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

Date of Decision: 22nd March, 2022

+ **CS (COMM) 129/2022 & I.As. 3107-08/2022**

MOTHER SPARSH BABY CARE PVT LTD Plaintiff

Through: Mr. Sandeep Sethi, Sr. Advocate with
Mr. Sagar Chandra, Ms. Surya
Rajappan, Advs. (M: 9873595315)

versus

AAYUSH GUPTA & ORS. Defendants

Through: Mr. Sadapuma Mukherjee & Mr.
Shivkrit Rai, Advocates for D-1 to 3
(M:9999707585)
Ms. Shweta Sahu, Advocate for D-5
(M:7738741586)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

I.A. 3107/2022 (for stay)

2. The Plaintiff has filed the present suit seeking permanent injunction, restraining infringement of trademark, passing off, dilution, unfair competition, delivery up, rendition of accounts, damages, and other reliefs in respect of the trademark 'PLANT POWERED'.

3. The case of the Plaintiff is that it was incorporated in the year 2016, and over the years, it has sold various baby care and personal care products which are natural and eco-friendly, including detergent, lotions, face wash, face cream, sunscreen face mask etc., under the trademark 'PLANT POWERED'. The trademark 'PLANT POWERED' was adopted by the

Plaintiff in the year 2019, and has been using the said trademark along with

two logos being  and . Trademark Application No.4363416 dated 30th November, 2019 was filed by the Plaintiff in Class 3, along with the label which was used by the Plaintiff. The said mark was registered. Apart from the said application, the Plaintiff has sought registrations by way of other applications in Class 5, which are currently objected to and are pending examination. The Plaintiff has also

sought registration of the device mark  ('PLANT POWERED').

4. The sales of the Plaintiff's products since the year 2019 is claimed to be Rs.5.95 crores, and the promotional expenses are claimed to be over Rs.4 crores. Various products of the Plaintiff have also been duly licenced under The Drugs and Cosmetics Act, 1940.

5. The grievance of the Plaintiff, in the present case, is that the Defendant No.1 – Mr. Aayush Gupta, who is also running two entities which are known by the names 'Plant Powered' and 'Bo International', applied for

the registration of the mark  (PLANT POWERED) with a

flower logo. The said application was filed on 29th December, 2020 in Class 3 on a 'proposed to be used' basis. The said mark proceeded for registration and the Plaintiff has now filed a rectification seeking cancellation of the said mark.

6. As per the Plaintiff, upon gaining knowledge of the said registration, the Plaintiff conducted a market survey and found a number of Defendant's products on the e-commerce platform *www.amazon.in* ("Amazon"). The details of the said products, along with product codes, and Amazon Standard Identification Number (ASIN) are also set out in the plaint.

7. Mr. Sethi, Id. Senior Counsel appearing for the Plaintiff has made the following submissions:

- i. A cease and desist notice was issued by the Plaintiff on 1st February, 2022. However, the Defendant did not respond to the same. Upon receiving the cease and desist notice, the Defendant wrote a complaint to Amazon, raising a grievance against the Plaintiff's products, which resulted in an email being sent to the Plaintiff on 8th February, 2022. Subsequent emails were also received from Amazon, and the Plaintiff's products were delisted from Amazon. Thus, the Defendant chose not to reply to the legal notice, but parallelly, took action against the Plaintiff which had addressed the legal notice to the Defendant. He submits that this shows the *mala fide* and dishonest nature of the Defendant's conduct.
- ii. The Defendant is also using the name 'PLANT POWERED' as a trading style for identical goods. The domain name *www.plantpowered.in* has also been registered on 9th October,

2021. In view of the dates on which the trademark applications were filed and the domain name was registered, it is submitted that the Plaintiff is the prior user and adopter of the mark in respect of identical products.

- iii. It is also brought to the notice of this Court that the invoices which have been placed on record by the Defendant to plead user in the year 2020 are also completely manipulated and fabricated inasmuch as the corresponding e-way bills, which can be downloaded from the GST portal, would show that the mark 'PLANT POWERED' is not reflected in the corresponding e-way bill. Thus, it is submitted that strict action is liable to be taken against the Defendant for filing such manipulated and forged documents.
- iv. The website of the Defendant i.e., *www.plantpowered.in*, as on 21st February, 2022, merely mentioned 'Opening Soon'. On the website *www.boessentialoil.com* as well, there was no reflection of any product by the name 'PLANT POWERED'.

8. On the other hand, Ms. Mukherjee, Id. Counsel on behalf of the Defendant, makes the following submissions:

- i. The term 'PLANT POWERED' is a descriptive mark and there can be no monopoly over the same. There is no similarity between the Plaintiff's products and the Defendants' products. The products are clearly distinguishable as the house mark 'MOTHER SPARSH' is used by the Plaintiff for its products. Reliance is placed upon the judgments in *Marico Limited v. Agro Tech*

- Foods Limited [174 (2010) DLT 279], Intex Technologies v. Micromax AZ Tech (India) & Anr. [2017 SCC OnLine Del 7392]* as also *ITC Ltd. & Ors. v. Britannia Industries Ltd. [2021 SCC OnLine Del 1489]* to argue that once there is a house mark which a distinguishing factor between the two parties, if the Defendant adds the name ‘Bo International’ or ‘Bio International’ as a prefix to their mark, it would be sufficient to distinguish the Defendant’s products from the Plaintiff’s products. She further submits that her client is willing to incorporate a hyphen between the word ‘PLANT’ and ‘POWERED’ so that the same is clearly distinguishable from the Plaintiff’s products.
- ii. The gap between the adoption of the mark by the Plaintiff and the Defendant is not too long. The Defendant having spent huge amounts of money for promoting the products, the Defendant should be permitted to use the mark ‘PLANT POWERED’ along with the logo ‘Bio International’ or ‘Bo International’. In this background, she submits that some distinguishable features can be added which could distinguish the Defendant’s products with Plaintiff’s products.
 - iii. She seeks to clarify and explain the discrepancy between the e-way bills and the invoice by submitting that the ‘PLANT POWERED’ name cannot be manually incorporated into the e-way bill.
9. Heard Id. Counsels for the parties. The question, in the present case, relates to the use of the word and the mark ‘PLANT POWERED’. Upon a perusal of the documents placed on record, *prima facie*, this Court is

convinced that the Plaintiff is the prior adopter and the user of the said mark since the year 2019. The earliest document placed on record by the Defendant is one of December, 2020, when the trademark application was filed by the Defendant.

10. It is further noticed that the product of the Defendant is not described with any prefix on the website of Amazon. In fact, it is described as 'PLANT POWERED'. Thus, it is clear that the mark 'PLANT POWERED' is being used as a trademark and not as a description of the products. Moreover, the fact that the Defendant itself applied for the trademark application and registration of the mark 'PLANT POWERED' means that they are estopped from claiming that the same is the description of the product. This is the settled legal position as per the judgement of this Court in *Automatic Electric Limited v. R. K. Dhawan & Ors.* [77 (1999) DLT 292]. The relevant observations from the said judgment read as under:

"16. The defendants got their trade mark "DIMMER DOT" registered in Australia. The fact that the defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT", it does not lie in their mouth to say that the word "DIMMER" is a generic expression. User of the word "DIMMER" by others cannot be a defense available to the defendants, if it could be shown that the same is being used in violation of the statutory right of the plaintiff. In this connection, reference may be made to the decision of this Court in Prakash Road line Ltd. Vs. Prakash Parcel Service (P) Ltd.; reported in 1992(2) Arbitration Law Reporter page 174. Reference may also be made to the decision in P.M. Diesels Ltd. Vs. S.M. Diesels; reported in MANU/DE/0636/1994 : AIR1994Delhi264 . It was held in those decision that if the plaintiff is a proprietor of the registered trade mark, the same gives to the proprietor of the registered trade mark the exclusive

right to use the trade mark with relation to goods in respect of which the trade mark is registered under the provisions of Section 28 of the Trade and Merchandise Marks Act. It was also held that such statutory right cannot be lost merely on the question of principles of delay, laches or acquiescence. It was also held that in general mere delay after knowledge of infringement does not deprive the registered proprietor of a trade mark of his statutory rights or of the appropriate remedy for the enforcement of those rights so long as the said delay is not an inordinate delay. In my considered opinion, the ratio of the aforesaid decisions are squarely applicable to the facts of the present case."

11. Similar is the view taken in ***Procter & Gamble Manufacturing (Tianjin) Co. Ltd. and Ors. v. Anchor Health & Beauty Care Pvt. Ltd. [211 (2014) DLT 466]***, wherein it was held as under:

"(xviii) As far as the argument, of the respondent/plaintiff not using the registered trade mark "ALLROUND" owing to having suffixed it with the word "PROTECTION" is concerned, again, the appellants/defendants in the US, obtained registration of the mark "ALL-AROUND PROTECTION" disclaiming the word "PROTECTION". The same is indicative of the appellants/defendants admitted that use of the word "PROTECTION" as a suffix to the use of the registered mark "ALL-AROUND" not negating the use of the trade mark. The same reasoning, of approbate and reprobate, applied by the learned Single Judge, in our opinion, would apply to this aspect as well.

(xix) As far as the contention, of Automatic Electric Ltd. (supra) having stood overruled by Marico Limited (supra) is concerned, we have perused Indian Hotels Company Ltd. (supra) and are unable to agree that the reference therein to Automatic Electric Ltd. is without affirming the same. It was the contention in Indian Hotels Company Ltd. also that the word "JIVA" therein

was a descriptive word which could not be protected as a trade mark. The Division Bench however negated the said argument by holding that the appellant therein having itself applied for registration of "JIVA" as a trade mark, could not argue that the mark was descriptive. Reference to Automatic Electric Ltd. was made in support of the said reasoning. Unfortunately, neither Automatic Electric Ltd. nor Indian Hotels Company Ltd. were noticed in the subsequent judgment of the Division Bench in Marico Limited. We, at this interim stage are inclined to go along with the affirmation by the Division Bench in Indian Hotels Company Ltd. with the view in Automatic Electric Ltd."

12. The sales of the Plaintiff have been sworn on affidavit and have been placed on record. On the other hand, due to the various discrepancies in the invoices which have been highlighted by the Plaintiff, the sales of the Defendant are not clear at this stage. It appears that there is also some manipulation of the e-way bill and tax invoice which has been placed on record. On the one hand, the tax invoices claim that the products sold are of 'PLANT POWERED', whereas in the e-way bill, there is no mention of the mark 'PLANT POWERED'.

13. The words 'PLANT' and 'POWER' by themselves, when considered as standalone words, may be descriptive. However, when used in conjunction with each other for identical products, there is likely to be confusion between the Plaintiff's products and Defendant's products, as is clear from the invoices which are placed on record by the Id. Counsel for the Defendant even today.

14. In this regard, the observations of the Supreme Court in ***Godfrey Philips India Ltd. v. Girnar Food and Beverages Pvt. Ltd. [(2004) 5 SCC 257]*** are relevant. The said observations reads as under:

*“4. Without going into the question whether the conclusion arrived at by the Division Bench that the trade mark is descriptive is correct or not, it appears to us, and as is conceded by both parties before us, that the enunciation of principle of law with regard to the protection available even in respect of the descriptive trade mark was wrong. **A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source.** We, therefore, remand the matter back to the Division Bench of the High Court so that it may address its mind to this question without disturbing the other conclusions arrived at this stage. In the event, the Division Bench answers the additional issue formulated by us against the appellant, it will be open to the appellant to raise all the issues which have already been concluded and which are the subject matter of this appeal in any further appeal as it may be entitled to prefer from the final decision of the Division Bench. The Division Bench is directed to dispose of the appeal as expeditiously as is conveniently possible. It is made clear that the trial of the suit may also be proceeded with and concluded expeditiously without being inhibited either by the pendency of the appeal or by any observation in the orders of the High Court on the interlocutory application.”*

15. This principle of law has been reiterated by the Bombay High Court in *Sky Enterprise Private Ltd. v. Abaad Masala & Co. [2020 (5) ABR 500]* wherein it was observed as under:

“8. It is not in dispute that the Plaintiff not only has trademark registrations both for the device and word marks using the words 'Star Zing', such as 'Star Zing White Chinese Pepper Masala' and 'Star Zing Black Chinese Pepper Masala', but even for the word marks 'White Chinese Pepper Masala' and 'Black Chinese Pepper Masala' themselves, as separate and distinct registrations, and as of the date of this interim

application, these registrations are very much valid and subsisting. If that is so, the Plaintiff is *prima facie* entitled to an interim injunction restraining the world at large from using these trademarks in connection with similar goods, unless the registration of these trademarks by the Plaintiffs can be shown to be demonstrably or *ex facie* illegal or fraudulent or shocking to the conscience of the Court. As noted by our Full Bench in *Lupin Limited (Supra)*, the object of providing for registration of a trademark is to obviate the difficulty in proving in each and every case the plaintiff's title to the trademark; this object is achieved by raising a strong presumption in law as to the validity of the registration and conversely, by casting a heavy burden on the defendant to question such validity or rebut such presumption at the interlocutory stage. It is not sufficient for the Defendant in such a case to show that he has an arguable case in support of invalidity of the registration. Even *prima facie* satisfaction of the Court for stay of a trial under Section 124 of the Act is not enough to refuse such injunction. There is only a small window for opposing grant of such injunction, in the form of three exceptional circumstances, as noted by the Full Bench in *Lupin Limited (Supra)*, namely, (i) *ex facie* illegality of registration, or (ii) fraudulent registration or (iii) registration that would shock the conscience of the Court. It is only through this small window that the Defendant can successfully defend his use of the infringing word/s. All that is alleged in support of such plea in the present case is that the marks consist of descriptive words. In the first place, it is not in any and every case, where the words forming part of a trademark are descriptive, that the applicant for registration is not entitled to it. Individual words in a given case may be descriptive, but their peculiar combination may yet create a unique appearance or identity. Secondly, by virtue of a long history of trading, it is quite possible that the mark, though it contains descriptive words, may have come to acquire a distinctive reputation and association with the

Plaintiff's product alone and with no others. In all these cases, it is perfectly legitimate to obtain a registration and prevent use of identical or deceptively similar marks by others, in spite of the descriptive words forming part of the Plaintiff's trademark. Indeed, as the Supreme Court has observed in Godfrey Philips India Ltd. vs. Girnar Food and Beverages Pvt. Ltd. MANU/SC/0541/2004, a descriptive trademark may well be entitled to protection, if it has come to assume a secondary meaning, which identifies a particular product or products as coming from a particular source.

9. In the Plaintiff's case here, each individual word forming part of its registered trademark may well be a descriptive word; it may not be possible to claim any proprietary right over it; but no rival trader can use the particular combination and order in which the Plaintiff uses these words in its registered trademark to distinguish its goods, if the particular combination or order is not generally used in the trade for describing the character or quality of goods. A rival trader, for example, in the present case, may describe his product as 'pepper masala'; he may describe it as 'Chinese masala', he may even call it 'black masala', if that is the colour of its product; he may even write on the label that the product is a black masala made of pepper and is for Chinese cookery. But he surely cannot describe his goods as 'White Chinese Pepper Masala' or 'Black Chinese Pepper Masala', using the very same combination and order of words, which form the registered trademarks of the Plaintiff. Secondly, the Plaintiff has an arguable claim to registration of these trademarks, though they may be in a broad sense descriptive, on the footing that through their extensive use as trademarks for sale and promotion of its goods, the trademarks have come to acquire a distinctive reputation and association with its goods and no others. There is even material in the plaint to indicate that. The Plaintiff had initially registered its trademarks 'Star Zing White Chinese Pepper Masala' and 'Star Zing Black

Chinese Pepper Masala' as far back as in 2012. Between the years 2012-2013 and 2015-2016, the Plaintiff's goods under the trademarks 'Star Zing White Chinese Pepper Masala' and 'Star Zing Black Chinese Pepper Masala' were extensively sold in the market, the sales rising progressively and exponentially and finally reaching to the tune of over Rs. 12.38 crores in the year 2015-2016 for 'Star Zing White Chinese Pepper Masala' and in the same year, of over Rs. 4.40 crores for 'Star Zing Black Chinese Pepper Masala'. It is possible to say that by that year, the words 'White Chinese Pepper Masala' and 'Black Chinese Pepper Masala' themselves had obtained a secondary meaning and association with the Plaintiff's goods and with no others. In fact, presumably in the light of this circumstance, in the year 2015-2016, the Plaintiff appears to have made an application for registration of word marks 'White Chinese Pepper Masala' and 'Black Chinese Pepper Masala' as separate word marks citing their user since 2012, and indeed, on that basis, even obtained registration from the Trademarks Registry. If that is so, it is permissible to term the words, in their peculiar combination and order, as distinctive, that is to say, as having acquired a secondary meaning and seek their registration as trademarks. Prima facie it is not possible to claim such registration as either ex facie illegal or fraudulent or shocking to the conscience of the Court."

16. Similar is the view taken by the Id. Single Judge of this Court in ***Natures Essence Private Limited v. Protogreen Retail Solutions Private Limited and Ors. [2021 (86) PTC 225 (Del)]***. The relevant paragraphs are extracted below:

"46.8. The contention, of Mr. Sharma, that the plaintiff cannot claim any trademark rights over the word "Nature", as it is descriptive in nature, is neither here nor there. In the first place, the plaintiffs trademark, of which it alleges infringement, is not "NATURE" per se, but "NATURE'S INC." or "NATURE'S ESSENCE". As I

have already held hereinbefore, the defendant's mark is, visually and phonetically, deceptively similar to the plaintiff's "NATURE'S INC." mark, and conveys a deceptively similar idea to that conveyed by "NATURE'S ESSENCE", as has the potential of confusing a customer of average intelligence and imperfect recollection. Whether an intellectual property monopoly can be claimed in respect of the word "NATURE" is, therefore, really off the mark. It would be totally antithetical to all canons of trademark jurisprudence to question the validity of the or marks because Nature is a descriptive word. Once "Nature's" is used in conjunction with "Inc.", or "Essence", it assumes a definite and distinct-as well as distinctive-connotation and meaning, which is totally different from "Nature" per se. Even if "Inc." were to be treated as an acronym for Incorporated, the mark has a distinctive identity all its own, immediately apparent to the naked eye. Once, therefore, deceptive similarity is established, violation of the proprietary right, of the plaintiff, over the or trademark, stands made out. Infringement being in the nature of a violation of the proprietary right of the owner of a registered trade mark, a case of infringement stands, thereby, prima facie established."

17. Similarly in *Living Media India Limited v. Jitender V. Jain & Ors.* [98 (2002) DLT 430], a ld. Single Judge of this Court has observed as under:

"25. The word trade mark has been defined as a registered trade mark or a mark used in relation to goods for the purpose of indicating so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark. If any mark is used in relation to goods for the purpose of indicating or so as to indicate and some person having the right as proprietor it is a trade mark which becomes the property of its prior user even if it happens to be descriptive in nature but has been coined by it.

26. The mark is always used for the purpose of indicating either a connection in the course of trade between the goods and it is the prior user which provides the right of protection. Thus even if the adjective "Khabrein" is pre-fixed it does not make the trade mark "Khabrein Aaj Tak" distinct or different from the mark "AAJ TAK".

27. The word "AAJ TAK" itself is no distinctive that it has acquired such a meaning that any pre-fix or suffix would be of no relevance so far as the action of passing off is concerned. The only object and design of the defendant to adopt the word "AAJ TAK" was to trade and encash upon the goodwill of the plaintiff earned over the years through the advertisements and because of its extensive popularity. The mark "AAJ TAK" has become synonymous with the plaintiff so far as the news channel is concerned.

28. The word "AAJ" and "TAK" may be individually descriptive and dictionary word and may not be monopolised by any person but their combination does provide a protection as a trademark if it has been in long, prior and continuous user in relation to particular goods manufactured, sold by a particular person and by virtue of such user the mark gets identified with that person. It is so irrespective of the fact whether such a combination is descriptive in nature and has even a dictionary meaning. In such a case any other person may choose any of the two words viz. either "AAJ" or "TAK" as its trade name or mark but it has to be prohibited from using the combination of these words as such a user not only creates confusion as to its source or origin but also bares the design or motive of its subsequent adopter.

29. Any kind of prefix or suffix would not make any difference so far as the trade name or for that purpose the domain name "AAJ TAK" is concerned. It is immaterial whether the defendant has no clientele or publication in Delhi. Channel "AAJ TAK" is a National Channel. It has widespread reputation and goodwill. Adoption of similar or deceptively similar mark amounts to passing off even if it has no local physical market, goodwill or reputation of a product or person is all

pervasive. It is not confined in the four walls or to a particular territory. It has to be protected wherever it is threatened or is sought to be eroded or exploited. Merely because the product or mark adopted by a rival has no circulation or sale in the territory of the plaintiff's mark or product is no defense against protection of the mark. Protection of mark is in actuality protection of reputation and goodwill. At every cost the reputation has to be protected and preserved."

18. In the opinion of this Court, both parties are selling the same kind of products. The mark of the Plaintiff is used prominently on its products. The Plaintiff is clearly the prior adopter and user of the mark. The Defendant's conduct is far from *bona fide* as the user documents of 2020 filed by the Defendant do not inspire confidence at this stage. The Defendant not only uses the mark 'PLANT POWERED' as a mark but also as a trading style. When a search is conducted for a product of this nature on any e-commerce platform, it is normal for a user to type the words 'PLANT POWERED' in order to search for the product. If such a search is carried out, it would automatically throw up the results with the Plaintiff's and Defendant's product, which ought to be avoided.

19. In light of the facts and circumstances of the present case, the *ex parte* injunction granted on 24th February, 2022 is confirmed. The Defendant shall stand enjoined during the pendency of the present suit, from using the mark 'PLANT POWERED' conjunctively in relation to baby care or personal care products or any other goods falling under Classes 3 and 5, including but not limited to, face wash, face cream, shampoo, etc., and/or such allied and cognate goods. This would, however, not preclude the Defendant from using the word 'PLANT' and 'POWER' separately in a manner, so as to not cause

any deception and confusion to the consumers, with the Plaintiff's mark 'PLANT POWERED'.

20. As is evident from the packaging of the Defendant's products, the products are shown to be marketed by 'PLANT POWERED'. Thus, henceforth, the Defendant shall also not use the trading style 'PLANT POWERED' as an entity. The domain name 'plantpowered.in' shall also stand injuncted during the pendency of the present suit.

21. Insofar as discrepancy between the e-way bills and tax invoices, as elaborated above, is concerned, the Plaintiff is permitted to move an application seeking appropriate reliefs against the Defendant in this regard.

22. ***I.A. 3107/2022*** is disposed of, in the above terms.

I.A. 3108/2022

23. This is an application filed by the Plaintiff seeking appointment of Local Commissioner. Application is not pressed at this stage.

24. ***I.A. 3108/2022*** is disposed of.

CS(COMM)-129/2022

25. Written statements be filed in accordance with the timelines of the Commercial Courts Act, 2015, along with documents. Replication be also filed.

26. List before the Registrar for completion of pleadings and marking of exhibits, on 28th April, 2022.

**PRATHIBA M. SINGH
JUDGE**

MARCH 22, 2022

dj/ad

(Corrected and released on 30th March, 2022)