

JSN

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION NO.1530 OF 2015
IN
SUIT NO.758 OF 2015

**FREUDENBERG GALA HOUSEHOLD
PRODUCTS PRIVATE LIMITED**

A company incorporated in India under the
Companies Act, 1956 having its office at B-902/3/
4, O2 Galleria, B-Wing, Plot 23/24, Minerva
Industrial Estate, Off LBS Marg, Near Asha
Nagar, Mulund (West), Mumbai 400 080

...Plaintiff

Versus

GEBI PRODUCTS

having their office at G4/5, Mewad Estate,
Patanwala Compoiund, Opposite Shreyas
Cinema, LBS Road, Ghatkopar (W), Mumbai 400
086 AND also at 392 Part 3, Dinkar Pada, Village
Kondle, Kudus, Wada, Thane 421 312.

...Defendant

APPEARANCES

FOR THE PLAINTIFF

Dr. V. V. Tulzapurkar, Senior Advocate
*with Ms. Deepa Hate i/b Gajaria and
Company for the Plaintiff.*

FOR THE DEFENDANT

Mr. Amardev J. Uniyal, for the
Defendant.

CORAM : G.S.Patel, J.

DATED : 14th July 2016

ORAL JUDGMENT:

1. The Plaintiff and the Defendant each claim entitlement to use the name of an Indian deity or goddess in relation to, of all things, everyday household grass brooms. The Plaintiff says that it has a registration in Class 21 of the trade mark “**LAXMI**”, and its mark has been completely incorporated and subsumed in the Defendant’s mark “**MAHALAXMI**”. There is no dispute that the Defendant also manufactures and vends grass brooms.

2. Dr. Tulzapurkar’s submission on behalf of the Plaintiff is that since the Plaintiff has a registration, and the whole of what he claims is its mark is part of the Defendant’s mark, therefore confusion and deception are inevitable, and he is entitled to (so to speak), a clean sweep, viz., reliefs in both infringement and passing off.

3. The response from Mr. Uniyal for the Defendant is straight forward. Both marks use common Indian names. The name **LAXMI** is a common and popular Indian female name. Both are also names of deities. None may claim monopoly over either. The difficulty with this argument as it placed, though I think it is correct, is that the Defendant has also sought registration of its own mark, **MAHALAXMI** in the same class. It is unclear from the record whether the application is for a word mark or a device mark or both.

4. Dr. Tulzapurkar relies on the decisions of this Court in the case of *Indchemie Health Specialities Private Limited v Naxpar Labs*

*Pvt Ltd*¹ and of the Supreme Court in the case of *Ruston and Hornby Ltd v Zamindara Engineering Company*.² In *Indchemie*, the respondents' mark 'Cherish' was held to be deceptively similar to the appellant's mark 'Cheri'. In *Ruston* the words '*Ruston*' and '*Rustam*' were held to be similar. Dr. Tulzapurkar says that it is now settled law that if the Defendants' mark is identical to that of the Plaintiffs' mark, there is no question of having to test the likelihood of deception or confusion.

5. On behalf of the Defendants, apart from principal defence that I have pointed out, Mr. Uniyal relies on the decisions of the Delhi High Court in *Kewal Krishan Kumar v Rudi Roller Flour Mills (P) Ltd*.³ and *Bhole Baba Milk Food Industries Limited v Parul Food Specialities (P) Ltd*.⁴

6. Incidentally, I note with a very great deal of dismay that the copy of the *Kewal Krishan Kumar* decision from the Gujarat Law Herald that Mr. Uniyal shows me is totally inaccurate. The so-called 'table of analysis' as also the coram column on the first page suggest that the decision was of Sanjiv Khanna J, sitting singly. On checking, I find this is wholly incorrect. The decision is of a Division Bench, of M.K. Sharma CJ and Sanjiv Khanna J, and was delivered by M. K. Sharma CJ. This is also clear from the body of the Gujarat Law Herald report itself, which shows that it was an appeal; and in which Sharma CJ's name appears at the head of the judgment. These are

1 2002 (24) PTC 341 (Bom) (DB).

2 AIR 1970 Supreme Court 1649.

3 2007 (35) PTC 848 (Del) (DB).

4 2011 (45) PTC 217 (Del).

serious mistakes, and I would urge Mr. Uniyal to bring this to the attention of the publishers. Out of abundant caution, I have not referred to the copy given to me by Mr. Uniyal of either of these two decisions, but have used the corresponding PTC reports instead (and of which citations the Gujarat Law Herald makes no mention). In future, I will not accept print outs or copies from this series.

7. In my view, the decisions in *Kewal Krishan* and *Bhole Baba* are apposite. The present case is at some distance from the factual conspectus in *Indchemie* and *Ruston*. In *Kewal Krishan*, the Division Bench of the Delhi High Court dismissed an appeal from an order rejecting a claim that the respondent's use of the mark **Shiv Shakti** (for maida, atta, etc) was deceptively similar to the appellant's mark **Shakti Bhog**, and ought not, therefore, to have been registered. The Court *inter alia* held that there cannot be a monopoly over **Shakti**, a purely descriptive word; and the words **Shiv Shakti**, read as whole, is descriptive, and identifies an Indian deity, **Shiva**.

8. Further, here, as in the case before the Court in *Bhole Baba*, as Mr. Uniyal points out, we are concerned with name that is not just a popular name but it is a widely used name of a deity. In *Bhole Baba*, Shakhder J said:

1. Parties in this case are locked in an intense court battle over the exclusive right to use the name of one of the reigning deities from amongst pantheon of Hindu Gods, not for any altruistic purpose but for pure commercial gains. Since the products in issue, in respect of which the impugned mark is being used are ghee, milk products and dairy products, the God who

has been invoked, and the name which would, in the litigants' estimation, catch consumers' imagination is "KRISHNA". **The Plaintiff claims exclusivity over the word mark and label mark KRISHNA**; which includes the attendant pictorial depiction.

14. Having perused the pleadings and documents filed by the parties and considered the submissions of the counsels, in my view, the following emerges: As indicated at the very outset, in the opening part of my judgment, the controversy, in my view, now centres around the use of the word KRISHNA. There have been in my opinion substantial changes incorporated in the label mark of the Defendant in so far as the colour scheme and the pictorial representation is concerned which should allay any apprehension that a prudent and a reasonable consumer would be deceived as regards the origin and the source of the goods on which such a label mark is put. This aspect was as a matter of fact was conceded before me by Mr Vidhani, though rather reluctantly. **Mr Vidhani, however, pressed his application for interlocutory injunction qua use of the word KRISHNA in the label mark of the Defendant.** I had indicated to both parties that the usage of the word "KRISHNA" in the Defendant's mark would necessarily have to be given the same prominence as the words "Parul" and "Lord" which precede the word KRISHNA in the Defendant's mark. In other words the font size and the prominence of the preceding words "Parul" and "Lord" had to be identical to that of KRISHNA. That a court can issue such directions in the interregnum is not now in doubt. See *Cadila Healthcare Ltd. v. Diat Foods (India)* [173 (2010) DLT 141]. Nevertheless since Mr Vidhani asserts his complete exclusivity to use the word "KRISHNA" I have decided to deal with that aspect of the matter as well.

14.2 A reading of paragraphs 18 and 23 of the plaint seems to suggest that the Plaintiff came to court being aggrieved by the fact that the word KRISHNA forms an essential part of the Defendant's trade mark and had been given greater prominence as compared to the suffix "Parul" and "Lord" and, therefore, resulted in confusion qua the Plaintiff's mark. **Apart from the Plaintiff's grievance vis-à-vis the packaging, which in my opinion stands satisfied, the Plaintiff has not set up the case of a monopolistic right to use the word KRISHNA; at least the same has not been said in so many words. But I will assume for the moment that, this is what the Plaintiff intends to say in the plaint for the purposes of decision of the captioned applications.**

14.5 What would have to be addressed at the final stage, in this case, would be whether the mark has achieved secondary distinctiveness of the kind which brings to mind immediately the Plaintiff's product. In order to come to a conclusion whether or not the mark has achieved a distinctiveness of such distinction evidence would have to be placed on record bearing in mind, amongst others, the following: (a) does the mark remind the consumer of the trade and origin. In other words does the trade origin get related to the propounder of the mark and none other; (b) has the mark required sufficient distinctive character that the mark has become a trade mark. *The use of the mark does not automatically translate into distinctiveness.* [See *Rich Products Corporation and Anr. v. Indo Nippon Food Ltd.*, 2010 (42) PTC 660 (Del)]. In this regard an argument was raised by Mr Vidhani that Rich Products case related to a descriptive mark whereas the present case deals with a common name. In my opinion, the test of secondary distinctiveness can be

no different for a common name than that which is enunciated for a descriptive mark. Applying the same test, in my view, at this juncture, I cannot come to the conclusion that a name as common as KRISHNA; which in the cultural context of our country is as common as the word 'John' used in West, has achieved in the Plaintiff's case a secondary distinctiveness of the kind that it is inalienably related by the consumers to the Plaintiff's product.

15. Mr Vidhani's submission that having obtained registration the Plaintiff has a right to seek an injunction as a matter of right and that adding a prefix such as "Parul's" and "Lord" to the word KRISHNA would not enure to the benefit of the Defendant is misconceived, in the facts of the present case. In a case where a registered mark appears with a prefix and, the registered mark over which rights are claimed is either a descriptive mark or is, as in the instant case, a common name, the same test ought to apply.

9. I am in most respectful agreement with these views. Further, this decision was upheld in Appeal.⁵

10. I notice that the Plaintiffs' mark is a label or device mark of the word **LAXMI** written in a particular, stylized manner: it is written vertically, and the letters use a distinct font. The registration certificate under No. 1195753 shows this.⁶ I will reject out of hand Dr. Tulzapurkar's submission that **LAXMI** is the 'leading, central and memorable' feature of the Plaintiffs' mark. When what has been

5 *Bhole Baba Milk Food Industries Limited v Parul Food Specialities (P) Ltd.*, 2011 (48) PTC 235 (Del) (DB).

6 *Plaint, Ex. A, pp. 16-17.*

obtained is registration of a label or a device, and that device uses a common first name, the name of a deity and so on, it is not possible to extract the name itself out of the label and claim any sort of exclusivity over it. The Defendants point out in their Affidavit in Reply and their Written Statement that they used the mark **GEBI**, and they do so prominently, for their wide range of cleaning products. The grass broom is but one of these. There are, in addition, several others who use the word **LAXMI** in their grass broom products. Some examples are cited in the Affidavit in Reply: *Grah Laxmi*; *Bhagyalaxmi*; and *Raj Laxmi*.⁷

11. If the Plaintiff chose a common word or a common name for its mark, it ran the risk of others using it too.⁸ Then, even the slightest variation is enough to distinguish one mark from another. It makes no difference if the mark registered is a device or a label mark that has a common word or name as part of that device or label; the registrant cannot then extract the common word or name and get, in this indirect fashion, exclusivity over the word that he would not otherwise have got had he applied for the registration of the word *per se*.

12. In my judgment, nothing in the Trade Marks Act, 1999 allows the monopolization of any of the many gods in our pantheon. Just because we have them in abundance does not mean that any of them is surplus, and therefore can be sequestered to, or expropriated, by a mortal. The words **LAXMI** and **MAHALAXMI** (or even **MAHA LAXMI**) do not lend themselves to any such monopoly. Claiming a

⁷ Notice of Motion paperback, pp. 19–20 and 60–63.

⁸ *Marico Ltd v Agro Tech Foods Ltd.*, 2010 (44) PTC 736 (Del).

device or a label mark is one thing; claiming a word monopoly is another. There is no case made out that the Defendant uses a device or label similar to that of the Plaintiff.

13. Mr. Uniyal makes a telling point: nobody, he says, calls for a broom by referencing a lady's name or that of a deity. Such piety in broom-wielding (or purchase) is unheard of.

14. I agree. Trade mark law ought to steer well clear of all things theological. None may appropriate a deity, let alone to base commerce. One look at the daily newspapers should be enough to tell us why not. Mankind needs all the divine intervention it can get.

15. The Notice of Motion is dismissed. No costs.

16. List the suit for framing issues on 28th July 2016.

(G. S. PATEL, J.)