



A.Nos.249 to 251 of 2020 in
O.A.Nos.947 to 949 of 2019 in
C.S.No.609 of 2019

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 05.02.2020	Pronounced on: 13.02.2020
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Coram::

The Honourable Dr.Justice G.Jayachandran

Application Nos.249 to 251 of 2020 in
Original Application Nos.947 to 949 of 2019 in
C.S.No.609 of 2019

Mr.Nenmal Jain

... Applicant/Defendant
in all cases

/versus/

1.Mrs.Preeti

2.Kosmos Global,
a Proprietary Concern,
Represented by its Proprietor
Mr.Piyush Jain,
No.20, Revanayer Street,
Park Town, Chennai – 600 003.

... Respondents/plaintiffs
in all cases

Prayer in Application No.249 of 2020:-

Judges summons filed under Order XIV Rule 8 of O.S Rules under
Order XXXIX Rule 4 and Section 151 of C.P.C:-

To vacate the interim injunction granted in O.A.No.947 of 2019 in C.S.
(Commercial Division) No.609 of 2019 on 22.10.2019 pending disposal of the
above suit.

Prayer in Application No.250 of 2020:-

Judges summons filed under Order XIV Rule 8 of O.S Rules under Order XXXIX Rule 4 and Section 151 of C.P.C:-

To vacate the interim injunction granted in O.A.No.949 of 2019 in C.S. (Commercial Division) No.609 of 2019 on 22.10.2019 pending disposal of the above suit.

Prayer in Application No.251 of 2020:-

Judges summons filed under Order XIV Rule 8 of O.S Rules under Order XXXIX Rule 4 and Section 151 of C.P.C:-

To vacate the interim injunction granted in O.A.No.948 of 2019 in C.S. (Commercial Division) No.609 of 2019 on 22.10.2019 pending disposal of the above suit.

For Applicant : Ms.Gladys Daniel
in all cases

For Respondents : Ms.Devi.N
in all cases

COMMON ORDER

Application No.249 of 2020 is filed to vacate the interim injunction granted in O.A.No.947 of 2019 in C.S.(Commercial Division) No.609 of 2019 on 22.10.2019; Application No.250 of 2020 is filed to vacate the interim injunction granted in O.A.No.949 of 2019 in C.S.(Commercial Division) No.609 of 2019 on 22.10.2019 and

Application No.251 of 2020 is filed to vacate the interim injunction granted in O.A.No.948 of 2019 in C.S.(Commercial Division) No.609 of 2019 on 22.10.2019.

2.The parties herein are described as plaintiffs and defendant, for the sake of convenience.

3.The case of the plaintiffs:-

The suit is filed for infringement of trade mark, infringement of copy right and passing off, alleging that the defendant is selling the duplicate product inside the carton and label with the essential features and character of the original product of the plaintiffs. The plaintiffs are the registered proprietors of the trade mark "BEAUTE BLANC" in class 3 and has authorised the second plaintiff to use the said trade mark "BEAUTE BLANC" for the hair colour products manufactured and imported by the second plaintiff from a manufacturer in China. The trade mark "BEAUTE BLANC" for cosmetic products including hair dye/hair colour was registered on 29.04.2014. It is valid and in force in the name of the first plaintiff.

4.The trade mark label/carton of the plaintiffs along with the carton which is artistically designed by the first plaintiff is registered under the Copyright Act, 1957 and the same is valid

and in force. The plaintiffs submit that the registered trade mark "BEAUTE BLANC" is written in bold black colour on silver colour on jet black colour back ground along with the device of a flower with creep and the word "FRUIT VINEGAR" written prominently in golden colour on wine red colour back ground below which the peach fruit is displayed in light orange colour and that the word "fruit vinegar black gel color" and other descriptive matters and contents are mentioned in silver colour on black carton. The product of the plaintiffs' is packed in black carton which is of a hexagonal shape specifically designed by the plaintiffs for their 'hair colour product' and on both the sides of the carton, the words "PROFESSIONAL HAIR COLOUR" is written and on the back side of the black carton, the product descriptions, application, ingredients, caution, price, batch no. QR code/bar code, scanner along with the device of peach fruit are displayed.

5.The plaintiffs submit that the inside pack of the plaintiffs are also artistically and uniquely designed by the plaintiffs for their product-hair colour. The product of the plaintiffs' are being manufactured by its manufacturer in China based on the Registration Certificate No.RC/COS - 000550 issued by the Central Drugs Standard Control Organisation, Ministry of Health and Family Welfare, Government of India. The first plaintiff is the owner of the registered trade mark "BEAUTE BLANC"

and the copyright of the carton/label of the trade mark "BEAUTE

BLANC". Further, the first plaintiff has also filed the application for the registration of the carton under the Trade Marks Act, 1999 and that the said application under No.4309341 in class - 3 is pending registration. Further, the plaintiffs have obtained the registration certificate for import of cosmetics into India under the Drugs and Cosmetics Rules, 1945 from the Government of India and the same is filed along with the plaint. The second plaintiff has the certificate of Importer - Exporter Code (IEC) issued by the Ministry of Commerce and Industry.

6.The plaintiffs submit that the products of the plaintiffs, the hair colour is packed in round slim bottle containers of 2 equal sizes and packed out with the above described carton black pack of the plaintiffs. The product of the plaintiffs are manufactured by its manufacturing company in China and are imported and marketed by the second plaintiff under the trade mark "BEAUTE BLANC" and that the second plaintiff markets the product directly to its customers who are the professional beauty saloons. The products of the plaintiffs are marketed to the professional beauty saloons and shops and other customers.

7.The further case of the plaintiffs is that, the product under the trade mark "BEAUTE BLANC" and carton are honestly adopted and used by them since 2014 without any interruption. They adopted the said trade mark and packing. They were first to

introduce the product in the market under the trade mark "BEAUTE BLANC". They have earned the name for their product in the beauty saloon market. The defendant taking advantage of the plaintiffs market for the product under the trade name "BEAUTE BLANC" is selling the duplicate product which has all the essential features and characters of the original product of the plaintiffs. The defendant is manufacturing the products under the same/similar and identical pack/carton trade dress, colour combination, get up, letter in style, etc. Except for few changes, the defendant is marketing the product under the name of "BEAUTY BOLD" and "Hair Black Color Gel". The defendant's product under the trade mark "BEAUTY BOLD" and "Hair Black Color Gel" are duplicates of the plaintiffs registered trade mark and copy right. The defendant by infringing the trade mark of the plaintiffs, selling their products clandestinely without any bill or Goods and Services Tax (GST) for illegal gains and profit.

8.The defendant is involved in unfair malpractice, illegal, fraudulent and of infringement of trade mark and copy right of the plaintiffs by sale of duplicate product under the trade name "BEAUTY BOLD" and "Hair Black Color Gel" similarly to the product of the plaintiffs "BEAUTE BLANC", carton/pack, the defendant is passing unethically and illegal threat to the business of the plaintiffs. The trade mark adopted by the defendant is visually, phonetically and structurally similar and identical to the

plaintiffs registered trade mark and copy right except for some additions, the colour scheme, get up etc., of the label/carton pack of the product, "BEAUTY BOLD" and "Hair Black Color Gel" are similar and identical and deceptively similar to that of the plaintiffs trade mark "BEAUTE BLANC" along with carton / pack/trade dress.

9. With the above said averments, the plaintiffs have stated in the injunction applications filed for infringement of copy right, infringement of trade mark and for passing off, that unless the defendant is restrained from infringing the plaintiffs registered trade mark, "BEAUTE BLANC" by using the offending trade mark, the label/carton/pack under the name of "BEAUTY BOLD" and "Hair Black Color Gel" they will be put to irreparable loss. Hence, this Court *prima facie* satisfied and granted interim injunction in O.A.Nos.947 to 949 of 2019 on 22.10.2019 and the same being extended time to time. However, on 23.01.2020, this Court has not extended the interim orders.

10. Aggrieved by the interim orders and the averments made in the affidavits filed in support of the applications filed for interim injunction (O.A.Nos.947 to 949 of 2019), the defendant has filed the present applications (A.Nos.249 to 251 of 2020) to vacate the interim injunction. In the present applications

(A.Nos.249 to 251 of 2020), the defendant has taken a primary

objection regarding the maintainability of the suit, on the ground that the suit suffers from suppression of truth and suggestion of falsehood. The true and crucial facts were not disclosed by the plaintiffs.

11. According to the defendant, the said trade label was adopted by the Chinese company - Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd., and the said company is the supplier for both plaintiffs and defendant and many others with their respective trade marks. The plaintiffs are proprietors of the registered trade mark "BEAUTE BLANC" whereas, the defendant is the proprietor of the registered trade mark "Nyomi". The plaintiffs have got the copy right registration for the trade mark label which is designed by the Chinese Company. The second plaintiff has got licence for import only in the year 2017. The plaintiffs have got permission under the Drugs and Cosmetics Rules 1945 only on 02.02.2018. Only after permission under Drugs and Cosmetics Rules, one can trade in the products related to cosmetics including the hair colour. Therefore, the plaintiffs averment that they are marketing the products with the said trade mark and copy right label since 2014 is per se, false and misleading. The product carrying the plaintiffs trade mark "BEAUTE BLANC" and the carton/label are all manufactured by the Chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,). The design on the pack also created by Chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,).

Whereas, the plaintiffs have claimed that the trade mark label is artistically designed by the first plaintiff which is a misleading and false statement.

12.The further case of the defendant is that, the plaintiffs claim on the trade dress of the carton is illegal. The chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,) which has exclusive right over the trade mark label supply the product to various persons in India with their respective trade marks. The plaintiffs have no right to represent it as their artistic work. As far as the trade mark of the defendant "Nyomi" is concerned, it is different and distinct. It is not phonetically, visually and structurally similar to that of the product of the plaintiffs. The plaintiffs have got the copy right over the artistic work claiming it to be used by them since 2014. Though the said artistic work was not their original work, but by getting the said artistic work, copy right the plaintiffs is putting the defendant under hardship which is an abuse of the process of law and not permissible under law. The claim of the plaintiffs that they are importing the goods since 2014, cannot be true since they got the import licence only in the year 2017. Prior to the plaintiffs application, for the said trade mark and copy right of the artistic work, there were other companies who have adopted the similar artistic work on the label and marketing their product.

13. According to the defendant, the registration obtained by the plaintiffs on false and misleading statement is invalid. The manufacturer of the product has given certificate to one Mega Arco Agency, Chennai that they purchase goods from Chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,) and one of the Indian customer. No Indian customer have right over the design of the box, though the Indian customers have their own respective brands and logos. The product "fruit vinegar black gel color" and the design on the pack/label is annexed along with the certificate of Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd. Contending that the plaintiffs are not the genuine proprietors of the registered copy right of the artistic label/carton and the trade mark "BEAUTE BLANC" of the plaintiffs and the trade mark "Nyomi" of the defendant are different and distinct, the defendant had pleaded that there is no infringement of either trade mark or copy right and consequentially there is no passing off of the defendant's product as that of the plaintiffs.

14. Before advertizing the merits of the rival contentions, it is pertinent to record that along with the injunction applications, the plaintiffs have taken out an Application for appointment of Advocate Commissioner to inspect the premises of the defendant and other places where the alleged infringed products are kept. Pursuant to the warrant issued by this Court,

the Advocate Commissioner has visited several places and has

seized infringed products which are similar to the products of the plaintiffs from few places and filed a report on 15.11.2019.

15.In response to the vacate injunction applications, the plaintiffs have filed a counter affidavit wherein, they have disclosed that the Chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,) is their supplier. Admit that even before getting the import license, they got the trade mark "BEAUTE BLANC" registered as proposed to be used. The plaintiff claim that they were the first to get product pack in the trade dress as designed by the plaintiffs so they are entitled for exclusive right and enjoyment of the artistic work on the label/carton. The defendant has not disclosed the Mega Arco Agency, Chennai is importing the goods under the trade mark "Nyomi". Even assuming Mega Arco Agency is importing the product from the same supplier carrying the trade mark "Nyomi", the registered copy right of the trade mark of the plaintiffs has to be protected being the prior user of the trade dress and duly registered as per the Indian law.

16.The plaintiffs contend that the defendant or Mega Arco Agency, Chennai who are competitors to the plaintiffs' business have approached the Chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,) and convinced them to get the product pack in the similar manner as that of the plaintiffs and

had adopted the trade mark "BEAUTY BOLD" exclusively placed where the plaintiffs have placed the registered trade mark "BEAUTE BLANC". The writing style clearly establishes the case of the plaintiffs. Taking exception to the conduct of the defendant using the trade mark "BEAUTY BOND" along with the trade mark "Nyomi", the plaintiffs would submit that the illegal intention of imitating the plaintiffs product is evident from the adoption of the word "BEAUTY BOLD" in the trade dress carton which is similar and identical of the trade mark of the plaintiffs.

17.The product which are marketed by the plaintiffs and the defendant is a fruit vinegar black gel color. The manufacturer of the product is Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd., which is a Chinese company. From the said company, both the plaintiffs and the supplier of the defendant are importing the products printing their respective trade marks on the label and carton. From the Advocate Commissioner's report and the annexures, this Court finds that not only the plaintiffs with their trade mark "BEAUTY BLANC" and the defendant with his trade mark "Nyomi" there are others with the registered trade marks like "YIRONGTANG", "Brimles" and "RB" are also marketing their products with the same artistic design, carton and label except carrying their registered trade marks at particular place on the left or top of the carton rest of the artistic work found on their carton

as identical.

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18.In the letter given by the manufacturer namely Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd., it claims that it has designed the artistic work on the carton and no Indian customer have right over that and he supply the Mega Arco Agency, Chennai and other Indian importers, his products with the logo / trade mark of the respective importers.

19.In the light of the above letter, issued by the Joyna Chinese company (Guangzhou Joynna Beauty Hairdressing Articles Co., Ltd.,) which is the manufacturer of the product as well as the carton/ label, the point now arise for consideration is, 'whether a manufacturer in a foreign country can supply identically similar product with different registered names in India. More so, when one of the Indian company has obtained registration of the trade mark and copy right of the artistic work.

20.Section 51 of the Copy Right Act, 1957 illustrates when a copy right deemed to be infringed. Section 53 of the Copy Right Act contemplates the situation of this nature and gives right to the owner of any copy right conferred under the copy right act to give notice to the Commissioner of Customs and request him the goods infringing the copy right shall be prohibited on arrival in India. For easy reference, Sections 51 and 53 of the Copy Right

Act read as below:-

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"51. When copyright infringed.—Copyright in a work shall be deemed to be infringed—

(a) when any person, without a licence granted by the owner of the copyright or the Registrar of Copyrights under this Act or in contravention of the conditions of a licence so granted or of any condition imposed by a competent authority under this Act—

(i) does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or 1[(ii) permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or] 1[(ii) permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or]"

(b) when any person—

(i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or

(ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or (iii) by way of trade exhibits in public, or (iv) imports 2[***] into India, 2[***] into India," any infringing copies of the work: 3 [Provided that nothing in sub-clause (iv) shall apply to the import of one copy of any work, for the private and domestic use of the importer.] Explanation.—For the purposes of this section, the reproduction of a literary, dramatic, musical or artistic work in the form of a cinematograph film shall be deemed to be an "infringing copy"."

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53. Importation of infringing copies.—

(1) The Registrar of Copyrights, on application by the owner of the copyright in any work or by his duly authorised agent and on payment of the prescribed fee, may, after making such inquiry as he deems fit, order that copies made out of India of the work which if made in India would infringe copyright shall not be imported.

(2) Subject to any rules made under this Act, the Registrar of Copyrights or any person authorised by him in this behalf may enter any ship, dock or premises where any such copies as are referred to in sub-section (1) may be found and may examine such copies.

(3) All copies to which any order made under sub-section (1) applies shall be deemed to be goods of which the import had been prohibited or restricted [under section 11 of the Customs Act, 1962 (51 of 1962),] and all the provisions of the Act shall have effect accordingly: Provided that all such copies confiscated under the provisions of the said Act shall not vest in the Government but shall be delivered to the owner of the copyright in the work."

21. In this case, the plaintiffs have obtained copy right of the design as well as the trade mark of "BEAUTE BLANC". From the documents relied by the parties, it is not the trade mark which is infringed in the products sold by the defendant but the design. Though the defendant's trade mark is "Nyomi", for the reason best known, they have also added the words "BEAUTY BOLD". Down below, the trade name "Nyomi" on seeing the product even a discerning mind will find difficult to identify the dissimilarities. Just because the source is one and the same and the source is outside India, products with similar trade dress infringing a registered copy right cannot be permitted.

22. Having been obtained a registration in his favour/defendant, the same has to be cancelled or rectified in the manner known to law. A manufacturer in Abroad cannot sell his products with the same get up, trade dress and design with different trade marks and flood the Indian market and make the

Indian customers get deceived. Therefore, this Court finds that the injunction sought to restrain the defendant from infringing the copy right (O.A.No.948 of 2019) and passing off (O.A.No.949 of 2019) have to be allowed. Accordingly, the defendant is restrained from infringing the copy right of the artistic work on the carton and passing off.

23.In so far as the infringement of trade mark (O.A.No.947 of 2019) is concerned, in isolation, the trade marks "BEAUTE BLANC" and "Nyomi" are dissimilar and the prayer of infringement of trade mark is rejected and injunction granted in that application alone is vacated.

24.In the result, Application No.250 of 2020 is dismissed and consequently, O.A.No.949 of 2019 (passing off) is allowed. Application No.251 of 2020 is dismissed and consequently, O.A.No.948 of 2019 (infringement of copy right) is allowed. Application No.249 of 2020 is allowed and consequently, O.A.No.947 of 2019 (infringement of trade mark) is dismissed.

Sd./-G.J.J
13.02.2020

//Certified to be true copy//

Dated at Madras this the day of 2020.

JJ 18/02/2020

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