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

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Date of Decision: 14th November, 2022

+ **FAO-IPD 43/2021 & CM APPL. 32440/2016 (Stay)**

**M/S PORNSRICHAROENPUN
CO. LTD & ANR.**

..... Appellants

Through: Mr. Shailen Bhatia, Ms. Vibhuti
Sharma, Ms. Snehil Bhatia, Ms. Janhvi
Chadha, Mr. Jay Shah, Mr. Anuraj
Tirthankar and Ms. Atiga Singh, Advocates.

versus

**M/S L'OREAL INDIA
PRIVATE LIMITED & ANR.**

..... Respondents

Through: Mr. Akhil Sibal, Senior
Advocate with Mr. S.K. Bansal, Mr. Ajay
Amitabh Suman, Ms. Asavari Jain,
Ms. Deboshree Mukherjee and
Ms. Aiswanya Debadarshini, Advocates.

**CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH**

JUDGEMENT

JYOTI SINGH, J.

1. Challenge in the present appeal is laid to an order dated 30.03.2016, passed by the learned Trial Court in TM No. 90/2014, whereby the application under Order XXXIX Rules 1 and 2 CPC, 1908 has been disposed of and Appellants have been restrained from using the trademark 'HAIR SPA'. Appellants herein are the Defendants before the learned Trial Court while Respondents are the Plaintiffs and the parties are hereinafter referred to by their litigating status in the present appeal.

2. Appellant No. 1, having its registered office in Thailand, is stated to be carrying on a well established business as manufacturer, marketer, exporter and/or dealer of cosmetics and hair care products under the trademark 'BERINA' for the past several years. Products of Appellant No. 1 are sold in Asian countries viz. Thailand, Singapore, Malaysia, India, etc. Appellant No. 2 is engaged in importing, selling, marketing and/or distributing various cosmetics and hair care products, manufactured by Appellant No. 1 for many years.

3. It is averred by Appellant No. 1 that Ms. A. Ngun Luechaputiporn, a Thai National is the first and original proprietor of the trademark 'BERINA', which is used in relation to cosmetics and hair care products and is registered in India in Class 03. As a registered proprietor, she granted a licence to Appellant No. 1, authorising it to use the trademark in relation to cosmetics and hair care products.

4. On 29.08.2006, Appellant No. 1 sent the first consignment of the products bearing the mark 'BERINA' HAIR SPA to Appellant No.2, for sale in India. The products were advertised in March, 2011 in a magazine wherein advertisement of Respondents' product was also published and despite this knowledge, no action was taken for over three years by the Respondents.

5. In November, 2014 Respondents filed a suit for permanent injunction against the Appellants alleging infringement of trademark, passing off, etc. On 20.11.2014, the learned Trial Court passed an *ex-parte* order of injunction, restraining the Appellants from using 'BERINA HAIR SPA'. *Vide* impugned order dated 30.03.2016, the application under Order XXXIX Rules 1 and 2 CPC, 1908 was disposed of and the interim injunction was confirmed by the learned Trial Court.

6. Appellants have laid a siege to the order of the learned Trial Court in the present appeal on the following grounds:-

A. Trial Court has erred in observing that counsel for the Appellants had referred to certain judgments during the course of the arguments but no such judgments were filed on record. The observation is contrary to the record of the Trial Court inasmuch as the judgments were filed along with the written submissions and the certified copy obtained by the Appellants would evidence that the written submissions run into 38 pages followed by judgements which were 11 in number, running into 219 pages. Appellants have filed certified copies of the judgments to substantiate their stand. The erroneous observation is also a pointer to the fact that the Trial Court has rendered the impugned findings without looking into the judgments filed by the Appellants and consequently the propositions of law enunciated therein which has caused grave prejudice to the Appellants' case.

B. Appellant No. 1 manufactures, markets, exports and is a dealer of cosmetics and hair care products under the trademark 'BERINA'. One Ms. A. Ngun Luechaputiporn, a Thai National is the first and original proprietor of the trademark 'BERINA', which is used in relation to cosmetics and hair care products and is registered in her name in India in Class 03. She has granted a licence to Appellant No. 1 authorising it to use the said trademark in relation to cosmetics and hair care products and the goods of the Appellants are identified by the trademark 'BERINA'. The goods manufactured by Appellant No. 1 bear the trademark 'BERINA' followed by description or nature of products viz. bleaching preparations, hair colour, hair

straightener cream, hair spa, heat protector, hair setting shampoo, conditioner, etc. The expression 'HAIR SPA' is used merely as a descriptive phrase and not as a trademark and thus no action for infringement *qua* the said mark can lie against the Appellants.

- C. The expression 'HAIR SPA' is generic and commonly understood and used by consumers as a treatment for hair and denotes the kind, quality, nature and intended purpose of the goods of the Appellants. In trade usage, running across the entire spectrum of goods/services, trademarks of many entities are usually succeeded by generic words HAIR SPA, HAIR COLOUR, etc. The word 'HAIR' in its plain dictionary meaning is 'any of the numerous fine, usually cylindrical, keratinous filaments growing from the skin of humans and animals'. Similarly, the dictionary meaning of the word 'SPA' is 'mineral spring or a luxurious resort or hotel'. Therefore, when put together the words 'HAIR SPA' only refer to a treatment and/or conditioning and/or nourishment of damaged hair and various articles in newspapers, magazines and websites fortify this position. Hence, use of the expression 'HAIR SPA' *bonafidely* by the Appellants to indicate hair-treatment, under the trademark 'BERINA', cannot amount to infringement.
- D. Respondents have deliberately concealed that the expression 'HAIR SPA' is *public juris* and that there are several manufacturers or marketers in the cosmetics and hair care industry, apart from many hair salons, beauty parlours and spas who use the expression 'HAIR SPA' in descriptive sense, to connote/denote the nature, kind and intended purpose of the product sold thereunder. One of the documents placed on record

by the Respondents reflects a third-party product, sold/advertised under the trademark 'Streax Pro Hair Spa' along with the Respondents' products and thus they are not oblivious of the common usage of this expression. In fact, perusal of Respondents' documents at pages 48, 53, 76 and 83 in the List of Documents, evidence Respondents' own understanding that the expression 'HAIR SPA' is generic and used in relation to services offered at hair salons and beauty parlours for treatment of hair. Besides the above, there are several entities which are marketing their products using the words 'HAIR SPA', either as a standalone descriptor or with suffixes as follows:-

<u>S.No.</u>	<u>TRADEMARK</u>	<u>NAME OF THE COMPANY</u>
1.	HAIRSPA REJUNEVATION	TRESEMME
2.	HAIR SPA MASK	SUNSILK
3.	HAIR SPA KIT	NATURE'S
4.	HAIR SPA	STREAX
5.	HAIR SPA	BODY CARE
6.	HAIR SPA	ASSURE
7.	HAIR SPA KIT	HERBAL GLOW
8.	HAIR SPA	MACADAMIA
9.	HAIR SPA	VEOLA
10.	HAIR SPA	HABIB'S
11.	HAIR SPA CREAM	OXYGLOW
12.	HAIR SPA	HAIR TREATS
13.	HAIR SPA	9 FINE
14.	HAIR SPA	CAREBEAU
15.	HAIR SPA	ALCOS
16.	HAIR SPA	INDOLA
17.	HAIR SPA	CAVINKARE PVT. LTD.
18.	FUNCOOL HAIR SPA	SAMS COSMETICS
19.	CREATOR OF HAIR SPA	RENE FURTERER
20.	HAIR SPA KIT	NANDINI HERBAL CARE
21.	HAIR SPA	WELLA
22.	HAIR SPA KIT	BALDEV INDUTRIES
23.	SPA ESSENCE	HANS SCHWARZKOPF & HENKEL GmBH
24.	HYDRASTASE SPA	JARON COSMETIQUE PVT. LTD.

- E. Since the expression 'HAIR SPA' is common to trade and *public juris*, no person can carve out a monopoly over the same. It is apparent that the suit, in relation to which the present appeal arises, was filed by the Respondents out of business rivalry and jealousy, with the sole intent of stopping the Appellants business by hindering a *bonafide* use of the expression 'HAIR SPA'.
- F. Trial Court has erroneously observed that Appellants have copied and appropriated the expression HAIR SPA, including the styling, colour combination, etc. thereof, with a view to usurp the goodwill of the Respondents and amounts to infringement, since 'HAIR SPA' is the registered trademark of the Respondents, with usage dating back to the year 2002. There is no similarity in styling, colour combination or the trade dress of two labels. Respondents' trademark and trade name is "L'OREAL" and Appellants' trademark is 'BERINA'. On a mere visual comparison, it is obvious that the Appellants' products are sold in a different trade dress with a wholly different colour combination of 'grey' and 'peach', while Respondents' products are sold in bottles bearing a trade dress with a colour combination of blue and white and even the stylized manner of writing the words 'HAIR SPA' is not similar. 'HAIR SPA' is used as a descriptor of the product and in conjunction with the trademark 'BERINA', which obviates any intent of the Appellants to infringe the trademark of the Respondents viz. "L'OREAL".
- G. Trial Court has recorded the plea of the Appellants in the impugned order that the registration of Respondents' trademark "HAIR SPA" is invalid and Appellants have already challenged

the registration, which application is pending before the Registrar for rectification of the trademark. Court has also recorded the response of the Respondents that where rectification application is filed after filing of the suit by the Plaintiffs, Defendants are under obligation to seek *prima facie* satisfaction of the Civil Court on invalidity of the registration and since no such permission has been obtained by showing a *prima facie* case, the same cannot be gone into. Having so recorded the rival contentions, Trial Court has simply extracted provisions of Section 124 of the Trade Marks Act, 1999 (hereinafter referred to as the 'Act') in the impugned order and given no finding on this aspect. It is trite that a Court, while deciding an interlocutory application for injunction, can examine the validity of Plaintiff's trademark registration, where Defendant raises a plea that Plaintiff's trademark, whose infringement is alleged, is generic, common to trade and cannot be monopolised and give a *prima facie* finding thereon.

- H. Trial Court has committed a gross error in holding that Respondents are owners of the expression 'HAIR SPA' and the trademark 'BERINA HAIR SPA' is deceptively and confusingly similar to the said trademark, overlooking glaring facts that: (a) 'HAIR SPA' cannot be monopolised; (b) 'HAIR SPA' is not used by the Appellants as a trademark; (c) 'HAIR SPA' is used in juxtaposition with the registered trademark 'BERINA', which is enough to obviate any confusion between the rival goods; and (d) 'HAIR SPA' is not a coined word and at best is a combination of two English words, which are descriptive of the nature of the product and adoption of a weak

trademark carries the risk of use of the trademark by the others in the field as descriptive of character or quality of their goods.

- I. Section 57 of the Act recognises that where due to inadvertence, misrepresentation, etc. certain registrations are put on the Register of the Trade Marks, the same can be cancelled or varied and the Register can be rectified by the Registrar of Trade Marks. In the present case, rectification application filed by the Appellants is pending and no finality can be attached to validity of the Respondents' trademark. In ***Lowenbrau AG & Anr. v. Jagpin Breweries Ltd. & Anr., 2009 SCC OnLine Del 45***, it was held that rights under Section 28 of the Act are subject to the registration being valid and the registration is only *prima facie* evidence of validity. Trial Court has not only taken a view contrary to the aforesaid decision but has also failed to appreciate the ratio of the decision by a Division Bench of this Court in ***Marico Limited v. Agro Tech Foods Limited, 2010 SCC OnLine Del 3806***, which was placed before the Trial Court. In the said decision the Court has *inter alia* held that once a person, against whom a suit is filed on the ground of infringement of a trademark, which is a descriptive word, then, if the Defendant uses his own word mark as a trademark prominently in addition to the descriptive word mark, nothing further is required to show the *bonafides* of the Defendant. Dealing with the expression 'LOW ABSORB', used by the Defendant, allegedly infringing Plaintiff's registered trademarks 'LOSORB' and 'LO-SORB', the Division Bench in the said case ruled that it was quite clearly a common descriptive expression/adjective and not a coined word. At best 'LOW ABSORB' is a combination of two popular English words,

which are descriptive of the nature of the product and as held by the Division Bench in *Cadila Health Care Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd. & Ors, 2009 SCC OnLine Del 2786*, such adoption naturally entails the risk that others in the field would also be entitled to use such phrases. The expression 'LOW ABSORB' is used in a functional sense for the product edible oil. In essence it only describes the characteristic of the product and is ordinarily/ normally incapable of being distinctive.

- J. In view of these judgements and facts of the present case, Respondents have no *prima facie* case in their favour, considering the factors viz: usage of the expression HAIR SPA by the Appellants is not in the sense of a trademark but merely as a descriptor; trade dress, lay out, colour combination, etc., are different and Respondents' trademark is generic and common to trade. Trial Court has thus erred in conforming the injunction order. Balance of convenience also lies in favour of the Appellants. Appellant No. 1 sent the first consignment of its products bearing the expression 'HAIR SPA' to Appellant No. 2 for sale in India in the year 2006. No explanation worth a mention has been given by the Respondents as to why no case was filed between 2007 to 2013. The case is, therefore, squarely covered by the decision of the Supreme Court in *Wander Ltd. and Another v. Antox India P. Ltd., 1990 Supp SCC 727*.
- K. Reliance was placed on the judgments in *Aviat Chemicals Pvt. Ltd. & Anr. v. Intas Pharmaceuticals Ltd., 2001 SCC OnLine Del 750* and *United Breweries Ltd. 100/1, 'Ub Anchorage' Richmond Road Bangalore v. Khodays Breweries Limited Industries Ltd. No. 9, Seshadri Road Bangalore - 560009*,

2013 SCC OnLine Kar 2303, for the proposition that no monopoly can be claimed on words which are generic and common. Reliance was placed on the judgment of this Court in ***Bigtree Entertainment Pvt. Ltd. v. Brain Seed Sportainment Pvt. Ltd. & Anr.***, **2017 SCC OnLine Del 12166**, wherein it was held that ‘BOOKMY’ is descriptive in nature and since Plaintiff’s trademark ‘BOOKMYSHOW’ has not acquired distinctiveness, coupled with examples placed on record by the Defendant, where numerous other Companies were operating with the same domain suffix, a case for grant of injunction by the Plaintiff is not made. Reliance was placed on the judgment in ***Jain Riceland Pvt. Ltd. v. Sagar Overseas***, **2017 SCC OnLine Del 11305**, for the proposition that where the Defendant uses a mark which is similar or deceptively similar to the registered trademark of the Plaintiff, but as a mere descriptor of its products and not in the sense of the trademark, it cannot be restrained by granting an injunction. For the same proposition, reliance was also placed on the judgment in ***Valvoline Cummins Limited v. Apar Industries Limited***, **2013 SCC OnLine Del 6414**. Further reliance was placed on the judgment in ***Skyline Education Institute (India) Private Limited v. S.L. Vaswani and Another***, **(2010) 2 SCC 142**, where the Supreme Court agreed with finding recorded by the High Court, both the learned Single Judge and the Division Bench, that the word ‘Skyline’ was used as a trade name by several entities and institutions and in fact as many as 117 Companies, including computer and software Companies, were operating by using the ‘Skyline’ as a part of their name or

nomenclature and therefore, being a generic word no restraint can be sought against its usage by the other parties.

7. *Per contra* the contentions put-forth on behalf of the Respondents are as under:-

A. Respondent No. 1 is a wholly owned subsidiary of Respondent No. 2 where the latter is organised under the laws of France. Ever since its *bonafide* adoption in the first decade of 1900, Respondent No. 2 has been using the word mark “L’OREAL” word *per se* and various formatives and labels as trademarks, with the word “L’OREAL” forming their essential part. Respondent No. 2 launched its products under the “L’OREAL” marks between the years 1910-1915 and has been constantly expanding its products which are now sold in about 130 countries of the world. Respondents have garnered immense transborder reputation, which is reflected in the sales figures and amounts expended on promotion and advertisements of its various products under the “L’OREAL” marks. The “L’OREAL” and “L’OREAL” formative trademarks/labels are duly registered in India in class 03. The trademarks are used both individually and/or in conjunction with other trademarks such as GARNIER, MATRIX, MAYBELLINE, ARMANI, etc. Respondents have a wide range of brand portfolio of various ranges of products, including L’OREAL professional range such as Hair Spa, Majirel, Platinum, etc.

B. In 2002, Respondent No. 2 honestly and *bonafidely* adopted the trademark ‘HAIR SPA’ in relation to its hair products and services in connection therewith and has been openly, commercially, continuously and extensively using the same and has built up a global reputation in the said trademark. The user

of the trademark in India is through Respondent No. 1. Trademark 'HAIR SPA' is an arbitrary and coined trademark in relation to the goods for which it is used and is, therefore, entitled to a high degree of protection. The registration dates back to 19.12.2006 with date of user being 31.05.2002 *albeit* with a disclaimer that the word 'HAIR' will not be used separately. The art features involved in the Respondents trademark 'HAIR SPA' are original 'artistic works' under Section 2(c) of the Copyright Act, 1957 and being proprietors thereof, Respondents are entitled to protection under provisions of the said Act. Sales figures of the products under the trademark 'HAIR SPA' and the expenses incurred on advertisements would show the formidable goodwill and reputation of the trademark 'HAIR SPA'.

- C. Appellants have maliciously adopted and are using the word mark 'HAIR SPA', stylized as a trademark, on various labels, of which 'HAIR SPA' is an essential feature, in relation to hair care products and related services. Appellant No. 1 manufactures and distributes the products while Appellant No. 2 imports and markets the impugned products, under the impugned trademark. The rival trademarks are phonetically, visually, structurally identical and the products being identical i.e. the creams used for treatment of damaged hair, it is inevitable that there will be a likelihood of confusion amongst the consumers. The attempt of the Appellants to copy the trade dress of the Respondents is a pointer to the intent of the Appellants to misrepresent amongst the public and members of trade that their products emanate from the Respondents, thereby causing injury to the business and reputation of the

Respondents. Appellants have not been able to explain how they have adopted the impugned trademark HAIR SPA, which has trappings of an invented/arbitrary word and is inherently distinctive.

- D. Appellants have themselves claimed trademark rights in the impugned trademark 'BERINA HAIR SPA' and therefore, it does not lie in their mouth to allege that the trademark 'HAIR SPA' is generic, non-distinctive or common to trade. The dishonesty is apparent from the fact that the Appellants use the mark 'BERINA' in a small font while 'HAIR SPA' is prominently placed on the product. Appellants have admitted in the preliminary objections of the written statement that 'HAIR SPA' is 'suggestive' of the product in relation to which it is used and thus even assuming that 'HAIR SPA' is suggestive, it is a strong trademark, entitled to protection, without proof of user.
- E. Appellants have filed voluminous record before the Trial Court in an endeavour to establish that 'HAIR SPA' does not have a dictionary meaning and is common to trade. Perusal of the documents, which are also filed in this Court, would reflect that none of the documents show any actual or commercial user of the trademark 'HAIR SPA' by any party and even assuming there is any use, the same is subsequent to that of the Respondents. It is also a settled law that the registered proprietor is not expected to sue every infringer unless and until the business of the third-party substantially affects the business of the registered proprietor. It is a misconceived contention of the Appellants that under no circumstances generic trademarks can be protected. Various trademarks such as JCB, SURF,

TUPPERWARE, AQUAGUARD, FEVICOL, GOOGLE, BOTOX, etc. though being generic, have been held entitled to protection.

- F. Respondents relied on the judgments in *Lupin Ltd. v. Johnson and Johnson*, 2014 SCC OnLine Bom 4596; *Anil Verma v. R.K. Jewellers SK Group and Others*, 2019 SCC OnLine Del 8252; *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, AIR 1965 SC 980; *Bata India Limited v. Chawla Boot House & Anr.*, 2019 SCC OnLine Del 8147; *Hem Corporation Pvt. Ltd. and Others v. ITC Limited a company existing under the companies Act, 1956*, 2012 SCC OnLine Bom 551; *Pidilite Industries Limited v. Jubilant Agri & Consumer Products Limited*, 2014 SCC OnLine Bom 50; *T.V. Venugopal v. Ushodaya Enterprises Limited and Another*, (2011) 4 SCC 85; *Pankaj Goyal v. Dabur India Ltd.*, 2008 SCC OnLine Del 1744; *Walter Bushnell Pvt. Ltd. & Ors. v. Miracle Life Sciences and Anr.*, 2014 SCC OnLine Del 3243; *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. & Ors. v. Anchor Health & Beauty Care Pvt. Ltd.*, 2014 SCC OnLine Del 3374; *Shree Nath Heritage Liquor Pvt. Ltd. v. M/s. Allied Blender & Distillers Pvt. Ltd.*, 2015 SCC OnLine Del 10164; *Globe Super Parts v. Blue Super Flame Industries*, 1985 SCC OnLine Del 373; *Ishi Khosla v. Anil Aggarwal & Anr.*, 2007 SCC OnLine Del 126; *Board of Control for Cricket in India and Another v. Netaji Cricket Club and Others*, (2005) 4 SCC 741; *Midas Hygiene Industries (P) Ltd. and Another v. Sudhir Bhatia and Others*, (2004) 3 SCC 90; and *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai and Others*,

2022 SCC OnLine SC 61, for various propositions, which shall be adverted to in the later part of the judgment.

G. The impugned order passed by the Trial Court suffers from no infirmity in law. It is a well-reasoned order and injunction has been granted on sound legal principles viz: (a) Respondents are registered proprietors of the trademark ‘HAIR SPA’; (b) Mark is used in a distinctive style and colour combination; (c) user dates back to the year 2002; (d) rival mark of the Appellants is deceptively similar, with similar colour combination, style, font, etc.; and (e) a person with average intelligence and imperfect recollection is likely to be confused, more particularly, when the trade dress is not different to an ordinary customer who relies on his memory and at the most can only recall the overall get up and prominent features. It is a settled principle of law that Appellate Court should not interfere in the impugned order only because it has different view, unless the order is arbitrary, perverse or contrary to the settled principles of law. The appeal be dismissed being devoid of merits.

8. I have heard learned counsel for the Appellants and learned Senior Counsel for the Respondents.

9. Before proceeding to examine the contentions raised by the rival parties on merits, it is important and relevant to deal with the first contention raised by the Appellants that the Trial Court has erroneously observed that no judgments had been filed on record by the Appellants, contrary to the record of the Trial Court, which evidences that written submissions running into 38 pages with judgments running into 219 pages were on record before the Trial Court, when the application under Order XXXIX Rules 1 and 2 CPC, 1908 was heard and disposed of. Appellants have placed before this

Court as Annexure-Z1, certified copies of the judgments relied upon by the Appellants, before the Trial Court and filed along with the written submissions. A categorical averment is made in ground-B of the present appeal, in the context of Annexure-Z1, that the written submissions were filed along with the index, wherein the written submissions' pages were marked as A-Z12 and citations of the judgments were mentioned therein.

10. Perusal of the certified copies fortifies the stand of the Appellants that the judgments were in fact filed along with the written submissions. Learned counsel for the Appellants is also right in his submission that the order dated 31.03.2015 passed by the Trial Court records that the parties were granted 15 minutes each to address further arguments and explain their written submissions, which were on record. The matter was fixed on several dates and it was never pointed out that the judgments were not on record. This argument of the Appellants assumes significance not only on account of the fact that the impugned order suffers from an error apparent on the record but also for the reason that this also goes to show that the Trial Court has passed the impugned order, oblivious of the judgments before it, resulting in consequential and grave prejudice to the case of the Appellants, as according to the Appellants some of the judgments relied upon squarely cover their stand in law.

11. With the consent of the parties, Court had proceeded to hear the appeal on merits. Extensive arguments were addressed by the respective counsels and both sides have placed reliance on several judgments.

12. Pithily put, stand of the Respondents is that they have a large brand portfolio of the "L'OREAL" marks and their formatives/logos as also registration in the trademark 'HAIR SPA', which is a coined

and an arbitrary mark, entitled to high degree of protection. Use of the registered mark by the Appellants as a trademark, amounts to infringement and passing off and the Trial Court rightly confirmed the injunction. The registered trademark of the Appellants, as per the case set out by them, is 'BERINA' and the expression 'HAIR SPA' is only used as a descriptor of the nature of product in question, which they sell under their registered trademark 'BERINA'. Validity of registration of Appellants' mark HAIR SPA is questioned on the ground that it is descriptive.

13. The first question that arises in the present appeal is whether the Respondents have an exclusive right to use the trademark 'HAIR SPA' and seek protection from infringement by the Appellants, who are allegedly using an identical/deceptively similar trademark. Appellants have questioned the validity of registration of Respondents' registered trademark 'HAIR SPA' on the ground that the mark is generic, descriptive and common to trade and thus the question is whether at this interlocutory stage, Court can go behind the registration and the defence raised by the Appellants under Sections 30(2)(a) and 35 of the Act. The only other and connected issue is the claim of the Respondents with respect to passing off.

14. Insofar as the power of this Court to go behind registration of Respondents' mark at this stage, while examining interlocutory application for injunction, is concerned, this very question came up before the learned Single Judge of this Court in *Stokley Van Camp, Inc. & Anr. v. Heinz India Private Ltd., 2010 SCC OnLine Del 2153*. The Court while deciding an interlocutory application, posed to itself the question as to whether at the interlocutory stage it could go behind the registration of Plaintiffs' trademark and examine the defences raised by the Defendant under various provisions of the Act, in light of

the stand of the Plaintiffs that Court is required to accept *prima facie* validity of the registered trademark under Section 31(1) of the Act, without more, at that stage. Learned Single Judge held that if this proposition of law enunciated by the Plaintiffs was accepted, it would render the provisions of Sections 30, 35 and 124 of the Act meaningless. I may refer to the observations of the Court, which are as follows:-

“10.1 I have heard the learned Counsel on both sides as well as considered the documents placed on record. Given the background the first issue which arises for consideration in this case is that : in view of the fact that, the plaintiffs have obtained registration of the mark/expression ‘Rehydrate Replenish Refuel’, could the Court firstly, go behind the registration at an interlocutory stage and secondly, examine the defence of the defendant in respect of the impugned mark used by it. It is submitted by the learned Counsel for the plaintiffs that the Court was required to accept prima facie, the validity of the registered mark/expression without more, at this stage and, grant the injunction sought for given the similarity of marks, the goods produced and also the similarity in profile of the consumers to which both, the plaintiffs and the defendants catered.

10.2 I tend to disagree with the aforesaid proposition of law enunciated by the learned Counsel for plaintiffs. The reason being : if it was so, it would render the provisions of Sections 30, 35 and 124 of the T.M. Act, 1999 quite meaningless. Since I had the occasion to deal with somewhat similar issue in the Marico's case, prolixity may well be avoided if I were to extract my observations in the said case:

“15. CONCLUSIONS—On a consideration of submissions and the judgments—

(i) The Court can at an interlocutory stage take a prima facie view as to the validity of a registered trade mark. This view can be taken based on averments made in the written statement/pleadings [see Lowenbrau AG (supra)]. The pleadings in this regard, as in every other case, has to be read ‘meaningfully’ [see Begum Sabiha Sultan v. Nawab Mohd. Mansar Ali Khan, (2007) 4 SCC 343].

(ii) Some marks are inherently incapable of distinctiveness [see Asian Paints Ltd. (supra)].

(iii) The rights under Section 28 are subject to other provisions of the Trade Marks Act. Also the registered proprietor or the permitted user can exercise his rights if the registered mark ‘is valid’.

(iv) A descriptive mark can be registered provided it has acquired secondary meaning [see Girnar (supra)],

(v) *If a descriptive mark is one, which is, essentially a combination of common English words the user of the marks has to bear the risk of, some amount of confusion. No monopoly can be claimed by the user of the mark [see Cadila Health Care (supra) & J.R. Kapoor (supra)].*

(vi) *The mark can be impugned both at the stage of registration and post registration. See provisions of Section 9(1)(a) to (c) of the Trade Marks Act for challenge at time of registration and Sections 30 and 35 for challenge after registration.*

(vii) *If the registered mark and the rival mark are not identical; in other words the two marks are similar then the same test as in the case of passing off is applicable; which is, is there a likelihood of deception or cause for confusion [see Ruston and Hornby Ltd. (supra)].*

16. In view of the discussion above in my opinion the use of the expression by the defendant 'LOW ABSORB' or 'LOW ABSORB TECHNOLOGY' cannot be enjoined at this stage, since they are descriptive of the character or the quality of the defendant's goods unlike a trade mark which identifies the origin. This defence is available even against registered mark under Sections 30(2)(a) and 35 of the Trade Marks Act. In the very least, this defence cannot be ruled out at the interlocutory stage. The use by the defendant cannot be said to be not bona fide since not only does it contain the additive which reduces oil absorption by food stuffs during the process of frying but the PFA Rules also recognize such an eventuality....."

10.3 *A similar view has been expressed by another Single Judge of this Court in the case of Lowenbrau AG v. Jagpin Breweries Limited, 157 (2009) DLT 791.*

10.4 *In addition to above, in my view, the provisions of Section 124 of the TM Act, 1999 are a clear pointer to the fact that the Court while hearing an application for grant of interlocutory order can come to a prima facie view of the validity of the mark. Section 124(1)(i)(a) of, the TM Act, 1999 provides that in any suit for infringement of a trade mark the defendant pleads that the registration of the plaintiff's trade mark is invalid the Court under clause (i) of Sub-section (1) of Section 124 has the power to stay the suit till the disposal of the proceedings entered for rectification before the Registrar or Appellate Board are concluded. Where no proceedings are pending under Sub-clause (ii) of Sub-section (1) of Section 124 the Court can adjourn the suit for a period of three months from the date of framing of issues to enable the concerned party to apply to the Appellate Board for rectification of the Register provided it is satisfied that the plea regarding invalidity of the registered mark is prima facie tenable. Sub-section (5) of Section 124 of the TM Act, 1999 exemplifies the power to the Court to make any interlocutory order notwithstanding the fact that the suit has been stayed. It is quite axiomatic where the Court comes to a prima*

facie view that the registration obtained is invalid, an injunction cannot follow.”

15. This decision of the learned Single Judge was carried up in appeal by the Plaintiffs therein and the Division Bench in ***Stokley Van Camp, Inc. & Anr. v. Heinz India Private Ltd., 2010 SCC OnLine Del 3889***, upheld the judgment, including the aforesaid findings and observed that the learned Single Judge, for the purpose of deciding the interlocutory application, was justified in looking into *prima facie* validity of the registration, as registration is a rebuttable presumption. It was further held that even assuming that there was finality of registration of trademark, Respondent had taken valid defences under Sections 30(2)(a) and 35 of the Act, inasmuch as the subject mark only describes the product, namely, the sports drink. Relevant passages from the Division Bench, which are relevant to the present case, are as follows:-

“8. In view of the ratio of the case of Marico, in the present case, the submissions as urged by the counsel for the appellants are liable to be rejected because:-

(i) The trade mark in question namely “Rehydrates, Replenishes and Recharges” is in fact an expression which clearly falls within Section 9(1)(b) of the said Act and it is clearly a descriptive trademark. There should be discouragement from giving protection to such descriptive trademarks. We have already observed in the judgment in Marico's case that we are using an expression “descriptive trademark” as a general expression to cover all cases which fall under Section 9(1) (b) and Section 30(2) (a) of the said Act.

(ii) The mark in question of the appellants was wrongly registered because a mark which is a deceptive mark could have only have been registered after extensive user to make such mark distinctive, however, the mark was registered on a proposed to be used basis.

(iii) The learned Single Judge for the purpose of deciding the interlocutory application was justified in looking into the *prima facie* validity of registration because the registration is only a *prima facie* proof of validity and is a rebuttable presumption, inasmuch as, it is not that there have been cancellation

proceedings initiated with respect to the registered trademark and which cancellation proceedings have been finally dismissed.

(iv).....

(v) *Even assuming that there was finality of registration of the trademark, the respondent has taken valid defences under Sections 30 (2) (a) and 35 of the said Act inasmuch as the subject mark only describes the product namely the sports drink.”*

16. I may also usefully allude to the judgment of a Division Bench of this Court in **Marico Limited** (*supra*), which in this Court’s view squarely covers most of the issues arising in the present appeal. It would be apposite to first refer to para 7 of the judgment, wherein the issues arising for adjudication in the said case are encapsulated. For ready reference, para 7 is extracted hereunder:-

“7. Two basic issues arise for decision in the present appeal along with incidental and related issues. The first issue is on the aspect of infringement i.e. whether the appellants registration gives it exclusive right to use the subject trade marks “LOSORB” and “LO-SORB” and consequently whether an action for infringement is maintainable if a person such as the respondent uses a trade mark which is deceptively similar or nearly identical or identical to the registered trade marks. Included in this first issue is the aspect of whether registration only confers prima facie validity and thereby does not prevent the Court from denying the injunction in spite of registration. Further, assuming that registration is final would the appellant be entitled to the reliefs of injunction with regard to its claims of infringement once the respondent lays out a valid defence under the applicable provisions of the Trade Marks Act, 1999 (hereinafter referred to as the “Act”) which inter alia, include Section 30(2)(a) and Section 35 thereof i.e. the use of the words by the respondent, which words are claimed by the appellant as its trade marks are statutorily permissible as the use is only in a descriptive manner. The second issue is the issue with regard to claim of the appellant pertaining to passing off and the issue is whether the respondent’s user of the expression “LOW ABOSORB TECHNOLOGY” in relation to its edible oil product amounts to passing off the goods of the appellant which uses the unregistered trade mark “LOW ABSORB”. We also would like to state that on quite a few aspects of “passing of” and “infringement” there will be commonality of the ratios and thus dovetailing on these common aspects.”

17. Genesis of the Appeal, in the aforesaid decision, was the impugned order passed by the learned Single Judge declining

injunction against the Respondent/Defendant from using the expression 'LOW ABSORB', alleged to be deceptively similar to the registered trademarks 'LOSORB' and 'LO-SORB' of the Appellant/Plaintiff and thus infringing. Relying on the decision of the Division Bench of this Court in *Cadila Health Care Ltd. (Supra)*, Court held that the Appellant, in the facts of the case, can have no exclusive ownership rights on the trademark 'LOW ABSORB'. The expression 'LOW ABSORB' is quite clearly a common descriptive expression/adjective and not a coined word and at best can be a combination of two popular English words, which are descriptive of the nature of the product. The Court also observed that it is high time that those persons who are first of the blocks in using a trademark which is a purely descriptive expression pertaining to the subject product ought to be discouraged from appropriating the expression and this view is in accordance with the spirit of Sections 9, 30 and 35 of the Act. Significantly, the Court also noted that these observations were made mindful of the Proviso to Section 9 of the Act as per which on account of distinctiveness, the absolute bar against registration is removed and observed that the Court was for the present stressing on the intendment of the main part of the Section, which is to prevent descriptive terms from being registered as trademarks, as also the fact that the Act itself contains provisions for cancellation of registered trademarks, including Section 57 thereof. Court also noted that this position was confirmed by provisions of Section 31(1) which states that registration is only *prima facie* evidence of validity of registration. Relevant paras are as follow:-

“10. In view of the judgment of the Division Bench in the Cadila Healthcare Ltd. (supra), and with which we respectfully agree, the appellant in the facts of the present case can have no exclusive ownership rights on the trade mark “LOW ABSORB”. The expression “LOW ABSORB” is quite clearly a common descriptive

expression/adjective. The expression “LOW ABSORB” is not a coined word and at best it is a combination of two popular English words which are descriptive of the nature of the product as held by the Division Bench in Cadila Healthcare Ltd. (supra) case that such adoption naturally entails the risk that others in the field would also be entitled to use such phrases. Low Absorb is not an unusual syntax and the same can almost be said to be a meaningful part sentence or phrase in itself. The expression “LOW ABSORB” surely and immediately conveys the meaning of the expression that something which absorbs less, and when used with respect to edible oil, it is descriptive in that it refers to less oil being absorbed or low oil being absorbed. Similar to the expression “Sugar Free” being not an unusual juxtaposition of two English words the expression “LOW ABSORB” equally is not an unusual juxtaposition of words in that the same can take away the descriptive nature of the expression. The expression “LOW ABSORB” is used in the functional sense for the character of the product viz. edible oil. With respect to the unregistered trade mark “LOW ABSORB” we are of the firm opinion that in essence the expression “LOW ABSORB” only describes the characteristic of the product edible oil and ordinarily/normally incapable of being distinctive.

11. *The aforesaid observations are made by us mindful of the proviso of Section 9 as per which on account of distinctiveness, the absolute bar against registration is removed, but, we are for the present stressing on the intendment of the main part of the section and which is to basically prevent descriptive terms from being registered as trade marks. The proviso no doubt does state that such marks can be registered as a trade marks, however, the Act itself also contains provisions for cancellation of registered trade marks including Section 57 whereby registration obtained is cancelled being violative of the applicable provisions of the Act. Our belief is further confirmed by the provision of Section 31(1) which clearly states that registration is only prima facie evidence of the validity of registration. It is only when cancellation proceedings achieve finality of the same being finally dismissed can it be said that a mark for which ordinarily there is an absolute ground for refusal of registration that it has acquired a distinctive character i.e. a secondary meaning or is a well known trade mark. Section 124 of the Act is also relevant in this regard. Sub Section 5 of Section 124 clearly provides that in spite of registration, the Court before which an action is filed seeking protection of the trade mark is not precluded from making any interlocutory order it thinks fit in spite of the registration and also the fact that the suit may have to be stayed till decision of the rectification/cancellation proceedings before the Registrar/Appellate Board filed in terms of Section 57 of the Act. This aspect of Section 124(5) and related aspects are dealt in details in the following portions of this judgment. The facts of the present case are not such that a cancellation proceeding has been dismissed and that which dismissal has obtained finality and it cannot be said that the validity of registration has been finally tested.”*

18. Examining the rival marks, the Division Bench, after a detailed analysis of various provisions of the Act and on conjoint reading of Sections 9, 29, 30, 31, 32 and 35 held as follows in respect of Appellant's claim for infringement:-

“35. Let us for the sake of argument now assume the registration to be valid, can it then be said that the appellant is entitled to grant of injunction for preventing the defendant from using the expression “LOW ABSORB TECHNOLOGY” in its packing under which the edible oil is sold and whether such use amounts to infringement of the registered trade marks of the appellant. We note the fact that the respondent was obviously not justified in using the expression “TM” after the expression “LOW ABSORB TECHNOLOGY” and the respondent has now rightly removed the expression “TM” after the expression “LOW ABSORB TECHNOLOGY”. An argument was however raised that the respondent had in fact used the expression “TM” after the expression “LOW ABSORB TECHNOLOGY” at one point of time and that such mala fides entitles the appellant to an injunction in the facts and circumstances of the present case, although, the plaintiff's registration itself may not be valid and the defendant may have valid defences in terms of Section 30(2)(a) and Section 35 of the Act. This aspect is also considered by us hereinafter.

36. It has been contended on behalf of the respondent that respondent is selling its edible oil in a package which clearly shows its trade mark as “Sundrop”. The respondent states that it is not using the expression “LOW ABSORB TECHNOLOGY” as a trade mark and the same is only being used as a descriptive expression, and as a part of a sentence, with respect to the product in question, namely, edible oil. The appellant, however, counters to say that the expression “LOW ABSORB TECHNOLOGY” is being used as a trade mark. We have already referred to the fact that the trade mark “Sundrop” is used by the respondent in a very prominent manner in its packaging by the respondent and that undoubtedly is the trade mark of the respondent. The defendant is using the expression “LOW ABSORB” not independently but only as a part of a sentence which reads on the packaging as “WITH LOW ABSORB TECHNOLOGY”.

37. Our conclusion is that we have in fact totally failed to appreciate the argument as raised on behalf of the appellant. Surely, when rights are claimed over a word mark as a trade mark and which word mark is in fact a mere tweak of a descriptive word indicative of the kind, quality, intended purpose or other characteristics of the goods, it is not open to urge that although the respondent is using the descriptive word mark in fact only as a part of sentence as a description (and even assuming for the sake of argument only the descriptive word mark in itself) alongwith another independent trade mark, yet the use of descriptive words are to be enjoined against. How can it at all be argued that though the

respondent is in fact shown to be using the disputed word(s) only with a descriptive intendment, yet, such use should be taken not in a descriptive manner but as a trade mark. If we permit such an argument to prevail then what will happen is that what cannot be directly done will be indirectly done i.e., whereas the appellant is not entitled to succeed in the infringement action because the use by the respondent is in furtherance of its statutory rights of the user of the words which are descriptive of the kind, quality, intended purpose or characteristic of the goods, yet, merely because the appellant states that the respondent is using the same as a trade mark, the same should be taken as infringement of the trade mark of the appellant. Not only the plaintiff has no exclusive rights whatsoever to the trade marks because they are such which fall within the mischief of Section 30(2)(a), the respondent/defendant is always fully justified and entitled to use the descriptive words in any and every manner that it so chooses and pleases to do. If there are no rights of the plaintiff to exclusive user of the trade mark then where does arise the question of disentitlement of a defendant to use the trade mark of the appellant inasmuch as any person who adopts a descriptive word mark does so at its own peril in that any other person will also be fully entitled to use the same in view of a specific statutory rights thereto, and there are various other statutory rights including that under Section 30(2)(a), and which is what is being done by the respondent in the facts of the present case and its rights being further stronger because of the use along with the simultaneous use of its trade mark "Sundrop".

38. *In the facts and circumstances of the present case, Section 30(2)(a) clearly applies in entitling the respondent to use the expression "WITH LOW ABSORB TECHNOLOGY" because that is only a descriptive use by normal English words in the English language indicative of the kind, quality, intended purpose of characteristic of the goods. There is no use of the expression "bona fide" in Section 30(2)(a) as is found in Section 35, and we do not propose to import in Section 30(2)(a) the expression "bona fide" because the subject matters of the two sections i.e. Section 32(a) and Section 35 are though common on certain limited aspects, however the two Sections do in fact operate in separate fields. Also looking at the issue in another way, "bona fide" aspect can in a way be said to be very much included in Section 30(2)(a) because the use of words which indicate their relation to the goods for the kind, quality, intended purpose or other characteristics, etc. of the goods, is clearly only a bona fide user of the same and which "bona fideness" does not have to be additionally proved. In fact, there is ordinarily not only no lack of bona fides in using the normal descriptive word, and on the contrary there is in fact mala fides of a plaintiff in adopting otherwise a descriptive word mark and for which adaption there is ordinarily an absolute ground for refusal of registration of the trade mark. There is no mala fides of the respondent as alleged by the appellant because the respondent is using the expression "LOW ABSORB" as part of a sentence in a descriptive manner and*

the respondent is also prominently using its own trade mark “Sundrop”, an aspect we have repeatedly referred to otherwise in this judgment. Merely because the respondent used “TM” earlier after the expression “LOW ABSORB TECHNOLOGY” is not such as to wipe out statutory rights/defences of the respondent.

39. We are also of the opinion that once the person, against whom a suit is filed on the ground of infringement of a trade mark which is in fact a descriptive word, then, if a defendant is using his own word mark as a trade mark prominently in addition to the descriptive word mark which the plaintiff claims to be his trade mark, nothing further is required to show the bona fides of the defendant against whom infringement of a registered trade mark is alleged. In the facts of the present case, we have already adverted to in detail the prominent use by the respondent of its independent trade mark “Sundrop”, and, the fact that the expression “LOW ABSORB” is being used only as part of the sentence which reads “WITH LOW ABSORB TECHNOLOGY”.”

19. Relevant would it be to refer to the judgment of the Division Bench in ***Cadila Health Care Ltd. (supra)***, on which reliance was placed in the case of ***Marico Limited (supra)***. The Appellant therein was aggrieved by the judgment of the learned Single Judge refusing injunction restraining the Respondents from using in any manner and particularly in relation to their products frozen desserts and choc minis, the expression ‘SUGAR FREE’, in which the Appellant claimed and asserted trademark rights. Prime contention of the Appellant was that the trademark ‘SUGAR FREE’ was a coined word and not descriptive but merely suggestive. As an alternate argument, it was also urged that the work ‘SUGAR FREE’ had become distinctive of the sugar substitute and acquired a secondary meaning. Contention of the Respondent was that the combination of the words ‘SUGAR’ and ‘FREE’ is common and used extensively in a wide variety of contexts to indicate a category of food. The mark being generic in nature and common to trade was unable to identify the source of the product, because of its very nature and use. After a detailed deliberation, the Division Bench held as follows:-

“9. We are unable to hold that the appellant's trade mark ‘Sugar Free’ is a coined word; at best it is a combination of two popular English words. The mere fact that the appellant's product cannot be directly consumed or eaten and merely is an additive does not detract from the descriptive nature of the trade mark. Once a common phrase in the English language which directly describes the product is adopted by a business enterprise, such adoption naturally entails the risk that others in the field would also be entitled to use such phrases provided no attempt is made to ride on the bandwagon of the appellant's indubitably market leading product ‘Sugar Free’. In this connection, merely because the attributes of ‘sugar free’ can be described by other phrases cannot detract from the common usage of the phrase ‘Sugar Free’ as denoting products which do not contain sugar and any trader which adopts such mark in the market place, does so with the clear knowledge of the possibility of other traders also using the said mark. That is precisely the reason for the denial of protection to such marks by refusing registration as envisaged by Sections 9, 30 and 35 of the Act.....

Thus, it is clear that the mark or indication which serves to designate the quality of the goods of the appellant, which indeed the phrase ‘Sugar Free’ does, would be an absolute ground for refusal of registration of a mark unless it has acquired a distinctive character. The expression can at best be said distinctive qua the artificial sweetener of the appellant and mere starting of the marketing of the drink ‘sugar free D’lite’ cannot give the appellant the right to claim distinctiveness in the expression ‘Sugar Free’ in relation to all the food products.

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14. In consonance with the above view we are also not in a position to agree with the appellant that the word Sugar Free’ has become so distinctive of the sugar substitute and has acquired such a secondary meaning in the sugar substitute market that it cannot refer to any other food product except the appellant's sugar substituted product labelled Sugar Free’. There cannot be any doubt that the word sugar free is not inherently distinctive and is clearly descriptive in nature. In fact, the word Sugar Free in essence clearly only describes the characteristics of the appellant's product and therefore, cannot afford it the protection sought in the plaint by restraining the respondent from using the phrase sugar free’. Sugar Free’, prima facie has not attained any distinctiveness, as alleged by the appellant outside the field of sugar substitute artificial sweeteners and the appellant would not be entitled to exclusively claim the user of the expression sugar free’ in respect of any product beyond its range of products and the respondent cannot be restrained from absolutely using the expression Sugar Free’, particularly in the descriptive sense. A mere descriptive usage of the expression Sugar Free’ by the respondent may thus blunt the edge of claim of distinctiveness by the appellant. However, we make it clear that if any party enters into the domain of artificial sweeteners with

the trademark Sugar Free' the appellant may have a just cause in seeking restraint."

20. In this context, I may also refer to the judgment of the Full Bench of the Bombay High Court in **Lupin Ltd. (supra)**, wherein it is observed that while a registered proprietor of a trademark would ordinarily be entitled to a finding of the Civil Court in its favour that the trademark registered in its name is *prima facie* valid, the jurisdiction of this Court is not barred for considering the plea of the Defendant, at the interlocutory stage, that the registration in Plaintiff's favour is so apparently invalid that Court should not grant injunction in favour of the Plaintiff *albeit* a very heavy burden lies on the Defendant to rebut the strong presumption in favour of the Plaintiff at that stage. In the present case, it is an undisputed position that a rectification petition has been preferred by the Appellants, which is pending. Appellant No. 2 in its written statement has taken a plea of invalidity of Respondents' registration and has also stated that appropriate steps to seek rectification would be taken in accordance with law. It is also stated in the written statement that the words 'HAIR SPA' are generic and common to trade and Plaintiffs can claim no monopoly over the same.

21. Examining the facts of the present case on the anvil of the aforesaid judgments, in my *prima facie* opinion, the trademark 'HAIR SPA' is descriptive and the expression is commonly used in the trade for products which are used for treatment and nourishment of hair. 'HAIR SPA' is not a coined word and is merely a combination of two popular English words HAIR and SPA juxtaposed or placed side by side. Applying the principles explicated in **Marico Limited (supra)** and **Cadila Health Care Ltd. (supra)**, the expression HAIR SPA, which only describes the characteristics of a product and is a common

descriptive expression, is incapable of being distinctive. The function of a trademark as defined under Section 2(zb) of the Act is to distinguish the goods or services of one person from the others, i.e. it acts as a source identifier/indicator. From the plethora of material placed on record by the Appellant, it appears *prima facie* that HAIR SPA is a very commonly used expression and connotes and describes hair treatment and falls short of serving as a source identifier of the Respondents. The word 'HAIR' in its plain dictionary meaning is 'any of the numerous fine, usually cylindrical, keratinous filaments growing from the skin of humans and animals'. Similarly, the dictionary meaning of the word 'SPA' is 'mineral spring or a luxurious resort or hotel'. Thus, the expression denotes nothing more than description of the product used for hair treatment/nourishment.

22. Appellants have placed on record: (a) screenshots from the e-commerce website Indiamart showing beauty salons, offering hair spa services and describing the method as well as advantages of the treatment; (b) articles from newspapers explaining/describing the advantages and methodology of hair spa treatment; (c) copies of service catalogues of various saloons/beauty parlours showing use of the expression 'HAIR SPA'; (d) photographs of products of various Companies, such as TRESEMME using the expression 'HAIR SPA'; and (e) magazines showing use of expression 'HAIR SPA' by several entities in relation to cosmetics and hair products. The examples are endless and fortify the position taken by the Appellants that not only the expression 'HAIR SPA' is generic and descriptive but also common to trade and necessarily describes the nature, characteristics and attributes of the product. Therefore, following observations of Division Benches of this Court in *Marico Limited (supra)* and *Stokley Van Camp, Inc. & Anr. (supra)*, Appellants cannot be restrained from

using 'HAIR SPA', notwithstanding registration of the trademark 'HAIR SPA' in favour of the Respondents. For a ready reference and illustratively, screenshots of some of the products are as follows:-



23. There is a categorical assertion in the appeal that Respondents' own documents indicate sale of a third-party product under the mark 'Streax Pro Hair Spa' alongside the Respondents' products. Additionally, a whole list of products manufactured and marketed in India by various companies has been furnished in the appeal, where the word/expression 'HAIR SPA' is used as a suffix or standalone for products used in hair treatment. For ready reference the same is extracted and placed below:-

<u>S.No.</u>	<u>TRADEMARK</u>	<u>NAME OF THE COMPANY</u>
1.	HAIRSPA REJUNEVATION	TRESEMME
2.	HAIR SPA MASK	SUNSILK

3.	HAIR SPA KIT	NATURE'S
4.	HAIR SPA	STREAX
5.	HAIR SPA	BODY CARE
6.	HAIR SPA	ASSURE
7.	HAIR SPA KIT	HERBAL GLOW
8.	HAIR SPA	MACADAMIA
9.	HAIR SPA	VEOLA
10.	HAIR SPA	HABIB'S
11.	HAIR SPA CREAM	OXYGLOW
12.	HAIR SPA	HAIR TREATS
13.	HAIR SPA	9 FINE
14.	HAIR SPA	CAREBEAU
15.	HAIR SPA	ALCOS
16.	HAIR SPA	INDOLA
17.	HAIR SPA	CAVINKARE PVT. LTD.
18.	FUNCOOL HAIR SPA	SAMS COSMETICS
19.	CREATOR OF HAIR SPA	RENE FURTERER
20.	HAIR SPA KIT	NANDINI HERBAL CARE
21.	HAIR SPA	WELLA
22.	HAIR SPA KIT	BALDEV INDSUTRIES
23.	SPA ESSENCE	HANS SCHWARZKOPF & HENKEL GmBH
24.	HYDRASTASE SPA	JARON COSMETIQUE PVT. LTD.

24. Learned Senior Counsel appearing on behalf of the Respondents though subtly had also sought to contend that the manner in which the mark 'HAIR SPA' is used by the Appellants, displaying the same prominently in a larger font as compared to its registered trademark 'BERINA' establishes that the usage is in the sense of a trademark. This contention also deserves to be rejected for various reasons. Firstly, as held above, hair spa is a term of common usage to denote a hair treatment and the Appellants are using 'HAIR SPA' only for this singular purpose. The expression by itself is not acting as a source identifier linking the product to the Appellant and thus it is not right to contend that Appellants are using HAIR SPA as a trademark. One cannot lose sight of the fact that Appellants have always used their trademark 'BERINA' in conjunction with the expression 'HAIR SPA', which obviates any intention to use the same as the trademark or to copy the registered trademark of the Respondents. The

observations of the Division Bench in *Marico (supra)* that persons who are first of the blocks using a trademark which is purely descriptive, ought to be discouraged from appropriating a descriptive expression and monopolizing the trademarks, is very apt in the present case. It was observed by the Court that where rights are claimed over a word mark as a trademark which mark is in fact a tweak of a descriptive word indicative of kind, quality, characteristics etc. it is not open to urge that even though the opposite party is using the descriptive word along with an independent trademark, yet the use of the descriptive word be enjoined. If this argument is allowed to stand then what cannot be done directly will be done indirectly. If there are no rights of a Plaintiff to exclusive user of a trademark, then where does arise the question of disentitlement of the Defendant to use the said trademark inasmuch as any person who adopts a descriptive word mark does so at his own peril.

25. It was contended on behalf of the Respondents that even descriptive words are registrable as trademarks and some examples were also cited. As a proposition of law, this cannot be doubted, but the argument will not aid the Respondents. It has been repeatedly held by Courts that the question of a mark having acquired a secondary meaning is a matter of trial. The issue of ‘distinctiveness’ of a mark came up before the Division Bench in *Marico Limited (supra)* and conscious of the Proviso to Section 9 of the Act, the Court examined the meaning ascribed to the expression ‘distinctive’. Relevant para is as follows:-

“15. The word ‘distinctive’ is not directly defined in the Act. However meaning of distinctive is indicated in the definitions of ‘trade mark’ [Section 2(zb)] and ‘well known trade mark’ [Section 2(zg)]. The word has been explained in a plethora of judgments. Distinctive has been explained to mean such use of the trade mark with respect to the goods of a person that the public will immediately and unmistakably co-relate the mark with the source or a particular

manufacturer/owner thereof. The real issue which however arises is what should be the meaning of the expression 'distinctiveness' in the situation when the trade mark is a word mark of descriptive nature. When a trade mark, which is a word mark, is arbitrarily adapted and is such having no co-relation to the goods in question, then in such a case distinctiveness is achieved by normal and ordinary use of the trade mark with respect to the goods and it has been repeatedly held that such trade mark is entitled to the highest degree of protection. However this is not and cannot/should not be so for a trade mark which is a descriptive word mark. Some colour has to be taken for the word 'distinctive' as found in the proviso to Section 9 from the expression 'well known trade mark' which follows the distinctiveness aspect as found in the said proviso. Courts should ordinarily lean against holding distinctiveness of a descriptive trade mark unless the user of such trade mark is over such a long period of time of many many years that even a descriptive word mark is unmistakably and only and only relatable to one and only source i.e. the same has acquired a secondary meaning. A case in point is the use of 'Glucon-D' for 60 years in the recent judgment in the case of Heinz Italia v. Dabur India Ltd., (2007) 6 SCC 1 A period of 60 years is indeed a long period of time and thus distinctiveness of the descriptive word mark used as a trade mark was accepted, albeit in a tweaked form of the normal descriptive word 'Glucose'. Therefore, when the descriptive trade mark is used only by one person undisturbed for a very long period of time, without anyone else attempting to use the trade mark during this long period time, a case can be established of a descriptive word having achieved distinctiveness and a secondary meaning."

26. Turning to the facts of the present case, this Court is not persuaded to come to a *prima facie* conclusion that Respondents' trademark HAIR SPA has acquired distinctiveness to claim an exclusive monopoly and exclude others from using the generic expression. Documents filed on record in terms of invoices show sales of various products sold by the Respondents, mostly shampoos and hair colours under the banner of Respondents' Company and "L'OREAL" marks, with sprinklings of sales in hair spa product and curiously some invoices do not have sales pertaining to the hair spa product. From the said invoices it cannot be said at this stage that there is undisturbed user of HAIR SPA for a very long time, without any other entity attempting to use it, so as to hold even *prima facie* that the expression brings to mind the trade origin of the product and

is distinctive so as to unmistakably relate to the Respondents. It is true as held in *Marico limited (supra)* that sometimes the sales or the values can be deceptive but even then it would be a point which is best decided during the trial.

27. Applying the aforesaid observations to the facts of this case, Respondents have failed to discharge the onus of establishing *prima facie* case of infringement. It would also be apposite to refer to the observations of the Division Bench in *Marico Limited (supra)*, while dealing with the question of grant of interim injunction in a claim for infringement, pertaining to descriptive trademarks. Relevant passages are as follows:-

“20. That takes us to the main issue which was argued in the present case being the first issue of whether the appellant by virtue of the registrations has got an exclusive right to use the expressions “LOSORB” and “LO-SORB” and is thereby entitled to prevent anyone else from using any trade mark which is identical or deceptively similar to the registered trade marks.

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23. A reading of the aforesaid sections taken together show that : A trade mark is ordinarily used in relation to goods of a manufacturer. A trade mark can be registered but ordinarily registration is not granted if the mark falls under Subsections (1)(a) to (1)(c) of Section 9. The proviso, however, provides for entitlement to registration although ordinarily not permissible under Section 9(1)(a) to (c), provided that the mark has acquired a distinctive character as a result of its use prior to registration or is otherwise a well known trade mark. Registration is only prima facie evidence of its validity and the presumption of prima facie validity of registration is only a rebuttable presumption, see para 31 of N.R. Dongre v. Whirlpool Corp., 1995 (34) DRJ 109 (DB). The right conferred by registration for exclusive use of the trade mark in relation to goods is if the registration is valid and which flows from the expression “if valid” occurring in Section 28. The expression “if valid” has been inserted for the purpose that post registration an aggrieved person is entitled to apply for cancellation under Section 57 of the Act even if no suit is filed alleging infringement of the registered trade mark. In case a suit is instituted, the Court, once there is already a pending action seeking cancellation of the trade mark, will stay the suit till the final disposal of the cancellation/rectification proceedings. The Court however is still entitled to, in spite of registration, pass any interlocutory order as it deems fit, including but not limited to, granting the injunction or

dismissing the prayer for injunction. If no cancellation proceedings are pending as on the date of filing of a suit for infringement if the Court is satisfied with regard to the plea of invalidity of registration (this language of Section 124(1)(a)(i) co-relates to the expression “if valid” as occurring in Section 28) then the Court may raise an issue in the suit and adjourn the case for three months after framing the issues in order to enable the defendant to apply to the Appellate Board for rectification of the register. Even in the circumstances where the Court stays the suit for three months and permits a party to apply for cancellation/rectification, the Court can pass any interlocutory order as it thinks fit under Sub-section (5) of Section 124.

24. *In view of the co-relation between Section 28 and different sub-sections of Section 124, it becomes clear that the entitlement to claim invalidity of registration on the ground of the expression “if valid” as found under Section 28 only arises if the defendant in his written statement in a suit alleging infringement of a registered trade mark takes up the plea with respect to registration of trade mark being “invalid” or has already applied for cancellation of the registered trade mark before the suit alleging infringement is filed.*

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26. *In view of the aforesaid legal position, the first issue which arises is whether the learned Single Judge was justified in holding that he was entitled to look into the validity of registration of the trade mark. Of course, we must hasten to add we are doing so and so has the learned Single Judge done, only for the purpose of deciding the interlocutory application for grant or refusal of injunction and as envisaged in Section 124(5).*

27. *In the facts of the present case, we find that the injunction application was disposed of at a stage when the defendant filed an application for vacation of the injunction and no written statement of the defendant was on record. As already discussed hereinabove, the stage of challenging the validity of registration by the defendant arises only when the written statement is filed, because it is only in the written statement that the plea of the registration being invalid would be taken up in furtherance of the expression “if valid” as found in Section 28 and also similar language as found in Section 124(1)(a). This also flows from the fact that under Section 31(1) registration is only a prima facie evidence of validity and not conclusive evidence. Registration would only be a conclusive evidence of validity if the rectification/cancellation proceedings filed for cancellation of the registered trade mark do not finally succeed. We are, therefore of the view that in the facts of the present case since the issue of invalidity of registration is to be taken up only in a written statement for an issue to be framed with respect thereto in terms of Section 124(1)(a)(ii) and the written statement was yet to be filed when the impugned order was passed, where such an issue would/could be raised, the learned Single Judge was justified in looking into the aspect of prima facie validity of the registration of*

the trade mark and it cannot be the stand of the appellant that the plea of invalidity of registration cannot be looked into because there is no such plea in the written statement inasmuch as the written statement was yet to be filed in the suit.

28. *The learned Single Judge was fully entitled to look into the aspect of validity of registration in the facts of the present case by reference to the expression “if valid” as occurring in Section 28 and the related provisions of Section 31 and the different sub-sections of Section 124. The learned Single Judge applied his mind and considered this issue of prima facie validity of registration of trade mark for deciding the interlocutory application and which is very much permissible and in fact so provided under Section 124(5).*

29. *Now let us examine the issue of prima facie validity of registrations of the appellant for deciding the aspect of grant of injunction in the facts of the present case. When we look at the facts in the present case, we find that when the application was filed for registration of the trade marks “LOSORB” and “LO-SORB”, the applications clearly stated “proposed to be used”. Quite clearly therefore on the date of registration there was no user at all of the trade mark, much less such use of it so as to give the trade mark a distinctive character as a result of use made of it or the same being a well known trade mark. Clearly therefore, the registration of the trade mark “LOSORB” and “LO-SORB” were prima facie invalid because the said trade marks basically are a minor variation of a descriptive expression “LOW ABSORB” which is not an unusual juxtaposition of words in the English language and no evidence existed before the Registrar of distinctiveness because the marks were sought to be registered not on proof of actual user so as to make the same distinctive on the date of filing of the application for registration but only on “proposed to be used” basis. The expression “LOW ABSORB” conveys the same meaning as “ABSORBS LOW”. Such descriptive word marks are clearly such for which there is an absolute ground for refusal of registration by virtue of Section 9(1)(b) of the Act because clearly the said word marks are in fact clear indications of designation of the kind, quality, intended purpose or other characteristics of the goods of which the trade mark is applied. The registrations being prima facie invalid no action for infringement would thus lie. On the issue of acquiring distinctiveness subsequent to the making of the application for registration, we have already dilated at length in the earlier part of this judgment while dealing with the issue of passing off that it cannot be said that the mark “LOW ABSORB” has acquired a secondary meaning by user of a few years.”*

28. The next issue that arises before the Court is qua the claim of passing off. The Jural opinions on passing off show that misrepresentation is a *sine qua non* to establish that a Defendant has

committed the tortious act. Relevant it is to notice the following observations in *Marico Limited (supra)*:

“12. An important aspect with respect to the issue of passing of is that the respondent is selling its product with a prominent trade mark “Sundrop” and which appears on the packaging of the respondent in a very prominent size, much larger than the size of the expression “LOW ABSORB TECHNOLOGY”. The colour scheme of the respective packaging is also wholly different. Appellant's colour scheme is orange and the respondent's blue. Merely because, the consumers are same and the trade channel same, it cannot be said that in the facts and circumstances of the case, there is a possibility of confusion, because there are more than enough differentiating features on the packaging so as to avoid any issue of the respondent passing of its goods as that of the appellant.

13. Thus the conclusion of the above is that, even though the two respective products of the parties are identical viz. edible oil, it cannot be said that the respondent is passing of its goods as that of the appellant-plaintiff.”

29. Tested on the anvil of the observations of Division Bench, as aforementioned and comparing the use of expression of ‘HAIR SPA’ as a descriptor with the registered trademark ‘BERINA’ along with the trade dress, colour combination, etc. which are completely different, it cannot be said that Appellants have an intent to misrepresent or that there is any likelihood of confusion as to the trade origin. For ready reference a comparative of the competing rival products using the rival marks and expressions, respectively, are as under:-

Appellants' Product	Respondents' Product
	

30. The colour scheme of the Appellants is evidently 'grey' and 'peach' while that of the Respondents is 'blue' and 'white'. Even the use of the expression 'HAIR SPA' in terms of their font, lettering style, colour, etc is different. Standalone factor that consumers and the trade channels are common, cannot lead to a conclusion that there is a possibility of confusion, because in this case the differential factors outweigh trivial commonalities/similarities, if any. It is trite that passing off is a cause which is premised on a misrepresentation by the Defendant with a view to encash on the goodwill and reputation of the Plaintiff, leading to confusion amongst the consumers. Once the elements of confusion and misrepresentation are out of the frame, it cannot be urged that claim for passing off is made out. The Trial Court has thus erred in all aspects in granting injunction in favour of the Respondents. In fact, as rightly contended by the Appellants, Trial Court has not even dealt with the most crucial issues raised by the Appellants, despite noting the contentions on those aspects.

31. It was strenuously urged by learned counsel for the Appellants that a plea was taken before the Trial Court that the Plaintiffs trademark 'HAIR SPA' is generic and common to trade and that the Appellants were using the expression 'HAIR SPA' as a descriptor and not in the sense of the trademark. Examples were cited to show how mark was common to trade and a generic term. Reading of the impugned order shows that the stand of the Appellants that these issues were raised before the Trial Court is substantiated. Trial Court has in so many words recorded these contentions, however, neither of them have been dealt with. Trial Court has only recorded the contentions and thereafter extracting Section 124 of the Act, concluded that sitting in the arm chair of an ordinary customer, product of the Defendants is likely to cause confusion in the minds of

the consumer of average intelligence and imperfect recollection and that the Defendants can pass off their goods as that of the Plaintiffs to their detriment. On this basis a finding of *prima facie* case, balance of convenience and irreparable harm has been rendered in favour of the Respondents, restraining the Appellants from dealing with the expression 'HAIR SPA', in any manner whatsoever. A holistic reading of the impugned order also shows that the Trial Court has decided the matter oblivious of the record before it, which contained as many as 219 pages of the judgments filed by the Appellants and the obvious consequence is that the Trial Court has not applied its mind to the judgments and the propositions of law relied upon, which may have tilted the case in favour of the Appellants. This becomes significant as the judgment in *Marico Limited (supra)*, entirely covers the case of the Appellants, but there is not even a reference to the judgement, though cited and filed by the Appellant.

32. Learned Senior Counsel for the Respondents has relied on several judgments during the course of arguments but having gone through them this Court is of the view that none of these judgments come to the aid of the Respondents. Reliance was placed on the judgment in *Lupin Ltd. (supra)*, to contend that *prima facie* satisfaction of the Court to stay the trial under Section 124 of the Act is also not enough to refuse grant of interim injunction. It is only in exceptional circumstances such as the registration being *ex-facie* illegal or fraudulent that the Court will refuse interim injunction in favour of the registered proprietor of the trademark and a heavy burden lies on the Defendant to rebut the strong presumption in law to the validity of a registered trademark. There can be no dispute on the proposition of law laid down in the said case. In my view, the judgment only inures in favour of the Appellants as the Court has held

that it is open to the Court to go into the question of validity of the registration of the trademarks of a Plaintiff, in view of the expression 'if valid' in Section 28 of the Act, relying on the observations of the Division Bench in the case of *Marico Limited (supra)*, wherein it was held that under Section 31 of the Act registration is only *prima facie* evidence of the validity of the registration *albeit* a heavy onus lies on the Defendant to rebut the presumption of validity. The Court also observed that though a challenge to the validity of the registered trademark can finally succeed only in rectification proceedings, however, there is no express or implied bar taking away the jurisdiction and power of the Civil Court to consider the challenge to the validity at the interlocutory stage by way of a *prima facie* finding. In *Anil Verma (supra)*, the Court held that descriptive nature of a mark can be determined by applying two tests: (a) Degree of Imagination Test; and (b) Competitors' need test, which are inversely proportional to each other. If the degree of imagination required is higher, than need of the competitor decreases. If the need of the competitors is not so high and there are alternate ways of describing some services, then the degree of imagination required would be higher. In the said case, the Court found as a matter of fact that the expressions 'Cash for Gold' and 'Gold Buyers' do not describe the entire gamut of services offered by the Plaintiff and the expressions could be suggestive of some part of the business of the Plaintiff and no evidence was placed on record by the Defendants to suggest that the expressions were perceived in the market as descriptive expressions. In fact, in the same judgment the Court observed that the expression 'WE BUY GOLD' was a sentence which described what the Plaintiff does i.e. buys gold and therefore held that it was descriptive in nature. The judgment is wholly inapplicable to the present case as the

expression 'HAIR SPA' is clearly descriptive of the product, which is used for treatment and nourishment of damaged hair and at the cost of repetition, be it stated that it is not used by the Appellants in the trademark sense, but merely as a descriptor of the product in question.

33. In *Bata India Limited (supra)*, the Court held that POWER could at best be termed as a suggestive mark for footwear which would make it inherently distinctive. Even if one considers the nature of the mark, it does not direct anyone immediately to shoes or to footwear and imagination could at best lead to products related to electricity, batteries etc. and it cannot therefore be termed as a descriptive mark. Quite contrary, in the facts of the present case the use of the expression 'HAIR SPA' would immediately direct a person with average intelligence and prudent mind to a treatment pertaining to hair and the descriptive nature of the mark can hardly be disputed. In *Hem Corporation Pvt. Ltd. and Others (supra)*, the Court expounded the principle that a registered trademark is infringed by a person if he uses it in such a manner as to render the use of the mark likely to be taken as a trademark i.e. it indicates a connection in the course of trade between the person and his goods, irrespective of his intention. The Court, thereafter, came to a conclusion that the use of the mark 'MADHUR' by the Defendant was a use in the sense of a trademark and was not descriptive of the product Agarbatti. Reliance on the said judgment is wholly inapt in the facts of the present case as the Appellants are not using the expression 'HAIR SPA' in a trademark sense. In *Pidilite Industries Limited (supra)*, the issue before the Court was an infringement of three registered trademarks of the Plaintiff, two-word marks and one label mark viz. 'FEVICOL MARINE'. The contention of the Defendant was that both Plaintiff and Defendant were using the word 'MARINE' in a descriptive

manner as the word was devoid of any distinctive character, being a word having a dictionary meaning and commonly used. The Court held that the word 'MARINE' forms a prominent and essential part of the three registered trademarks of the Plaintiff and going by the products for which they were used i.e. adhesives, it could not be said that the trademarks are descriptive. Moreover, it was also found that by reason of open, continuous and extensive sales over a period of 09 years, the mark 'MARINE', either by itself or as a constituent of the registered trademark 'FEVICOL MARINE', had acquired a secondary meaning/distinctiveness and had come to be exclusively associated with the Plaintiff. 'HAIR SPA' is a word of common usage, common to the trade and descriptive of the product and thus, in my view, the judgment would be inapplicable to the facts of the present case. For the same reason, the judgments in *Walter Bushnell Pvt. Ltd. & Ors. (supra)*, and *Pankaj Goyal (supra)*, would not help the Plaintiffs.

34. In *T.V. Venugopal (supra)*, dealing with the mark 'EENADU' the Supreme Court held that the mark had acquired extraordinary reputation and goodwill in the State of Andhra Pradesh and 'EENADU' newspaper and T.V. were extremely well-known and almost household words. Though the word 'EENADU' may be a descriptive word, but had acquired a secondary meaning and fully identified the products and services provided by the Respondent company. In *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. & Ors. (supra)*, the Court observed that the argument of 'ALLROUND PROTECTION' as being descriptive of toothpaste is being raised today only because of the use of the same for a considerably long time as the tagline/slogan by the Respondent and the resultant association thereof with the product toothpaste. Till it was so used, none, from the expression itself could have associated it with or held the same as

descriptive of a toothpaste. It was further observed that the test of descriptive is not of the day after long/repeated usage of some words in relation to some goods or services, but of the day before such use and therefore, before the day of first use of the expression 'ALLROUND PROTECTION', in relation to a toothpaste, the same could not have been said to be descriptive thereof. Clearly, both the judgments would not apply to an expression 'HAIR SPA', when used in the context of a product used for hair treatment and this is sufficient to distinguish the two judgments from the present case.

35. In *Globe Super Parts (supra)*, the dispute before the Court related to the mark 'SUPERFLAME' and the question was whether any proprietary rights can or have been acquired in the said mark. The Court held that there was no word Superflame in the standard dictionary of English language and *prima facie* it would appear that the word was not a common place word of English language nor has any meaning in that language. Therefore, the conclusion is inescapable that it is a coined or fancy word and is made meaningful only when applied to the product for which it is created. It was further observed that Yellow flame, Red flame and Blue flame are part of general public knowledge and have been in existence in the physical world and may actually be descriptive of a naturally existing flame, but the same could not be said for Superflame and that while the word Superflame may have a meaning by itself, but that would not denigrate the amount of skill and labour spent thinking it up and giving it an expression. Since the judgment was passed post the trial, on the basis of the evidence, the Court held that there was ample evidence in the form of testimony of witnesses of the Defendant, who admitted that the Plaintiffs were the first persons to use the word Superflame upon their goods and the word Superflame is a coined or a

fancy word, exclusively appropriated by the Plaintiffs, in respect of gas cookers or appliances. Appellants in the present case have been able to *prima facie* demonstrate that the expression HAIR SPA is a word which is commonly used and is common to the trade, by placing on record plethora of documents indicating its use by various beauty parlours, salons, etc. and can't be equated with the word Superflame, held to be a coined and fancy word by the Court.

36. Reliance on *Renaissance Hotel Holdings Inc. (supra)*, by the Appellants is also in my view wholly misplaced as the same deals with the presumption of confusion under Section 29(3) of the Act, where there is identity of trademark and identity of the goods/services for which the trademark is registered. In view of the finding in the earlier part of the judgment that the Appellants are not using the HAIR SPA as trademark, this judgment is clearly distinguishable in the facts of the present case.

37. For all the aforesaid reasons, the appeal is allowed setting aside the impugned order dated 30.03.2016, passed by the learned Trial Court, whereby the application under Order XXXIX Rules 1 and 2 CPC filed by the Respondents herein was allowed, restraining the Appellants from using the trademark of the Respondents i.e. 'HAIR SPA'.

38. The appeal is accordingly disposed of along with pending application.

39. No orders as to costs.

JYOTI SINGH, J

NOVEMBER 14, 2022/rk/shivam