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

+ **CS (COMM) 1316/2018 & I.A. 525/2019**

GENEVA LABORATORIES LIMITED & ANR. Plaintiffs

Through: Ms. Anuradha Salhotra, Mr. Zeeshan
Khan and Ms. Saugaat Khurana,
Advocates. (M:8376843538)

versus

REALMAN COSMETICS LLP & ANR. Defendants

Through: Mr. Anjuman Tripathy, Advocate.
(M:9818408960)

CORAM:

JUSTICE PRATHIBA M. SINGH

ORDER

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15.01.2019

1. The Plaintiff no.1 is a British Virgin Islands Company and the Plaintiff no.2 is a company incorporated in South Africa. It is averred in the Complaint that a German chemist – Dieter Beier, living in South Africa had conducted vast research and had formulated a product for improvement of scars, stretch marks for women, especially during pregnancy. The said product was launched under the mark BIO-OIL in 1987.

2. The Plaintiff no.1 acquired rights in the mark in 2000 and commenced manufacture and sale on a global scale. Currently, the products under the mark BIO-OIL are sold in 139 countries of the world. The mark is claimed to be in use in India since 2013. The BIO-OIL product is the highest selling scar and stretch mark product in the world. The same is used along

with the device of a drop, in logo form since 2017. The mark and logo of the Plaintiff is set out below:



PLAINTIFF'S PRODUCT

3. The trade mark BIO-OIL along with the drop device are registered in India in Class 3 in respect of `Soaps, perfumery, essential oils, cosmetics. The word mark BIO-OIL is pending registration. It is stated that the Plaintiff's mark BIO-OIL had acquired enormous goodwill and reputation.

4. The grievance in the present suit was that the Defendants had commenced sale of an identical product under an identical mark i.e., 'BIO-OIL'. The Defendants had started marketing their products through the

website www.therealwoman.in. Though the Defendants are based out of Gujarat, their products could be purchased from any location where the website was accessible. The Defendants' product images are set out below:



DEFENDANTS' PRODUCT

5. The Plaintiffs pleaded that there were several points of identity between the products of the Plaintiff and the Defendants. The same are:

- Use of identical mark of BIO-OIL with the Drop Device with Horizontal Lines.

- Use of an identical tagline “*SKINCARE OIL*” used below the artistic work including the use of the colour *WHITE* for depicting *BIO-OIL*.
- Identical product description and product use enlisted in an identical sequence i.e. Scars, Stretch Marks, Uneven Skin Tone, Ageing Skin, and Dehydrated Skin.
- Identical content and manner of describing the product and its intended use.
- Identical content, layout and directions of use for customers.

6. In view of these facts, the Plaintiffs filed the present suit for infringement of trade mark, passing off and account of profits. The reliefs sought in the present suit are:

a) A decree of permanent injunction against the Defendants, their officers, directors, partners, proprietors, employees, servants, agents, representatives, dealers, successors in title, sister concern(s), associates, subsidiary(ies), franchisee(s), licensees, or any other person claiming through or under the Defendants jointly and/or severally or otherwise whatsoever, from infringing the registered trade mark BIO-OIL/(Oil Drop Logo)/and/ or any other mark identical/deceptively similar thereto using it by itself or in conjunction with any other word in relation to the goods and services or a trade name or part of a trade name, domain name or part of domain name or in any manner whatsoever;

b) A decree of permanent injunction against the Defendants, their officers, directors, partners, properties, employees, servants, agents, representatives, dealers, successors in title, sister concern(s), associates, subsidiary(ies),

- franchisee(s), licensees, or any other person claiming through or under the Defendants jointly and/or severally or otherwise whatsoever, from off the Plaintiff's trade mark BIO-OIL/(Oil Drop Logo)/ and/or any other mark identical/ deceptively similar thereto using it by itself or in conjunction with any other work in relation to the goods, services or a trade name or part of a trade name, domain name or part of domain name, or in any manner whatsoever;*
- c) The Defendant No.1 be directed to immediately take down the infringing listing of the impugned bearing the mark BIO-OIL/(Oil Drop Logo), on its websites under the domain name www.therealwoman.in and be also directed to not advertise and take down the listings of the impugned goods under the trade mark and logo BIO-OIL/(Oil Drop Logo), on any other website/ social media pages.*
- d) The Defendant No.1 be directed to immediately delete/ remove the impugned product from its Facebook page from the link <https://www.facebook.com/commerce/products/2425651177508313/> and/or any other page having the trade mark BIO-OIL, (Oil Drop Logo)*
- e) Deliver to the Plaintiffs' attorneys or its representatives for destruction, all product, labels, stickers, moulds, signs, stationary, business cards, prints, packages, plates, dyes, wrappers, receptacles, materials and advertisements in their possession or under their control, bearing the mark BIO-OIL, and /or (Oil Drop Logo) and/or (Oil Drop Logo) by itself or in conjunction with any other word, or any simulation, reproduction, copy or colourable imitation of the Plaintiffs' BIO-OIL/(Oil Drop Logo) trade mark and cost of which be borne by the Defendants;*
- f) Any order directing the Defendants to allow inspection of their accounts to assist in ascertaining the amount of profits made by them and/or damages*

suffered by the Plaintiffs as a result of the Defendants' use of the offending mark and a decree be passed in favour of the Plaintiffs and against the Defendants for the amount found due. The Plaintiffs be additionally granted exemplary and punitive damages at least to the tune of Rs.2,00,00,050/- (Two Crore and Fifty Rupees Only;)

- g) A declaration that the BIO-OIL/(Oil Drop Logo) trade mark is a well-known mark belonging to the Plaintiff;*
- h) The Decree of injunction as granted be binding upon the Defendants, their partners or directors, as the case may be, their principal officers, servants, agents and all other acting for and on their behalf;*
- i) Costs of the suit be awarded to the Plaintiffs;*
- j) Any further order(s) which the Hon'ble Court deems fit and proper in facts and circumstances of the present case."*

7. The suit was listed before this Court on 21st December, 2018. An ad-interim injunction was granted in favour of the Plaintiffs and against the Defendant in the following terms:

"12. A prima facie case has been made for grant of injunction at this stage, Till the next date, the Defendants are restrained from manufacturing any oil products under the mark/logo 'BIO-OIL'. However, insofar as the existing stock is concerned, Defendants are permitted to sell the same subject to filing accounts before the Court. If the Defendants wish to sell the inventoried products, the same shall be done after giving an undertaking that they would furnish the true and correct accounts of the sales so made."

8. Vide the said order, Local Commissioners were also appointed to visit the premises of the Defendants, to prepare an inventory of all the goods

manufactured by the Defendants bearing the impugned marks.

9. The Defendants, today, have moved an application under Order XXXIX Rule 4 CPC being I.A. 525/2019 seeking vacation of the injunction order dated 21st December, 2018.

10. Mr. Anjuman Tripathy, learned counsel appearing on behalf of the Defendants, submits that his clients are very small entrepreneurs, who have started manufacturing and marketing cosmetic products very recently. Their adoption of the mark '*BIO-OIL*' is recent and learned counsel for the Defendants submits that the Defendants have manufactured a total of 1236 products under the mark '*BIO-OIL*'. He submits that he has placed on record the statement of accounts, which reveals that only 159 units out of the 1236 units have been sold so far. He further submits that his clients are willing to give undertaking not to use the mark '*BIO-OIL*'. In fact, he has handed over a new and alternate packaging, which the defendants are willing to adopt for their products. It is, thus, prayed that the Defendants be permitted to dispose of the goods, which were seized by the Local Commissioner, which are to the extent of 1015 unsold units.

11. The Court has perused the new and alternate packaging that the Defendants wish to adopt. A copy of the new packaging bearing the mark *W- The Real Woman* has also been handed across to Ms. Anuradha Salhotra, learned counsel for the Plaintiffs. A perusal of the same clearly shows that the Plaintiffs cannot have any objection towards the Defendants use of the new and alternate carton/mark/logo. The Defendants, accordingly, are permitted to use the new and alternate carton/packaging and mark containing the name *W- The Real Woman*. The new carton/packaging, which the Defendants intend to adopt, is taken on record and marked as **Exhibit X**,

and is as under:



NEW AND ALTERNATE PACKAGING OF THE DEFENDANT

12. Learned counsel for the Plaintiffs also submits that her client would have no objection if the Defendants adopt the new and alternate carton/packaging, which has been shown to the Court today. The suit is, thus, decreed in the following terms.

- a) The Defendants, their manufacturers, sellers and anyone acting for and on their behalf are restrained by a decree of permanent injunction from manufacturing, selling and offering for sale any cosmetics or cognate and allied products under the name/mark 'BIO-OIL' as also containing the *Bio-Oil drop logo*.
- b) The Defendants are directed to, within 48 hours, bring down any

entries in respect of the '*BIO-OIL*' mark/logo and products which are displayed on the website www.therealwoman.in and any other social media platforms.

- c) The Defendants are permitted to dispose of the existing stock of '*BIO-OIL*' products (1015 numbers) on or before 30th April, 2019. A communication shall be sent by learned counsel for the Defendants to the learned counsel for the Plaintiffs, confirming the sales/disposing of all the seized products on or before 15th April 2019. No further manufacturing of any cosmetic products with the mark '*BIO-OIL*' or product logo shall be undertaken by the Defendants from today.
- d) The Defendants are permitted to use any mark/logo/packaging, which is not identical and deceptively similar to that of Plaintiffs' mark/logo/packaging. The Defendants are permitted to adopt **Exhibit X**, which is taken on record.

13. The suit is decreed in the above terms. Decree sheet be drawn up. All pending I.As. stand disposed of. Next date of hearing stands cancelled.

PRATHIBA M. SINGH, J.

JANUARY 15, 2019/dk