

\* IN THE HIGH COURT OF DELHI AT NEW DELHI

% *Judgment Reserved on: 27<sup>th</sup> February, 2023*  
*Judgment Delivered on: 23<sup>rd</sup> March, 2023*

+ **C.O. (COMM.IPD-TM) 497/2022**

LOREAL INDIA PVT. LTD.

..... Petitioner

Through: Mr. S.K. Bansal and Mr. Ajay  
Amitabh Suman, Advocates

versus

RAJESH KUMAR TANEJA TRADING  
AS INNOVATIVE DERMA CARE AND ANR ..... Respondents

Through: Mr. Pramod Kumar Singh and  
Ms. Priya Nagpal, Advocates for R-1.  
Mr. Harish Vaidyanathan Shankar,  
CGSC with Mr. Srish Kumar Mishra,  
Mr. Sagar Mehlawat and  
Mr. Alexander Mathai Paikaday,  
Advocates for R-2.

**CORAM:**  
**HON'BLE MR. JUSTICE AMIT BANSAL**

### **JUDGMENT**

1. The present cancellation petition has been filed on behalf of the petitioner seeking removal of impugned trademark 'CLARIWASH' registered under No.1950938 in Class 03 in the name of the respondent no.1 from the Register of Trademarks.

**CASE SET UP BY THE PETITIONER**

2. The case set up in the petition is as under:
  - 2.1. The petitioner is the registered proprietor of various trademarks with the word “Clari”, details of which are given in paragraph 4 of the petition. The petitioner is engaged in the business of manufacture and sale of a wide range of hair care, skin care, toiletries and beauty products.
  - 2.2. The “CLARIWASH” mark was adopted in 2010 by the petitioner and has been used along with the other “Clari” formative marks.
  - 2.3. The first of the “Clari” formative marks were adopted by a company by the name of Cheryl’s Cosmeceuticals Pvt. Ltd. [hereinafter “Cheryl’s Cosmeceuticals”] in 2009. The petitioner acquired Cheryl’s Cosmeceuticals in 2013 by way of a Deed of Assignment and Asset Transfer Agreement.
  - 2.4. By virtue of the said Deed of Assignment and Transfer Agreement, the reputation and goodwill related to various “Clari” formative marks stood transferred to the petitioner.
  - 2.5. The petitioner is the prior user of the “Clari” formative marks from the year 2009 on account of the user of his predecessor.
  - 2.6. The respondent no.1 applied for registration of the trademark “CLARIWASH” in Class 03 on 16<sup>th</sup> April, 2010 showing user from 16<sup>th</sup> November, 2009. However, the first invoice filed on behalf of the respondent no.1 is dated 10<sup>th</sup> May, 2010, which is after the registration of the “Clari” formative marks. On the other hand, the registration granted in favour of the petitioner in respect of trademark “CLARI-FI” is of 3<sup>rd</sup> February, 2010 with user from 1<sup>st</sup> April, 2009.

- 2.7. It is further submitted that the respondent no.1 cannot claim the benefit of concurrent user under Section 12 of the Trademarks Act as there was no use by the respondent no.1 at the time of the trademark application. The trademark application was filed on 16<sup>th</sup> April, 2010 and the earliest invoice filed on behalf of the respondents is of 10<sup>th</sup> May, 2010.
- 2.8. The Examination Report dated 3<sup>rd</sup> January, 2012 issued by the Registrar of Trade Marks wrongly notes the mark of the respondent no.1 as “CHARIWASH” instead of “CLARIWASH”. Based on the aforesaid Examination Report, the Certificate of Registration of Trade Mark was issued in favour of the respondent no.1 for the word mark “CHARIWASH”. However, subsequently, the Certificate was modified by the Registry to “CLARIWASH”.
- 2.9. The procedure adopted by the Registry in changing the Registration Certificate of word mark from “CHARIWASH” to “CLARIWASH” was an erroneous. Having discovered the error, the Registry should have proceeded for a fresh examination for the mark “CLARIWASH”. Reliance in this regard is placed on the orders of the Intellectual Property Appellate Board (IPAB) in *Vans Inc. USA v. Fateh Chand Bhansali and Anr.*, 2020 SCC OnLine IPAB 44 and *Prajapati Constructions Ltd. v. Manoj Ramanand Prajapati and Anr.*, 2018 SCC OnLine IPAB 313.

### **CASE SET UP BY THE RESPONDENT**

3. The case set up by the respondent no.1 is as under:

- 3.1. The respondent no.1 has filed a suit for infringement of the registered trademark “CLARIWASH” of the respondent no.1 against the petitioner, which is pending before the District Courts, Tis Hazari.
- 3.2. Even though the Examination Report was in respect of the mark “CHARIWASH”, the Trademark Journal correctly published the mark “CLARIWASH” and not “CHARIWASH”. In May, 2012, the Trademark Registry erroneously issued Trademark Registration Certificate for the word mark “CHARIWASH”. The respondent no.1 immediately filed an application to rectify the said clerical error and accordingly, the Trademark Registry rectified the error and issued a fresh Trademark Registration Certificate for the correct word mark “CLARIWASH”. Reliance is placed on the judgment of a Coordinate Bench in *Epsilon Publishing House Pvt. Ltd. v. Union of India and Ors.*, 2009 SCC OnLine Del 3922.
- 3.3. Though the petitioner claims adoption of the mark “CLARIWASH” in the year 2010, nothing has been filed in support of the same. Further, the petitioner has not filed any application for registration of the mark “CLARIWASH” till date.
- 3.4. Use of the mark “CLARIWASH” by the petitioner or its predecessor was only in the year 2013. Attention of the Court in this regard is drawn to the invoices filed on behalf petitioner.
- 3.5. The petitioner uses several other marks other than the “Clari” formative marks. Therefore, it cannot be said that “Clari” belongs to a family of marks.
- 3.6. The petitioner cannot claim any monopoly on a part of the trademark “Clari”. The fact that the petitioner has various marks registered with

the prefix “Clari” does not mean that the registration granted in favour of the respondent no.1 for the mark “CLARIWASH” is defective. There are a number of trademarks registered where the word “Clari” has been used as a prefix or suffix.

- 3.7. The petitioner was aware of the respondent’s use of the trademark “CLARIWASH”, yet never applied for its trademark registration.
4. Despite opportunity being granted, the respondent no.2 has not filed any reply/counter statement or written submissions in the present petition.

#### **ANALYSIS AND FINDINGS**

5. I have heard the counsels for the parties.
6. In the present case, it appears from the record that the Trademarks Registry erroneously issued the Examination Report for the mark “CHARIWASH” instead of “CLARIWASH”. Yet again, the Registry issued a Trademark Registration Certificate in favour of the respondent, wherein the mark of the respondent was wrongly shown as “CHARIWASH”. Immediately thereafter, an application was filed on behalf of the respondents on 14<sup>th</sup> June, 2012, requesting for rectification of the clerical error and the same was allowed by the Registry and a correct Trademark Registration Certificate was issued in favour of the respondent for the mark “CLARIWASH”. However, it is pertinent to note that the mark of the respondent no.1 was published correctly as “CLARIWASH” in the Trademark Journal No.1519 on 16<sup>th</sup> January, 2012. Therefore, it was open for the petitioner or its predecessor to oppose the said application, which they failed to do.

7. If the Registrar has committed an error and issued a faulty examination report, the respondent no.1 cannot be faulted for the same. It is not that the respondent no.1 had misrepresented or misled the trademark Registry into issuing a faulty examination report. The registration of a trademark entails valuable rights and the respondent no.1 cannot be deprived of the same on account of mistake committed by the Registry. Therefore, this by itself cannot be the ground for removal of the registration granted in favour of the respondent no.1.

8. In ***Epsilon Publishing*** (supra), a Coordinate Bench of this Court was seized of a petition challenging the order of the Registrar renewing the trademark granted in favour of the respondent therein. The ground taken by the petitioner was that since the respondent had not filed an application for renewal of the registration before its expiration and not paid the surcharge, the Registrar was required to remove the trademark from the Register. While noting that the Trade Marks Registry has not adhered to the statutory timelines, it was held that the respondent cannot be penalized for the same and would be entitled to pursue its renewal application. In the said case, the Registrar had admitted that the renewal application filed on behalf of the private respondent was not examined and therefore, could not be processed further. It was observed that the private respondent could not be deprived of its rights on account of the fault of the Registrar. The relevant observations of the court as set out in paragraph 26 are reproduced below:

***“26. There may be merit in the contention that the Registrar has to follow the procedure as prescribed; however, the essential question is not whether the Registrar has any discretion in the matter, but, what are the consequences of the Registrar not***

*following the established procedure? Plainly, in the facts of the present case, it is apparent that the Trademark Registry has not adhered to the timelines as required. Surely, respondent no.3 cannot be penalised for the same and would be entitled to pursue its application for renewal of its trademark. The same was filed well within the period of six months and even though the same was not accompanied by a fee of surcharge, nonetheless, respondent no.3 had the right to know the fate of its application. Since no deficiency was pointed out at the material time, respondent no.3 cannot be deprived of its valuable rights to cure the defects within the prescribed period. The Registrar also did not advertise the removal of the trademark as required under section 25(4) of the Act read with Rule 66 of the 2002 Rules. Such advertisement would have provided another opportunity for the petitioner to seek restoration of the trademark.”*

9. The dicta of the aforesaid judgment is squarely applicable to the present case. The respondent no.1 cannot be deprived of his valuable rights of registration on account of the error of the Registry.

10. Counsel for the petitioner has relied upon the orders passed by the IPAB in ***Prajapati Constructions*** (supra) and ***Vans Inc. USA*** (supra) in support of his submission that the Registrar of Trade Marks has to follow the statutory procedure prescribed under the Trade Marks Act, 1999 in respect of examination of a trade mark application. At the outset, it may be noted that both are interim orders passed by the IPAB and therefore, no reliance can be placed on the same in the present case, which is at the stage of final hearing. After noticing the various procedural lapses committed by the Trademark Registry, the IPAB only ordered that the respondent therein shall not rely upon the impugned registration in any proceedings during the pendency of the rectification proceedings. There was no order for removal

of the registration granted in favour of the respondent on account of lapses committed by the Registry.

11. Reliance has also been placed on the order passed by the IPAB in *Jahangir Biri Factory Pvt. Ltd. v. Mohd. Dildar Hossain (Proprietor) & Anr.*, 2018 (76) PTC 479 [IPAB]. In the aforesaid order, the marks of the petitioner and the respondent were identical, namely, “HOWRAH BIDI”. The respondent therein had merely added a number to the mark “HOWRAH BIDI”, which is not the position in the present case. Therefore, the said judgment does not further the case of the petitioner.

12. Counsel for the petitioner also submitted that the matter be remanded back to the Registry for reconsideration of the trademark application of the respondent no.1 from the stage of issuance of examination report. I am not inclined to remand back the matter as this would amount to cancellation of the registration already granted in favour of the respondent no.1 as far back as in 2012. Therefore, I proceed to consider the matter on merits, i.e., whether the registration in favour of the respondent no.1 was granted erroneously.

13. At the time when the respondent no.1 filed its application for registration of the mark “CLARIWASH” in 2010, there was one mark of the predecessor of the petitioner, “CLARI-FI”, that was registered in Class 03. All other marks of the petitioner with the term “Clari” have been registered subsequent to the registration of the respondent no.1. The petitioner acquired rights in the mark “CLARI-FI” in 2013, pursuant to the Asset Transfer Agreement dated 19<sup>th</sup> September, 2013. It is submitted on behalf of the petitioner that since the mark of the respondent no.1, “CLARIWASH” was

similar to the earlier registered trademark “CLARI-FI”, in respect of similar goods, the respondent no.1 should not have been granted registration in terms of Section 11 of the Trade Marks Act, 1999. In my considered view, there is no similarity in the marks “CLARI-FI” and “CLARIWASH” so as to cause a likelihood of confusion in the public or likelihood of association of “CLARIWASH” with “CLARI-FI”. It is a settled position of law that while comparing the marks, the marks have to be seen as a whole and cannot be broken into their individual components. Reference in this regard may be made to the judgment of the Supreme Court in *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, AIR 1960 SC 142. Therefore, “CLARIWASH” cannot be read as “CLARI” plus “WASH” and similarly, “CLARI-FI” cannot be read as “CLARI” plus “FI”. Taken as a whole, there is no similarity in the competing marks so as to cause confusion. Therefore, on the basis of registration of the mark “CLARI-FI”, the petitioner cannot seek cancellation of the trademark “CLARIWASH” registered in favour of the respondent no.1 in Class 03.

14. Under the Asset Transfer Agreement dated 19<sup>th</sup> September, 2013, the petitioner took over approximately 170 marks, both registered and pending registration, from Cheryl’s Cosmeceuticals. Only 12 out of the 170 marks use “Clari” as a part of the mark. Therefore, the petitioner cannot say that there was a family of marks with the term “Clari” as part of the marks that were registered in favour of the petitioner.

15. Counsel for the petitioner has contended that even though the user shown in the application filed by the respondent no.1 is 16<sup>th</sup> November, 2009, the first invoice placed on record is of 12<sup>th</sup> May, 2010. In my view,

this would not make any difference as registration can be granted on a 'proposed to be used' basis. Even if the first user of the respondent no.1 is taken to be 12<sup>th</sup> May, 2010, the user of the petitioner or its predecessor of the trademark "CLARIWASH" is after the said date. Nothing has been placed on record on behalf of the petitioner to show that the mark "CLARIWASH" was adopted in 2010 either by the petitioner or its predecessor. It was only on 22<sup>nd</sup> August, 2013 that a license was issued by the FDA, Maharashtra in favour of the predecessor of the petitioner, Cheryl's Cosmeceuticals. Even the first invoice placed on record by the petitioner that corresponds to the use of "CLARIWASH" is dated 5<sup>th</sup> December, 2013 and the sales figures in the petition have been given only from the year 2014. It is also relevant to note that the petitioner has not filed any application for registration of the mark "CLARIWASH" till date.

16. In light of the discussion above, no grounds for rectification are made out.

17. The petition is dismissed with no order as to costs.

**MARCH 23, 2023**

*at*

**AMIT BANSAL, J.**