

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION NO. 245 OF 2025
IN
COMMERCIAL IP SUIT (LODGING) NO. 32628 OF 2024

Hygienic Research Institute Private Limited ...Applicant

IN THE MATTER BETWEEN:

Hygienic Research Institute Private Limited ...Plaintiff

Versus

Chandan and Shah Trading LLP & Anr. ...Defendants

- Mr. Hiren Kamod a/w Mr. Ramesh Gajria, Ms. Deepa Hate and Mr. Prem Khullar i/b Gajria & Co. for Applicant/Plaintiff
- Mr. Ashish Kamat, Senior Counsel a/w Mr. Rashmin Khandekar and Mr. Pranshul Dube i/b Haseena Khan for Defendants.

CORAM : MANISH PITALE, J.

RESERVED ON : 13th FEBRUARY, 2025

PRONOUNCED ON : 05th MARCH, 2025

ORDER

1. In these proceedings, the applicant / plaintiff is asserting its proprietary rights in the registered trademark "STREAX." The plaintiff uses the said registered trademark in connection with its products pertaining to cosmetics, hair care preparations, hair dyes, hair colours, hair oil, hair lotions, shampoos, skin care products, sanitary preparations etc. The plaintiff claims that the defendants have infringed upon its registered trademark by using the



mark . The plaintiff also claims that the defendants are

indulging in passing off their products as those of the plaintiff by using the aforesaid impugned trademark.

2. The plaintiff claims that the leading and essential feature of the impugned mark i.e. the word “STREAK” is identical / deceptively similar to the registered trademark “STREAX.” Since the defendant No.1 partnership firm, of which defendant No.2 is a partner, is also in the business of hair care products, including hair extensions and curly hair extensions, according to the plaintiff, there is every likelihood of confusion in the minds of the consumers. This not only dilutes the registered trademark of the plaintiff, but it also adversely affects the huge amount of goodwill earned by the plaintiff over a period of time.

3. As per pleadings placed on record, the plaintiff originally was a proprietorship firm, which started business in or about the year 1950. Later, it was converted into a partnership firm. The constitution of the partnership firm underwent changes over a period of time. Subsequently, the partnership firm was converted into a joint stock company and on 10th June, 2008, it was incorporated as a company limited by shares under the provisions of the Companies Act, 1956, known as Hygienic Research Institute Private Limited. According to the plaintiff, over a period of 70 years spent in research and innovation, has led to huge presence of the products of the plaintiff in the

premium beauty products segment. The plaintiff has five production locations in Mumbai, Himachal Pradesh and Guwahati.

4. The pleadings on record show that the trademark “STREAX” was conceived and adopted by the predecessor of the plaintiff on or about 01st April, 2002, and on 01st July, 2002, an application was filed for registration of the said trademark in class 3, pertaining to cosmetics and other goods. Registration was granted by the Trade Marks Registry. In paragraph No.7 of the plaint, the plaintiff has given details of its applications for registration of trademarks in various classes, which show that the plaintiff has registration for its trademark “STREAX”, as also few label marks in various classes totaling to 44 such registrations. Copies of the relevant certificates are also placed on record with the plaint. Reference is made to applications for registration for some variants of the mark “STREAX” such as “STREAX PRO”, “STREAX PROFESSIONAL” etc. It is specifically brought to the notice of this Court that the plaintiff also has registrations in various international jurisdictions and further that the District Court of Central Jakarta, Indonesia, has even held the plaintiff's mark “STREAX” as a well-known trademark. Translated copy of the said order is placed on record with the plaint.

5. The plaintiff has stated that its products bearing the said registered trademark “STREAX” are available on various e-commerce websites

such as Amazon, Nykaa, Flipkart etc. and that its products are popular throughout India and also in some foreign countries where the same are exported.

6. The details of the annual sales turnover from the year 2004-05 to the year 2023-24 are given with supporting certificates issued by Chartered Accountants. The annual sales turnover figure for goods bearing the mark “STREAX” pertaining to the year 2023-24 is stated to be about ₹ 501 Crores. The advertising and publicity figures for the year 2023-24 are stated to be about ₹ 50 Crores. The plaintiff has also placed on record details as to the manner in which it has been advertising its products over a period of time.

7. It is stated that around March, 2022, the plaintiff came across an advertisement in the Trade Marks Journal dated 20th December, 2021, with regard to the defendants’ mark. The plaintiff further found that the defendant No.1 had applied on 12th October, 2019, for registration of its mark



, under class 3 on proposed to be used basis. The plaintiff has further stated details of other such applications found on the website of the Trade Marks Registry, revealing that five applications were filed between October, 2019 to December, 2022 in classes 3, 26, 35 and 42, of which one application preferred on 30th July, 2021, was withdrawn, while all the other

applications were opposed or objected to. The plaintiff has also given details as to the manner in which the defendants were advertising their products on Instagram page and on their website.

8. In this backdrop, the plaintiff issued two cease and desist notices dated 18th November, 2022, to the defendants. In response, the defendants sent letters dated 13th December, 2022, through their advocates claiming that their mark had no resemblance to the registered trademark of the plaintiff and that they had been using the trademark for the past five years, due to which the goodwill concerning the said mark had considerably grown and there was no question of changing the impugned mark. Thereupon, the plaintiff has referred to certain orders passed by this Court in its favour, indicating the fact that the plaintiff has been vigilant in protecting its proprietary rights in the registered trademark “STREAX.” The plaintiff has then pleaded why it claims that the impugned trademark of the defendants is infringing upon its registered trademark and how the impugned products of the defendants are sought to be passed off as those of the plaintiff.

9. The plaintiff moved the present application seeking interim reliefs in respect of infringement and the action of passing off against the defendants. The defendant No.1 filed affidavit-in-reply opposing the interim reliefs. The defence as pleaded in the affidavit-in-reply of defendant No.1

pertained to the word “STREAK” being used in a descriptive sense. It was claimed that “STREAK” in general parlance pertains to streaks of hair that may be coloured in different colours. It was further pleaded that the mark of the defendants is “STREAK Street”, which is completely different from the registered trademark “STREAX” of the plaintiff, further pleading that the entire getup and logos of the rival marks being completely different, there is no question of confusion in the minds of the consumers. It was further claimed that the defendants mark “STREAK Street” had gained immense goodwill, reputation and popularity amongst the consumers, thereby indicating that no case was made out by the plaintiff for granting interim reliefs. The defendant No.2 adopted the affidavit in reply filed on behalf of defendant No.1.

10. The plaintiff filed rejoinder affidavit and the defendant No.1 filed sur rejoinder affidavit to complete the pleadings.

11. The interim application was taken up for hearing. The learned counsel for the rival parties made their submissions and relied upon various judgments in support of their respective contentions.

12. Mr. Hiren Kamod, learned counsel appearing for the applicant / plaintiff submitted as follows :

(A) That the trademark “STREAX” of the plaintiff was first

registered way back in the year 2002 and that it was registered as a word mark, being openly extensively and commercially used by the plaintiff from the year 2002 onwards. The sales turnover figures placed on record show the extent of goodwill earned by the plaintiff in the context of the said registered trademark. The total sales turnover for the period of 20 years between 2004 to 2024 was more than ₹ 2,777 Crores, with the sales turnover for the year 2023-24 alone being more than ₹ 500 Crores. Reference was made to the order passed by the District Court of Central Jakarta, Indonesia on 13th June, 2016, declaring “STREAX” as a well-known trademark in Indonesia. On this basis, it was submitted that the plaintiff had used the said registered trademark and earned sufficient goodwill in that context, thereby being entitled to assert its proprietary rights.

- (B) On this basis, it was submitted that when the defendants entered the industry pertaining to hair products in the year 2018, the plaintiff was already highly well established and the defendants cannot claim that they were unaware about the registered trademark of the plaintiff “STREAX”

dominating the industry of hair products. Reference was made to the five applications for registration of trademarks of the defendant No.1 i.e. under classes 3, 26, 35 and 42, between October, 2019 to December, 2022. It was submitted that in these applications, the defendant No.1 claimed user from the year 2018. But, the dishonesty of defendant No.1 becomes obvious from the fact that while in the application for the impugned trademark filed on 30th July, 2021, it was stated that it was proposed to be used, but, after withdrawing the said application and while filing a fresh application for the same impugned trademark in the very same class i.e. class 26 on 10th December, 2022, the defendant No.1 claimed user since 08th January, 2018. This was after the plaintiff had filed notice of opposition dated 13th January, 2022, to the application dated 12th October, 2019, filed on behalf of defendant No.1 on proposed to be used basis, thereby showing the dishonest conduct of the defendants.

- (C) It was submitted that the defences taken by the defendants before this Court can be said to be in two parts. The first part pertains to the grounds taken in the reply affidavits

while the second part are submissions made orally for the first time, without any basis in the pleadings i.e. the reply affidavits and sur-rejoinder filed on behalf of the defendants. It was specifically submitted that the contentions raised on behalf of the defendants without any basis in their pleadings ought not to be considered by this Court. Reliance was placed on judgment of the Delhi High Court in **PEPS Industries Private Limited Vs. Kurlon Limited**¹. Without prejudice to the said contention, the learned counsel for the plaintiff made submissions in respect of all the defences raised on behalf of the defendants.

- (D) It was submitted that the defendants are not justified in claiming that the word “STREAK” is descriptive. It was submitted that the defendants are not justified in claiming that the word “STREAK” has only one obvious meaning i.e. a coloured strand of hair. In this regard, it was submitted that the word “STREAK” has several meanings in English vocabulary and it cannot be said to be necessarily descriptive in nature. It was emphasized that the defendants are using their trademark “STREAK

1 2022 SCC OnLine Del 3275

Street”, in respect of the gels, brushes and combs, thereby indicating that in the context of the said products, the mark is not being used by the defendants in a descriptive manner.

- (E) It was further submitted that at worst, the word “STREAK” could be said to be suggestive in nature, but, certainly not descriptive. On this basis, it was submitted that such suggestive trademarks can be said to be inherently distinctive. In any case, it was submitted that since the plaintiff has registration for its trademarks, including the word mark “STREAX” from the year 2002 onwards, the stand taken by the defendants cannot be a matter for defence in such an infringement action. Reliance was placed on judgment of this Court in the case of **Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited**², to contend that the defendants in the present case were using their mark “STREAK Street” as a trademark and not in a descriptive sense, which was also evident from the fact that they themselves had applied for registration of their trademark.

It was submitted that once the defendants are found to be

2 2014 SCC OnLine Bom 50

using the mark as a trademark, they cannot raise a defence that the registered trademark of the plaintiff is a descriptive term or mark.

- (F) It was further submitted that the defendants cannot blow hot and cold at the same time, for the reason that while they are contending that the registered trademark “STREAX” of the plaintiff is descriptive and inherently a “weak” mark, they themselves have applied for registration of their own mark, of which the leading and essential feature is the word “STREAK.” Reliance placed on behalf of the defendants on judgment of this Court in the case of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors.**³ was stated to be misplaced, for the reason that in the said case the plaintiff itself conceded that the word “Shaadi” in the mark shaadi.com was not inherently distinctive. Reliance placed on judgment of this Court in the case of **ARG Outlier Media Pvt. Ltd. Vs. Rayadu Vision Media Ltd.**⁴ was also claimed to be misplaced, for the reason that in the said case also the plaintiff had conceded that it was neither asserting monopoly over the alphabet “R” per se

3 2016 SCC OnLine Bom 7351

4 2023 SCC OnLine Bom 1825

nor in the red and white combination per se. Such is not the case in the present matter.

- (G) The defendants are not placing their case on a higher pedestal by relying upon full bench judgment of this Court in the case of **Lupin Ltd. Vs. Johnson and Johnson**⁵, to claim that the trademark of the plaintiff was inherently non-registrable or that registration of the mark would shock the conscience of this Court. Once the said position is conceded, the plaintiff is entitled to full statutory protection for registration of its trademark. Before adopting the impugned trademark, of which the leading and essential feature is the word “STREAK”, the defendants ought to have taken sufficient care and proper enquiries ought to have been made to find out as to whether any similar mark is already on the register of the Registry of Trade Marks. Having failed to do so, the defendants took a risk and now they cannot resist the reliefs sought by the plaintiff in this application. Reliance was placed on judgment of this Court in the case of **Bal Pharma Ltd. Vs. Centaur Laboratories Ltd.**⁶

5 2015 (1) Mh.L.J. 501

6 2001 SCC OnLine Bom. 1176

(H) It was submitted that the defendants have raised defence with regard to the alleged weak nature of registration of the trademark of the plaintiff and that the plaintiff is allegedly trying to use a misspelling of the word “STREAK,” without raising any such points in their reply affidavits. Therefore, this Court ought not to consider the said contentions. Yet, the plaintiff can demonstrate that even the said defences raised by the defendants are unsustainable. In this regard, it was submitted that reliance placed on behalf of the defendants on the judgment of a learned Single Judge of this Court in the case of **Indchemie Health Specialties Pvt. Ltd. vs. Intas Pharmaceuticals and others**⁷, is misplaced because the said judgment was set aside by the Division Bench of this Court. As per settled law, in terms of judgment of this Court in the case of **Lufeng Shipping Company Ltd. Vs. M.V. Rainbow Ace and Anr.**⁸, once a judgment is set aside, it is as though it never existed. It was further submitted that the other judgments from International Jurisdictions relied upon by the defendants are also of no consequence, simply for the reason that the

7 2017 SCC OnLine Bom 10127

8 2013 SCC OnLine Bom 733

case of misspelling sought to be raised on behalf of the defendants is entirely misplaced in the facts and circumstances of the present case.

(I) It was further submitted that the contention with regard to the examination report issued by the Registrar of Trade Marks in respect of the plaintiff's trademark "STREAX", is also based on certain documents tendered across the bar without any reference to them in the reply affidavits and su-rejoinder of the defendants. Even if the said documents are to be considered, enquiries made with the Trade Mark Registry revealed that the response of the plaintiff to the examination report is not available even in the record of the Trade Marks Registry. A written reply dated 05th February, 2025, from the Trade Marks Registry confirms the said fact. In such a situation, it was submitted that the contention pertaining to prosecution history estoppel sought to be raised on behalf of the defendants is also highly misplaced.

(J) It was submitted that throughout the pleadings the defendants have referred to their trademark as "STREAK Street" with no reference to the phrase "quirk up your

hair”, although in the applications filed before the Trade Marks Registry, the said phrase has been shown at the bottom of the words “STREAK Street.” Reliance is placed on judgment in the case of **Ruston & Hornsby Ltd. Vs. Zamindara Engineering Co.**⁹, to contend that merely by adding the word “Street” to the word “STREAK”, the defendants cannot claim that their mark is distinguishable from that of the plaintiff. It is submitted that the leading, essential and central feature of the trademark of the defendants is the word “STREAK”, which is deceptively similar to the registered word mark of the plaintiff “STREAX.”

- (K) Reliance is placed on judgment of this Court in the case of **Jagdish Gopal Kamath and Ors vs. Lime and Chilli Hospitality Services**¹⁰, to contend that a word mark gets absolute protection. It is submitted that the registered word mark of the plaintiff is “STREAX” and the central feature of the trademark of the defendants is the word “STREAK” and a comparison of the two shows that the defendants have dishonestly adopted the impugned

9 (1969) 2 SCC 727

10 2015 SCC OnLine Bom 531

trademark. The defendants placed reliance on the said judgment of this Court also for the proposition that a party cannot blow hot and cold at the same time, when it raises doubts about the registrability of the trademark of the plaintiff and at the same time, applies for its own trademark for registration.

- (L) It is submitted that the defendants have claimed that the word “STREAK” is common to trade in respect of the hair product industry and some documents have been annexed to the reply affidavits. But, the defendants have miserably failed to show even one party using the word “STREAK” involved in the business of hair products as a trademark and therefore, the argument of common to trade is bereft of any logic. On the aspect of delay also, reliance is placed on the judgment of this Court in the case of **Jagdish Gopal Kamath and Ors vs. Lime and Chilli Hospitality Services (supra)**, wherein this Court reiterated the position of law that in an action for infringement or passing off the question of delay, so as to disentitle the plaintiff to claim relief, cannot be determined on the basis of a *priori* considerations. It was further submitted on behalf of the

plaintiff that the ground of acquiescence can also not be raised by the defendants because the plaintiff raised objection at the first available opportunity and in any case, the ground of acquiescence has to be proved by detailed pleadings and in the present case, such pleadings are absent.

13. On the other hand, Mr. Ashish Kamat, learned senior counsel and Mr. Rashmin Khandekar, learned counsel for the defendants made the following submissions:

- (A) It was submitted that the word “STREAK” has a specific meaning in relation to hair and hair care products and therefore, the plaintiff cannot claim monopoly over the misspelling of the said word. It was submitted that even if registration has been granted to the word mark “STREAX” of the plaintiff, this Court cannot ignore the fact that word “STREAK” in common parlance means coloured strand of hair and therefore, it is immediately associated with hair and hair care products. It was submitted that the said ground being essentially an argument based on the relevant position of law, even if the reply affidavits of the defendants do not refer to such a ground, this Court ought

to consider the same as a defence raised by the defendants to resist interim reliefs.

- (B) It was submitted that even though the order of a learned Single Judge of this Court in the case of **Indchemie Health Specialties Pvt. Ltd. vs. Intas Pharmaceuticals and another (supra)**, was set aside by the Division Bench of this Court, the discussion contained therein refers to certain judgments of foreign jurisdictions on the question of the approach to be adopted by Courts when a plaintiff relies upon registration obtained of a misspelling of a word or an expression. It was submitted that only to that extent reference was made to the said order passed by the learned Single Judge of this Court. In that context, the learned counsel appearing for the defendants referred to the judgments of the Chancery Division, England, in the case of **In re UNEEDA Trade Mark**¹¹, judgment of House of Lords in the case of **Electrix Limited Vs. Electrolux Limited**¹² and the United States of Court of Customs and Patent Appeals in the case of **The Fleetwood Company Vs. Syl**¹³

11 (1901) 1 CH 550

12 1959 H.L. (E) 503

13 298 F.2d 797

- (C) It was submitted that dishonesty of the plaintiff is evident from the fact that examination report of the Registrar of Trade Marks was held back from this Court, wherein the Registrar had indicated that the word “STREAX” was phonetically close to the word “STREAK” and therefore, not distinctive. It was submitted that the plaintiff cannot avoid responding to the said allegation of suppression, by taking a technical plea that this aspect was not specifically mentioned in the reply affidavits filed on behalf of the defendants. The only response that the plaintiff could have given to the Registrar was that the word “STREAX” was not close to the word “STREAK”, thereby showing that the plaintiff cannot now turn around and raise objection to the use of the word “STREAK” by the defendants in their trademark.
- (D) It was submitted that the trademark of the defendants is in the nature of a label mark as it has various components, including the word “STREAK Street” with the phrase “quirk up your hair” in a band placed below the aforesaid two words, with a design drawn towards the left of the mark. Hence, the trademark of the defendants has to be

seen as a whole and then compared with the registered trademark of the plaintiff. If such a comparison is carried out, it becomes evident that the plaintiff cannot claim deceptive similarity with its registered trademark and the dissection of the trademark of the defendants cannot be permitted.

- (E) Reliance was placed on judgment of this Court in the case of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors. (supra)**, wherein the plaintiff, despite having registration for its mark “shaadi.com”, was not granted interim reliefs against the defendant, which used the trademark “secondshaadi.com.” This Court found that the word “Shaadi” is used in common parlance to refer to marriage and despite registration, the plaintiff therein could not claim exclusivity in the said word. It was emphasized that in the very same judgment, this Court held that mere high sales and expenses being shown to the Court are not enough for the plaintiff to claim exclusivity in a mark, which contains a word used in common parlance, being non-unique and which clearly indicates the descriptive nature of the word. Reliance was placed on judgment of

this Court in the case of **ARG Outlier Media Pvt. Ltd. Vs. Rayadu Vision Media Ltd. (supra)**, to contend that that concept of “weak” trademarks is judicially recognized by the Court and the plaintiff cannot claim that either it should be a case of the registration of the trademark shocking the conscience of the Court as specified in the full bench of this Court in the case of **Lupin Ltd. Vs. Johnson and Johnson (supra)** or the only other alternative being that the registration must lead to fullest protection.

- (F) Reliance was also placed on judgment of this Court in the case of **Kamruddin I. Mehsaniya Vs. Sarah International**¹⁴, where this Court referred to Section 17 of the Trade Marks Act, to clarify that the word “KIMIA” used in the trademark of the plaintiff concerned a kind or type of dates and therefore, the *ex-parte* order of injunction stood recalled. It was held that the word “KIMIA” *prima facie* was nothing but a description or variety of particular type of goods. It was submitted that in the present case also the word “STREAX” concerns hair and hair care products directly and therefore, the plaintiff does not deserve any relief in the present application.

14 2021 SCC OnLine Bom 13933

(G) Much emphasis was placed on the alleged dishonesty on the part of the plaintiff in being economical in placing all the facts pertaining to the proceedings before Trade Marks Registry when the application was moved for registration of the trademark “STREAX.” It was indicated that prosecution history estoppel ought to operate against the plaintiff in terms of law laid down by this Court in various judgments, including in the case of **PhonePe Private Limited Vs. Resilient Innovations Private Limited**.¹⁵

14. This Court has considered the rival submissions in the light of the documents placed on record. Considering the details of the 44 registrations obtained by the plaintiff in its favour as regards the trademark “STREAX” and its variants in different classes starting from 01st July, 2002, this Court is convinced that the plaintiff is entitled to assert its proprietary rights in its registered trademark “STREAX/STREAX formative marks.” The statement of the gross annual turnover of the plaintiff in the context of its product using the registered trademark “STREAX/STREAX formative marks” shows that for the year 2023-24, the sales turnover was more than ₹ 500 Crores. Similarly the plaintiff spent an amount more than ₹ 50 Crores towards advertisement and publicity expenses. Therefore, there is sufficient

15 2023 SCC OnLine Bom 764

material on record to indicate that the applicant has earned considerable goodwill in its favour in respect of its registered trademark “STREAX/STREAX formative marks” and hence, it is entitled to assert its proprietary rights in respect of the said registered trademark. In fact, copies of earlier orders passed by this Court, placed on record, do show that plaintiff has been vigilant in protecting its proprietary rights in respect of the said registered trademarks and this Court on earlier occasions has also granted ad-interim reliefs / interim reliefs in favour of the plaintiff.

15. As noted hereinabove, the defendants while resisting the prayers made in the present application, have raised various defences. Some of the defences are borne out from the reply affidavits of the defendants, while others have been raised without there being any reference to such defences in the reply affidavits or even the sur-rejoinder. It would be appropriate to first deal with the defences raised on the basis of what has been stated in the reply affidavits and sur-rejoinder filed on behalf of the defendants.

16. The defendants have claimed that the word “STREAK” has a specific meaning in relation to hair and hair care products i.e. the word means a coloured strand of hair. It is claimed that the registered trademark of the plaintiff i.e. “STREAX” is phonetically similar and almost identical to the word “STREAK” and since the products of the plaintiff are admittedly concerned with hair and hair care products, the registered trademark of the

plaintiff is nothing but descriptive in nature and that despite registration, the plaintiff cannot claim exclusive right in the same. It is also sought to be indicated that the said word “STREAK” is common to trade and hence, the plaintiff cannot assert its rights, so as to restrain the defendants from using their mark in respect of hair and hair care products. Much emphasis was placed on the judgments of this Court in the cases of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors. (supra)** and **ARG Outlier Media Pvt. Ltd. Vs. Rayadu Vision Media Ltd. (supra)**. This Court in the case of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors. (supra)**, considered the question of a trademark being generic and commonly descriptive and in that context noted the degrees of distinctiveness that can be claimed in respect of trademarks. Reference was made to four such categories i.e. generic or commonly descriptive, merely descriptive, suggestive and arbitrary or fanciful. It was observed that generic or commonly descriptive words cannot become trademarks on their own and they cannot acquire distinctiveness or a secondary meaning, while merely descriptive words upon acquiring secondary meaning can become the basis for claiming exclusivity. As regards suggestive words, they hint at a feature or speciality, leading to a link in the mind of the consumer between the word and the actual products and that such suggestive words would not require proof of acquisition of secondary meaning to proceed to registration.

17. Arbitrary or fanciful words would always be registered as such words clearly distinguish goods of one person from those of the others. It was emphasized that the more obvious the word, less the degree of distinctiveness and the chances of registration. It was further indicated that a mark may be able to move from a lower class of distinctiveness to a higher class and that it would depend upon facts and circumstances of each case.

18. Keeping the aforesaid position in mind, the contention raised in this regard on behalf of the defendants will have to be examined, It is asserted on behalf of the defendants that the only obvious meaning of the word “STREAK” is a coloured strand of hair. But, it has been correctly pointed out on behalf of the plaintiff that this is not the only obvious meaning of the word “STREAK” and that the said word is used in various ways in English language. This Court is unable to accept the contention of the defendants that the word “STREAK” would be associated only with a coloured strand of hair and hence, it is descriptive of the products of the plaintiff. It is to be noted that the plaintiff has been in the hair care industry with its registered trademark “STREAX” since the year 2002, with the stated claim of the said trademark being conceived in April 2002. The plaintiff is into the business of goods and services concerning cosmetic products, hair care products, sanitary preparations and others. Although the defendants have annexed certain

documents from the public domain to demonstrate that the word “STREAK” is used by various entities involved in the hair care industry, they have failed to show use of the word “STREAK” as a trademark by other entities in the very same trade channels in which the both the plaintiff and defendants are operating.

19. It is crucial to appreciate that the plaintiff in the present case is strongly asserting its statutory rights in the registered trademark “STREAX,” as opposed to plaintiffs in the cases of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors. (supra)** and **ARG Outlier Media Pvt. Ltd. Vs. Rayadu Vision Media Ltd. (supra)**, conceding that the marks concerned therein could not be said to be inherently distinctive. In the case of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors. (supra)**, the plaintiff conceded that its mark “shaadi.com” was not inherently distinctive and that the word “shaadi” was a commonly used word in Hindi for marriage. Similarly in the case of **ARG Outlier Media Pvt. Ltd. Vs. Rayadu Vision Media Ltd. (supra)**, the plaintiff specifically conceded that it was not asserting monopoly over either the letter or alphabet “R” per se or red and white combination per se in which the said alphabet was presented. The entire mark of the plaintiff therein consisted of the alphabet “R” with a white dot in the backdrop of a red coloured square and nothing else. It is in such facts that this court proceeded to hold against the plaintiff on the ground that although the trademarks were registered, the

central, leading and essential features of those marks were indeed conceded to be either lacking inherent distinctiveness or being common to trade. Such are not the facts in the present case.

20. The plaintiff is justified in relying upon judgment of the Delhi High Court in the case of **PEPS Industries Private Limited Vs. Kurlon Limited (supra)**, wherein it has been held that if the validity of the registration of the trademark is not brought into issue, the statutory presumption that the mark is valid must be accepted and that it is not open for the Court to suo-motu question the validity of the registration of the trademark. In the present case, the defendants have not gone to the extent of claiming that registered trademark of the plaintiff “STREAX” could never have been registered or that its registration should shock the conscience of the Court. The defendants pitched their case at the level of claiming that the registered trademark of the plaintiff is a “weak” mark. At the interlocutory stage, except where the plaintiff itself concedes that its mark is not inherently distinctive or that it is not claiming monopoly over the features contained within the mark as in the case of **People Interactive (I) Pvt. Ltd. Vs. Vivek Pahwa & Ors. (supra)** and **ARG Outlier Media Pvt. Ltd. Vs. Rayadu Vision Media Ltd. (supra)**, and the defendants are not pushing their case to call upon the Court to apply the ratio of the Full Bench judgment in the case of **Lupin Ltd. Vs. Johnson and Johnson (supra)**, it would not be appropriate to proceed on the basis that

despite registration, the plaintiff cannot assert all its rights as statutorily granted to it under the provisions of the Trade Marks Act. It is only where the Court, within the narrow window available under the Full Bench judgment in the case of **Lupin Ltd. Vs. Johnson and Johnson (supra)**, finds that the trademark of the plaintiff is inherently non-distinctive that interim reliefs can be denied despite registration of the trademark.

21. This Court is also of the opinion that the plaintiff in such a case would be entitled to claim protection under Section 32 of the Trade Marks Act, which specifies that even where the trademark is registered in breach of Section 9(1) of the said Act, it shall not be declared invalid, if the plaintiff is able to demonstrate that after registration of its trademark, before commencement of any legal proceedings challenging the validity of such registration, the mark itself has acquired distinctive character in relation to goods or services for which it is registered. It is significant that there is still no proceeding initiated for challenging validity of registration of the plaintiff's trademark. In any case, the plaintiff has placed on record sufficient material to demonstrate that after having obtained registration of the word mark "STREAX" in the context of hair products and such other services from July, 2002 onwards, over 44 registrations have been granted in its favour, alongwith material to show continuous commercial use thereof. The plaintiff has been able to make out a strong *prima facie* case that its registered trademark

“STREAX” has indeed acquired distinctive character. This is also evident from the turnover figures placed on record, which show that for the year 2023-24, the turnover was more than ₹ 500 Crores and an amount of more than ₹ 50 Crores was spent towards advertisement and publicity expenses. In fact, sales turnover figures from 2004-05 have been certified by the Chartered Accountant showing continuous increase in the sales turnover for a period of more than 20 years, thereby indicating that the products of the plaintiff using the said registered trademark “STREAX/STREAX formative marks” have obtained a reputation for the plaintiff and that the products have been in the public domain for a considerable period of time .

22. It is also significant that the defendants are unable to show that other entities are using the word “STREAK” or “STREAX” as a trademark in the context of hair and hair care products or in the aforesaid industry. In such a situation, when the defendants decided to adopt its trademark, it was expected to make proper enquiries, including enquiries with the Trade Marks Registry and having failed to do so, the defendants adopted the impugned trademark at their own risk. The position of law in this regard is made clear by this Court in the case of **Bal Pharma Ltd. Vs. Centaur Laboratories Pvt. Ltd. & Anr. (supra)**.

23. Even otherwise, in the present case, the defendants are clearly

blowing hot and cold at the same time, for the reason that on the one hand they are raising doubts about the character and strength of the registered trademark of the plaintiff, while on the other hand the defendants have themselves applied for registration of the impugned trademark, of which the leading, essential and central feature is the word “STREAK.” This Court in the case of **Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited (supra)**, has referred to the well settled position that when the defendant seeks registration of its mark, it is estopped from urging that the mark is incapable of registration. The defendants themselves in the present case are using their mark as a trademark and not in the descriptive sense, thereby indicating that the defendants can be said to be guilty of blowing hot and cold at the same time. It further renders their defence unsustainable against the plaintiff.

24. An attempt was sought to be made on behalf of the defendants to claim that their trademark is “STREAK Street” with the phrase “quirk up your hair” and an artistic design incorporated in the mark, thereby claiming that the mark as a whole would have to be considered while comparing the same with the registered trademark of the plaintiff. It was sought to be indicated that the impugned trademark of the defendants ought not to be dissected. But, this Court is of the opinion that even if the trademark of the defendants is to be treated as a composite mark and a combination of words, while considering

the allegation of infringement raised on behalf of the plaintiff, this Court is well within its powers to identify as to what is the leading, essential and central feature of the trademark of the defendants in order to test the allegation of infringement made by the plaintiff. In the case of **Jagdish Gopal Kamath and Ors vs. Lime and Chilli Hospitality Services (supra)**, this Court held that while testing the allegation of infringement in such cases, the Court must of necessity consider what is the essential, prominent and leading feature of the impugned mark by whatever named it is called i.e. a label mark, device mark, composite mark or word mark.

25. Thus, while comparing the two marks on the question as to whether a *prima facie* case is made out as regards infringement by the plaintiff, this Court has specifically considered the impugned trademark of the defendants. Although the the phrase “quirk up your hair” is stated in the application filed on behalf of the defendants before the Trade Marks Registry for registration of the impugned trademark, throughout the pleadings in the present proceedings, the defendants have harped upon their trademark being “STREAK Street.” A look at the impugned trademark of the defendants does *prima facie* show that the prominent, leading and essential feature of the same is the word “STREAK.” The plaintiff has registration for its trademark “STREAX/STREAX formative marks” and crucially it has a registration for word mark “STREAX” dating as far back as 01st July, 2002. This Court is of

the opinion that the plaintiff has made out a strong *prima facie* case in its favour to claim that the prominent, leading and essential feature of the impugned trademark of the defendants i.e. “STREAK” is deceptively similar to the registered word mark of the plaintiff “STREAX.” In this regard, the defendants cannot be heard to say that since the word “Street” and the phrase “quirk up your hair” have been added to the word “STREAK”, there is distinctiveness to the trademark of the defendants. It is a well settled position of law, since the decision of the Supreme Court in the case of **Ruston & Hornsby Ltd. Vs. Zamindara Engineering Co. (supra)**, rendered in the year 1969, that merely adding a prefix or suffix to a word that is identical / similar / deceptively similar to the registered trademark of the plaintiff, would not take away the mischief of the defendants. In the case of **Mauj Mobile Private Limited Vs. Mohalla Tech Private Limited and Others**¹⁶, this Court found that phonetic similarity does assume significance, for the reason that by merely changing the spelling even when the pronunciation and sound of the rival marks appears to be similar, the defendants cannot escape an order of temporary injunction. This Court finds substance in the contention raised on behalf of the plaintiff that, viewed from this angle, the manner in which the defendants have adopted the impugned trademark shows that such adoption can be said to be dishonest.

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26. This takes us to the contentions raised on behalf of the defendants that do not find any basis in the pleadings i.e. in the reply affidavits filed on behalf of the defendants. This Court is of the opinion that there is substance in the contention raised on behalf of the plaintiff that in the absence of any pleadings before this Court with regard to certain defences raised by the defendants, such defences cannot be considered by the Court. Reliance placed on judgment of the Delhi High Court in the case of **PEPS Industries Private Limited Vs. Kurlon Limited (supra)**, in this regard is justified. This Court is of the opinion that such defences raised on behalf of the defendants in the absence of the pleadings ought not to be considered and deserve to be rejected only on the said ground.

27. But, since the learned senior counsel appearing for the defendants sought to raise such defences as if they were pure questions of law, in order to satisfy the conscience of this Court, the said defences have also been considered.

28. The first such defence pertains to misspelling of the word “STREAK” by the plaintiff by deliberately using the word “STREAX” as its trademark. It is claimed that using such a misspelt word shows the mischief on the part of the plaintiff to give an impression that a word in common parlance or a word common to trade was not being actually used. Much emphasis was

placed on judgment of a learned Single Judge of this Court in the case of **Indchemie Health Specialties Pvt. Ltd. vs. Intas Pharmaceuticals and others (supra)**, wherein there is some discussion on the said aspect of misspelling of an obvious expression or word in the context of Intellectual Property Law. But, it has been correctly pointed out by the learned counsel appearing for the plaintiff that the said judgment of the learned Single Judge of this Court was set aside by the Division Bench of this Court in appeal. To be fair to the learned senior counsel appearing for the defendants, this fact was pointed out on behalf of the defendants themselves and yet, it was submitted that some observations purely on the position of law in the judgment of the learned Single Judge could be looked at, particularly because there was a reference made to precedents, including precedents from foreign jurisdictions.

29. This Court is of the opinion that the settled position of law is clear, including in the judgment of the Division Bench of this Court in the case of **Lufeng Shipping Company Ltd. Vs. M.V. Rainbow Ace and Anr. (supra)**, that once a judgment is set aside, it is as if it never existed. Therefore, this Court is not in agreement with the aforementioned submissions made on behalf of the defendants, by relying upon judgment of the learned Single Judge of this Court in the case of **Indchemie Health Specialties Pvt. Ltd. vs. Intas Pharmaceuticals and others (supra)**.

30. Even otherwise, the judgments referred to therein from foreign jurisdictions in the cases of **In re UNEEDA Trade Mark (supra)**, **Henri's Food Products Co., Inc., Vs. Tasty Snacks, Inc.**,¹⁷ and **Electrix Limited Vs. Electrolux Limited**, all arose from proceedings before the Registrars and Authorities of the Trade Marks in such respective foreign jurisdictions. There is a qualitative difference as to the manner in which the Court deals with issues that arise at the stage where registration of the trademark is in process, as opposed to a registered trademark holder approaching the Court alleging infringement against the defendants. This Court also finds that in the said judgments from foreign jurisdictions, there were obvious cases of general expressions being deliberately misspelt while seeking registration. In the present case, the plaintiff is holding registration of its word mark "STREAX" from the year 2002 onwards and this is a fact that materially changes the applicability of the said judgments upon which the defendants have relied.

31. The next defence raised on behalf of the defendants, without any basis in the pleadings, pertains to alleged suppression on the part of the plaintiff by not placing the examination report of the Registrar when the application for registration was filed by the plaintiff for its mark "STREAX." According to the defendants, suppression of the said document disentitles the plaintiff from pressing for interim reliefs. The said argument is based on the

¹⁷ 817 F.2d 1303

premise that the response to the examination report of the plaintiff would obviously have been that the word “STREAX” is dissimilar to the word “STREAK” and that this hits at the very root of the contentions raised on behalf of the plaintiff. Another offshoot of the said submission on behalf of the defendants pertains to prosecution history estoppel and in that context reliance was placed on various judgments, including judgment of this Court in the case of **PhonePe Private Limited Vs. Resilient Innovations Private Limited** (*supra*).

32. It is to be noted that photocopy of the examination report was tendered across the bar on behalf of the defendants, without any basis in the pleadings i.e. the reply affidavits filed on their behalf. It is brought to the notice of this Court on behalf of the plaintiff that even while tendering the photocopy, the last page thereof was not tendered, wherein the Registrar, despite having made certain observations in the examination report, had directed that the case would proceed to advertisement. In other words, truncated photocopy of the examination report was placed. In response, it is significant that the plaintiff also tendered a recent letter sent by the Registrar of Trade Marks dated 05th February, 2025, to the advocates representing the plaintiff when they had submitted a request for certified copy of the reply to the examination report, stating that the reply to the examination report was not available in the records of Registrar of Trade Marks. In this situation,

nothing can be made out about the allegation of suppression and the argument pertaining to prosecution history estoppel sought to be raised on behalf of the defendants. As noted hereinabove, the Trade Marks Registry proceeded with the matter and registration for word mark 'STREAX' was granted in favour of the plaintiff as far back as on 01st July, 2002. Thereafter, the Registry granted registration to the trademarks "STREAX/STREAX formative marks" over a long period of time, showing at least 44 such registrations in favour of the plaintiff in various classes. Therefore, there is hardly any substance in the aforementioned contention raised on behalf of the defendants.

33. Even otherwise, estoppel is to be specifically pleaded and strictly proved as per the settled position of law, laid down in various judgments, including the judgment of this Court in the case of **Patel Govindbhai Lallubhai Vs Patel Dahyabhai Nathabhai**¹⁸. The pleadings in the present case on behalf of the plaintiff are completely bereft of any such material and therefore, the said contention also deserves to be rejected. An attempt was made on behalf of the defendants to claim that there is delay on the part of the plaintiff in approaching the Court while seeking such reliefs. But, the said contention deserves to be rejected on the basis of the settled position of law that when a registered trademark holder in asserting its proprietary rights in such a mark, delay can hardly be a ground for refusing interim reliefs. In the

18 AIR 1937 BOM. 201

case of **Jagdish G. Kamath and Ors vs. Lime and Chilli Hospitality Services (supra)**, the position of law is reiterated that such relief cannot be denied to the plaintiff as the aspect of delay cannot be determined on the basis of a priori considerations. An attempt was also made by the defendants to claim acquiescence on the part of the plaintiff but, the question of acquiescence would arise only if the registered trademark holder, despite being aware about the infringing trademark of the defendants does not take any affirmative action, thereby encouraging such a defendant to continue using the infringing trademark. Such a situation requires detailed pleadings and proper evidence and at this stage, defendants have completely failed to show any basis in their pleadings with regard to the said aspect of the matter.

34. This Court is also of the opinion that sufficient pleadings and material have been placed on record on behalf of the plaintiff, including its sales turnover figures to show that considerable goodwill is earned by the plaintiff in respect of its registered trademark “STREAX/STREAX formative marks.” The sales turnover of more than ₹ 500 Crores for the year 2023-24, is indeed a relevant consideration in this regard. As this Court has found that the adoption of the impugned trademark by the defendants *prima facie* appears to be dishonest, a case is made out by the plaintiff to claim that the defendants are seeking to pass off their products as those of the plaintiff in order to ride over the considerable goodwill of the plaintiff in the market.

35. The material on record also shows a *prima facie* case in favour of the plaintiff to claim that the adoption of the impugned trademark by the defendants can be said to be dishonest. Even according to the defendants, they first used the impugned trademark some time in the year 2018. The first application for registration of the impugned mark was filed on behalf of the defendants was 12th October, 2019, in class 3. It is relevant to note that in the application dated 30th July, 2021, the defendants applied for registration in class 26 and the said application was moved on proposed to be used basis. But, this application was subsequently withdrawn and thereafter, on 10th December, 2022, an identical application in class 26 was moved by the defendants, on this occasion claiming user from 08th January, 2018. This further indicates a *prima facie* case of dishonesty on the part of the defendants in claiming the date of user of the impugned trademark. Such defendants cannot be heard to say that the plaintiff is not entitled to assert its statutory rights in its registered trademark. The record shows that the plaintiff has 44 registrations for its trademark “STREAX/STREAX formative marks,” starting from the year 2002. In this context reliance placed on behalf of the defendants on the judgment in the case of **Kamruddin I. Mehsaniya Vs. Sarah International (supra)**, is also misplaced because the defendant therein had stated that it was using the mark “KIMIYA” in a descriptive sense and not as part of its trademark, which was “SARAH.” In this backdrop, reference was

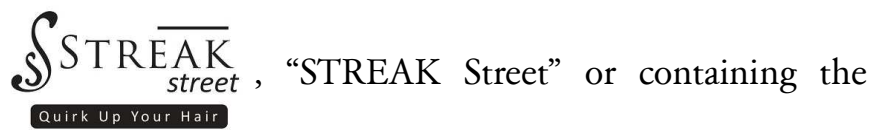
made to Section 35 of the Trade Marks Act, in the said judgment, which in the facts and circumstances of the present case is inapplicable, simply for the reason that the defendants are using the word “STREAK” as a part of its trademark “STREAK Street” and they cannot turn around to claim relief on the basis of the aforesaid judgment.

36. This Court is of the opinion that, considering the above discussion in respect of various aspects of the matter, a strong *prima facie* case is made out by the applicant / plaintiff in its favour to seek interim reliefs for both infringement as well as the act of passing off and that, unless such reliefs are granted, the plaintiff would continue to suffer grave and irreparable loss, thereby indicating that balance of convenience is also in favour of the plaintiff.

37. On the aspect of balance of convenience, it is to be noted that the plaintiff has placed on record voluminous material to show its sales turnover and its goodwill in the market over a considerable period of time. The defendants, on the other hand, while claiming first user from the year 2018, have miserably failed to place on record any statistics with regard to their sales turnover or their presence in the market. Therefore, on this aspect of the matter also, this Court is inclined to hold in favour of the plaintiff.

38. In view of the above, the application is allowed in terms of prayer clauses (a) and (b), which read as follows :

- “a) that pending the hearing and final disposal of the suit, the Defendants by themselves, their partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them be restrained by an order and injunction of this Hon’ble Court from in any manner using the mark



mark STREAK or any other mark that is identical with or deceptively similar to the Plaintiff's registered trademark Nos. 1115358, 3189737 and 4483561 in class 3, trademark No. 2912184 in class 21 trademark No. 2912189 in Class 26 and trademark No. 2912198 in Class 35 described in Exhibit-A-1 To Exhibit-A-6 to the plaint;

- b) that pending the hearing and final disposal of the suit, the Defendants by themselves, their partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them be restrained by an order and injunction of this Hon’ble Court from in any manner using the trademark



“STREAK Street” or containing the

mark STREAK or any other mark that is identical with or
deceptively similar to the Plaintiff’s trademark “STREAX”
and/or its variants so as to pass off their goods as and for
the goods of the Plaintiff;”

(MANISH PITALE, J.)