** in relation to polyester films, plastic films, packing and packaging, and insulation material. These were registered in 1983¹ and 1999² respectively, with a disclaimer that Garware had no exclusivity over the word ‘control’. It claims extensive and continuous usage since. As regards Garware’s other marks, **SUN CONTROL Classic** was registered in 1998 in Classes 16 and 17,³ where there was a disclaimer over the word ‘classic’, and **GARWARE SUN CONTROL** was registered in 2002, in Class 17.⁴ Garware’s mark has a device of a sun before the word ‘**SUNCONTROL**’. Garware holds 70% of the market share in India, and 80% of its products are exported. It has a significant international presence, with 32 registrations in overseas jurisdictions across Asia, Europe, South America, North America and Africa, as also several countries under the Madrid Protocol.⁵ As a result of its high sales figures⁶ and considerable promotional expenses,⁷ Garware claims its goods with these marks have acquired substantial repute and goodwill.

1 Plaint, Exhibit “A1”, *p.* 40.

2 Plaint, Exhibit “A4”, *p.* 46.

3 Plaint, Exhibit “A2”, *p.* 42; Plaint, Exhibit “A3”, *p.* 44.

4 Plaint, Exhibit “A5”, *p.* 48.

5 Plaint, Exhibits “B1” to “B32”, *pp.* 50–92.

6 Plaint, Exhibits “E1” to “E109”, *pp.* 95–203.

7 Plaint, Exhibit “D”, *p.* 94.

3. 3M India is an Indian subsidiary of 3M Co. The latter needs no introduction. It is an old, established and reputed US-based company, known the world over for its range of products. These range from industrial products to those meant for everyday home and office use. The legal fraternity is itself no stranger to at least one such range of office stationery, the fabled Post-It sticky notes.

4. Garware says that in April 2014, it came across 3M Co's identical usage of its mark '**SUNCONTROL**'. On further inquiry, Garware discovered that 3M Co uses the mark **3M Sun Control Window Films** in relation to its window films.⁸ On 26th April 2014, Garware sent 3M Co a cease-and-desist notice, claiming prior usage and registration.⁹ 3M Co refused.¹⁰ Further correspondence followed.¹¹ The defences taken by the Defendants in the letters exchanged are also, essentially, the defences taken in the present Motion. These are set out below.

5. The defence, stated briefly, is this: the trade mark used is **3M** or **SCOTCHTINT** and *sun control* is only used descriptively to denote the kind, quality and intended purpose of the goods; and the expression is *publici juris*, i.e., common to the trade, and Garware cannot, therefore, in view of Sections 30(2) and 35 of the Trade Marks Act, 1999 ("**TMA 1999**"), claim exclusive rights over the expression. 3M also says there is acquiescence because Garware delayed in initiating infringement proceedings.

8 Plaint, Exhibit "H", p. 10

9 Plaint, Exhibit "I", p. 257

10 Plaint, Exhibit "J", p. 261

11 Plaint, Exhibit "K", p. 269; Plaint, Exhibit "L", p. 271

6. For Garware, Mr. Tulzapurkar contends that the expression ‘sun control’ is not descriptive. The reason, he says, is that ‘sun control’ simply does not describe the products in question. It is therefore incapable of being used descriptively in relation to these products. These are polyester films. The expression ‘sun control’ has no direct reference to the character or quality of the goods in question. It is therefore not descriptive. Further, in its own trade mark registration applications, 3M Co does not describe its products as ‘sun control films’.¹² Therefore, he says, 3M’s assertion that the expression is used descriptively is incorrect. 3M uses it as a trade mark, in a ‘trade marky’ sense. That is an infringement. When, further, 3M uses ‘sun control’ in a domain name, this also suggests that the use is as a trade mark, and not descriptively. It is well-settled, he says, that the use of trade mark in a domain name is also infringement.

7. In any case, Mr. Tulzapurkar argues that even if the expression is otherwise considered to be descriptive, it has now attained a distinctive character on account of Garware’s extensive use of it since 1982. This, he says, is evidenced by the voluminous sales and advertising expenses. It is on account of such extensive use by Garware that the mark ‘*sun control films*’ has come to be associated exclusively with Garware. Mr. Tulzapurkar invites my attention to an incident concerning one V-Kool Films (India) Pvt. Ltd. In 2006, V-Kool advertised in ‘Overdrive’, an automobile magazine, in which it claimed to be “India’s No.1 Sun Control Film

12 Rejoinder Affidavit, Exhibit “E”, p. 31; Rejoinder Affidavit, Exhibit “F”, p. 34; Rejoinder Affidavit, Exhibit “G”, p. 36; Rejoinder Affidavit, Exhibit “H1”, p. 38; Rejoinder Affidavit, Exhibit “H2”, p. 39;

brand” and referred to its product as “sun control films”. Garware, on seeing this advertisement, sent a cease-and-desist notice to V-Kool. V-Kool complied.¹³ This, according to Mr. Tulzapurkar, is evidence of the distinctiveness of Garware’s ‘mark’.

8. Mr. Tulzapurkar also contends that ‘**SUN CONTROL**’ is the essential or distinguishing feature of Garware’s mark, not the sun device. This, he says, is evident when one looks at the mark. The expression is in bold italicized capital letters; this is eye-catching and visible. The sun device is small and offset to the left. In the UK, the mark registered is **GARWARE SUNCONTROL**, without the sun device.¹⁴ This establishes that the sun device is irrelevant; and therefore, in his submission, 3M’s use of the mark on their products is apt to cause confusion among consumers. There is every likelihood of confusion about the source or origin of these products. Consumers may well associate 3M’s products as Garware’s. For these reasons, Garware is entitled to the protection under Section 32 of the Act.

9. Mr. Tulzapurkar goes on to say that it matters little even if 3M’s use of the expression is considered to be descriptive. The test, in law, is not *how* the infringer *intended* to use the mark, but whether or not the mark is likely to be construed as a trade mark. If it is likely to be so construed, then the intention of the infringer is immaterial. Moreover, in his submission, it cannot be argued that the mark is

13 Plaint, Exhibit “G”, p. 252

14 Plaint, Exhibit “B-8”, p. 44

incapable of registration: Garware already has in place numerous registrations worldwide.

10. Dr. Tulzapurkar for the Defendants refutes each of these submissions. He submits that the expression ‘sun control’ is purely descriptive. It cannot be anything else. It is an expression frequently used in reference to plastic or polyester films to indicate kind, quality and intended purpose. These are routinely used for what the expression directly suggests: to control dangerous UV radiation and heating by the sun through glass. When applied to glass, these films cut the radiation and heat. The expression combines two ordinary, commonplace, generic words. None may monopolize them.

11. Dr. Tulzapurkar has a compilation of material to buttress these arguments on facts. He first refers to a letter from a customer in 1976, which refers to 3M Co’s product under the mark **SCOTCH TINT** (3M Co’s other registered trade mark), as a ‘sun control film’.¹⁵ This, he points out, was well before Garware entered the scene. The letter shows that the expression is one used in everyday parlance. There is another letter from a hospital, of 1978, and this, too, describes the product in question as a ‘sun control’ film.¹⁶ Central and State Governments, in various legislative materials, custom authorities in their notices,¹⁷ government agencies in their tenders, and even Courts in their judgments¹⁸ use ‘sun control films’ to describe the kind, quality and intended purpose of the goods.

15 Defendant’s Compilation, Volume 1, *p.* 52

16 Defendant’s Compilation, Volume 1, *p.* 53

17 Defendant’s Compilation, Volume 1, *p.* 267

18 Defendant’s Compilation, Volume 1, *p.* 288

Rule 172 of the Gujarat Motor Vehicles Rules, 1989 prohibits certain kinds of ‘sun control films’.¹⁹ There is a tender issued by the All India Institute of Medical Sciences for ‘sun control films’,²⁰ and others that relate to bus bodies²¹ and Ennore Port.²² An article in ‘The Hindu’²³ uses the same expression. In all these, the expression is used as a description, in an everyday sense.

12. What sets the matter at rest, Dr. Tulzapurkar says, is Garware’s own descriptive use of the expression. Garware’s registration certificates found in Exhibit “A” of the Plaint describe its products as “polyester films for arresting the radiation of ultra violet rays”. This, he contends, is precisely what the expression ‘sun control’ means.²⁴ The patent specification in Garware’s application No. 6316531B1 in America,²⁵ for a process patent for dyeing ultraviolet stabilized films also shows that Garware itself understood the expression to be purely descriptive:²⁶

“More specifically, the Garware et al/ patent was directed to a new process for the manufacturer of dyed film for sun control application.”

(Emphasis added)

19 Defendant’s Compilation, Volume 1, p. 269

20 Defendant’s Compilation, Volume 1, p. 218

21 Defendant’s Compilation, Volume 1, p. 219

22 Defendant’s Compilation, Volume 1, pp. 256, 263

23 Defendant’s Compilation, Volume 1, p. 283

24 Plaint, Exhibit “A1”, p. 40; Plaint, Exhibit “A2”, p. 42; Plaint, Exhibit “A3”, p. 44; Plaint, Exhibit “A4”, p. 46; Plaint, Exhibit “A5”, p. 48;

25 Defendant’s Compilation, Volume 1, p. 303

26 Defendant’s Compilation, Volume 1, p. 307

13. The brochure²⁷ and application²⁸ filed by Garware with the Trade Marks Registry, while seeking registration of the mark **SUN CONTROL** in Class 17 also use the expression descriptively:

“Garware Plastics & Polymers Limited have developed Polyester Film for Sun Control applications, making it the newest and most significant development in Sun Control technology.”²⁹

14. Further, Garware disclaimed the word *Control* in the mark **SUN CONTROL** when the Examiner of Trade Marks raised an objection to its descriptive nature. The word **SUN** is, of course, descriptive. Moreover, the expression over which Garware now claims a monopoly finds no place at all in its invoices for 1993 to 2000.

15. By its own descriptive usage of **SUN CONTROL**, Garware is, Dr. Tulzapurkar submits, estopped from now claiming exclusivity over it. Paragraph 12.13 of *McCarthy on Trademarks and Unfair Competition* has this to say:³⁰

“(2) Plaintiff’s Use. If the proponent of trademark status itself uses the term as a generic name, this is strong evidence of genericness. A kind of estoppel arises when the proponent of the trademark use is proven to have itself used the term before the public

27 Defendant’s Compilation, Volume 1, p. 106

28 Defendant’s Compilation, Volume 1, p. 104

29 Defendant’s Compilation, Volume 1, p. 107

30 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Thomson West, 2006), Volume 2, 4th edition, p.12–33.

as a generic name, yet now claims that the public perceives it as a trademark.”

16. Dr. Tulzapurkar relies on the decision of this court in *Schering Corporation & Anr. v M/s United Biotech Ltd & Anr.*,³¹ in which Deshmukh J. held that when a proprietor adopts a trade mark on the basis of the name of the generic expression (in that case, a drug or ingredient), it would be safe to assume that he is aware that other proprietors are also likely to adopt and use similar marks should their products be based on the same generic expression. In such cases, the first user can claim no exclusivity in either the name or trade mark.

17. The decision of the Delhi High Court in *Marico Limited v Agro Tech Foods Limited* is instructive.³² The mark in question was **LOW ABSORB**, one that the respondents used in conjunction with their trade mark **SUN DROP**. The Division Bench held that, at best, the mark was a combination of two popular English words; was descriptive of the nature of the product; and that this adoption ran a risk, viz., that others in the field would also be entitled to use the same, or similar, phrase. The acquisition of a ‘secondary meaning’ is not lightly to be assumed. For such a claim to succeed, there must be evidence of uninterrupted use of considerable longevity without a competitor attempting to use it too. Where a plaintiff has no right to exclusivity, he cannot claim another’s disentitlement to use the same expression or one similar to it.

31 (2010) 7 Mah LJ 611.

32 2010 (44) PTC 736 (Del)

18. In *British Vacuum Cleaner Company Ltd. v New Vacuum Cleaner Company Ltd.*,³³ Parker J. held that there is a distinction ordinary descriptive words and a ‘fancy word’, one that does not primarily relate to the article, but perhaps to the person manufacturing it. In principle, there can be no restraint against the use of general, commonplace words:

“Now here I think that the principles which are laid down in the reported cases have some application. I do not consider myself that if a company chooses to incorporate into its own name words descriptive of the article in which it deals it can fairly claim a monopoly of the use of those words in trade names. It seems to me that it runs the risk of having articles similarly described in the trade names of rival traders. If any such monopoly can be gained by such means it appears to me that, from the point of view of the public, the sooner the provisions of the Companies Act in that respect are altered, the better.”

19. I believe Dr. Tulzapurkar to be completely correct in saying that Sections 30(2)(a) and 25 of the TMA 1999 provide for just such a situation.

“30. Limits on effect of registered trade mark.

(1)....

(2) A registered trade mark is not infringed where—

33 1907 2 Ch 312, *p.* 328

- (a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services”

“35. Saving for use of name, address or description of goods or services

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.”

(Emphasis added)

20. In my judgment, the expression ‘sun control’ is purely descriptive. It only indicates the kind, quality and intended purpose of these films. It describes their main characteristic, which is to block certain effects of sunlight. The material Dr. Tulzapurkar has marshalled shows this. Garware’s own use of the expression has been descriptive, and whether or not there is any kind of estoppel, in the sense of an evidentiary prohibition to the claim, there is certainly a fatal inconsistency. A registered proprietor may not

interfere with a *bona fide* descriptive use that relates to the character or quality of the goods in question.³⁴

21. Further, Garware cannot show that 3M's use is calculated to deceive. To the contrary: 3M's *bona fide* intention is evident from their use of the marks **3M** or **SCOTCHTINT** along with 'sun control'.

22. I am unable to accept Mr. Tulzapurkar's argument that the 'essential feature' of Garware's mark is 'sun control'. That cannot be; the use is purely descriptive of what it is that Garware's polyster films actually do. The marks must be compared as a whole. Garware uses the sun device; 3M uses its marks **3M** or **SCOTCHTINT**.³⁵ In any case, I think Garware is getting more than a little ahead of itself. 3M is not some fly-by-night operator, or some cheap imitator operating in the shadows. 3M has a colossal international presence with well-known trade marks and huge sales.

23. These two words, *sun* and *control*, are, as Dr. Tulzapurkar correctly says, ordinary words commonly found in any (and every) dictionary. Their combination is not unique. There is no innovation or invention in the juxtaposition of these two words; nor is their combination in any sense 'distinctive'. Garware's own trade mark and patent application show this. Garware uses a description as part of its mark. It can claim no monopoly on that description. What Garware now suggests has possibly unimaginable consequences. If

34 *Irvings Yeast-Vite Ltd. v F.A. Horsenail*, 51 RPC 110

35 Defendant's Compilation, Volume 1, p. 54

its submission is to be accepted, then the day is not far when someone will claim a similar monopoly over every common phrase: ‘fountain pen’, perhaps, or ‘yellow highlighter’.

24. The decisions on which Mr. Tulzapurkar relies do not, in my view, sufficiently support him in this case. There was a very similar defence *Hem Corporation Pvt. Ltd. v ITC Ltd.*³⁶ The products in question were incense sticks. The defendant argued that the word ‘MADHUR’ was used descriptively, to denote the sweet fragrance of the product, in conjunction with its trade mark ‘MANGALDEEP’. In paragraphs 24 and 25, Vazifdar, J., held that even if the Defendant genuinely intended to use the mark descriptively, it would still constitute infringement if such use was likely to be taken as a trade mark as per sections 29(1) and 2(zb)(ii) of the Act. The test is whether the expression is used to distinguish rather than describe. That is undoubtedly correct, and well-established,³⁷ but I do not see how it carries Garware’s case further. In *Hem Corporation*, the Court found the use not to be purely descriptive, and therefore granted relief. Further, there was an admission, albeit unwitting, that the expression in question, MADHUR, was used as a ‘sub-brand’, i.e., as a trade mark (or, more accurately, a trade mark within a trade mark).

25. Mr. Tulzapurkar cites *Sapat International Pvt. Ltd. v Girnar Food and Beverages Pvt. Ltd.*³⁸ for two propositions. First, that even a

36 2012 (52) PTC 600 (Bom)

37 *Sopariwala Exports & Anr. v Shreenathji Overseas*, Notice of Motion No. 407 of 1994, in Suit No. 920 of 2013, decided on March 31st 2015.

38 2016 (65) PTC 499 (Bom)

descriptive word or term may attain distinctiveness by reason of extensive use.³⁹ That is of course correct as a general proposition, but it seems to me that the proposition is being read in isolation, unviably divorced from its companion requirements. The use must be not just extensive; it must also be uninterrupted, and it must be exclusive. If others have used it, and used it descriptively (doubly so if the claimant himself has used it descriptively), then no question arises of it ever ascending to the rarefied heights of distinctiveness merely by dint of length of time. For the words to achieve a secondary meaning, the primary meaning must be shown to have been lost. A man may say “I have taken two everyday words, and combined them. But only I have used them so widely and for so long; there are no others who have attempted to do so. I claim no monopoly in these words, but I do say that my use of these, to so great an extent, in this form, for this length of time without interruption, challenge or competitor has now so elevated them that their primary and plain meaning has been left behind and they have taken on a new *avatar*, a secondary meaning. This secondary meaning is now uniquely associated with my goods and those alone, and with no one else’s.” That level of user demands proof, even at the *prima facie* stage. The claim may be dislodged in a variety of ways; for instance, by showing that there is no such association for others use the same expression and do so to describe their own products. Where it is further shown that the claimant or plaintiff has himself used the phrase in a descriptive sense, the claim will be defeated. There is no presumption of distinctiveness. Absent cogent material, distinctiveness is not a conclusion easily to be reached.

39 *T.V. Venugopal v Ushodaya Enterprises Ltd.*, (2011) 4 SCC 85

There is not, as I have noted, before me any evidence of the expression having acquired a secondary meaning. Garware must show that 'sun control' is exclusively associated with its products. This it is unable to do. On the contrary, the sizeable material placed on record by Dr. Tulzapurkar clearly shows that the expression is still used generically.

26. Mr. Tulzapurkar's second submission drawn from *Sapat v Girnar* is that the infringer's intention is immaterial.⁴⁰ If the use of even commonplace words is such that there is a likelihood of confusion or of association with the plaintiff's mark, then that is enough to warrant an injunction. That manner of use would run afoul of Section 29. In the *Sapat v Girnar* case, the two words were also commonplace, *chai* and *time*, in relation to tea. The defendant there used the same words, similarly juxtaposed. Gupte J held that Sapat could not claim any monopoly in either of the words; yet, their use in a similarly juxtaposed manner, was sufficient for the grant of relief. He found the defendant's mark to be structurally similar, and there to be a likelihood of confusion or deception as to the origin of the goods. Therefore, the case turned on the manner in which the defendant used the two marks. I fail to see the parallel to this case. Here, 3M uses a descriptive phrase in conjunction with its well-known marks **3M** or **SCOTCHTINT**. The two marks are entirely different. No one seeing 3M's sun control film mark is even remotely likely to take it for Garware's.

40 Also: *Nestle India Limited v Mood Hospitality Pvt. Ltd.*, 2010 (42) PTC 514 (Del).

27. Mr. Tulzapurkar's reliance on the decision in *Central Camera v Registrar of Trade Marks*⁴¹ is inapposite. There, the Court held that the prohibition under Section 9(d) of the Trade & Merchandise Marks Act, 1958 applied only to words that directly referenced the character or quality of the goods. The mark there was 'solar' and sought to be used with photographic gear; the connection was held to be too remote. I do not see how I can be dragged to the same conclusion here. The expression 'sun control' *does* have a direct reference to the character of the goods; it is the very function of the goods. The material placed by Dr. Tulzapurkar shows precisely this. I reject out of hand the argument in the plaint that 'sun control' is not descriptive because Garware's product does not 'control the sun'. Neither do the expressions 'sun block', 'sun screen' or 'sun roof', yet each one of these is purely descriptive.

28. I am unable to understand the relevance to this case of the decision in *Satyam Infoway Ltd. v Sifynet Solutions Pvt. Ltd.*,⁴² in which the Supreme Court held that an Internet domain name may have all the characteristics of a trade mark and may found an action in passing off. This does not mean that every domain is *per se* a trade mark, or that every use of every expression in every domain is as a trade mark. Merely because 3M's website uses 'sun control' in its domain name, it does not follow that this is use as a trade mark, or that it ceases to be descriptive.

41 1980 Bom CR 626.

42 (2004) 6 SCC 145.

29. As an extension to his argument on the descriptive nature of ‘sun control’, Dr. Tulzapurkar argues that the expression ‘sun control’ is *publici juris*, i.e, in the public domain, and common to the trade. It is used to describe the product by traders, manufacturers, customers and the public in general. As he puts it, this is the essence of the concept of *publici juris*. There can be no monopoly over such an expression. He refers to a list of entities with registrations or applications for SUN CONTROL in India and around the world.⁴³ There are 12 international users of SUN CONTROL, all manufacturers or traders of films, or related products. One of the international entities, American Sun Control Commercial Division, which provides design and installation services for all forms of natural and artificial light control, was founded in 1969, long before Garware’s adoption of its mark. Though Garware claims to have a significant presence in the USA, it has not proceeded against any of these users. There are, in his compilation, examples of Indian applications or registrations in the name of third parties, all with the mark SUN CONTROL.⁴⁴ There are entities in other jurisdictions as well: USA,⁴⁵ UK,⁴⁶ WIPO registrations,⁴⁷ and elsewhere:⁴⁸ THERMOBEL SUNCONTROL under registration No. 9015132 in Belgium for building glass and window glass; HOTSPOT SUN CONTROL under registration No. T1107010G in Singapore for window insulating and other plastic films; and SUN CONTROL

43 Reply in Affidavit of Defendants, *pp.* 25–32

44 Reply in Affidavit of Defendants, *p.* 27

45 Reply in Affidavit of Defendants, *p.* 29

46 Reply in Affidavit of Defendants, *p.* 29

47 Reply in Affidavit of Defendants, *p.* 30

48 Reply in Affidavit of Defendants, *pp.* 30–32

I.V. in France that dates back to 1977, well prior to Garware's adoption.

30. Mr. Tulzapurkar, on the other hand, argues that the expression 'sun control' cannot be considered *publici juris* since none of the registrations alluded to by Dr. Tulzapurkar, at least in the Indian jurisdiction, pertain to goods in Classes 16 or 17. Label 1163461 (Sunanda Chemicals) is for chemicals for insulation coating and is proposed to be used. This mark was valid only till 1st January 2013 and apparently has not been renewed since. Label 2087705 (Kishanlal Gupta) has been abandoned. Label 1574496 (Garnier Sun Control) is in Class 03, relating to cosmetics. It has been registered with a condition such that the applicant has no exclusive right in respect of the words 'sun' and 'control' separately. Label 1746896 (Sun Shine Electric Co. Pvt. Ltd.) is registered in Class 09 relating to electricals. Even in international jurisdictions, there is only one ('HOTSPOT Sun Control') that is in Class 17, and it is registered in Singapore.

31. I am unable to accept Garware's arguments; these seem to me to entirely overlook the considerable material of descriptive use, including by Garware itself, that has been made available by Dr. Tulzapurkar. On an overall *prima facie* assessment, it seems to me clear that the expression is understood and used not only generally, but by Garware itself, as a description of what the product is and what it does.

32. The point on acquiescence, though pleaded, is not pressed. It does not, therefore, need to be considered.

33. For the foregoing reasons, the Notice of Motion fails. It is dismissed, but with no order as to costs.

(G.S. PATEL, J.)