



C.S(COMM.DIV.)No.19 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on	22.12.2022
Pronounced on	24.02.2023

CORAM

THE HON'BLE MR.JUSTICE C.SARAVANAN

C.S(COMM.DIV.)No.19 of 2021

Nureca Limited,
Having its Corporate Office at
SCO 6 to 8, First Floor, Sector 9-D,
Madhya Marg, Chandigarh 160 009.

... Plaintiff

vs.

M/s.Thaker Brothers,
No.73, Devaraj Mudali Street,
Chennai 600 003.

.. Defendant

PRAYER : Civil Suit filed under Order VII Rule 1 of CPC, r/w Order IV Rule 1 of Madras High Court Original Side Rules, r/w Sections 28,29,134 & 135 of the Trade Marks Act, r/w Section 2(1)(c)(xvii) of the Commercial Courts Act, No.4 of 2016 praying to pass :

a) A permanent injunction restraining defendant, its men, agents, servants, licenses, franchisees, distributors, assigns and representatives or anyone claiming through or under them from infringing the plaintiff's registered trademark under No.3380757 in Class 10 or and other registered trademarks DR TRUST by using an identical trademark



DOCTOR'S TRUST or any other mark which is/are identical with and / or deceptively similar to the plaintiff's Trademark or in any other manner whatsoever;

b) A permanent injunction restraining defendant, its men, agents, servants, licenses, franchisees, distributors, assigns and representatives or anyone claiming through or under them from passing off or enabling others to pass the defendant's DOCTOR'S TRUST products as and for the plaintiff's products under the trademark DR Trust by using, selling, or offering to sell, distributing, displaying, printing, stocking, using, advertising their products or in any other manner whatsoever;

c) Directing the defendant to render a true and faithful account of sales made by sale of products to the customers under the impugned mark and the defendant be further ordered and directed to pay to the plaintiff such amount as may be found due on such account being taken.

d) The defendant be ordered to pay to the plaintiffs a sum of Rs.1,00,00,000/- as damages for the act of infringement of Trade Mark and passing off committed by defendant.

e) To declare the plaintiff DR TRUST mark as a well-known Trade Mark.

f) For costs of the suit

g) For such further or other relief.

For Plaintiff : M/s.R.Sathish Kumar
M/s. Priya.V



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

For Defendant : Mr.Surya Senthil.N
for M/s.Surana and Surana

J U D G M E N T

The plaintiff has filed the present suit for a permanent injunction to restrain the defendant, its men, agents, servants, licensees, franchisees, distributors, assigns and representatives or anyone claiming to or under them from :

- i. infringing the plaintiffs registered Trademark No. 3380757 in class 10 or other registered trademarks Dr Trust by using an identical trademark Doctor's Trust or any other mark which is/or identical with and/or deceptively similar to the Plaintiff's Trademark or in any other manner whatsoever; or
- ii. passing off or enabling others to pass of the defendant's DOCTOR'S TRUST products as that of the plaintiff's product under the trademark Dr Trust by using, selling, or offering for sale, distributing, displaying, printing, stocking, using, advertising their products or any other manner whatsoever; and
- iii. to direct the defendant to render a true and faithful account of sales made of the products to the customers under the offending trademark and to pay the plaintiff such amount



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

as may be found due on such account being rendered and to pay a compensation of ? 1,00,00,000 as damages for act of infringement and for passing off anti-declare the trademark Dr.Trust.

2. The following snap shot of the marks determines the scope of dispute between the plaintiff and the defendant.

TABLE – 1

Defendant's trademark	Plaintiff's registered trademark
	

3. Following issues were framed by this Court on 23.2.2022:-

- (i) Whether the plaintiff has been using the trademark “Dr Trust” and if the prior user of the said trademark?
- (ii) Whether the plaintiff was the register proprietor of the trademark “Dr Trust” and its formative marks?
- (iii) Whether the defendant’s mark “Doctor’s Trust” is infringing the plaintiff’s trademark “Dr Trust”?
- (iv) Whether the defendant is passing off its



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

product with the trademark “Doctor’s Trust” as that of the plaintiff’s product under the trademark “Dr Trust”?

- (v) Whether the plaintiff is entitled to a declaration that it’s trademark “Dr Trust” is a well-known trademark under applicable provisions of the Trademarks Act, 1999?
- (vi) Whether the defendant is liable to render accounts of pay damages in a sum of ? 1, 00, 00, 000/-to the plaintiff?
- (vii) Whether the parties are entitled to any other relief?

4. Both on behalf of the plaintiff and defendant examined only one witness each as PW 1 and DW 1. On behalf of the plaintiff, Exhibits P-1 to 32 were marked as detailed below:-

TABLE - 2

Sl.No.	Exhibits	Date	Description of documents
1	Ex.P.1	28.06.2021	Board Resolution
2	Ex.P.2	27.06.1995	Certificate of incorporation upon name change of Nectar Life sciences Limited
3	Ex.P.3	01.08.2015	Assignment deed in favour of Nectar Biopharma Private Limited
4	Ex.P.4	20.08.2018	Assignment deed in favour of Nectar Biopharma Private Limited



C.S(COMM.DIV.)No.19 of 2021

Sl.No.	Exhibits	Date	Description of documents
5	Ex.P.5	02.11.2016	Certificate of Incorporation of Nureca Private Limited
6	Ex.P.6	29.04.2022	Demerger scheme along with NCLT Bench Order
7	Ex.P.7	08.07.2020	Conversion of Nureca Private Limited to Public Limited
8	Ex.P.8	14.05.2014 09.09.2011 & 24.04.2017	Whois details
9	Ex.P.9	21.06.2021	Chartered Accountant Certificate showing the sales in India and USA through regional website
10	Ex.P10	21.06.2021	Chartered Accountant certificate showing the total sales in India and USA
11	Ex.P11	2016 to 2021	Invoices/Order details reflecting the sales in India through e-commerce platforms
12	Ex.P12	2016 to 2021	Stock transfer/invoices reflecting sales through distributors, agent and dealers in India
13	Ex.P13	2016 to 2021	Invoices reflecting the amount spent by the plaintiffs in promoting and advertising its product under the DR TRUST mark on Amazon, Flipkart and Google
14	Ex.P14	25.06.2021	Chartered Accountant Certificate showing the expenditure towards the promotion and advertisement on various e-commerce and commercial platforms
15	Ex.P15	2020	Endorsement agreement
16	Ex.P16	2020 and 2021	Awards won by plaintiff and media coverage of plaintiff
17	Ex.P17	2016 to 2021	Web analytic report of both the website visitors



C.S(COMM.DIV.)No.19 of 2021

Sl.No.	Exhibits	Date	Description of documents
18	Ex.P18	28.07.2018	Registration Certificate for the Application No.2151603
19	Ex.P19	13.07.2018	Registration Certificate for the Application No.3380757 in Class 5
20	Ex.P20	02.06.2021	Registration Certificate for the Application No.3718500 in Class 10
21	Ex.P21	22.06.2018	Registration Certificate for the Application No.3718500 in Class 9
22	Ex.P22	28.01.2019	Registration Certificate for the Application No.3898354 in Class 11
23	Ex.P23	25.05.2021	Request to trademark registry to obtain certified copies along with filing receipt
24	Ex.P24	22.09.2020	Cease and Desist notice sent to defendant along with postal receipt
25	Ex.P25	05.10.2020	Reply notice sent by the defendant
26	Ex.P26	05.10.2020	Notice of opposition filed by the defendant
27	Ex.P27	25.11.2020	Counter statement filed by the plaintiff
28	Ex.P28	08.12.2020	Interlocutory petition filed by the plaintiff in application No.4566470
29	Ex.P29	08.12.2020	Reply to examination report in Application No.4566470
30	Ex.P30	24.02.2021	2 nd cease and desist notice sent by the plaintiffs with postal receipt
31	Ex.P31	08.01.2021	Registration certificate of the defendant mark "DIVINE TOUCH" bearing application No.4520901 in Class 10
32	Ex.P32	-	Sale of defendants product through online marketplace



C.S(COMM.DIV.)No.19 of 2021

5. On behalf of the defendant, Exhibits D1 to D16 together with Material Object No.1 and an affidavit under section 65B Of the Indian Evidence Act 1872 were filed as detailed below:-

TABLE - 3

Sl.No.	Exhibits	Date	Description of documents
1	Ex.D.1	-	Plaintiff's Dr.Trust Blood Pressure Monitor along with the Material Object
2	Ex.D.2	31.07.2021 to 03.03.2021	Partnership Deeds of the defendant firm and GST Registration Certificate
3	Ex.D.3	20.09.2019 to 06.08.2020	Trademark certificate obtained and application made by the defendant
4	Ex.D.4	07.07.2020 to 28.05.2021	Sample invoices raised against the defendant for import of medical devices
5	Ex.D.5	Nil	Credentials obtained by the defendant's supplier for the products being imported
6	Ex.D.6	14.10.2020	Certifications and NPPA compliance relating to the defendant's product
7	Ex.D.7	16.08.2020 to 17.08.2020	Correspondences regarding enquiries for supply of gloves for distribution made by the defendant
8	Ex.D.8	13.07.2020 to 16.09.2020	Defendant's messages relating to logo selection and correspondence
9	Ex.D.9	Nil	Defendant's logos for the mark Doctor's Trust and Divine Touch
10	Ex.D10	18.09.2020 to	Sample invoices by the defendant for its medical devices



Sl.No.	Exhibits	Date	Description of documents
		01.12.2020	
11	Ex.D.11	17.08.2021	Chartered Accountant Certificate for Annual Sales turnover and Sales Promotional Expenses for the financial years 2020-21 & 2021-22
12	Ex.D.12	20.05.2021 to 01.06.2021	Supply of medical devices for charitable causes
13	Ex.D.13	Nil	Extracts from internet regarding the plaintiff's products
14	Ex.D.14	Nil	Documents pertaining to the plaintiff extracted from the Ministry of Corporate Affairs
15	Ex.P15	12.03.2012 to 04.01.2021	Extracts of plaintiff's trademark registrations and applications
16	Ex.P16	11.03.1983 to 08.06.2021	Other proprietors as per the trademark registry under class 10

6. On behalf of the plaintiff following case laws were relied

upon:-

- i) ***Renaissance Hotel Holdings Inc. Vs. B.Vijaya Sai and Others***, (2022) 5 SCC 1;
- ii) ***Laxmikant vs. Patel***, AIR 2002 SC 275;
- iii) ***Abercrombie Fitch Co., vs. Hunting World, Inc.***, 2021(86) PTC 128 (US);
- iv) ***Bata India Limited vs. Chawla Boot House &Anr.*** , 2019(78) PTC 505 (Del);
- v) ***Corn Products Refining Co., vs. Shangrila Food Products Ltd.***, AIR 1960



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

SCC 142;

vi) ***National Bell Co., and another vs. Metal Goods Mfg. Co.(P) and Another***, 1970 3 SCC 665;

vii) ***Cadila Health Care Ltd vs. CadilaPharmaceuticals Ltd.***, AIR 2001 SCC 1952;

viii) ***Pidilite Industries Limited vs. Pidilite Industries Limited***, 2014 SCC Online Bom 50;

7. On behalf of the defendant following case laws were relied

upon:-

i) ***Prina Chemical Works and Others vs. Sukhdayal and Others***, ILR (1974) ` Delhi 545;

ii) ***Rich Products Corporation &Anr. Vs. Indo Nippon Food Ltd.***, ILR (2010) II Delhi 663

iii) ***Orange City Mobile Collection through its Partners vs. City Collection, through its Partners and Others***, 2021 SCC Online Bom 3567;

iv) ***S.Syed Mohideen vs. P.Sulochana Bai***, (2016) SCC 683;

v) ***Nandhini Deluxe vs. Karnataka Cooperative Milk Producers Federation Limited***, (2018) 9 SCC 183;

8. The plaintiffs is the registered proprietor of the following



C.S(COMM.DIV.)No.19 of 2021

trademarks :-

TABLE – 4:-

Exhibits	Trade Mark No.	Mark	Class	Status	User Details
	3380756	Dr.Trust(L)	5	R	08.02.2011
Ex.P.18	2151603	Dr.TRUST(D)	5	R	17.04.2010
Ex.P.19	2297560	Dr.Trust(D)	5	R	Proposed to be used
Ex.P.20	3380757	Dr.Trust(D)	10	R	08.02.2011
Ex.P.21	3718500	Dr.Trust(D)	9	R	17.04.2010
Ex.P.22	3898354	DR.TRUST(W)	11	R	15.02.2016

[(D)– Label Mark: (W)– Word Mark; (R)- Registered; (O):-

Opposed)]



9. The plaintiff also claims that the plaintiff and its associated company have also filed the following applications for registration of the label and a device with the word “Dr Trust” as detailed below:-

TABLE – 5:-

Appl.No.	Applicant	Mark	Class	Exhibit	Status
3380758	Nureca Ltd.	Dr.Trust	35		Accepted &Advertised
3898364	Nureca Ltd.	DR.TRUST(W)	10		Opposed
47449604	Nureca Ltd.	Dr.Trust	3,9,28,30, 35 & 42		Objected
4284707	Nectar Biopharma Pvt.Ltd.	Dr.Trust	27		Objected

10. However, copies of some of these trademarks have not been filed as Exhibits. Plaintiff claims that its associated companies namely Nectar Bio Private Limited has also filed overseas applications for



C.S(COMM.DIV.)No.19 of 2021

registration of the above trademarks in various classes in other country though copies. It is stated that some of them have been registered while some of them are pending registration as detailed below:-

TABLE – 6 :-

Appl.No.	Applicant	Mark	Class	Jurisdiction	Status	Valid upto
8889981	Nureca Ltd	Dr.Trust	10	USA	Registered	24.11.2030
018318746	Nureca Ltd	Dr.Trust	9 & 10	EUIPO	Registered	09.10.2030
45143124	Nectar Biopharma Pvt.Ltd	Dr.Trust	10	China	Advertised	--
88930779	Nectar Biopharma Pvt.Ltd	Dr.Trust	5	USA	Published for Opposition	--
88902397	Nectar Biopharma Pvt.Ltd	Dr.Trust	9	USA	Published for Opposition	--
90355613	Nectar	Dr.Trust	35	USA	Awaiting Examination	--

11. Again copies of these Trade Mark registration and Trade mark and Trade Mark applications have not been filed as Exhibits.



WEB COPY

12. The brief case of the plaintiff is that the defendant has entered the very same field in which the plaintiff is engaged and has adopted the offending mark viz., offending label of DOCTOR'S TRUST of which is deceptively similar to the plaintiff's registered trade mark Dr.Trust in various classes. It is submitted that the plaintiff and its associated companies have been using the trade Mark Dr.Trust both as a word mark and also as a device mark and in combination thereof for medical goods since 2010.

13. It is case of the plaintiff that the defendant has adopted the offending mark DOCTOR'S TRUST for medical instruments, devices, apparatus and equipment and has thus not only infringed the registered trademark of the plaintiff Dr.Trust which have been in use since 2010 but has also attempted to pass-off their goods as that of the plaintiff.

14. That apart, it is submitted that since the defendant was found selling "oxygen concentrator" with the offending label DOCTOR'S TRUST, Ex.P.24 Cease and Desist Notice dated 22.09.2020 was issued to



the defendant from using the aforesaid offending mark for “oxygen concentrator”.

15. It is submitted that instead of refraining from using the offending trademark or “oxygen concentrator”, the defendant vide Ex.P25 dated 5.10.2020, replied back stating that the plaintiff is not the proprietor of the registered trademark DR TRUST for products under class 10 in respect of surgical and medical instruments.

16. In Ex.P25 dated 5.10.2020 it was further stated that the aforesaid word Dr.Trust does not qualify for registration on the absolute grounds, since the mark is descriptive in nature, common to the trade and public *juris*.

17. The defendant also stated that the adoption of the mark was *bonafide* and in good faith for surgical and medical goods and that the offending mark was both structurally and visually different, dissimilar and not-identical with the plaintiffs registered for the words/label and device trademarks Dr.Trust.



C.S(COMM.DIV.)No.19 of 2021

18. At the same time, the defendant has also filed application for registration of the offending marks as Label/Device Mark vide TM Application No. 4566470 in class 10 on 12.7.2020 by stating that the aforesaid. At the time of filing of the application the offending mark was proposed to be used.

19. Details of TM Application No. 4566470 in class 10 dated 12.7.2020 was filed as Ex.D3 series along with other registrations obtained by the defendant in other classes for different goods with different trade mark. This Court is not concerned with other registrations obtained by the defendant.

20. It the case of the defendant that the plaintiff has been marketing the product through e-commerce and internet commercial platform in India such as Amazon, Snapdeal, Flipkart, Indiamart, Indiacom, etc., while the defendant was distributing the product bearing the offending mark through wholesale distributors and through retail outlets directly to the consumers. It is therefore submitted that there is neither any infringement or passing off as there is no scope for confusion



on account of the business model.

WEB COPY

21. The plaintiff on the other hand would submit that it was promoting its products with brand the DR.TRUST which has provided remarkable results and consistently over these years with the number of visitors to the website www.drtrust.in and www.drtrustusa.com respectively.

TABLE – 7:-

Year	Website Traffic	
	www.drtrust.in	www.drtrustusa.com
2019-2020	283,542	2,172
2020-2021	3,922,991	14,372

22. The defendant has also initiated opposition proceedings for registration of the word mark Dr.Trust in Appl.No.3898364 vide Opposition No.1065336. The plaintiff also appears to have approached the defendant by issuing another cease-and-desist notice/reply vide Ex.P30 Dated 24.2.2021 in an attempt to dissuade defendant from using the impugned offending trademark mark Doctor Trust.



23. The facts on record also indicates that the defendant has also registered under the trademark Divine Touch vide T.M.No. 4520901 in class 10 for “medical mask, medical gloves, medical instruments, surgical, medical, dental and veterinary practice and instruments, artificial limbs, eyes, and teeth; automatic article, suture materials”. The application was filed on 6.6.2020 and the registration was granted on 8.01.2021.

24. It is the specific case of the plaintiff that the act of the defendant is brazen. The adoption of the offending trademark “DOCTOR TRUST” was nothing short of an attempt to misappropriate the goodwill and reputation associated the plaintiffs registered trademark “Dr.Trust” in various classes and an attempting to ride on the goodwill and popularity associated with the aforesaid mark(s) of the plaintiff and to cause confusion among the consuming public.

25. It is further case of the plaintiff that the defendant is a late entrant in the market while the plaintiff has been on the market since 2010 and that the defendant has been found selling oxygen concentrator



with the offending trademark “Doctor Trust” only since September 2020 after the outbreak of Covid 19 Pandemic and therefore the brazen attempt to use the offending trademark “Doctor Trust” should be permanently enjoined.

26. It is submitted that the adoption of the offending trade mark “Doctor Trust” in 2020 was not *bonafide* as the plaintiff has been on the market since 2010 and continuation of use of the offending mark by the defendant would be in gross violation of registered trademarks of the plaintiff and is liable to be injected under the common law remedy of passing off.

27. The defendant defends its action primarily on the ground that the channel of sale are totally different. It is submitted that the defendant markets the product through the wholesale and retail dealers whereas the plaintiff predominantly markets the product using the e-commerce an electronic platform.

28. It is submitted that adoption of the offending mark was



bonafide and was not intended to deceive anybody. That apart, it is submitted that the plaintiff's mark "Dr.Trust" and the defendants trademark "DOCTOR TRUST" with the device of a stethoscope was visually different and therefore there is no case made of either infringement of the registered trademarks of the plaintiff or for passing off.

29. That apart, it is further submitted that the plaintiff does not have a registration of the "Dr.Trust" in class 10 and therefore the present plaint has been filed only with a view to emasculate and stifle a fair competition.

30. It is further submitted that the word "Dr.Trust" is descriptive of the product and therefore not distinctive and therefore the registration granted hitherto in various classes to the plaintiff are liable to be rectified.

31. It is submitted that the plaintiff's application in class 10 Vide Appl.No.3898364 is still pending registration which has been also



opposed by the defendant vide Opposition No. 1065336 on the ground that available under Section 9(1)(b) of the Trademarks Act, 1999. It is submitted that the both the marks are visually different from each other and therefore there is no scope for confusion among the consumers.

32. The defendant further submitted that the plaintiff has failed to disclose to the court that registration in Ex.P19 in TM No.2297560 in class 5 came with a disclaimer i.e “registration of the trademark shall give no right to the exclusive use of the words of the descriptive nature’s”. It is submitted that the plaintiff has purposely misrepresented regarding the chronology of the registration of the defendants trademark “Divine Touch” and “Doctor’s Trust”.

33. The defendant also questions details of the sales turnover and the advertising expenses borne by the plaintiff and has stated that the plaintiff has given different version of the turnover before the Trademark Registry and before this Court. It is therefore submitted that there is no truth in the above mentioned the plaintiff regarding the plaintiff’s turnover.



WEB COPY

34. That apart, it is submitted that the defendant was founded in the year 1980 in Chennai and was primarily engaged in importing, distribution and also whole sale trade of polyvinyl chloride resin, polymers, PVC foam boards, PVC sheets, flooring, gypsum tiles and mineral fibre ceilings et cetera and has a good marketing network. The defendant have also given the sales turnover of these products in the written statement though they are of no relevance.

35. The defendant has further stated that due to adverse impact of the lockdown post due to the outbreak of Covid-19 pandemic and considering the fact that there was an acute shortage of medical devices particularly oxygen concentrator during the 2nd wave, the defendant entered the market by importing and selling medical devices and after obtaining necessary statutory permission. In the written statement defendant has given reasons for adopting the marks “Divine Touch” and “Doctor’ s Trust”. It is submitted that the offending mark was adopted after the defendant decided to import much-needed oxygen concentrators which was an acute shortage during the said 2nd wave of Covid-19.



WEB COPY

36. It is submitted that the offending trademark “Doctor’ s Trust” was adopted as it would convey the message to the consuming public that the product was trusted by the doctors and would accompany required certifications and would have undergone audits by regulatory authorities to ensure quality and integrity.

37. It is submitted that the words“Doctor’s Trust” in the offending trademark stands for the reliability, affordability and most importantly the trust of the doctors and since it was distinctive, the word was used with the distinctive label after considering a number of factors and discussion among the family members and professionals.

38. It is submitted that the defendant has been using them of continuously over a period of 2 years since then since September 2020. The defendant has also sought to defend its stand by stating that the word “Doctor” is common to the trade and that there are several registrations in class 10 already in favour of various other proprietors and therefore while the defendant would be entitled to register the offending mark and the plaintiff cannot claim exclusive monopoly over the word“Doctor” or its



abbreviation “Dr” to the exclusion of the defendant. The defendant has also disputed the sales turnover no disclosed in the plane by comparing it with the documents filed before the Ministry of Corporate Affairs for the year 2016-2019.

39. I have considered the arguments advanced by the learned counsel for the plaintiff and the defendant. I have also perused the plaint and the written statement and the proof affidavits filed on behalf of the plaintiff and defendant and the deposition of the respective witnesses before the learned Additional Master IV, have also perused the provisions of the Trademarks Act, 1999 and the case laws filed by the respective parties.

40. The plaintiff has obtained registration for the trademark “Dr Trust” in various classes as detailed in Table 4. At the time of filing of the suit and during the trial, the Legal Use Certificate had not been obtained by the plaintiff. During Trial, the plaintiff however marked Ex.P.23 - copies of request filed with the Trade Marks Registry for issuance of Legal Use Certificate of its registered trade marks. During hearing, Legal Use Certificate was produced for Ex.P.19 and Ex P20.



WEB COPY

41. Ex.P.18 is a copy of Registration Certificate for the label “DR TRUST” in TM.No.2151603 in class 5. The registration is with effect from 30.05.2011 claiming user since 17.04.2010.

42. Ex.P.19 is a copy of Registration Certificate for the label “Dr Trust” in TM.No.2297560 in class 5 with effect from 12.03.2012 proposed to be used. The aforesaid registration in Clause 5 for the label/device of “Dr Trust”. It was subject to the condition “**Registration of the Trademark shall give no right to the exclusive use of the words of descriptive natures**”. There the application for the aforesaid device mark was made with a tag line “Better Solutions for Better Health”.

43. It cannot be assumed that the mark in Ex.P.19 vide TM.No.2297560 in clause 5 for the label/device of “Dr Grust” also along with the Tag line “Better Solutions for Better Health” was a descriptive mark and yet registered. The description in Ex.P.19 in the label/device of “Dr.Trust” vide TM No.2297560 in class 5 was confined only to the tag line “Better Solutions for Better Health” and not to the



entire mark.

WEB COPY

44. Ex.P.20 is a copy of Trade Mark registration certificate of the word “Dr Trust” in TM.No.3380757 in class 10 together with caricature/device of a person implying a Doctor. The application was filed on 04.10.2016 claiming user since 08.02.2011. Ex.P.20 Trade Mark Certificate is a composite mark for the words “Dr Trust”

45 Similarly, Ex.P.21 is a copy of Trade Mark Registration Certificate for the words “Dr Trust” together with a caricature/device of a person implying a Doctor in TM.No.3718500 in class 9 with effect from 03.01.2018 claiming user since 17.04.2010.

46. Ex.P.22 is a copy of Trade Mark Registration Certificate for the label “Dr Trust” in TM.No.3898354 in class 11 with effect from 26.07.2018 claiming user since 15.02.2016. The plaintiff has obtained registration for the words “Dr Trust” in TM No. 3898354 in class 11. The application was filed for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes on



25.7.2018 .

WEB COPY

47. The plaintiff has also filed T.M.A.No. 3898364 in class 10 for surgical Medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth orthopaedic articles, suture materials T.M.A.No. 3898364 is pending registration and is now subject matter of opposition proceeding at the instance of the defendant Opposition No.1065536 in Ex.P.26.

48. As per Section 31(1) of the Trademark Act, 1999, in all legal proceedings, relating to a trade mark registered under the Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.

49. As per Section 31(2) of the Trade mark Act, 1999, in all legal proceedings, a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under Section 9 except upon evidence of distinctiveness and that such evidence was not



submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

50. Unlike under Section 32 of the 1958 Act, there is however no provision in the present law to render the registration to be conclusive as to validity after seven years. The two parts of the Registrar , Part A and Part B which existed under the 1958 Act have now been combined into a single Register having the same distinctiveness requirements and legal rights. Consequently, the legal presumption as to conclude validity in respect of a Part A registration, as existed in the 1958 Act, has been omitted in the new law. However, a new provision has been added to provide that distinctiveness acquired after the date of registration will be taken into account if the validity is subsequently contested in respect of a registered trade mark.

51. The defendant has not produced any evidence to disprove the claim of the plaintiff regarding prior adoption and use of the word and label device mark with the words “Dr Trust”. Therefore, it has to be



construed that the plaintiff adopted the words “Dr Trust” in the device prior in time.

52. It is also an admitted fact that defendant has started using the offending mark even only with effect from September 2020 such as per their own admission in paragraph 11 of the written statement. Therefore, issue Nos. (i) and (ii) have to be answered in favour of the plaintiff.

53. The word “Dr Trust” by the plaintiff in Ex.P.18 – P.22 was intended to let the imagination of the consumer/consuming public to infer a trust in the product marketed by the plaintiff when it was adopted the mark “Dr.Trust”. It was suggestive and therefore distinctive.

54. The present suit is based on ExP.20 Registered Trademark No. 3380757 in class 10. The said trademark is a Lable Mark. The defendant has filed an application for registering the offending mark only recently vide T.M.A.No.4566470 in Class 10 on 12.07.2020. On the date



of the application, the offending mark was proposed to be used. In any event, it has been opposed in Form TM-M vide Ex.P.28 dated 08.12.2020 by the plaintiff.

55. As mentioned above, a Ex.P.20 Registered Trade Mark No.3380757 in clas 10 is a composite mark consisting of the words “ Dr Trust” together with caricature/device of a person implying Doctor.

56. As per section 17(1) of the Trade marks Act, 1999, when a trademark consists of several matters, it’s registration shall confer on the proprietor an exclusive right to use of the trademark taken as a whole. This is the general rule. In other words, in case of a composite registered mark, the composite trademark, has to be seen as a whole and should not to be dissected to infer any infringement.

57. However, an exception to Section 17(1) is provided in section 17 (2). It starts with a *non-obstante* clause. Section 17(1) and Section 17(2) of the Trade Mark Act, 1999 are reproduced below to discern the exception to the general rule:-



TABLE – 8:-

WEB COPY

Section 17(1)	Section 17(2)
(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.	(2) Notwithstanding anything contained in sub-section (1), when a trade mark— (a) contains any part— (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or (ii) which is not separately registered by the proprietor as a trade mark; or (b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

58. Section 17(2) of Trade Marks Act, 1999 enables a registered proprietor to claim exclusive right both over whole and part of the composite mark subject to certain conditions.

59. Section 17 (2) of the Trademarks Act, 1999, can be understood as follows:-



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

Notwithstanding anything contained in Section 17 (1), when a trademark:

- i. contains any part which is not the subject matter of a separate application by the proprietor for registration as a trademark;
or
- ii. contains any part which is not separately registered by the proprietor as trademark;
or
- iii. contains any matter which is :
 - a) common to the trade, or
 - b) otherwise is of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of whole of the trademarks or registered.

60. In other words, if a registered proprietor of a mark has either filed a separate application for registration of the part of the mark or has a separate registration for the part of the mark separately, then the said proprietor can claim monopoly over the part of the registration. Therefore, a composite trademark can be said to be infringed, if any part of such composite mark is either

- (1) registered as a separate trademark or
- (2) if an application for registering such part has been filed by the proprietor.



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

61. In this case, admittedly, the plaintiff also has obtained a separate registration for the Word “Dr Trust” vide Ex.P.18 TM No.2151603 in class 5 for goods and service viz Pharmaceutical Veterinary and Sanitary Preparations, dietetic substances adapted for medical use, food for babies, plasters, materials for dressing, materials for dressing, material for stopping teeth, dental wax, dis-infectance preparation for destroying vermin, fungicides, herbicides. Similarly, the plaintiff has registered in Ex.P.19 to Ex.P.22. Therefore, the restrictions in Section 17 of the Trademarks Act, 1999 cannot operate against the plaintiff.

62. The adoption of the offending mark/label with the device of a stethoscope with the words “Doctors Trust” was clearly conceived by having plaintiff’s registration for the word mark “Dr Trust” in different classes vide Ex.P.18 to Ex.P.28. The offending mark is both visually and phonetically similar to the plaintiff’s composite mark. Use of the offending mark therefore infringes of the Trade Marks of the plaintiff.



Therefore, issue No.(iii) is answered in favour of the plaintiff and against the defendant.

63. The offending mark “Doctors Trust” closely resembles both visually and phonetically with the label/word mark of the plaintiff in various classes with the words “Dr.Trust”. It has to be construed the adoption of the offending mark/label consisting of the device of a stethoscope with the words “Doctors Trust” was not *bonafide* and was adopted with a view to “pass –off” and to ride on the goodwill associated with the plaintiff and plaintiff’s registered trademarks. Therefore, issue No.iv is also answered in favour of the plaintiff and against the defendant.

64. The expression “well-known trade mark” is defined in Section 2(zg) of the Trade mark,1999 as follows:-

(zg)“well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark



C.S(COMM.DIV.)No.19 of 2021

in relation to the first mentioned goods or services.

WEB COPY

65. Primarily the power to declare a Trade Mark as a “well-known Trade Mark” is vested only with the Registration of Trade Mark under the Trade Mark Act, 1999 and Trade Mark Rules, 2017.

66. The plaintiff has an alternate remedy under Rule 124 of the Trade Mark Rules, 2017 by filing an appropriate application before the Trade Mark Office in TM-M to the II schedule of the Trade Mark Rules, 2017 on payment of necessary appropriate fees as per the I Schedule to the Trade Mark Rules, 2017 to declare the said trade mark as a “well-known trade mark”.

67. However, under Section 11(8) of the Trade Mark Act, 1999, where a trade mark has been determined to be “well-known” in atleast one relevant section of the public in India by *any Court or Registrar*, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.



68. Thus, Courts can also declare a Trade Mark as a “well-known trade mark”. However, the threshold for declaring a Trade Mark as a “well-known trade mark” under the Act is very high. There has to be evidenced to substantiate the same.

69. The Delhi High Court in **Tata Sons Ltd., vs. Manoj Doia & Ors., 2011 SCC Online Del 1520**, has held as follows:-

“13. Trademarks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well knownmark or not, though it does contain factors which the Registrar has to consider whether a trademark is a well known mark or not. In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including (i) the extent of knowledge of the mark to, and its recognition by the relevant public; (ii) the duration of the use of the mark; (iii) the extent of the products and services in relation to which the mark is being used; (iv) the method, frequency, extent and duration of advertising and promotion of the mark; (v) the geographical extent of the trading area in which the mark is used; (vi) the state of registration of the mark; (vii) the volume of business of the goods or services sold under that mark; (viii) the nature and extent of the use of same or similar mark by other parties; (ix) the extent to which the rights claimed in the



mark have been successfully enforced, particularly before the Courts of law and trademark registry and (x) actual or potential number of persons consuming goods or availing services being sold under that brand. A trademark being well known in one country is not necessarily determinative of its being well known and famous in other countries, the controlling requirement being the reputation in the local jurisdiction.”

70. The plaintiff has not established that the subject mark has attained the cult status of a “well-known trade mark” by letting sufficient evidence before the Court during trial to conclude that the subject trade mark Dr.Trust of the plaintiff is a “well-known trade mark” in at least one relevant section of the public.

71. Therefore, issue No.(v) is answered against the plaintiff while preserving rights of the plaintiff to have the mark declared as a “Well-known Trade Mark” in an appropriate proceedings either before this Court or be TMO.

72. As far as the claim for a compensation of Rupees One



C.S(COMM.DIV.)No.19 of 2021

Cröre as damages on account of alleged misuse of the trade mark by the defendant is concerned, again the documents filed by the plaintiff are not sufficient to establish that the plaintiff has suffered loss to warrant awarding compensation for the alleged damage. The pleadings in the plaint are also sketchy Exhibits filed regarding sales turnover before this Court and in the opposition proceedings are contradictory.

73. In any event, there are no documents to substantiate that the defendant has made a substantial intrusion into the market of the plaintiff and has caused damage to the plaintiff warranting compensation of Rupees One Crore to the plaintiff. Therefore, prayer No.(iv) for compensation is also answered against the plaintiff.

74. In the light of the above discussion, the civil suit is partly decreed in so far as prayer Nos.(i), (ii) & (iii). Parties to bear their own costs.

24.02.2023

Index : Yes/No
Internet : Yes/No



C.S(COMM.DIV.)No.19 of 2021

Speaking /Non-speaking Order
kkd

WEB COPY

Plaintiff's witnesses :

Tr.Saurabh Goyal : P.W.1

Defendant's witnesses :

Tr.Bharat G.Thaker : D.W.1

Documents exhibited by the Plaintiff:

Sl.No.	Exhibits	Date	Description of documents
1	Ex.P.1	28.06.2021	Board Resolution
2	Ex.P.2	27.06.1995	Certificate of incorporation upon name change of Nectar Life sciences Limited
3	Ex.P.3	01.08.2015	Assignment deed in favour of Nectar Biopharma Private Limited
4	Ex.P.4	20.08.2018	Assignment deed in favour of Nectar Biopharma Private Limited
5	Ex.P.5	02.11.2016	Certificate of Incorporation of Nureca Private Limited
6	Ex.P.6	29.04.2022	Demerger scheme along with NCLT Bench Order
7	Ex.P.7	08.07.2020	Conversion of Nureca Private Limited to Public Limited
8	Ex.P.8	14.05.2014 09.09.2011 & 24.04.2017	Whois details
9	Ex.P.9	21.06.2021	Chartered Accountant Certificate showing the sales in India and USA through regional website



C.S(COMM.DIV.)No.19 of 2021

Sl.No.	Exhibits	Date	Description of documents
10	Ex.P10	21.06.2021	Chartered Accountant certificate showing the total sales in India and USA
11	Ex.P11	2016 to 2021	Invoices/Order details reflecting the sales in India through e-commerce platforms
12	Ex.P12	2016 to 2021	Stock transfer/invoices reflecting sales through distributors, agent and dealers in India
13	Ex.P13	2016 to 2021	Invoices reflecting the amount spent by the plaintiffs in promoting and advertising its product under the DR TRUST mark on Amazon, Flipkart and Google
14	Ex.P14	25.06.2021	Chartered Accountant Certificate showing the expenditure towards the promotion and advertisement on various e-commerce and commercial platforms
15	Ex.P15	2020	Endorsement agreement
16	Ex.P16	2020 and 2021	Awards won by plaintiff and media coverage of plaintiff
17	Ex.P17	2016 to 2021	Web analytic report of both the website visitors
18	Ex.P18	28.07.2018	Registration Certificate for the Application No.2151603
19	Ex.P19	13.07.2018	Registration Certificate for the Application No.3380757 in Class 5
20	Ex.P20	02.06.2021	Registration Certificate for the Application No.3718500 in Class 10
21	Ex.P21	22.06.2018	Registration Certificate for the Application No.3718500 in Class 9
22	Ex.P22	28.01.2019	Registration Certificate for the Application No.3898354 in Class 11
23	Ex.P23	25.05.2021	Request to trademark registry to obtain certified copies along with filing receipt



C.S(COMM.DIV.)No.19 of 2021

Sl.No.	Exhibits	Date	Description of documents
24	Ex.P24	22.09.2020	Cease and Desist notice sent to defendant along with postal receipt
25	Ex.P25	05.10.2020	Reply notice sent by the defendant
26	Ex.P26	05.10.2020	Notice of opposition filed by the defendant
27	Ex.P27	25.11.2020	Counter statement filed by the plaintiff
28	Ex.P28	08.12.2020	Interlocutory petition filed by the plaintiff in application No.4566470
29	Ex.P29	08.12.2020	Reply to examination report in Application No.4566470
30	Ex.P30	24.02.2021	2 nd cease and desist notice sent by the plaintiffs with postal receipt
31	Ex.P31	08.01.2021	Registration certificate of the defendant mark "DIVINE TOUCH" bearing application No.4520901 in Class 10
32	Ex.P32	-	Sale of defendants product through online marketplace

Documents exhibited by the Defendant:

Sl.No.	Exhibits	Date	Description of documents
1	Ex.D.1	-	Plaintiff's Dr.Trust Blood Pressure Monitor along with the Material Object
2	Ex.D.2	31.07.2021 to 03.03.2021	Partnership Deeds of the defendant firm and GST Registration Certificate
3	Ex.D.3	20.09.2019 to 06.08.2020	Trademark certificate obtained and application made by the defendant
4	Ex.D.4	07.07.2020 to 28.05.2021	Sample invoices raised against the defendant for import of medical devices



WEB COPY



C.S(COMM.DIV.)No.19 of 2021

Sl.No.	Exhibits	Date	Description of documents
5	Ex.D.5	Nil	Credentials obtained by the defendant's supplier for the products being imported
6	Ex.D.6	14.10.2020	Certifications and NPPA compliance relating to the defendant's product
7	Ex.D.7	16.08.2020 to 17.08.2020	Correspondences regarding enquiries for supply of gloves for distribution made by the defendant
8	Ex.D.8	13.07.2020 to 16.09.2020	Defendant's messages relating to logo selection and correspondence
9	Ex.D.9	Nil	Defendant's logos for the mark Doctor's Trust and Divine Touch
10	Ex.D.10	18.09.2020 to 01.12.2020	Sample invoices by the defendant for its medical devices
11	Ex.D.11	17.08.2021	Chartered Accountant Certificate for Annual Sales turnover and Sales Promotional Expenses for the financial years 2020-21 & 2021-22
12	Ex.D.12	20.05.2021 to 01.06.2021	Supply of medical devices for charitable causes
13	Ex.D.13	Nil	Extracts from internet regarding the plaintiff's products
14	Ex.D.14	Nil	Documents pertaining to the plaintiff extracted from the Ministry of Corporate Affairs
15	Ex.P15	12.03.2012 to 04.01.2021	Extracts of plaintiff's trademark registrations and applications
16	Ex.P16	11.03.1983 to 08.06.2021	Other proprietors as per the trademark registry under class 10

CSNJ



WEB COPY



C.S(COMM.DIV)No.19 of 2021

C.SARAVANAN, J.

kcd

Pre-delivery Judgment in
C.S(COMM.DIV)No.19 of 2021

24.02.2023