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IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

THURSDAY, THE 29TH DAY OF JULY 2021

THE HON'BLE DR. JUSTICE G.JAYACHANDRAN

C.S.(Comm.Div)No.217 of 2019

and

A.No.9084 of 2019

C.S.No.217 of 2019:-

M/S.PRABA'S VCARE HEALTH CLINIC PVT. LTD.,
REP.BY ITS MANAGING DIRECTOR
MRS.E.CAROLIN PRABA,
15, NEW GIRI ROAD,
T.NAGAR,
CHENNAI – 600 017.

...Plaintiff

Vs

M/S. I-CARE AESTHETIC CLINIC,
NO.107/4, AE BLOCK, 1ST FLOOR,
10th MAIN ROAD,
ANNA NAGAR WEST,
CHENNAI – 600 040.

...Defendant

Civil Suit Praying that this Hon'ble Court be pleased to grant a
Judgment and Decree against the Defendant on the following terms:

a) A perpetual injunction restraining the Defendant by themselves
or their men, partners, proprietors, stockiest, dealers, servants, agents,
franchisees, successors in interest, licensees, assignees, representatives
distributors, sister concerns or any of them from in any manner infringing



logo by hosting websites/web pages, any services and/or manufacturing, selling, offering for sale, goods/services stocking, advertising, exporting, importing products either directly and/or indirectly by use of any mark/label/logo/device, such as 'ICARE' or any other mark which are deceptively similar to that of the Plaintiff's trade and service mark **or in any combination thereof either in Tamil or English or in any other language** or by use of identical or deceptively similar trading style such as 'I CARE' aesthetic Clinic and/or by use of imitative artistic work/lettering style or in any other manner whatsoever;

b) A perpetual injunction restraining the Defendant by themselves or their men, partners, proprietors, stockiest, dealers, servants, agents, franchises, successors and interest, licensees, assignees, representatives or any of them from in any manner **passing off** or enabling passing off of the Defendants' goods and/or service under the Trademark/label **“I CARE”** or any other deceptively similar Trade and Service Mark as and for the goods and services of the Plaintiff under the Trade Mark/label **“V CARE”** , or by use of any deceptive trading style **“I CARE”** or any trading style comprising the essential expression **“CARE”** in Tamil/ Telugu/ Hindi and/or English or in any other manner whatsoever;

c) The Defendant be ordered to surrender to Plaintiff for

<https://hcservices.ecourts.gov.in/hcservices/>

destruction all name boards, packing materials, visiting cards,



letterheads, printer bills, cartons, sachets and other goods bearing the Trademark “I CARE” or any mark deceptively similar to that of the Plaintiff's Trademark/label;

d) The Defendant be ordered to prepare and submit an account of profits made by them by the unlawful use of the Trade/Service Mark of the Plaintiff and thereafter to pass a final decree upon ascertaining the accounts, in favour of the Plaintiff and against the Defendant;

e) The Defendant be ordered to pay exemplary damages to the Plaintiff for acts of passing off and infringement of the trademark and service mark committed by them:

f) and declare the mark of the Plaintiff as well-known mark under the provisions of the Trademark Act 1999.

g) For the costs of the suit;

A.No.9084 of 2019:-

M/S. I-CARE AESTHETIC CLINIC,
No.107/4, AE Block, I Floor,
10th Main Road,
Anna Nagar west,
Chennai – 600 040.

...Applicant/Defendant

Vs

M/S.PRABA'S VCARE HEALTH CLINIC PVT. LTD.,
Rep.by its Managing Director
Mrs.E.Carolin Praba,
15, New Giri Road,
T.Nagar,
Chennai – 600 017.

...Respondent/Plaintiff



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Application praying that this Hon'ble Court be pleased to allow the present application and pass a summary judgement dismissing the above suit with cost.

This suit along with the application having been heard on 23.07.2021 in the presence of Mr.P.L.Narayanan, Advocate for the plaintiff in C.S.No.217 of 2019 and for the respondent in A.No.9084 of 2019 and Mr.Raghavan Ramabadrana for M/s.Lakshmi Kumaran & Sridharan, Advocates for the defendant in C.S.No.217 of 2019 and for the applicant in A.No.9084 of 2019 and upon reading the plaint filed in C.S.No.217 of 2019 and the judge's summon and the affidavit of D.E.Raghavan filed in A.No.9084 of 2019 and having stood over for consideration till this date and coming on this day before this court for orders in the presence of said advocates for the parties hereto and this court having observed that when there is no real prospect for the plaintiff to succeed and there is no other compel reason for the court not be disposal of the suit before recording oral evidence, this court is of the view that this case filed due to trade rivalry squarely falls within the order XIII-A of the civil procedure code to pass a summary judgement, allowing this application, **it is ordered as follows:**

That the suit in C.S.No.217 of 2019, be and is hereby dismissed.



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2) That the connected applications do stand closed.

3) That there shall be no order as to costs of this suit.

WITNESS THE HON'BLE MR. JUSTICE SANJIB BANERJEE,
CHIEF JUSTICE, HIGH COURT AT MADRAS AFORESAID, THIS
THE 29TH DAY OF JULY 2021.

Sd./-

ASSISTANT REGISTRAR(Comm.Cases)

//Certified to be true copy//

Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)

From 25th Day of September 2008 the Registry is issuing certified
copies of the Orders/Judgments



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24/08/2021

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C.S.No.217 of 2019
and
A.No.9084 of 2019

ORDER

DATED : 29.07.2021

THE HON'BLE DR. JUSTICE
G.JAYACHANDRAN

FOR APPROVAL: 09/09/2021

APPROVED ON: 13/09/2021



IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Reserved on :23/07/2021

Pronounced on :29/07/2021

Coram:

THE HONOURABLE DR. JUSTICE G. JAYACHANDRAN

Civil Suit (Comm.Div)No.217 of 2019
and A.No.9084 of 2019

C.S.No.217 of 2019:

M/s Praba's V Care Health Clinic Pvt. Ltd.,
Rep.by its Managing Director Mr.E.Carolin Praba,
15, New Giri Road,
T.Nagar, Chennai 600 017.

.. Plaintiff

/versus/

M/s I-Care Aesthetic Clinic,
No.107/4, AE Block, 1st Floor,
10th Main Road,
Anna Nagar West,
Chennai 600 040.

.. Defendant

Prayer in C.S.No.217 of 2019: Civil Suit has been filed under Order VII, Rule 1 of CPC R/W Order IV, Rule 1 OS Rules along with Section 27, 28,29,134 & 135 of the Trade Marks Act, 1999 and Section 7 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, No.4 of 2016 praying to grant a judgment and decree against the defendant on the following terms:

(a)A perpetual injunction restraining the defendant by themselves or their men, partners, proprietors, stockiest, dealers, servants, agents, franchises, successors in interest, licensees, assignees, representatives distributors,



sister concerns or any of them from in any manner infringing the plaintiff's registered trademark "V CARE" and/ or the mark/device/logo by hosting websites/web pages, any services and/or manufacturing, selling, offering for sale, goods/services stocking, advertising, exporting, importing products either directly and/or indirectly by use of any mark/label/logo/device, such as 'I CARE' or any other mark which are deceptively similar to that of the plaintiff's trade and service mark or in any combination thereof either in tamil or english or in any other language or by use of identical or deceptively similar trading style such as 'I CARE' aesthetic Clinic and/or by use of imitative artistic work/lettering style or in any other manner whatsoever;

(b) A perpetual injunction restraining the defendant by themselves or their men, partners, proprietors, stockiest, dealers, servants, agents, franchises, successors and interest, licensees, assignees, representatives or any of them from in any manner passing off or enabling passing off of the defendants goods and/or service under the Trademark/label "I CARE" or any other deceptively similar trade and service mark as and for the goods and services of the plaintiff under the trade mark/label "V CARE", or by use of any deceptive trading style "I CARE" or any trading style comprising the essential expression "CARE" in Tamil/Telegu/Hindi and/or English or in any other manner whatsoever;

(c) The defendant be ordered to surrender to plaintiff for destruction all name boards, packing materials, visiting cards, letterheads, printer bills, cartons, sachets and other goods bearing the Trademark "I CARE" or any mark deceptively similar to that of the plaintiff's trademark/label;



(d) The defendant be ordered to prepare and submit an account of profits made by them by the unlawful use of the trade/service mark of the plaintiff and thereafter to pass a final decree upon ascertaining the accounts, in favour of the plaintiff and against the defendant;

(e) The defendant be ordered to pay exemplary damages to the plaintiff for acts of passing off and infringement of the trademark and service mark committed by them;

(f) and declare the mark of the plaintiff as well-known mark under the provisions of the Trademark Act, 1999;

(g) for the cost of the suit.

For Plaintiff
For Defendant

:Mr.P.L.Narayanan
:Mr.Raghavan Ramabadrana

A.No.9084 of 2019:

M/s I-Care Aesthetic Clinic,
No.107/4, AE Block, 1st Floor,
10th Main Road,
Anna Nagar West,
Chennai 600 040.

.. Applicant/Defendant

/versus/

M/s Praba's V Care Health Clinic Pvt. Ltd.,
Rep.by its Managing Director Mr.E.Carolin Praba,
15, New Giri Road,
T.Nagar, Chennai 600 017.

.. Respondent/Plaintiff

Prayer in A.No.9084 of 2019: This application has been filed under Order XIV, Rule 8 of Original Side Rules Read Order XIII-A Read with Section 151 of the Code of Civil Procedure, 1908 praying to allow the present application and pass a summary judgment dismissing the above suit with cost.



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For Applicant : Mr.Raghavan Ramabadrar
For Respondent : Mr.P.L.Narayanan

J U D G M E N T

(The case has been heard through Video Conferencing)

The suit is filed for perpetual injunction restraining the defendant from infringing the plaintiff's registered trademark "V CARE" and/or the mark/device/logo by hosting websites/web pages, any services using any mark/label/logo/device such as, "V CARE" which are deceptively similar to that of the plaintiff's trade.

2.The gravamen of the plaintiff:-

The plaintiff is the registered proprietor, sole owner, first adopter and user of the trademark "V CARE". It was originally conceived, coined and adopted by the plaintiff in the year 1999 in respect of cosmetics, soaps, personal care products, skin care products, body care products, essential oils and perfumery preparations and herbal products and later, in respect of services relating to health care services, medical laboratory services, medical and scientific research and health-related consulting services, hospital, clinics and medical centre, medical services, hair loss treatments, hair transplantation, hair growth treatments, hair care treatments, healthcare services, medical health assessment services, medical advisory services, medical diagnostic services. The plaintiff also adopted tag line "We build confidence" in relation to its goods and services.



3.The plaintiff has started its business in the year 1999 and subsequently, incorporated as company under the Companies Act, 1956 and has adopted and used the mark openly and continuously and extensively over a period of 20 years in respect of above goods and services. The mark “V CARE” has become very popular and has attained a very high reputation among the general public. The plaintiff has secured its first trademark protection for the mark “V CARE” under trademark application No.1297896 in class-42 in respect of “Health Care” with user date as 12/03/1999. Thus, the plaintiff has become the prior registered owner in respect of the mark “V CARE”. The plaintiff has filed numerous applications for registration of the said trademark/label for various goods and services.

4.The details of such registered trademark are listed below:-

<i>S.No.</i>	<i>App.No.</i>	<i>Trade mark</i>	<i>CI</i>	<i>Goods/Services</i>	<i>Status</i>
1.	2145263	V CARE	03	Cosmetics, Soaps, Personal Care Products, Skin Care products, Hair Care Products, Body Care Products, Essential Oils and Perfumery Preparations and Herbal Products included in class	Registered
2.	2145260	V CARE	05	Pharmaceutical and Sanitary Preparations, Dietary Supplements, Disinfectants, Anti fungal Preparations, Herbal Supplements	Registered
3.	2420324	V CARE	05	Medicinal and	Registered



S.No.	App.No.	Trade mark	CI	Goods/Services	Status
		(Word mark)		Pharmaceutical Preparations; Food Supplements including Mineral Supplements, vitamin Supplements And Nutritional Supplements; Sanitary Preparations for Medical purposes; Dietetic substances adapted for medical use; Disinfectants; medicinal Ointments; Medicated Cream; Medicated	
4.	2420323	V CARE (Word Mark)	03	Cosmetics, Soaps, Personal Care Products, Skin Care Products, Hair Care Products, Body Care Products, Essential Oils and Perfumery.	Registered
5.	1297896	V CARE	42	Health Care Services	Registered
6.	2420325	V CARE (Word Mark)	42	Medical Laboratory Services, Medical and Scientific Research	Registered
7.	2420326	V CARE (Word Mark)	44	Health-Related Consulting Services; Hospitals, Clinics and Medical Centre; Providing Medical Services, hair Loss Transplantation, hair transplantation, hair growth Treatments, hair care treatments; healthcare services, medical health Assessment Services Medical Advisory Services, Medical Diagnostic Services	Registered
8.	2405666	V CARE FOR YOUR HAIR	44	Providing Medical Services, Hair Loss Treatments, Hair	Registered



<i>S.No.</i>	<i>App.No.</i>	<i>Trade mark</i>	<i>CI</i>	<i>Goods/Services</i>	<i>Status</i>
				Transplantation, Hair Growth Treatments, Hair care Treatments	
9.	2405667	V CARE BEAUTY CONCEPTS	35	Marketing, Retailing Services Connected with Medicinal, Pharmaceutical, Veterinary and Sanitary Preparations and Substances, Cosmetics, Beauty Care Products, Personal Care Products toiletries, Surgical Instruments, apparatus and equipment, Sales Promotion (for others), Advertising, Wholesale Distributorship and ordering services, organization of Exhibitions and Trade Fair for Advertising purposes, Distributing of credit fund discount cards, demonstration of goods, distribution of samples.	Registered

5.The said word mark “V CARE” and the device mark/label  in an artistic manner including in its getup, lettering style, colour scheme, placement of words, artistic features etc., termed as trade dress is original within the device meaning of the Copyright Act. Thus, the plaintiff is the sole and exclusive registered proprietor of the trademark “V  CARE” and device and has acquired

distinctiveness and secondary meaning in its mark in so far as the above



said services and products. The plaintiff's mark "V CARE" has acquired good reputation and goodwill among the trade and general public because of its long usage and popularity of over 20 years. By virtue of the same, the said mark/label by itself has become exclusively associated with the plaintiff and hence, the plaintiff has been vigilantly watching the potential infringer's to protect their trademark. While so, it has come to the notice of the plaintiff that a former employee of the plaintiff has commenced the business in the field of cosmetic service under the mark "I CARE" which is strikingly similar/identical to that of the plaintiff's trade mark/label under the name of "I CARE" Aesthetic Clinic, with the mala fide intention to unjust enriching their service at the expense of plaintiff's goodwill and reputation. The defendant is providing service under the trade mark with the prominent part of the plaintiff's registered trademark. The letter "I" is strikingly similar to that of essential letter "V". The depiction of the word "CARE" in the very same manner by the defendant after illegitimate selection of the word "CARE" being ex-employee is enough to demonstrate the malafide of the defendant. Apart from the same, the phonetic similarity cannot be ignored in comparing the labels.

6. The defendant had filed written statement wherein the averments,



were denied. The defendant states that she is a partnership firm by name

M/s R.D.Associates consisting of Mr.B.Pandiyan, P.Divya,

Mr.D.C.Raghavan and D.C.Aarthi on 16.07.2018. The Defendant trades

as “I CARE AESTHETIC CLINIC”. The defendant is a hair replacement,

skincare and slim care centre that specializes in all types of treatments

related to hair, skin & slimming. In order to popularize its services and to

create an innovative trading style for itself, the defendant coined and

adopted the highly stylized and unique trademark and started

commercially using the same since September 2018. The plaintiff

trademark “V CARE” is not similar to that of the defendant trademark “I

CARE”, which is highly stylized device mark having several other

elements attached to it. The word “CARE” is used in common parlance

in all fields more so, in the field of healthcare and cosmetics. Therefore,

all the parts of subject trade mark are essential features and this is also

evidenced by the condition imposed on the plaintiff by the Trademark

Registry that they cannot claim exclusive use of the word “CARE”. The

use of the word “CARE” has to be seen in combination with other

features of a mark. The plaintiff has adopted a strategy of dissecting a

composite mark and therefore, the plaintiff can allege infringement and

passing off of its trademarks in the same class as that of the plaintiff

though there is no adoption or deceptive similarity between the mark of



the plaintiff and the defendant. Hence, the suit is liable to be dismissed.

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7. Besides the written statement, the defendant has filed an application in A.No.9084 of 2019 seeking summary judgment of dismissal of the suit. The defendant in its application has brought out the unique feature of its trade mark and to show the trade mark of the plaintiff's has not been adopted by the defendant. Further, for the common word "CARE" has been used in both trade mark, the case of the defendant is that the word is not distinctive but descriptive. Trade mark authority has granted registration to the plaintiff trade mark "V CARE" on condition that they cannot claim exclusive use of the word "CARE". Therefore, there is no real prospects of the plaintiff succeeding the suit. Hence, the application for summary judgment dismissing the suit has to be passed.

8. For easy reference, the defendant has made comparison of two marks and the same is extracted below:

<u>Plaintiff's trademarks</u>	<u>Defendants' subject trademark</u>
V CARE	
	



9. In the application filed under Order XIII-A of the Code, the applicant/defendant claims to pass a summary judgment.

10. On a bare perusal of the above mentioned marks, it is palpable no similarity either phonetic, visual or structural is noted. Only commonness between the plaintiff and the defendant trade mark is the word “CARE”, which is a generic word over which the respondent/plaintiff cannot claim exclusiveness. Even according to the trade mark registration certificate, the plaintiff is granted trademark certificate subject to the condition not to claim exclusive right over the word “CARE”. Thus, the grant of trademark is for the composite words “V CARE”. The learned counsel for the applicant/defendant informs the search for trademarks containing the term “CARE” under class 44 resulted about 2952 trademarks. This makes it evident that the word “CARE” is a common term and *publici juris* and no single entity can claim any proprietorship right over the same. The mark has to be compared as a whole and cannot be dissected. The defendant's mark is a device mark with several other visual elements and it is completely different from both the word and logo of the plaintiff's mark. Therefore, there is no deceptive or otherwise any similarity between the said marks.

11. The learned counsel appearing for the applicant/defendant reiterating the averments made in the affidavit filed for the summary



judgment would submit that the plaintiff has no prospect of succeed.

Hence, summary judgment has to be passed.

12.Per contra, the learned counsel appearing for the respondent/plaintiff would submit that the fundamental and essential features in the registered trade mark of the plaintiff has been adopted by the defendant. The plaintiff and the defendant are engaged in allied and cognate trade. The suit is filed on the premises that the defendant is trying to ride piggy back over the reputation of the plaintiff and trying to allure the customers of the plaintiff by adopting the deceptive similar trademark and thereby, indulging in the act of passing off and infringement of the trademark of the plaintiff and the plaintiff has listed out nine trademarks, for which registration has been obtained.

13.According to the learned counsel appearing for the plaintiff/respondent, the registered trade mark “V CARE” and the impugned trade mark of the defendant “I CARE” are phonetically similar. “V” (We) and “I” are pronouns, which are normally inter-placed. Therefore, adopting phonetically similar word deceptively in a similar manner demonstrates the mala fide intention of the defendant.

14.The learned counsel appearing for the plaintiff/respondent strongly relying upon the judgment of the Hon'ble Supreme Court in



in (2011) 4 SCC 85, popularly known as “Eenadu” case, submitted that the registered trade mark of the plaintiff is a strong enough association with health care and the trade mark “V CARE” is the fundamental feature, which is adopted by the defendant leading to infringement.

15. In *T.V. Venugopal case* cited above, the Court has identified two situations where the infringement of trademark will arise and those two situations are:

“81. From the above discussions, the following two situations arise:

- (i) Where the name of the plaintiff is such as to give him exclusivity over the name, which would ipso facto extend to barring any other person from using the same viz. Benz, Mahindra, Caterpillar, Reliance, Sahara, Diesel, etc.*
- (ii) The plaintiff's adopted name would be protected if it has acquired a strong enough association with the plaintiff and the defendant has adopted such a name in common field of activity i.e. the purchaser's test as to whether in the facts of the case, the manner of sale, surrounding circumstances, etc. would lead to an inference that the source of the product is the plaintiff.”*

16. In the said case, the Hon'ble Supreme Court has held that the respondent company “Eenadu” has acquired extraordinary reputation and goodwill in the State of Andhra Pradesh. It is extremely well known and almost a household words in the State of Andhra Pradesh. The word “Eenadu” may be a descriptive word, but has acquired the secondary or subsidiary meaning, were fully identified with the products and services provided by the respondent company. Therefore, relying this observations, the learned counsel appearing for the plaintiff submitted



that the fact whether the trade mark is acquired a strong association with the plaintiff or whether the trade mark “V CARE” has acquired extraordinary reputation and goodwill, is to be tested through witnesses. Therefore, summary judgment of dismissal without examination of witnesses is not possible.

17. Section 29 of the Trade Marks Act enlist when infringement as trade mark will arise. Therefore, it is to be tested whether the contention of the plaintiff is proved will amount to infringement of its trademark. For that purpose, Section 29 of Trade Marks Act, 1999 is extracted before for easy reference:

29. Infringement of registered trade marks.—*(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.*

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and



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the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of subsection (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to



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a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

18. In **Kaviraj Pandit Durga Dutt Sharma v. Navaratna**

Pharmaceutical laboratories reported in (1965) 1 SCR 737, the Hon'ble

Supreme Court held as:

“Once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be “in the course of trade”, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the



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defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21)(new Section 29(2)). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks — the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the



trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff”.

(Emphasis added)

19. The above view of the Apex Court based on Section 21 of the Old Trade Marks and Merchandise Act, 1958, is partially changed in the light of Section 29 of the New Trade Mark Act, 1999.

20. In ***S.M.Dyechem Ltd. v. Cadbury (India) Ltd., reported in (2000) 5 SCC 573***, the Hon'ble Supreme Court has held:

“23. Under Section 29 of the Act, a plaintiff in a suit on the basis of infringement has to prove not only that his trademark is infringed by a person who is not a registered proprietor of the mark or a registered user thereof but that the said person is using a mark in the course of his trade, “which is identical with or *deceptively* similar to the trademark of the plaintiff, in such manner as to render the use of the mark likely to be mistaken as the registered trademark”. Under Section 2(1)(d), the words “deceptively similar” are defined as follows:

“2. (1)(d) ‘deceptively similar’.—A mark shall be deemed to be deceptively similar to another mark if it so *nearly resembles* that other mark as to be *likely to deceive or cause confusion*.”

(emphasis supplied)

25. It is well settled that the plaintiff must

prove that essential features of his registered mark have been copied. The onus to prove “deception” is on the part of the plaintiff who alleges infringement. A mark is said to be infringed by another trader if, even without using the whole of it, the latter uses one or more of its “*essential features*”. The identification of an essential feature depends partly on the court's own judgment and partly on the burden of the evidence that is placed before it. Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude consideration of the *sound* of words forming part or the whole of the mark. (*Kerly's Law of Trade Marks and Trade Names*, 11th Edn., 1983, para 14.21.) (Emphasis Added)

21. Under Section 29 of the Trade Marks Act, 1999, as it reads cast the burden on the applicant to make out a *prima facie* that the mark, is identical with or deceptively similar to, the trade mark, in relation to goods or services in respect of which, the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

22. Regarding passing off, the test should be whether a person with average intelligence and poor recollection will be misled by the impugned product.



23. In the light of the above discussion, if one search for identification of essential feature between the mark of the plaintiff and the mark of the defendant, we will be able to find none except the common word “CARE”.

24. For reference both the marks are given below:



These two marks either juxtaposition or separately seen, no person of average intelligence and poor recollection will be misled or get confused.

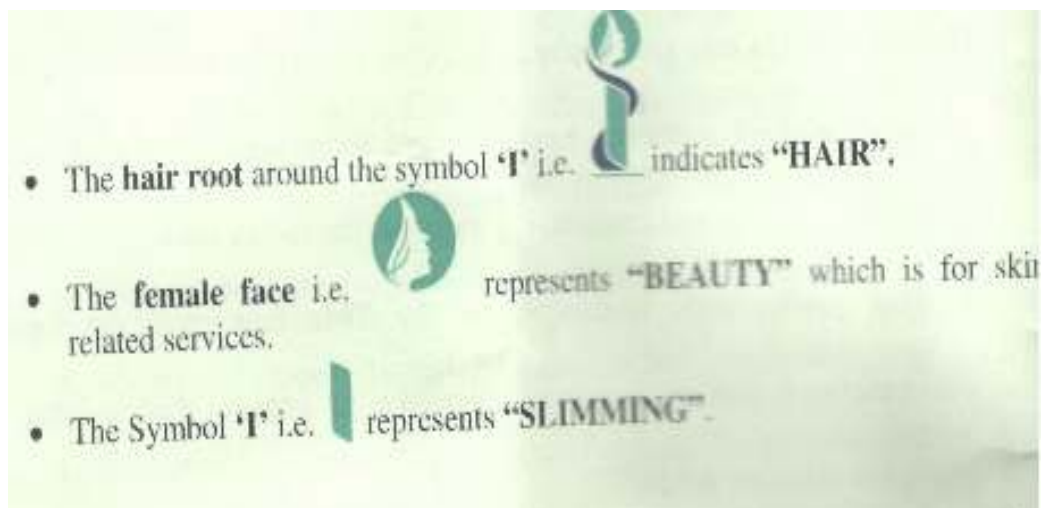
25. It is to be noted that the defendant had explained the unique features found in its device mark as below:



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The registered trade mark of the plaintiff is strikingly different from the



mark of the defendant. As laid down by the Hon'ble Supreme Court in *M/s S.M.Dyechem Limited* case cited supra, the identification of the essential feature is partly on the Courts own judgment. This Court on search of common or similar essential features among the above two trademarks unable to find any.

26. In such circumstances, when there is no real prospect for the plaintiff to succeed and there is no other compel reason for the Court not be disposed of the suit before recording oral evidence, this Court is of the



view that this case filed due to trade rivalry squarely falls within the Order XIII-A of the Civil Procedure Code to pass a summary judgment.

27. Accordingly, the application to pass summary judgment in A.No.9084 of 2019 is allowed. Consequently, the Civil Suit is dismissed. No order as to costs. Consequently, connected applications are closed.

Sd./-G.J.J
29.07.2021

//Certified to be true copy//
Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)

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