



IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

THURSDAY, THE 09TH DAY OF JUNE 2022

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

O.A.Nos. 71 & 72 of 2022

in

C.S.(Comm Div)No. 22 of 2022

M/s. Proklean Technologies P. Ltd.,
Represented by Mr. Vishwadeep Kuila,
4th Floor, Sintron Square,
Dr. VSI Estate,
Phase 1, Thiruvanmiyur,
Chennai – 600 096.

... Applicant / Plaintiff

-Vs-

M/s. Godrej Consumer Products Ltd.,
4th Floor, Godrej One,
Pirojshanagar, Eastern Express Highway,
Vikhroli,
Mumbai – 400 079.

... Respondent / Defendant

O.A.No. 71 of 2022 :-

Original Application praying that this Hon'ble Court be pleased to grant an order of ad-interim injunction restraining the Respondent / Defendant, its men agents and servants from in any manner Passing off its business as that of the Applicant/Plaintiff by using the name



similar name as that of the Applicant/Plaintiff with or without any
deceptively similar or similar logo as that of the Applicant / Plaintiff in its
registered mark or any of the
other names and logos for which registration has been applied for by the
Applicant / Plaintiff pending disposal of the suit.

O.A.No. 72 of 2022 :-

Original Application praying that this Hon'ble Court be pleased to
grant an order of ad-interim injunction restraining the Respondent /
Defendant, its men agents, servants, employees, licensees, distributors and
anyone claiming through it, from or in any manner infringing the registered
trade mark of the Applicant / Plaintiff with or

without a similar logo, or by any other identical name or deceptively similar
name as that of the Applicant / Plaintiff with or without any deceptively
similar or similar logo as that of the Applicant / Plaintiff in its registered
mark or any of

the other names and logos for which registration has been applied for by the
Applicant / Plaintiff pending the disposal of the suit.



These Original Applications having been heard on 27.04.2022 in the presence of Mr.K.Harishankar, Advocate for the Applicant in both Original Applications, and Mr.Arun C. Mohan, Advocate for the Respondent in both Original Applications and upon reading the Judges Summons and the Affidavit of Mr.Vishwadeep Kuila, filed in O.A.Nos. 71 & 72 of 2022 and the Complaint filed herein, and having stood over for consideration till this date and coming on this day before this Court for orders in the presence of the said advocates for the parties hereto and this Court having observed that both in the reply to the cease and desist notice and in the counter, the respondent asserted that it has used the mark 'ProClean' from June 2020, in fact, the respondent stated that its turnover from the sale of products bearing the impugned mark is about Rs.4327 lakhs, the applicant is unable to controvert these assertions, by contrast, the applicant has not produced its sales turnover and advertising expenditure, it is also pertinent to notice and record that the Applicant sells products under different names such as ProFab, ProDish, GreaseOut, ProGloss, DeepImpact, ProJanit, the mark "ProKlean" is only used in conjunction with the above mentioned trade names and not separately, and the above tilts the balance of convenience against the grant of interim injunction since in this factual context, the hardship caused thereby to the respondent would outweigh the hardship to the applicant by the denial of interim injunction, as regards the application



for passing off, as asserted by the respondent, the applicant has not produced either its sales turnover or advertising expenditure to establish goodwill. Therefore, the higher threshold is not satisfied at this juncture, and **It is ordered as follows :-**

That respondent herein, shall maintain and submit accounts of turnover and profits from the sale of goods bearing the impugned mark 'ProClean' in this Court on quarterly basis.

2. That the O.A.Nos. 71 & 72 of 2022 in C.S.(Comm.Div.)No. 22 of 2022 be posted on 13.06.2022.

WITNESS THE HON'BLE MR. JUSTICE MUNISHWAR NATH BHANDARI, CHIEF JUSTICE, HIGH COURT AT MADRAS AFORESAID, THIS THE 09TH DAY OF JUNE 2022.

Sd/-

ASSISTANT REGISTRAR (Comm.Cases)

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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10.06.2022
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O.A.Nos. 71 & 72 of 2022
in
C.S(Comm.Div.)No. 22 of 2022

ORDER

DATED : 09.06.2022

THE HON'BLE MR. JUSTICE
SENTHILKUMAR RAMAMOORTHY

FOR APPROVAL: 10.06.2022

APPROVED ON : 10.06.2022



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Orders Reserved on : 27.04.2022

Orders Pronounced on : 09.06.2022

CORAM:

THE HON'BLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

Original Application Nos.71 & 72 of 2022

in

C.S.(Comm. Div)No.22 of 2022

M/s.Proklean Technologies P. Ltd.,
Represented by Mr.Vishwadeep Kuila,
4th Floor, Sintron Square, Dr.VSI Estate,
Phase 1, Thiruvanmiyur,
Chennai-600 096.

... Applicant/Plaintiff
in both OAs

Vs.

M/s.Godrej Consumer Products Ltd,
4th Floor, Godrej One,
Pirojshanagar, Eastern Express Highway,
Vikhroli, Mumbai-400 079.

... Respondent/Defendant
in both OAs

Prayer in O.A.No.71 of 2022: Original Application is filed under Order

XIV Rule 8 of Original Side Rules r/w. Order XXXIX Rule 1 & 2 of CPC,

1908 seeking to grant an order of ad-interim injunction restraining the

Respondent/Defendant, its men agents and servants from in any manner

passing off its business as that of the Applicant's/Plaintiff's by using the

name 'ProKlean' with or without a similar logo, or by any other identical



name or deceptively similar or similar logo as that of the applicant/plaintiff, with or without any deceptively similar or similar logo as that of the Applicant/Plaintiff in its registered mark 'Proklean' or any of the other names and logos for which registration has been applied for by the applicant/plaintiff pending disposal of the suit.

Prayer in O.A.No.72 of 2022: Original Application is filed under Order XIV Rule 8 of Original Side Rules r/w. Order XXXIX Rule 1 & 2 of CPC, 1908 seeking to grant an order of ad-interim injunction restraining the Respondent/Defendant, its men, agents, servants, employees, licensees, distributors and anyone claiming through it, from or in any manner infringing the registered trade mark of the applicant/plaintiff 'ProKlean' with or without a similar logo, or by any other identical name or deceptively similar name as that of the Applicant/Plaintiff, with or without any deceptively similar or similar logo as that of the applicant/plaintiff in its registered mark 'proklean' or any of the other names and logos for which registration has been applied for by the applicant/plaintiff pending the disposal of the suit and thus render justice.

For Applicant : M/s.K.Harishankar

For Respondent : M/s.Arun C.Mohan

**ORDER**

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In a suit for alleged trademark infringement, passing off, rendition of accounts, damages and surrender of infringing materials, the plaintiff has presented these two applications for interim injunctions to restrain the defendant from infringing the applicant's trademark and from passing off, respectively.

2. The applicant/plaintiff is a limited company incorporated under the name and style of ProKlean Technologies Private Limited. The applicant's predecessor adopted the mark 'ProKlean' for its unique probiotic products. The applicant stated that it has used the mark 'ProKlean' from the year 2012 on a continuous basis. The mark was registered as a word mark under Registration No.1981425 on 17.06.2010 in class 5 for goods described as 'deodorants other than personal use'. Concurrently, the word mark 'ProKlean' was registered under Registration No.1981426 on 17.06.2010 in class 3 for goods described as 'cleaning preparation' within the South Indian territory. One more registration was effected on 17.06.2020 for the word mark 'ProKlean' in class 35 for goods described as wholesale and retail services of cleaning preparation, etc. The applicant stated that it invested substantial sums of money and put in considerable effort in popularising the trademark which has acquired a strong reputation and goodwill in the Indian



and international market.

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3. Upon noticing the use of the mark 'ProClean' by the respondent in relation to floor cleaning products, before filing this suit, the applicant issued a cease and desist notice on 19.07.2021 calling upon the respondent not to use any trademark which infringes or results in passing off the applicant's trademark 'ProKlean'. The suit was filed because such cease and desist notice did not elicit an appropriate response.

4. With regard to the disclaimer by the applicant at the time of registration of the trademark, the applicant stated that such disclaimer was provided in the year 2010. Moreover, the disclaimer was in respect of two products bearing the mark ProClean which were used as surgical hand wash products. The applicant also pointed out that the Trademark Registry raised objections to the respondent's application for registration of the mark 'Godrej ProClean' on grounds specified under Section 11 of the Trademarks Act, 1999 (the Trade Marks Act) because similar trademarks were already on record for the same or similar goods. As regards the restriction in respect of territorial limits, the applicant contended that such restriction was accepted in the year 2010 because the applicant was not marketing its products outside South India at the relevant time. Since the applicant is



marketing its products all over India at present, the applicant contended that it is entitled to the interim orders prayed for in these applications.

5. These contentions were refuted by the respondent. As regards the trade mark registration certificates produced by the applicant dated 17.06.2010, the respondent pointed out that the registration certificates are in the name of S.Sivaramakrishna Pillai except for the registration dated 17.06.2020 in class 35, which is in the name of the applicant/plaintiff. The respondent also pointed out that the applicant has not produced the assignment deed or the certificate of registration of the assignment in its favour. The next contention of the respondent is that the applicant has not produced any proof of sales turnover or advertising expenditure. The respondent relied on the principle of prosecution history estoppel and contended that an estoppel operates against the applicant because in response to the objections of the Trademark Registry the applicant asserted that 'ProKlean' with the letter 'K' is distinct from 'ProClean' with the letter 'c'. Consequently, the respondent cannot contend otherwise upon noticing the respondent's product, which is 'ProClean' with the letter 'C' instead of the letter 'K'. The respondent further contended that the two marks should be looked at as a whole and, if so examined, the products are easy to differentiate because the respondent uses the distinctive and well known



prefix 'Godrej'. The respondent further contended that its products are chemical based, whereas the applicant's products are organic.

6. In support of these contentions, the respondent relied on the following judgments:

(i) Medley Pharmaceuticals Limited v. Megh Healthcare Private Limited 2016 SCC Online Bom 4317 (Paragraphs 3 and 4)(Medley Pharmaceuticals)

(ii) BRS Refineries Private Limited v. Liberty Oil Mills Limited 2016 SCC Online Bom 10470 (paragraphs 2 to 8)(BRS Refineries)

(iii) Unichem Laboratories Ltd v. IPCA Laboratories Ltd 2011 (45) PTC 488 (paragraphs 39-59)

(iv) Living Media India Ltd. v. Alpha Dealcom Pvt. Ltd. 2016 SCC Online Del 815 (Paragraphs 14 to 19).

(v) S K Sachdeva & Another v. Shri Educare Limited & Another 2016 SCC Online Del 473 (Paragraphs 15 to 19)(Sachdeva)



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(vi) *Meso Private Limited v. Liberty Shoes*

Ltd (SB) 2019 (80) PTC 186 (Paragraph 9)

(vii) *Meso Private Limited v. Liberty Shoes*

Ltd (DB) 2020 (1) Mh.L.J.253 (Paragraph 34)(Meso)

(viii) *Peshawar Soaps Chemical Ltd. v.*

Godrej Soas Ltd. 2001 (58) DRJ 170 (Paragraphs 13, 14 and 19)

(ix) *Ajanta Pharma Limited v. Theon*

Pharmaceutical Ltd. 2016 SCC Online Bom 10469 (Paragraphs 18 and 19)

(x) *T.T.Krishnamachari & Co. v. Godrej*

Agrovet Ltd. (2009) 1 MLJ 679.(TTK)

7. By way of rejoinder, the applicant stated that the observations of the Trademark Registry cannot be attributed to the applicant. The mark 'ProKlean' does not stand for professional cleaning; it is a house mark which is inspired by the use of probiotics by the applicant. The territorial restriction was based on use at the relevant point of time. As regards the



Sivaramakrishna Pillai is a promoter of the plaintiff company. Since this objection was not taken in the counter, the relevant documents, although available, could not be produced. The last contention of the applicant was that the respondent entered the market recently with full knowledge of the applicant's use of the registered trademark 'ProKlean'. Therefore, the respondent is not entitled to any equity.

8. The documents on record evidence that the mark 'ProKlean' was registered as a word mark in classes 5 and 3 with effect from 17.06.2010. While the class 5 registration is in respect of deodorants other than personal use, the class 3 registration is in respect of the cleaning preparation. Both these registrations are in the name of S.Sivaramakrishna Pillai and B. Chandrasekhar, trading as Eco Systems and Technologies, which appears to be a partnership firm. As pointed out by the respondent, neither the assignment deed nor the registration certificate in respect of the assignment of the trade mark in favour of the applicant/plaintiff is on record. Consequently, it is not possible to conclude, on the basis of materials on record, that the applicant/plaintiff is the registered proprietor of the mark 'ProKlean' in class 3 or 5. The registration certificate in respect of class 35 is also on record, and this certificate dated 17.06.2020 is in the name of the plaintiff. Class 35 pertains to the wholesale and retail services of cleaning



preparation; liquid soap for washing dishes; hand cleaners, clearing preparations for household purposes, etc. The grievance of the applicant/plaintiff is primarily directed at the disinfectant floor cleaner and disinfectant bath room cleaner of the respondent/defendant. Therefore, on the basis of the registration obtained in the name of the plaintiff on 17.06.2020, the application for infringement is maintainable. Even otherwise, the applicant/plaintiff is entitled to maintain the application for passing off. The sustainability of the application is, however, distinct from the maintainability thereof and the said aspect is addressed next.

9. The respondent pointed out that objections were raised by the Trademark Registry in the year 2014, when the application for registration of the mark 'ProKlean' in class 3 was prosecuted. By relying on the observations of the Trademark Registry, the respondent contended that the applicant distinguished its mark from the mark 'ProClean', which was previously registered in the name of M/s.Casil Health Products Limited in class 3, by stating that the use of the letter 'K' makes it distinct from the earlier mark. The respondent also pointed out that the applicant had agreed to restrict the area of operation to South India. On such basis, it was contended that the Trademark Registry agreed to advertise the mark before



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10. Upon considering the materials on record, there is sufficient basis to conclude that S.Sivaramakrishna Pillai and B.Chandrasekhar were the prior users of the trademark 'ProKlean'. While the registrations in the name of S.Sivaramakrishna Pillai and B.Chandrasekhar are with effect from 17.06.2010, the trademark application of the respondent specifies that the mark is in use from 31.07.2020. Thus, the use of the mark 'Godrej ProClean' by the respondent is even subsequent to the registration of the word mark 'ProKlean' in the name of the applicant under class 35 on 17.06.2020. Even otherwise, for interlocutory purposes, I am inclined to proceed on the assertion of the applicant that S.Sivaramakrishna Pillai and B.Chandrasekhar are the predecessors-in-interest of the applicant. Indeed, even the status report produced by the respondent in respect of the class 3 TM application shows the name of the applicant as the proprietor. The applicant should, however, produce requisite documents in this regard in the suit.

11. The respondent relied strongly on the observations by the Trademark Registry on 07.11.2014 to contend that it is not open to the applicant to claim that 'ProClean' with 'C' and 'ProKlean' with 'K' are deceptively similar. In support of the proposition that prosecution history



estoppel operates against the applicant, several judgments such as *Medley*, *BRS Refineries* and *Sachdeva* were cited. Any estoppel, including prosecution history estoppel, is a rule of evidence that operates against the person who made the representation provided the representation was acted on to the detriment of the person to whom such representation was made. In this case, the representation is not on record and only the observations of the Trademark Registry are on record. The observation is to the effect that “the applicant mark is able to be distinguished from the cited mark”. At the interlocutory stage, in my view, this observation does not preclude the applicant from prosecuting the applications. On this issue, it is pertinent to note that all the judgments cited by the respondent turned on the unambiguous representations made by the respective applicant therein and, therefore, are not applicable in this factual context.

12. The respondent also contended that the word mark 'ProKlean' is descriptive by citing precedents such as *Living Media*, *Meso* and *Peshawar Soaps*. The question whether a mark is distinctive in spite of being a fusion of two or more descriptive words is dependent on whether the constituent words are self-evident and also whether the mark has attained a secondary meaning. In the case at hand, 'ProKlean' is an essential feature of the corporate name of the applicant. The mark has been used from the year 2010



by the applicant's predecessor-in-interest and by the applicant, and is a registered word mark in three classes. In these circumstances, *prima facie*, it cannot be concluded that it is not distinctive. The respondent also contended that its product is distinguishable by the use of the prefix 'Godrej'. While testing the likelihood of deception or confusion, the essential features and overall impression are significant. The word or element 'ProClean' in the respondent's mark is prominent and, therefore, is not sufficiently offset by the prefix 'Godrej' for infringement purposes.

13. The balance of convenience and hardship remain to be considered. Both in the reply to the cease and desist notice and in the counter, the respondent asserted that it has used the mark 'ProClean' from June 2020. In fact, the respondent stated that its turnover from the sale of products bearing the impugned mark is about Rs.4327 lakhs. The applicant is unable to controvert these assertions. By contrast, the applicant has not produced its sales turnover and advertising expenditure. It is also pertinent to notice and record that the Applicant sells products under different names such as ProFab, ProDish, GreaseOut, ProGloss, DeepImpact, ProJanit. The mark "ProKlean" is only used in conjunction with the above mentioned trade names and not separately. In my view, the above tilts the balance of convenience against the grant of interim injunction since in this factual



hardship to the applicant by the denial of interim injunction. However, the respondent shall maintain and submit accounts of turnover and profits from the sale of goods bearing the impugned mark "ProClean" in this Court on quarterly basis. In the interest of both parties, however, the suit should be concluded on expedited basis.

14. As regards the application for passing off, as asserted by the respondent, the applicant has not produced either its sales turnover or advertising expenditure to establish goodwill. Therefore, the higher threshold is not satisfied at this juncture.

15. O.A.Nos.71 and 72 of 2022 are disposed of on the above terms.

List the suit on 13.06.2022.

Sd./- S.K.R.J.,
09/06/2022

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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