



C.S.No.23 of 2015

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Judgment reserved on	16.08.2022
Judgment pronounced on	01.11.2022

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

Civil Suit No.23 of 2015

Wipro Enterprises Limited,
'C' Block, CCLG Division,
Doddakannelli, Sarjapur Road,
Bangalore – 560 035
And having branch office at
33/34. Ganesh Nagar,
G.K. Industries Estate, Alapakkam,
Chennai – 600 116
Rep. by Amit Mathur, Manager - Legal.
vs.

... Plaintiff

- 1.ZYDUS WELLNESS PRODUCTS LIMITED,
A company incorporated under the Companies Act,1956
House No.6 & 7, Sigma Commerce Zone,
Near Iscon Temple, Sarkhej – Ghandinagar,
Highway, Ahmedabad,
Gujarat, India – 380 015.
(Amended as per order dated 27.06.2019 in
Appl. No.4261 of 2019)
- 2.Candico (I) Limited
M-32, MIDC Industrial Area,
Hingna Road, Nagpur – 440 016.
- 3.New Naathan Store,
No.54, Armenian Street,
Chennai – 600 001.

... Defendants



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The suit is filed under Order IV Rule 1 of O.S. Rules, Order VII Rule 1 of the Civil Procedure Code, 1908, read with Sections 27, 134 & 135 of the Trade Marks Act, 1999 praying for (a) granting a permanent injunction, restraining the defendants, by themselves, their servants, agents, men or anyone claiming through them from manufacturing, marketing, disturbing, offering or advertising for sale any kind of products using the mark **VOLT** or similar sounding marks in the course their business and pass of their products using the Trade Mark **VOLT** as and for products sold under trademark **BOLTS** of the plaintiff or enable others to pass off;(b) granting a permanent injunction, restraining the defendants, by themselves, their servants, agents, men, or anyone claiming through them from manufacturing, marketing, disturbing, offering or advertising for sale any kind of products using the tag line INSTANT ENERGY, ANYTIME, ANYWHERE., or similar sounding lines in the course of their business and pass of their products using the tag line ENERGY OF GLUCON-D, ANYWHERE, ANYTIME, as and for products sold under the tag line INSTANT ENERGY, ANYTIME, ANYWHERE, of the plaintiff or enable others to pass off; (c) granting a permanent injunction, restraining the Defendants, by themselves, their servants, agents, men or anyone claiming through them from manufacturing, marketing, disturbing, offering or advertising for sale any kind of products using the color scheme and get up as seen in DOCUMENT NO.1 or similar color schemes and get up in the course of their business and pass of their products using the color scheme and get up in DOCUMENT NO.2 as and for products sold under the color scheme and get up in DOCUMENT NO.1 of the plaintiff or enable others to



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pass off; (d) directing the defendants to surrender to the plaintiff all products, packing material, cartons, advertisement materials and hoardings, letterheads, visiting cards, office stationery and all other materials containing/bearing the trademark **VOLT** or other necessary similar Trade Mark in respect of pharmaceutical and medicinal preparations; (e) for a preliminary decree in favour of the plaintiff, directing the defendant to render an account of profits made by them by the use of the Trade Mark **VOLT** in relation to their products and for a final decree in favour of the plaintiffs for the amount of the profits found to have been used made by the defendants, after the defendant have rendered accounts; and (d) for costs of the suit.

For Plaintiff : Mr.N.L.Rajah, Senior Advocate,
for Ms. Gladys Daniel

For Defendants : Mr.Satish Parasaran,
Senior Advocate,
for Mr.Arun C.Mohan for D1

JUDGMENT

One of the products manufactured and marketed by the plaintiff is a glucose-based chewy tablet sold under the trademark BOLTS. The defendants also manufacture and market a glucose-based chewy tablet under the trademark VOLT. The suit was filed seeking relief in respect of alleged passing off by the defendants of their products under the mark VOLT as the products of the plaintiff bearing the mark BOLTS. The plaintiff also sought



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to restrain the defendants from using the tag line ENERGY OF GLUCON-D, ANYWHERE, ANY TIME, on the ground that the said tag line is deceptively similar to the plaintiff's tag line INSTANT ENERGY, ANYTIME ANYWHERE. Pursuant to the interim application being contested, the defendants removed the tag line ENERGY OF GLUCON-D, ANYWHERE, ANYTIME. The plaintiff had also prayed for relief in respect of the colour scheme and get up of the defendants' packaging, as represented in Document No.2, which was annexed to the plaint. Such colour scheme and get up of the packaging was modified by the defendants, in terms of an interim compromise, and O.S.A.Nos.111 to 113 of 2015 were disposed of on that basis without prejudice to the plaintiff's objection to the use of the mark VOLT. Consequently, prayers (b) & (c) of paragraph 24 of the plaint do not survive for adjudication.

2. The plaintiff stated the following. Wipro Limited entered into a scheme of arrangement with Azim Premji Custodial Services Private Limited and Wipro Trademarks Holding Limited. By such scheme, the customer care products were transferred to and vested in Azim Premji Custodial Services Private Limited. The scheme was approved by the Hon'ble Karnataka High Court by order dated 01.03.2013 in Company



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Petition Nos.8, 9 and 10 of 2013. Thereafter, Azim Premji Custodial Services Private Limited changed its name and is presently known as Wipro Enterprises Limited, i.e. the plaintiff herein. In course of business, on 16.04.2003, the predecessor-in-interest of the plaintiff acquired the trademark GLUCOVITA from Hindustan Lever Limited. As a result of the de-merger, the said mark vests with the plaintiff. The plaintiff is the proprietor of several trademarks, including BOLTS. The mark BOLTS was conceived and adopted the mark in the year 2012 and the plaintiff uses the mark along with the house mark GLUCOVITA to market and sell glucose based chewy tablets. These tablets contain three active ingredients, namely, vitamin-D, calcium and iron. These tablets may be consumed without water and therefore they may be carried in the pocket and are a good source of instant energy.

3. The plaintiff further stated as follows. It earned Rs.26.35 million from the sale of the above mentioned product in the financial year 2012-2013, Rs.171.07 million in the financial year 2013-2014 and Rs.233.90 million in the financial year 2014-2015. A considerable amount of money was expended in promoting products under the trademark BOLTS. In the financial year 2012-2013, it is stated that the sales expenditure of



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Rs.26.35 million and advertising expenditure of Rs.21.60 million was incurred. This increased to Rs.171.07 million towards sales expenses and Rs.81.54 million towards advertisement expenses in the financial year 2013 - 2014 and further increased to Rs.182.65 million towards sales expenses and Rs.112.42 million towards advertisement expenses in the financial year 2014-2015.

4. In December 2014, the plaintiff stated that it noticed an identical product in the market, which was manufactured and marketed by the first and second defendants and sold by the third defendant. According to the plaintiff, the adoption of the mark VOLT by the defendants is *mala fide* because the said mark is deceptively similar to the plaintiff's mark BOLTS. The plaintiff further stated that the *mala fide* intention of the defendants is clear from the adoption of an identical colour scheme and get up for the packaging. The plaintiff also stated that the adoption of the tag line ENERGY OF GLUCON-D ANYWHERE, ANYTIME underscores the *mala fide* intention because the said tag line is an imitation of the plaintiff's tag line INSTANT ENERGY ANY TIME, ANY WHERE. The plaintiff asserted that consumers referred to its product as BOLTS and, therefore, the adoption and use of a deceptively similar trademark VOLT by



the defendant is likely to cause confusion. The suit was instituted in the said facts and circumstances.

5. In spite of service of suit summons and the names of the defendants being printed in the cause list, there was no representation for defendants 2 and 3. Therefore, by order dated 25.07.2019, defendants 2 and 3 were set *ex parte*.

6. The first defendant refuted the statements in the plaint by filing a written statement. In the said written statement, the first defendant raised the preliminary objection that leave to sue was obtained in Application No.11 of 2015 by suppressing material facts. The first defendant also alleged that the plaintiff had made changes to the plaint after obtaining leave to sue, and that the changes in the cause of action paragraph substantially altered the basis on which leave to sue was obtained earlier. The first defendant pointed out that the plaintiff had filed O.S.No.15 of 2015 before the City Civil Court, Hyderabad, on substantially the same grounds. In the said suit, an *ex parte* order of injunction was granted on 20.01.2015 and thereafter vacated on the ground of suppression of material facts.

7. The first defendant further stated the following. The word BOLTS is common to the trade and was previously adopted and used by



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other entities offering products that provide energy or speed. The mark VOLT is not visually, phonetically or structurally similar to BOLTS. The plaintiff's goods are manufactured and marketed under the well known trademark GLUCOVITA and similarly the first defendant's products are manufactured and marketed under the well known trade mark GLUCON-D. Therefore, it is not possible for members of the public to be confused or deceived. The expression BOLT/BOLTS is a common generic expression over which monopoly cannot be claimed. The expression VOLT is the SI unit of electromagnetic force and was adopted honestly with a view to communicate to consumers that they will experience a sudden charge of energy on consuming the product.

8. The first defendant further stated as follows. It launched the product GLUCON-D VOLT in December 2014 in the State of Tamil Nadu. The sales turnover and marketing expenditure in respect of GLUCON-D VOLT runs into several crores. It invested several lakhs in promoting and advertising GLUCON-D VOLT.

9. The first defendant denied that the plaintiff adopted the mark BOLTS in the year 2017. The first defendant asserted that VOLT is not identical or deceptively similar to BOLTS. The first defendant also stated



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that the plaintiff's product carries the mark GLUCOVITA and is not known by the mark BOLTS. The first defendant denied that the packaging is deceptively similar and also denied that it copied the plaintiff's tag line. For reasons stated earlier, these aspects have become irrelevant on account of subsequent changes made by the first defendant to the colour scheme, get up and tag line.

10. The plaintiff filed a reply statement in response to the written statement. With regard to the changes made to the plaint after obtaining leave to sue, the plaintiff stated that the suit was instituted a few days after the first defendant launched the product. Therefore, at that time, the plaintiff had not obtained invoices pertaining to the sale of the first defendant's products. Such invoices were obtained from four pharmacies in Chennai and, therefore, the cause of action paragraph was amended to reflect the sale of the product at Saidapet, Parry's Corner, Teynampet and West Mambalam. With regard to jurisdiction, the plaintiff pointed out that the first defendant withdrew the application to revoke leave and, therefore, cannot challenge the jurisdiction of this Court.

11. The plaintiff reiterated that VOLT is deceptively similar to BOLTS and that such similarity is visual, phonetic and structural. The



plaintiff further stated that the products of the plaintiff and the first defendant are sold through the same trade channels. Although the trademark GLUCOVITA and GLUCON-D are used by the plaintiff and defendant, respectively, the products are known as BOLTS and VOLT, respectively. The plaintiff denied that BOLTS is generic and stated that VOLT is deceptively similar although it has a dictionary meaning.

12. Based on the pleadings and documents, the Court framed the following issues:

(1) Whether the defendant's product “Glucon-D Volt” is passing the plaintiff's product “Glucovita”?

(2) Whether the plaintiff can claim exclusive right to use the expression “BOLT” when they themselves are not prior users of the same?

(3) Whether there is any confusion created in the minds of the general public with regard to differentiating the expressions “Glucovita BOLT” & “Glucon-D VOLT”?



(4) *Whether the expression "anywhere, anytime"*

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13. Mr.V.G.T. Raj, the Manager-Regional Accounts of the plaintiff, was examined as P.W.1. In course of the examination-in-chief of P.W.1, 10 documents were exhibited as Exs.P1 to P10. P.W.1 was cross examined by learned counsel for the first defendant. Ms.Urvashi Soni, the authorized representative of the first defendant, was examined as D.W.1. In course of the examination-in-chief of D.W.1, 13 documents were exhibited as Exs.D1 to D13. D.W.1 was cross-examined by learned counsel for the plaintiff.

14. Oral arguments were advanced on behalf of the plaintiff by Mr.N.L.Rajah, learned senior counsel, assisted by Ms.Gladys Daniel, learned counsel; and on behalf of the first defendant by Mr.Satish Parasaran, learned senior counsel, assisted by Mr.Arun C.Mohan, learned counsel.

15. Learned senior counsel for the plaintiff commenced his submissions by stating that the plaintiff adopted and used the mark BOLTS



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in the year 2012. He invited my attention to Ex.P2, which is the plaintiff's label, and to Ex.P4, which is the defendants' label. He submitted that the first defendant had adopted not only the deceptively similar mark BOLT but had also copied the plaintiff's tag line INSTANT ENERGY, ANY TIME, ANY WHERE by adopting the tag line ENERGY OF GLUCON-D, ANY WHERE, ANY TIME. In addition, he stated that a similar colour scheme was adopted. Subsequently, the colour scheme and tag line were modified but the first defendant continues to use the deceptively similar mark VOLT. The first defendant's adoption and use of the mark VOLT is admittedly subsequent in point of time because the said defendant adopted the mark in the year 2014.

16. Learned senior counsel denied that other entities had adopted and used the mark BOLTS previously. By referring to Ex.D11(series), he pointed out that the marks depicted therein are not marks used in India. For instance, he referred to the use of the mark VOLT for an organic energy product at page No.33 of the typed set of exhibits and pointed out that this product is sold at US Dollars 29.88. Similarly, with reference to the label at page 39, he pointed out that the BOLT energy drink is not available in India.



His next submission was that GLUCOVITA is the house mark of the plaintiff and that the plaintiff manufactures and markets products under several trademarks, including BOLTS, by also using the house mark GLUCOVITA. However, consumers refer to each product by the specific trademark assigned to such product. Consequently, as regards the glucose based chewy tablets, he stated that consumers refer to it as BOLTS and not as GLUCOVITA. Therefore, he stated that VOLT is deceptively similar to BOLTS and that the plaintiff is entitled to restrain the first defendant, which is a subsequent user of the deceptively similar mark, from using the same. In support of these contentions, he referred to and relied upon the following judgments:

(1) Parle Products (P) Ltd. v. J.P. And Co., Mysore, MANU/SC/0412/1972, particularly paragraphs 8 & 9 thereof.

(2) Power Control Appliances and Others v. Sumeet Machines Pvt. Ltd., MANU/SC/0646/1994, particularly paragraph 44 thereof.

(3) Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd.(Cadila), MANU/SC/0199/2001, particularly paragraphs 42 thereof.

(4) Amritdhara Pharmacy v. Satyadeo Gupta(Amritdhara), MANU/SC/0256/1962, particularly paragraphs 11 and 12 thereof.



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(5) Ciba Ltd v. M.Ramalingam and S.Subramaniam trading in the

name of South Indian Manufacturing Co. and Others, MANU/MH/0021/1958, particularly paragraph 8 thereof.

17. Learned senior counsel for the first defendant submitted that the first defendant entered the market first under the mark GLUCON-D. He focused attention on the conduct of the plaintiff and pointed out that the plaintiff filed a different version of the plaint along with the application for leave to sue, and made material amendments to the cause of action paragraph of the plaint subsequently. Secondly, he submitted that the plaintiff instituted a suit in Hyderabad and later withdrew the same. With regard to the sale of the plaintiff's product, he submitted that only secondary evidence was produced. By referring to Ex.P8, which is an invoice in the name of Wipro Enterprises Limited, he pointed out that the said invoice is fabricated because the plaintiff was incorporated only on 19.04.2013, whereas the invoice is dated 12.05.2012. Therefore, he submitted that the invoices submitted by the plaintiff should not be relied upon.



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18. With regard to the merits of the dispute, he submitted that the lightning device is used by the first defendant to represent the sudden surge of energy or power. On this issue, he referred to question No.3 and the answer thereto of P.W.1 during cross-examination. With regard to the submission that GLUCOVITA is a house or umbrella mark, he stated that the only pleading on the said issue is in paragraph 6 of the plaint. Consequently, he submitted that the plaintiff failed to establish that GLUCOVITA is a house mark. His next contention was that the plaintiff applied for registration of the mark GLUCOVITA BOLTS as a device mark. In the application submitted for registration of the said device mark, the plaintiff relied on the prior registration of the mark GLUCOVITA in class 30 and submitted that GLUCOVITA BOLTS is an extension of the already well-known brand GLUCOVITA. He also pointed out that the plaintiff responded to the objections of the trademark registry by pointing out that the mark is a composite mark consisting of the words GLUCOVITA and the word BOLTS and that, when compared as a whole, the mark is different from the prior marks GLUCOFIT and GLUCOVITS.



19. By referring to the changes made to the colour scheme, get up and tag line, learned senior counsel concluded his submissions by stating that the plaintiff failed to provide any evidence of actual confusion although the first defendant's product is in the market from 2014. He further stated that there is no likelihood of confusion either because the plaintiff's mark BOLTS is used with the registered mark GLUCOVITA and the first defendant's mark VOLT with the registered mark GLUCON-D. In support of these contentions, he referred to and relied upon the following judgments:

(1) *F.Hoffmann-La Roche Ltd and two others v. Intas Biopharmaceuticals Limited*, 2013 SCC Online Mad 1545.

(2) *Quadricon Pvt. Ltd. v. Shri Bajarang Alloys Ltd*, 2009 SCC Online Bom 402.

(3) *S.R.Muthusami Gounder v. T.Krishnaswamy Iyengar and another*, 1951 SCC Online Mad 319.

(4) *Kishore Samrite v. State of Uttar Pradesh and others*, (2013) 2 SCC 398.

(5) *Stokely Van Camp, Inc and Another v. Heinz India Private Limited (Stokely Van Camp)*, 2010 (44) PTC 381 (Del).

(6) *Free Elective Network Private Limited v. Matrimony. com. Limited (Free Elective)*, judgment of this Court dated 14.07.2022 in Civil Suit (Comm.Div.) No.122 of 2021.

(7) *ITC Limited v. Nestle India Limited (ITC Limited)* 2020 (84) PTC 395 (Mad).



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(8) *ITC Limited v. Nestle India Limited*,
MANU/SCOR/50230/2021.

(9) *Ultratech Cement Grasim Industries Limited v. Dalmia Cement Bharat Limited*, 2016 SCC Online Bom 3574.

(10) *Kopran Chemical Co. Ltd. v. Sigma Laboratories*, 1993 SCC Online Bom 461.

(11) *Erven Warnink Bestloten Vennootschap and others v. J.Townend & Sons (Hull) Limited and others*, *MANU/UKHL/0030/1979*.

20. By way of rejoinder, learned senior counsel for the plaintiff submitted that changes were made in the cause of action paragraph before the suit was numbered. Therefore, the permission of the Court was not required. He relied on the judgment of the Hon'ble Supreme Court in *Hanamanthappa and another v. Chandrashekharappa and others* (1997) 9 SCC 688 for the proposition that alterations may be made to the plaint upon return thereof. With regard to the objections on jurisdiction, he submitted that the first defendant withdrew Application No.1443 of 2015 to revoke leave on 03.03.2015 upon the plaintiff agreeing to prosecute the suit before this Court and not institute proceedings in any other court. With regard to Ex.P7, he stated that the said invoice was computer generated and that the system was set up in such manner that the invoice was generated under the



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new name instead of the old name. He concluded his submissions by pointing out that the classic triple test comprising misrepresentation, goodwill and reputation and damage thereto were duly established by the plaintiff. Therefore, the plaintiff is entitled to succeed.

21. Although four issues were framed by the Court on 18.10.2019, the fourth issue pertaining to the tag line does not survive for consideration on account of the deletion of such tag line by the first defendant. The remaining three issues warrant consideration. Issue No.2 pertains to whether the plaintiff can claim exclusive right to the expression BOLT/BOLTS. Since the decision on this issue would have a strong bearing on issues 1 and 3, this issue is decided first.

Issue No.2:

22. Learned senior counsel for the first defendant cited *Free Elective* and *Stokely Van Camp* to contend that the rival mark BOLT/BOLTS is commonly descriptive and, therefore, not entitled to protection. Trademarks are typically placed in four categories on a spectrum. At one end of the spectrum are marks that are not entitled to protection. Two categories that are entitled to conditional and unconditional protection, respectively, are placed in the middle, and slotting marks into the one or the



other is not always free from contest. At the other end, are marks entitled to strong unconditional protection. The categorisation of trademarks in the landmark judgment of *Abercrombie & Fitch Company v. Hunting World Incorporated*, 537 F.2d 4 (2d Cir. 1976) , in relevant part, is extracted below:

“The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright...”

A generic mark is one which describes a product or service category, i.e. a genus comprising several species; a descriptive mark is one which describes the quality, nature, purpose, ingredient or characteristic of a product or service; a suggestive mark is one which suggests but does not describe the quality, nature, purpose, ingredient or characteristic of a product or service; and an arbitrary mark is chosen capriciously and does not bear any discernible connection with the product or service.

23.The placement of a mark into one of these categories, which are not watertight, is dependent on the product or service to which the mark is applied. Therefore, the exercise cannot be carried out divorced from



context. For instance, in the context of a dating and matchmaking service

app, I concluded in *Free Elective* that the mark “Jodi” is descriptive. The conclusion may have been different if the same mark had been used for a different service or product. In *Stokely Van Camp*, the Division Bench of the Delhi High Court refused to protect the tag line Rehydrates, Replenishes Refuel, in the context of the use of the trademark “Glucon D Isotonik” prominently on the packaging by the counter party, on the ground that it is descriptive. As stated earlier, in this case, the tag line controversy has been resolved. The questions that arise are : (i) into which category on the spectrum of marks should BOLTS be placed in; and (ii) whether protection should be extended to BOLTS. The defendant exhibited three distinct dictionary meanings of BOLTS as Ex.D10 to substantiate the contention that it is a commonly used word in the English language and, therefore, not distinctive. The three meanings are: a large metal pin; a short, heavy arrow shot from a crossbow; and a jagged white flash of lightning.

24. Trademark protection cannot be denied merely because a mark is listed in dictionaries. Of the three meanings ascribed in the dictionary, the first two meanings have no relation to the product to which the mark is applied. The third: a jagged white flash of lightning also does



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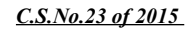
not directly describe the nature, quality, characteristic, purpose or ingredient of the product. The plaintiff has adopted the mark BOLTS in relation to glucose based chewy tablets. While BOLTS is a dictionary word, in the context of glucose based chewy tablets, it cannot be said to be descriptive of the product category or even the nature, quality or purpose. The mark was probably adopted in view of the 'instant energy' characteristic of the product, but a fair measure of imagination is required to make the connection between BOLT (which also means flash of lightning) and the 'instant energy' characteristic of the product. Therefore, the mark is suggestive and not descriptive.

25. The plaintiff asserted that the mark BOLTS was adopted and used from 2012. In support of this submission, the plaintiff exhibited invoices pertaining to the sale of the product. These invoices are exhibited as Ex.P8(series). The first invoice is dated 12.05.2012 and the last invoice is dated 20.12.2014. These invoices were disputed by the first defendant on the ground that they are photocopies. Secondly, the first defendant contended that the invoices were fabricated by pointing out that the plaintiff was incorporated only on 19.04.2013 and therefore could not have issued invoices prior thereto. In order to establish devolution of title, the plaintiff



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exhibited the order dated 01.03.2013 of the Karnataka High Court in Company Petition Nos.8 to 10 of 2013. The said document discloses that a scheme of arrangement was approved by the members and other stakeholders of Wipro Limited, Azim Premji Custodial Services Private Limited and Wipro Trademarks Holding Limited. On examining the scheme, it is evident that all three companies were part of the same group. Wipro Limited was carrying on consumer care products business and the scheme envisaged that the said business would be de-merged from Wipro Limited and vested in Azim Premji Custodial Services Private Limited. Azim Premji Custodial Services Private Limited was converted into a public limited company later and changed its name as Wipro Enterprises Limited on 19.04.2013. The mark GLUCOVITA BOLTS was conceived of, adopted and used by the plaintiff's predecessor-in-interest, Wipro Limited. The scheme of arrangement specifies the appointed date as 01.04.2012. Therefore, upon approval of the scheme on 01.03.2013, the scheme takes effect from the appointed date, i.e. 01.04.2012. As a consequence, accounting is done by the parties to the scheme on the basis that the de-merger took effect from 01.04.2012. For instance, all sales effected by the consumer care products division of Wipro Limited would be accounted in



26. The question that follows is whether any other entity used the mark BOLTS prior thereto. In order to establish that the mark BOLT/BOLTS was used earlier, the defendant placed on record Exs.D9 to D11. Ex.D9 is an application by GRV Confectionery and Foods Pvt. Ltd. for registration of the device mark BOLT in Class 30 in relation to confectionery, chocolates, candy, etc. This application was filed on 19.08.2013 and use is asserted therein from 01.04.2012, but evidence of use is not on record. Ex.D10 sets out the dictionary meaning of the word BOLT. Ex.D11 contains labels used by other entities bearing the mark BOLT. On closely examining the same, it appears that the mark BOLT has been used outside India both in relation to an energy bar and an energy drink. In India, it has been used for a car brand. However, there is no evidence of the use of the mark BOLT/BOLTS in relation to similar products in India except for the above mentioned



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application by GRV Confectionery and Foods Pvt. Ltd. Based on this evidence, I conclude that there is no evidence of prior use of the mark BOLT/BOLTS in India in relation to the same or similar products. Therefore, it is concluded that the plaintiff appears to be the first user of the mark BOLTS in relation to glucose based chewy tablets or products similar thereto in India. In *S.Syed Moideen v. P.Sulochana Bai*, (2016) 2 SCC 683, at paragraph 30.4, the Hon'ble Supreme Court noted that the scheme of the Trademarks Act recognizes the rights of a prior user as being superior to that of a registered proprietor and that even a registered proprietor cannot disturb/interfere with the rights of a prior user. Therefore, as the first user, the plaintiff is entitled to claim exclusive right to use the mark BOLTS in relation to glucose based chewy tablets or products similar thereto.

Issue Nos.1 and 3:

27. Issue Nos.1 and 3 relate to passing off. Since these issues are inter-related, they are dealt with and disposed of jointly. On examining Exs.P2 and P4, it is clear that the plaintiff's mark is a device mark which contains the word elements GLUCOVITA BOLTS. The defendant's mark is also a device mark which contains the word elements GLUCON-D VOLT.



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The plaintiff asserted that the consumer refers to the product as BOLTS and not as GLUCOVITA BOLTS, and placed on record invoices relating to the sale of the product. All the invoices refer to the product as GLUCOVITA BOLTS. In the proof affidavit of P.W.1, P.W.1 stated that BOLTS is a trademark conceived and adopted in the year 2012 and used along with the house mark GLUCOVITA to market and sell glucose based chewy tablets. The details of advertisements pertaining to the mark BOLTS are placed on record as Ex.P9(series). Ex.P9 series also refers to the product as GLUCOVITA BOLTS.

28. Therefore, the dispute boils down to whether the use of the mark GLUCON-D VOLT by the defendant is deceptively similar to GLUCOVITA BOLTS and would therefore lead to confusion or deception among consumers. The Hon'ble Supreme Court formulated the tests for determining whether there is passing off in ***Cadila***. In paragraph 42 of the Manupatra report, the following factors were held to be relevant for such purpose.

"42. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered.



a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

c) The nature of the goods in respect of which they are used as trade marks.

d) The similarity in the nature, character and performance of the goods of the rival traders.

e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f) The mode of purchasing the goods or placing orders for the goods and

g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

29. If the above tests are applied, it is clear that both marks are composite marks. Both marks have word mark elements. Both marks are used in relation to identical goods, target the same class of consumers, and are likely to be purchased in an identical retail environment. In a similar factual matrix, the Supreme Court discussed likely consumer behaviour and decided ***Amritdhara*** on the following lines:



"7. Let us apply these tests to the facts of the case under our consideration. It is not disputed before us that the two names "Amritdhara" and "Lakshman-dhara" are in use in respect of the same description of goods, namely a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townsfolk, literate as well as illiterate. As we said in *Corn Products Refining Co. v. Skangrila Food Products Ltd.*[(1960) (1) SCR 968] the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity-of the two names "Amritdhara" and "Lakshmandhara" is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words "Amritdhara" and "Lakshmandhara". We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as "current of nectar" or "current of Lakshman". He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language



would go by the etymological or ideological meaning and see the difference between “current of nectar” and “current of Lakshman”. “Current of Lakshman” in a literal sense has no meaning; to give it meaning one must further make the inference that the “current or stream” is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him; but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between “Amritdhara” and “Lakshmandhara”. He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments."

In similar fashion, the rival marks 'FEVICOL MARINE' and 'JIVANJOR MARINE PLUS' were considered similar in *Pidilite Industries Limited v. Jubliant Agri & Consumer Products Limited*, 2014 SCC OnLine Bom 50, by observing that carpenters and other potential users of such products were likely to get confused as to origin.

30. Turning to the case at hand, the first defendant contended that the use of the prefix GLUCOVITA by the plaintiff and GLUCON-D by the first defendant distinguishes the products and would avert the likelihood of confusion or deception. On the contrary, the plaintiff contended that these products are referred to as BOLTS and VOLT, respectively, and therefore,



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there is strong likelihood of confusion or deception. The plaintiff asserted both in pleadings and oral evidence that GLUCOVITA is a house mark and that several products under different marks are sold under the house mark GLUCOVITA. The defendant denied the said assertion and contended that the plaintiff did not prove that GLUCOVITA is a house mark. All the invoices filed by the plaintiff as Ex.P8(series) bear the description GLUCOVITA BOLTS as regards its products. Therefore, there is no doubt that the product is referred to as GLUCOVITA BOLTS and not merely as BOLTS. Be that as it may, the exercise of determining whether there is likelihood of deception or confusion should be carried out from the perspective of a consumer of average intelligence and imperfect recollection. The question is whether such consumer is likely to be confused or deceived as regards GLUCON-D VOLT and GLUCOVITA BOLTS. In contrast to *ITC Limited* - where the comparison was between ITC SUNFEAST YIPPEE INSTANT NOODLES MAGIC MASALA, on the one hand, and NESTLE MAGGI XTRA DELICIOUS MAGICAL MASALA, on the other - the distinguishing factors are minimal. When examined from the perspective of the average consumer, the retail sale environment should also be borne in mind. These products are typically



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sold as over-the-counter products by pharmacies. It is reasonable to assume that consumers would ask for the product by using the easier-to-use expressions BOLTS and VOLT. The said expressions are certainly phonetically, structurally and visually similar. Consequently, the likelihood of confusion or deception cannot be disregarded.

31. The manner of adoption of the first defendant's device mark is also relevant while deciding this case. Both the plaintiff and the first defendant are large entities with considerable reputation. The plaintiff introduced the product GLUCOVITA BOLTS before the first defendant introduced the product GLUCON-D VOLT. Given the fact that they operate in the same segment, the first defendant was certainly aware about the plaintiff's product. After being aware of the plaintiff's product, the first defendant introduced a near identical product under the mark GLUCON-D VOLT and adopted a similar tag line and colour scheme. Therefore, the adoption of the device mark by the first defendant was certainly with the intention of coming as close to the plaintiff's product as possible. When all the facts and circumstances are taken into account, I am of the view that the use of VOLT as part of the device mark in relation to a near identical product is likely to cause confusion or deception. The plaintiff has placed



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on record evidence of reputation and goodwill in the form of its sales turnover and advertisement expenses. Such reputation and goodwill would be injured by the use of the deceptively similar mark GLUCON - D VOLT by the first defendant. Therefore, Issue Nos.1 and 3 are decided in favour of the plaintiff and against the first defendant.

32. Before drawing the curtain, however, the fact that the defendant has sold GLUCON-D VOLT for a considerable period of time should be reckoned. Consequently, it is possible that unsold inventory is in the pipeline. In order to provide lead time to liquidate inventory in the sales channels, subject to accounting for profits, the order of injunction shall come into effect two months from the date of receipt thereof. The plaintiff is also entitled to delivery of impugned products and the like and for a preliminary decree for rendition of account of profits. Since costs follow the event, the plaintiff is entitled to costs. By taking into account court fees, reasonable lawyer's fees and other expenses, the plaintiff is entitled to a sum of Rs.3,00,000/- as costs.

33. In the result, the suit is decreed in terms of prayers **(a), (d)** and **(e)** of paragraph 24 of the plaint subject to the qualifications set out herein. Consequently, the defendants are restrained by an order of



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permanent injunction from applying the mark VOLT in relation to glucose based energy tablets or any products similar thereto, which are manufactured by it after the date of the order, with immediate effect. As regards products in the sales channels, in order to enable liquidation of inventory, the order of permanent injunction and the delivery-up order shall come into effect two months from the date of receipt of a copy of this order. However, the first defendant shall provide an account of profits made by the use of the mark VOLT in relation to its products. The defendants are directed to pay a sum of Rs.3,00,000/- (Rupees three lakhs only) as costs to the plaintiff towards court fee, reasonable lawyer's fees and other expenses.

01 .11.2022

Index : Yes
Internet : Yes
rrg

Plaintiff's witness:

1.Mr.V.G.T.Raj : P.W.1

Defendants' witness:

Mr.Kamlesh Soni : D.W.1

Documents exhibited by the Plaintiff:

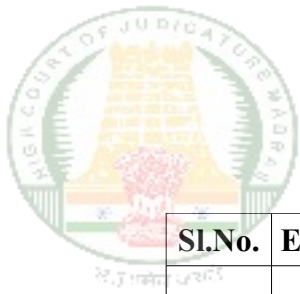


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Sl.No	Exhibits	Date	Particulars of Documents
1.	Ex.P1	-	Photocopy of Power of Attorney
2.	Ex.P2	-	Printout of the Plaintiff's product BOLTS mentioned in 65B Certificate
3.	Ex.P3	23.12.2014	Original Chartered Accountant Certificate
4.	Ex.P4	-	Printout of Defendant's product VOLT mentioned in 65B certificate
5.	Ex.P5	30.12.2014	Original Invoice showing the sale of the third defendant product within the jurisdiction of this court.
6.	Ex.P6	-	Original invoice showing sale of the impugned product from a third party within the jurisdiction of this court.
7.	Ex.P7	01.03.2013	Order passed in C.P.Nos,8,9,10 of 2013 by the High Court of Karnataka
8.	Ex.P8	-	Photocopy of the Sales Invoices of the plaintiff from the year 2012-2014 as per order in A.No.2718/2021 and 2719/2021 dated 17.06.2021.
9.	Ex.P9	-	Photocopy of the Advertisement details pertaining to the Trade Mark BOLTS from the year 2012-2014.
10.	Ex.P10	16.04.2003	Photocopy of Deed of Assignment

Documents exhibited by the Defendants:

Sl.No.	Exhibits	Date	Particular of Documents
1.	Ex.D1	30.03.2022	A copy of the Board resolution
2.	Ex.D2	-	A photocopy of the Brand Equity ratings of Most Trusted Brands
3.	Ex.D3	-	A photocopy of the Chartered Accountant Certificate for the sales turnover and sales promotional figures
4.	Ex.D4	-	A photocopy of the first defendant's range of products.
5.	Ex.D5	-	A print out of the online status of the plaintiff's trade mark application under No.2827969
6.	Ex.D6	-	A printout of the online status of the plaintiff's trade mark application under No.2808370
7.	Ex.D7	-	A printout of the reply to the examination report for the trade mark application under No.2808370
8.	Ex.D8	-	A printout of the reply to the examination report for the



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Sl.No.	Exhibits	Date	Particular of Deocuments
			trade mark application under No.2828969
9.	Ex.D9	-	Service agreement entered between first and second defendants
10.	Ex.D10	-	A printout of the Third-party application under No.2582054 for the mark Bolt
11.	Ex.D11	-	A printout of others using the mark Bold
12.	Ex.D12	-	A printout of others using the color combination orange for orange flavoured goods
13.	Ex.D13	-	A printout of others using the expression ANYTIME, ANYWHERE.

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SENTHILKUMAR RAMAMOORTHY, J.
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Pre-Delivery Judgment

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01.11.2022