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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of Decision: 26th September, 2022
+ **CS(COMM) 612/2021 & I.A. 15704/2021, 15708/2021**
COLGATE PALMOLIVE COMPANY & ANR. Plaintiffs
Through: Mr. Pravin Anand, Mr. Saif Khan,
Mr. Achuthan Sreekumar and Mr.
Rohil Bansal, Advocates.
(M:9999756265)

versus

JOHN DOES & ANR. Defendants
Through: Mr. Anurag Ojha, Sr. Standing
counsel and Mr. Deepak Somani,
Advocates for D-2. (M:8368202116)

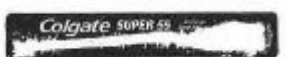
CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J.(Oral)

1. This hearing has been done through hybrid mode.
2. The Plaintiffs- Colgate Palmolive Company, USA, and Colgate Palmolive (India) Ltd. have filed the present suit for permanent injunction, restraining infringement of trademark, copyright, trade dress etc. against unknown Defendants, described as John Doe(s), as also the Central Board of Indirect Taxes & Customs (CBITC)/Defendant No. 2. The Plaintiffs are the manufacturers and sellers of oral health care, personal care, household surface care and fabric care products including toothpaste under the well-known mark 'COLGATE', which was adopted in 1806. 'COLGATE' is one of the leading products in the oral healthcare segment, across the world, as also, in India. It is one of the Fortune 500 companies and its products are available in over 4 million retail outlets in the world. The Plaintiffs have



won several awards since they entered into business in India in 1937, and currently have an employee strength of over 32,000. The plaintiffs have several registered 'COLGATE' marks both in black and white, in logo form, coloured label, etc., which have been set out hereinbelow:

Sl. No.	TRADEMARK	REG. NOS.	CLASS
1.	COLGATE	134071	21
2.		1322313	3
3.	COLGATE MAX FRESH	1322317	3
4.	COLGATE	289703	21
5.	COLGATE ULTRA PROTECTION	567908	21
6.	COLGATE TOTAL	567909	21
7.	COLGATE PRECISION	584763	21
8.	COLGATE DUOACTION	662815	21
9.	COLGATE	745393	21
10.		923558	21
11.	COLGATE TRIPLE ACTION	1043892	21
12.		1416653	21



13.		2857786	21
14.	COLGATE	86932	3
15.	COLGATE	167064	3
16.		190276	3
17.		190279	3
18.		1416616	3
19.		1576674	3

3. The 'COLGATE' name, packaging and trade dress, are distinctive of the Plaintiffs, and the use of the mark, name 'COLGATE', trade dress, or any other deceptively/confusingly similar mark or trade dress, would be violative of the Plaintiff's rights, and will also cause confusion in the marketplace among consumers.

4. The present suit has also been filed against the identified Defendant No. 2 which controls customs and ports across India. The Defendant No. 2 has been impleaded in order seeking restraint orders against a particular container which the Plaintiff apprehended as consisting of infringing products bearing marks which are deceptively/ confusingly similar to the Plaintiffs' mark.

5. The grievance of the Plaintiffs is that, in October, 2021, a container



bearing number ECNU4006477, containing approximately 3,600 pieces of infringing toothpaste, bearing the mark/name 'CONAETE COOL-ICE' had been shipped from Yiwu City to Ningbo Port (China), and finally the container was to be discharged at Mundra Port, India. The details of the same are set out hereinbelow:

Container No.	ECNU4006477
Date of Loading	Oct. 23,2021
Date of Departure	Oct. 24, 2021
Vessel/Voyage	SINGAPORE BRIDGE/2106
Place of Discharge	Mundra, India
ET A at place of Discharge	Nov. 10, 2021

6. The Plaintiffs tracked the said container on the basis of inputs received from its Chinese counterparts and the tracking details of the container have also been placed on record. Photographs of the cartons containing the toothpastes, the container and the truck carrying the container with the impugned products, have also been extracted in the plaint. It is averred that the products in the said container were named as 'CONAETE COOL-ICE', and are nearly identical or confusingly/deceptively similar to the Plaintiffs' product - 'COLGATE MAX FRESH', as also the carton packaging.

7. The Plaintiffs found that the Defendant No. 1's entire packaging was an imitation of the Plaintiffs' packaging. The distinctive colour scheme, blue and red colour combination with a white cap, bold font, as also the



placement of the various features, has been copied. The comparative table of the Plaintiff and Defendant No. 1's product, is set out below:

Original Product of the Plaintiffs	Defendant No. 1's Imported product
	
Red, white and blue color scheme	Red, white and blue color scheme
Red chevron with white lettering for the brand; blue background with white lettering for the sub-brand	Red chevron with white lettering for the brand; blue background with white lettering for the sub-brand
Light blue and white accent designs in sprinkle patterns throughout the packs; as well as ice imagery to connote coolness/freshness .	Light blue and white accent designs in sprinkle patterns throughout the packs; as well as ice imagery to connote coolness/freshness .

8. Mr. Anand, Id. Counsel appearing for the Plaintiffs, relies upon the judgment of the Supreme Court in ***Gramophone Company Of India Ltd. vs Birendra Bahadur Pandey & Ors AIR 1984 667***, to argue that importation of infringing goods, even for the purpose of transit, would be violative of the Plaintiff's rights. Reliance is placed on the following observations in the said decision:

"32. We have, therefore, no hesitation in coming to the conclusion that the word "import" in Sections 51 and 53 of the Copyright Act means "bringing into India from outside India", that it is not limited to importation



for commerce only, but includes importation for transit across the country. Our interpretation, far from being inconsistent with any principle of international law, is entirely in accord with International Conventions and the Treaties between India and Nepal. And, that we think is as it should be”

9. Accordingly, the reliefs set out in the prayer, and sought against Defendant No. 1, are for permanent injunction, restraining manufacture, sale, export, import of the infringing goods, delivery up, etc. The reliefs sought against Defendant No. 2, are in the following terms:

“An order directing the Defendant No. 2 to immediately freeze the contents of the Container No. ECNU4006477 coming from Ningbo, China via the vessel called SINGAPORE BRIDGE /2106 and to divulge the details of the goods contained therein, the details of the importer, the value and number of the goods, the documents submitted by the importer etc. to the Plaintiffs;”

10. Vide order dated 29th November, 2021, summons were issued to Defendant No. 2. Ld. Counsel for Defendant No. 2, Mr. Ojha, had sought time to assess the status of the Container at Mundra Port, Gujarat. The said order dated 29th November, 2021, reads as under:

“7. Mr. Anurag Ojha, Advocate accepts summons in the suit and notice in the applications on behalf of the defendant No.2. After some hearing, he seeks time to verify the position from the Mundra Port, Kachchh, Gujarat in view of the letter dated 20th October, 2021 of the Superintendent, Special Intelligence & Investigation Branch (S.I.I.E.), Custom House, Mundra, Kachchh, Gujarat at page 58 of the plaintiffs' documents.”



11. On 30th November, 2022, i.e., the next date of hearing, Id. Counsel for Defendant No. 2, had assured that the customs department would not allow the import of the impugned goods found in the impugned container no. ECNU4006477, into India. The said statement was recorded in the following terms:

“5. Mr. Anurag Ojha, learned counsel for the defendant No.2 submits that the Customs Authorities shall not allow the import of the goods in Container No.ECNU4006477 coming from Ningbo, China via the Vessel called Singapore Bridge/2106 from Mundra Port, Kachchh, Gujarat. This assurance is noted and accepted.”

12. Since then, it is stated that the Defendant No. 2 has filed the written statement, which is not yet on record due to non-filing of admission/denial affidavit. The Registry is directed to place the written statement on record. However, it is submitted by Id. Counsel for the Defendant No. 2 today, that the import of the contents of the said container into India, has not been permitted by the custom authorities.

13. At present, a copy of the written statement has been handed over to the Court by the Id. Counsel for Defendant No. 2. The same has been filed by Mr. Mukesh Kumar Karela, from the Deputy Commissioner's Office of the Principal Commissioner Customs, Mundra, Gujarat. In the written statement, it is averred that the import of the impugned goods has not been permitted by the Customs Authorities into India. The relevant portion of the written statement has been copied hereinbelow:

“9. That it is further submitted that on 29.11.2021 this Hon'ble Court was apprised of the fact, based on plaintiff's documents itself that alleged infringing



goods are not scheduled for any import at Mundra Customs 4/4/2021 and request was made to take instruction and that on 30.11.2021 while the matter was taken on board, it was argued by the plaintiff that injunctive relief has necessitated requiring answering defendant's aid to intercept the goods there is a possibility of infringing goods being unloaded at that Mundra Port and flooding the Indian Markets. In that connection, upon instructions, it was submitted that Customs authorities will not allow the import of goods in the subject container. The said assurance is complied with and no import from subject container has so far taken place from Mundra Customs.”

14. Accordingly, it is submitted by Id. Counsel for Defendant No. 2, that as recorded in the previous order dated 30th November, 2022, and as also stated in the written statement extracted above, the import of the infringing products into India has not been permitted. Mr. Anand submits that even in the future, such imports of infringing products ought not to be permitted.

15. Heard the Id. Counsels and perused the record. The import of goods which violate Intellectual Property Rights is governed by the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007 (*hereinafter “IPR Rules”*). As per the said rules, import of any counterfeit products or products which violate IP rights of trademark owners, copyright owners, etc., is not permissible. The customs authorities have to, upon complaint received from any IP owner, or on its own accord, form an opinion *qua* the infringement of the IP rights. Upon forming an opinion, the import or sale of products which violate rights of IP owners including trademark, copyright, etc., would have to be stopped by the customs authorities. Section 7 of the IPR Rules deals with the suspension of the clearance of imported



goods, and has been copied hereinbelow:

7. Suspension of Clearance of Imported Goods:

(1)(a) Where the Deputy Commissioner of Customs or Assistant Commissioner of Customs, as the case may be, based on the notice given by the right holder has a reason to believe that the imported goods are suspected to be goods infringing intellectual property rights, he shall suspend the clearance of the goods.

(b) The Deputy Commissioner of Customs or Assistant Commissioner of Customs, as the case may be, may, on his own initiative, suspend the clearance of goods, in respect of which he has prima-facie evidence or reasonable grounds to believe that the imported goods are goods infringing intellectual property rights.

(2) The Deputy Commissioner of Customs or Assistant Commissioner of Customs, as the case may be, shall immediately inform the importer and the right holder or their respective authorised representatives through a letter issued by speed post or through electronic mode of the suspension of clearance of the goods and shall state the reasons for such suspension

16. The customs authorities in this case, have already categorically made a statement that the subject container consisting of the infringing products has not been allowed to be imported into the country. Mr. Ojha, Id. Counsel, further submits that the products were in transit and were headed to a European country.

17. The import having been stopped by the customs authorities, Id. counsel for the Plaintiffs does not press for any further relief in this matter. However, if there are any details available with the Customs Department in respect of importer, seller or manufacturer, as per the bill of lading or any other documents, the same may be intimated to the Plaintiffs upon request.



This has also been provided for in Section 9 of the IPR Rules, extracted hereinbelow:

“9. Supply of information to the right holder. -

At the request of the right holder, the Deputy Commissioner of Customs or Assistant Commissioner of Customs, as the case may be, shall inform the name and address of the importer and without prejudice to the protection of confidential information the Deputy Commissioner of Customs or Assistant Commissioner of Customs, as the case may be, may also provide additional relevant information relating to the consignment which has been suspended from clearance.”

18. The Defendant No. 2 having not permitted imports of the impugned products, paragraph 5 of the prayer clause stands satisfied. None of the goods bearing the impugned mark in the said container no. ECNU4006477, have been allowed to enter India. Accordingly, the injunction is also not required to be passed in view of the statement made in the written statement by the customs authorities. The Plaintiffs are free to take action in accordance with law, either in India, or in other foreign jurisdictions.

19. Binding the customs authorities to comply with the enforcement of IPR Rules in the future, the present suit is disposed of in these terms. No further orders are called for. All pending applications are disposed of.

PRATHIBA M. SINGH, J.

SEPTEMBER 26, 2022

dj/ss