

**IN THE HIGH COURT AT CALCUTTA  
(Ordinary Original Civil Jurisdiction)  
COMMERCIAL DIVISION**

**Present:**

**The Hon'ble Justice Krishna Rao**

**IA No: GA 1 of 2020**

**In CS 64 of 2020**

**Berger Paints India Limited**

**Versus**

**JSW Paints Private Limited**

Mr. Surajit Nath Mitra, Sr. Adv.

Mr. Sayantan Basu

Mr. Sourav Sengupta

Mr. Amain Baid

... For the plaintiff.

Mr. Ranjan Bachawat

Mr. Debnath Ghosh, Adv.

Ms. Vaibhavi Pandey

Mr. Shaunak Mitra

Mr. Salfiqar Ali

Md. Zulfiqar Ali Al Quaderi

Ms. Shivangi Thard

... For the defendant.

Hearing Concluded On : 18.10.2023

Judgment on : 12.12.2023

**Krishna Rao, J.:**

1. The plaintiff has filed the present application being G.A. No. 1 of 2020 praying for injunction restraining the defendant from infringing the petitioner's registered trademark "SILK" or its variants by using the trademark "HALO SILK".
2. The petitioner company was originally incorporated on 17<sup>th</sup> December, 1923 in West Bengal, India. It commenced Paints business from that date or soon thereafter and the first Paint Factory was established in Howrah, West Bengal with the corporate name Hadfields India Limited. Thereafter, a series of change in the name of the Plaintiff Company had taken place and now it is known as Berger Paints India Limited.
3. The petitioner company has an international presence in Nepal, Bangladesh, Poland, United Kingdom, France, Ukraine and Russia directly or through its subsidiaries. The petitioner's sister Company in Bangladesh is the dominant leader, with over 65% market share in that country. The petitioner company has maintained its position of being amongst the top two Paint Companies in India, and the sales turnover of its products, amounts to more than Rs.6000 Crores for the financial year 2018-2019.
4. The petitioner company (which expression shall include the predecessor in interest) owns more than 250 trade marks in India, and most of them are registered in India. One of such trademarks was adopted by the petitioner Company in an independent and bona fide manner which

was the trade mark “SILK”, sometimes on or about 07.06.1980 in respect of goods dealt in by the petitioner company and the petitioner has been using the said mark since then, either standalone or in conjunction with some other marks and charters.

5. The expression SILK was first ingeniously adopted by the plaintiff company in respect of a wide ambit of paint products and it has been in use ever since the adoption in the year 1980. The said trade mark SILK has been in use by the petitioner company in myriad forms for paint and other related products. First commercial use of the expression SILK as the mark, LUXOL SILK was made way back in the year 1980 in relation to Paints, Primers, Emulsions, Enamels, and Varnishes amongst others. The trade mark LUXOL SILK has become one of the *“premium highly sought after brands”* in the field of Paint and allied products in India. The mark SILK are being used either standalone, or along with its house mark BERGER/LEWIS BERGER and other trademarks, but the products marketed and sold under the mark SILK are called, asked for and described by the customers or traders with the name SILK, which has been an established trade mark in India. The trade mark SILK registered in favour of the plaintiff in different forms and manners are as follows :

Sl. No.	Trade Mark	Trade Mark No.	Class	Goods/Services	Status
1.	SILK	2598721 As of 19.09.2013	02	Paints, Enamels, Primers and Varnishes (other than	Registered

				<p>Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.</p>	
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Sl. No.	Trade Mark	Trade Mark No.	Class	Goods/ Services	Status
2.	SILK DESIGNZZ	2641641 as of 12/12/2013	02	<p>Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration</p>	Registered



				of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	
3.	Bp British Paints LUXOL SILK	369887 as of 19.12.1980	02	Paints, Varnishes, Enamel in the Nature of Paints all being goods included in Class 2	Registered

Sl. No.	Trade Mark	Trade Mark No.	Class	Goods/Services	Status
4.	LUXOL SILK	369885 as of 19.12.1980	02	Paints, Varnishes (other than Insulating Varnish) and Enamel in the Nature of Paints all being the goods included in Class 2	Registered
5.	LUXOL SILK SPLENDO UR	988901 as of 08.02.2001	02	Paints, Varnishes, Lacquers, Powder Paints, Dry Paints, Chemical Colouring	Registered

				Composition, Dye and Dyestuffs, Gum Resins	
6.	LEWIS BERGER BREATHE EASY SILK EMULSION	1498685 as of 25.10.2006	02	Paints, Varnishes, Acrylic Emulsion, Enamels, Primer, Colouring Matters, Preservatives against Rust and Deterioration of Wood, Dyestuff, Powder Coatings, Coluring Resins	Registered
7.	LEWIS BERGER COLORBA NK SILK SPLENDO UR LUXURY EMULSION PRECIOUS INTERIOR WALL PAINT	1498707 as of 25.10.2006	02	Paints, Varnishes, Acrylic Emulsion, Enamels, Primer, Colouring Matters, Preservatives against Rust and Deterioration of Wood, Dyestuff, Powder Coatings, Coluring Resins	Registered
8.	LEWIS BERGER SILK LUXURY EMLUSION PRECIOUS INTERIOR WALL PAINT	1498710 as of 25.10.2006	02	Paints, Varnishes, Acrylic Emulsion, Enamels, Primer, Colouring Matters, Preservatives against Rust and Deterioration of	Registered

				Wood, Dyestuff, Powder Coatings, Coloring Resins	
9.	LEWIS BERGER SILK	2322928 as of 27/04/2012	02	Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	Registered
10.	LEWIS BERGER SILK DESIGNZZ	2641642 as of 12/12/2013	02	Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers,	Registered

				Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	
11.	XP LEWIS BERGER SILK GLAMOR	3335353 As of 12.08.2016	02	Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints,	Registered

				Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	
12.	LEWIS BERGER SILK GLAMOUR	3335347 As of 12.08.2016	02	Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	Registered
13.	LEWIS BERGER SILK IMULSION S	2641639 As of 12/12/2013	02	Paints, Enamels, Primers and Varnishes (other than Insulating	Registered

				Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	
14.	Experience Silk	2765811 As of 01/07/2014	02	Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire	Registered

				Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	
15.	DuniyaDekhegi Jab Silk SeSaje Zindagi	2765808 As of 01/07/2014	02	Paints, Enamels, Primers and Varnishes (other than Insulating Varnish) and Dry Colours for Paints, Distempers, Lacquers, Lacquering Matters ( Not for Laundry or Toilet use), Preservatives against Rust and Deterioration of Wood, Dyes, Dyestuffs, Resins, Fire Retarding Paints and Compounded Paints, Cement Paints, Preservatives against Heat and Corrosion, Powder Paints and Dry Paints, Acrylic Paints and Emulsion, Gum Resins, Thinners.	Registered
16.	ACRI-SILK	2739987	02	Paints,	Registered

		As of 20/05/2014		varnishes, lacquers, preservatives against rust & deterioration of wood, colouring matters, dye stuffs, natural resins, metals in foil & powder form for painters & decorators, enamels, distempers, varnishes, thinners, strainers, acrylic paints, anti-corrosive paints, anti- fouling paints, anti-static paints, automotive paints, cement preservatives, ceramic paints, dispersion paints, emulsions in the nature of paints, luminous paints, paints, powder paints, rubber paints textured paints.	
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Sl. No.	Trade Mark	Trade Mark No.	Class	Goods/Services	Status
17.	LUXOL SILK	369886 As of 19.12.1980	17	Insulating Varnishes and Materials other than Glass of Porcelain included in Class 17 for Insulation	Registered
18.	B. British Paints	369884 as of	17	Insulating Varnishes and	Registered



	LUXOL SILK	19.12.1980		Materials other than Glass and Porcelain included in Class 17 for Insulation	
19.	LEWIS BERGER SILK	2322924 as of 27/04/2012	37	Painting (interior and exterior), repairing and renovation of building (interior and exterior).	Registered
20.	LEWIS BERGER SILK	2322927 as of 27/04/2012	01	Synthetic Resine Chemical Compounds and substances, Colouring and Tanning; Polyurethane, Chemical solution and Chemical Preparations used against Deterioration of Wood, Chemical Solutions used in Paints, Polymer Binder, Emulsifying Agents, Chemical Coating Containing Phosphorus for use in Industrial Treatment of Metals to render them resistant o Corrosion, Chemical Composition (Not being in the Nature of Paints) for use in the industrial Process of Mechanical Deformation of Iron and Steel, Chemical	Registered

				Compositions (Not in the Nature of Paints) for the Treatment of Non-Ferrous Metals in the Course of Manufacture Chemical, Substance used in Industry for use in the Treatment of Metals.	
21.	LEWIS BERGER SILK	2322923 As of 27/04/2012	17	Insulating Varnishes.	Registered
22.	XP LEWIS BERGER SILK GLAMOR	3335356 As of 12.08.2016	35	Wholesale, Retail Outlet & Departmental Store, Showroom To Enable the Customers To View And Purchase of Paints, Primers, Chemical products and Paint related products, Wholesale & Retail outlets and shops including services relating To distribution, trading and marketing of Paints, Primers, Chemical products and Paint related products, Advertising, Radio Advertising and Commercials, Television Advertising and Commercials,	Registered

				Creating Advertisement Films, Providing Online Shopping Services, Business Management and Business Administration.	
23.	XP BERGER SILK GLAMOR	3335357 As of 12.08.2016	37	Painting (interior and exterior), repairing and renovation of building (interior and exterior) building construction	Registered
24.	LEWIS BERGER SILK GLAMOR	3335346 As of 12.08.2016	01	Synthetic Resins, Chemical Compounds and Substances, Colouring and Tanning, Polyurethane, Chemical Solution and Chemical Preparations used against Deterioration of Wood, Chemical Solutions used in Paints, Polymer Binder, Emulsifying Agents, Chemical Coating Containing Phosphorus for use in Industrial Treatment of Metals to render them resistant to Corrosion.	Registered
25.	XP LEWIS BERGER SILK	3335352 As of 12.08.2016	01	Synthetic Resins, Chemical Compounds and	Registered

	GLAMOR			Substances, Colouring and Tanning, Polyurethane, Chemical Solution and Chemical Preparations used against Deterioration of Wood, Chemical Solutions used in Paints, Polymer Binder, Emulsifying Agents, Chemical Coating Containing Phosphorus for use in Industrial Treatment of Metals to render them resistant to Corrosion.	
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Sl. No.	Trade Mark	Trade Mark No.	Class	Goods/Services	Status
26.	LEWIS BERGER SILK GLAMOR	3335348 As of 12.08.2016	16	Paper, Paper Stationery, Newspaper, Periodicals, books, Magazines, Paper Articles, Printed Matters, Office Requisites, Instructional and Teaching Materials, Files, Publications, Pads, Posters, Calenders, Pamphlet, Computer Printout, Computer Programmes, Stationery for Computers, Journals, forms,	Registered

				Manuals, Photographs, Cards, Guide Books.	
27.	XP LEWIS BERGER SILK GLAMOR	3335354 As of 12.08.2016	16	Paper, Paper Stationery, Newspaper, Periodicals, books, Magazines, Paper Articles, Printed Matters, Office Requisites, Instructional and Teaching Materials, Files, Publications, Pads, Posters, Calenders, Pamphlet, Computer Printout, Computer Programmes, Stationery for Computers, Journals, forms, Manuals, Photographs, Cards, Guide Books.	Registered
28.	XP BERGER SILK GLAMOR	3335355 As of 12.08.2016	17	Insulating Varnishes.	Registered
29.	LEWIS BERGER SILK GLAMOR	3335350 As of 12.08.2016	35	Wholesale, Retail Outlet & Departmental Store, Showroom To Enable the Customers To View And Purchase of Paints, Primers, Chemical products and Paint related products,	Registered

				Wholesale & Retail outlets and shops including services relating To distribution, trading and marketing of Paints, Primers, Chemical products and Paint related products, Advertising, Radio Adverting and Commercials, Television Adverting and Commercials, Creating Advertisement Films, Providing Online Shopping Services, Business Management and Business Administration.	
30.	LEWIS BERGER SILK GLAMOR	3335351 As of 12.08.2016	37	Painting (interior and exterior) repairing and renovation of building (interior and exterior), building construction Insulating Varnishes.	Registered
31.	LEWIS BERGER SILK GLAMOR	3335349 As of 12.08.2016	17	Insulating Varnishes.	Registered
32.	Duniya Dekhegi Jab SILK	2765810 As of 01/07/2014	37	Painting (Interior and Exterior),	Registered

	Se Saje Zindagi			Repairing and Renovation of Building (Interior and Exterior).	
33.	Duniya Dekhegi Jab SILK Se Saje Zindagi	2765809 As of 01/07/2014	35	Wholesale, Retail Outlet & Store, Showroom To Enable The Customers To View And Purchase of Paints, Primers, Chemical products and Paint Related products, Wholesale& Retail outlets and shops including services relating To distribution, trading and marketing of Paints, Primers, Chemical products and Paint related products, Advertising, Radio Advertisingand Commercials, Television Advertising and Commercials, Creating Advertisement Films, Providing Online Shopping Services.	Registered
34.	Experience Silk	2765812 As of 01/07/2014	35	Wholesale, Retail Outlet & Store, Showroom To Enable The	Registered

				Customers To View And Purchase of Paints, Primers, Chemical products and Paint Related products, Wholesale & Retail outlets and shops including services relating To distribution, trading and marketing of Paints, Primers, Chemical products and Paint related products, Advertising, Radio Advertising and Commercials, Television Advertising and Commercials, Creating Advertisement Films, Providing Online Shopping Services.	
35.	Experience Silk	2765813 As of 01/07/2014	37	Painting (Interior and Exterior), Repairing and Renovation of Building (interior and Exterior).	Registered

6. The plaintiff company in order to promote its reputed trade mark "SILK" and its variants made extensive publicity campaign, advertisements in various media and other sales promotional campaigns, in such a



manner that the said brand/name/trademark "SILK" and its variants subliminally sticks in the minds of the consumers as the product of the plaintiff company.

- 7.** In the first part of December' 2019, the plaintiff came to know that the defendant who is a new comer on the field of paints, has been pushing their paint products with the mark "SILK" under the grab of expression "HALO". The plaintiff has issued a legal notice dated 4<sup>th</sup> December, 2019, to the defendant calling upon the defendant to immediately cease and desist from using the Trade Mark of the plaintiff "SILK" either standalone or in conjunction with the other trade mark, together with "HALO", for the paint products and also to refrain from making any advertisement and promotion of the products with the mark "SILK". The defendant had sent a reply by denying to comply with the requisitions made on behalf of the plaintiff.
- 8.** Mr. Surajit Nath Mitra, Learned Senior Advocate representing the plaintiff submitted that the trade mark containing the expression "SILK" adopted by the defendant constitutes infringement of the plaintiff's well known and registered trade mark "SILK" and variants thereof, besides a violation of the plaintiff's common law rights in the said trade mark. The defendant adopted the trade mark wantonly and knowing fully well about the plaintiff's business carried under the reputed trade mark "SILK" as well as statutory rights therein.

9. Mr. Mitra submitted that in order to put a shield on the notoriety and impropriety in the adoption of the trade mark “SILK” for paint products has been pushing the products with the name or expression “HALO SILK”. The adoption of the expression/ mark “SILK” for the paint products by the defendant, even as the part of the trade mark is not permissible and certainly is an act of infringement of the plaintiff’s reputed and registered trade mark “SILK” and variants thereof.
10. Mr. Mitra submitted that the defendant has deliberately adopted the plaintiff’s reputed and registered trade mark “SILK” on its products, in order to derive wrongful advantage and to trade upon the enormous popularity, goodwill and reputation of the plaintiff’s products.
11. Mr. Mitra submitted that the defendant has no right and is not entitled to use the plaintiff’s trade mark “SILK”. The defendant was aware of the fact that the trade mark “SILK” or its variants thereof is the sole and exclusive property of the plaintiff, particularly for paint products and the plaintiff alone has the right to exploit the same.
12. Mr. Mitra in support of his case has relied upon the following case laws:
  - i. *1989 (9) PTC 14 (Cal) (Express Bottlers Services Pvt. Ltd. –vs- Pepsi Inc. & Ors.)*.
  - ii. *2004 (29) PTC 435 (Del) (Dr. Reddy’s Laboratories Ltd. –vs- Reddy Pharmaceuticals Limited)*.
  - iii. *AIR 1955 SC 558 (Registrar of Trade Mark –vs- Ashok Chandra Rakhit Ltd.)*.

- iv. 1984 SCC OnLine Del 465: 1984 PTC 102 (Charan Dass & Veer Industries (India) -vs- Bombay Crockery House).*
- v. 2016(66) PTC 1[SC] (S. Syed Mohideen -vs- P. Sulochana Bai).*
- vi. 2015 SCC OnLine Cal 3866 (Khadim India Ltd. - vs- Lifestyle International Private Ltd.).*

- 13.** *Per contra*, Mr. Ranjan Bachawat, Learned Senior Advocate representing the defendant submitted that the expression “SILK” on the defendants packaging is not used as a trade mark or in the trade mark sense, but only with a view to describe and identify the characteristics /quality/finish offered by its product variants. He submits that the use of term “SILK” by the defendant does not constitute infringement as contemplated under the Trade Marks Act.
- 14.** Mr. Bachawat submitted that that the expression “SILK” is being used only as description to indicate the kind and characteristic of the paint’s finish and texture and not as a trade mark. He submits that the expression “SILK” as used upon the range of products sold under the house mark “JSW PAINTS” and bearing the product identification mark HALO,AQUAGLO,AURUS or PIXA is a common industry jargon for explaining the type of paint finish that has a mid-shine finish and is easy to maintain considering that surfaces with “SILK” finish can be wiped.
- 15.** Mr. Bachawat submitted that the use of the expression “SILK” for paint finish is customary in the trade and is not capable of being protected as

a trade mark with respect to paints, emulsions and distempers. He submits that no amount of use of the said term can provide any exclusive right in the said term in one manufacturer of paints to the exclusion of another. He submits that the plaintiff is attempting to claim a monopoly in the term "SILK" in respect of paints which is not permissible under law. He submits that the plaintiff has sought to claim exclusive right in the term "SILK" but the plaintiff has failed to demonstrate any statutory or common law with regard to the same.

- 16.** Mr. Bachawat submitted that the registration sought to be relied upon by the plaintiff subject to disclaimers and the conditions imposed by the Registrar of Trade Mark who is the statutory authority on the Trade Marks in India. He submits that the plaintiff is not entitled to claim any exclusive right over word "SILK" per-se.
- 17.** Mr. Bachawat submitted that in the month of January' 2020, the defendant has filed Trade Mark Application Nos. 4416451 in Class 2 and 4416452 in Class 2 for the labels being used for the silk finish variant for the product bearing the mark "HALO". He submits that the application filed by the defendant were directly accepted and advertised by the Registrar of Trade Mark and they were not considered to be similar to any other trade mark in the Trade Mark Register.
- 18.** Mr. Bachawat submitted that the term "SILK" forms a part of any other registrations obtained by the petitioner, such registrations cannot in law confer any monopoly or exclusive rights in favour of the petitioner

in the descriptive term SILK in view of the express language of Section 17 of the Trade Marks Act irrespective of whether or not a disclaimer or condition has been imposed upon the petitioner.

**19.** Mr. Bachawat relied upon the following case laws in support of his case:

- i. *(2018) 16 SCC 632 (Parakh Vanijya Private Limited –vs- Baroma Agro Product and Others).*
- ii. *2010 SCC Online Cal 134 (Three –N-Product Private Limited –vs- Emami Limited).*
- iii. *ILR(2010) II Delhi 85 (Cadila Health Care Ltd.-vs- Gujrat Co-operative Milk Marketing Federation Ltd.&Ors).*
- iv. *2021 SCC Online Cal 3068 (Shree Ganesh Besan Mills and Others –vs- Ganesh Grains Limited and Another).*

**20.** It is relevant to extract the relevant provisions of the Trademarks Act, 1999 (“the Act”):

**Section 2(1)(h): ‘deceptively similar’**— A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;

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**Section 29. Infringement of registered trademarks**— (1) A Registered trade mark is infringed by a person who, not being registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is

registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods on services covered by such registered trade mark is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(c) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labeling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall construed accordingly.

**21.** A trademark, it is said, denotes a connection in the course of trade between a manufacturer and his goods. It is an identification characterized famously as “a badge of origin”. An important aspect here is that the mark should be distinctive; it should be capable of distinguishing the goods and services of one from another. The heart of trademark protection revolves around protecting consumers from being misled. Trademarks impart source and producer identifying cues (or markers), and thereby provide consumers with the means to make judgments concerning the goods before sampling or purchasing them. One of the essential conditions for protection is that the mark should have acquired some distinctiveness, and the claim for that is not founded on mere continued use. The unfair use of a mark which is identical, or similar to the trademark in question leads the courts, in infringement actions, to examine the rival marks, as a whole, to determine the scope or potentiality or likelihood of confusion. This was explained in **Durga Putt Sharma v. Navaratna Pharmaceuticals Laboratories, (1965) 1 SCR 737** once the use by the defendant of the mark which is claimed to infringe the plaintiffs mark is shown to be “in the course of trade”, the question whether there has been an



infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiffs registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered. A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks, the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiffs mark. The purpose of the comparison is for determining whether the essential features of the plaintiffs trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in

essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff. These tests have been applied in subsequent decisions reported as **F. Hoffman La Roche & Co v. Geoffrey Manner Co Pvt) Ltd. 1969(2) SCC 716; Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73,** and **Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel, (2006) 8 SCC 726.** In the last decision (Ramdev) the Supreme Court noted the decision of the European Court in **Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc., 1999 RPC 117** to the following effect:

*“28. That case concerned the interpretation of Article 4(1)(b) of the directive insofar as it refers to ‘a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark’. The court explained that it had been submitted that ‘the likelihood of association may arise in three sets of circumstances: (1) where the public confuses the sign and the mark in question (likelihood of direct confusion); (2) where the public makes a connection between the proprietors of the sign and those of the mark and confuses them (likelihood of indirect confusion or association); (3) where the public considers the sign to be similar to the mark and perception of the sign calls to mind the memory of the*

*mark, although the two are not confused (likelihood of association in the strict sense) (para 16 of the judgment).*

*29. The court stated that it was therefore necessary to determine ‘whether Article 4(1)(b) can apply where there is no likelihood of direct or indirect confusion, but only a likelihood of association in the strict sense’ (para 17 of the judgment). It concluded: ‘The terms of the provision itself exclude its application where there is no likelihood of confusion on the part of the public’ (para 18 of the judgment). Thus, the court held that ‘the mere association which the public might make between two trademarks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion’ within the meaning of Article 4(1)(b).*

*40. That view is also confirmed by the judgment of the court in Sabel, in which it held that the ‘likelihood of confusion must ... be appreciated globally, taking into account all factors relevant to the circumstances of the case’ (at para 22). It is true that that statement was made in a different context: the court was there considering the question whether conceptual similarity of the marks alone could give rise to confusion within the meaning of Article 4(1)(b), in a situation in which the goods in question were clearly the same. However, the statement is one of general application.”*

**22.** As Section 29(1) and (2) of the Act clarify, infringement actions cover resemblance or deceptive similarity between a registered mark and

another, in relation to the same or similar goods. In such case, *if the requisite degree of resemblance is established, infringement has to be presumed*, by virtue of Section 29(3). However, the legislature has devised a slightly different standard in case of infringement of trademarks, where the goods or products are not similar, but are dissimilar. This is, in Trademark law parlance, known as action for trademark dilution.

- 23.** The old law in India, i.e the Trade and Merchandise Marks Act, 1958, did not provision for trademark dilution, as in the case of Section 29(4). The principle of dilution therefore, was developed by our courts, having regard to internationally recognized standards about the need to protect generally well known trademarks, whose exploitation, without any good cause in relation to diverse and dissimilar products or services could injure and “dilute” its appeal. Thus, in ***Daimler Benzaktiegesellschaft v. Eagle Flask Industries Ltd., ILR (1995) 2 Del 817*** this court held that:

“14. There are marks which are different from other marks. There are names and marks which have become household words. Mercedes as name of a Car would be known to every family that has ever used a quality car. The name “Mercedes” as applied to a car, has a unique place in the world. There is hardly one who is conscious of existence of the cars/automobiles, who would not recognize the name “Mercedes” used in connection with cars. Nobody can plead in India, where “Mercedes” cars are seen on roads, where “Mercedes” have collaborated with TATAs, where

there are Mercedes Benz—Tata trucks have been on roads in very large number, (known as Mercedes Benz Trucks, so long as the collaboration was there), who can plead that he is unaware of the word “Mercedes” as used with reference to car or trucks;

15. In my view, the Trade Mark law is not intended to protect a person who deliberately, sets out to take the benefit of somebody else's reputation with reference to goods, especially so when the reputation extends worldwide. By no stretch of imagination can it be said that use for any length of time of the name “Mercedes” should be not, objected to.

16. We must keep in mind that the plaintiff company exists in Germany. An insignificant use by too small a product may not justify spending large amounts needed in litigation. It may not be worthwhile.

17. However, if despite legal notice, any one big or small, continues to carry the illegitimate use of a significant world wide renowned name/mark as is being done in this case despite notice dated 04-07-1990, there cannot be any reason for not stopping the use of a world reputed name. “None should be continued to be allowed to use a world famed name to goods which have no connection with the type of goods which have generated the world wide reputation.

18. In the instant case, “Mercedes” is a name given to a very high priced and extremely well engineered product. In my view, the defendant cannot dilute that by user of the name Mercedes with respect to a product like a thermos or a casserole.”

The observations have been assimilated in case law, by the courts in India, and applied, wherever trademark dilution was alleged (***Ref Larsen & Toubro Limited v. LachmiNarain Traders, ILR (2008) 2 Del 687, Sunder ParmanandLalwani and Ors. v. Caltex (India) Ltd., AIR 1969 Bombay 24; Bata India Ltd. v. M/s. Pyare Lal & Co. Meerut City, AIR 1985 All 242; Kiriloskar Diesel Recon (P) Ltd. v. Kirloskar Proprietary Ltd., AIR 1996 Bom 149.***

24. The Act, as existing is not explicit about dilution-it does not refer to that term. Yet, the entire structure of Section 29(4) is different from the earlier part, and in effect expresses Parliamentary intent about the standards required for a plaintiff to establish dilution of its trademark, in relation to dissimilar goods or products. This is because:

*(1) The “likelihood of Confusion” test which is the essential basis of Trademark law, is not incorporated in relation to infringement of the kind Section 29(4) envisions. Section 29(1) — which talks of trademark infringement, generally, prescribes that the impugned mark should be “identical with, or deceptively similar to” the registered trademark. Section 29(2), (which deals with trademark infringement) enacts that the impugned mark should be similar or identical with the registered mark, as to cause confusion in relation to similar goods. The emphasis on similar goods is the recurring theme in each of the sub clauses (a), (b) and (c)) and the identity/similarity requirement along with the similarity of goods are twin, conditions (established by the use of the conjunctive “and”).*

*However, Section 29(4) posits identity or similarity of the mark alone but, in relation to dissimilar goods.*

*(2) The object of the “dilution” form of infringement (under Section 29(4)) in effect, is a wider trademark protection without the concomitant likelihood of confusion requirement, as it is in respect of dissimilar or unrelated products and services.*

*(3) The confusion requirements under Section 28 are different from those under Section 29(4). Section 29(4) does not refer to the need for proving confusion anywhere in the relevant portions. Obviously the emphasis here is different.*

*(4) The plaintiff has to establish, under Section 29(4) apart from the similarity of the two marks (or their identity) that his (or its) mark—*

*(i) has a reputation in India;*

*(ii) the use of the mark without due cause*

*(iii) the use (amounts to) taking unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.*

*(5) Importantly, there is no presumption about trademark infringement, even if identity of the two marks is established, under Section 29(4). In contrast, Section 29(3) read with Section 29(2)(c) enact that if it is established that the impugned mark's identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark, “the court shall presume that it is likely to cause confusion on the part of the public.”*

25. The test of similarity or confusion had been indicated, in **Sabel BV v. Puma AG, [1998] RPC 199** as follows:—

*“... The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case....That global appreciation of the visual, aural or conceptual similarity or the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components ... The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”*

It was held, in **Adidas-Salomon AG v. Fitnessworld Trading Ltd., 0041 Ch 120**, that it is not necessary to establish confusion or the likelihood of confusion in order to establish infringement under this head. The plaintiff has to show that there is sufficient degree of similarity between the mark with a reputation and the sign (i.e. the impugned mark) to have the effect that the relevant section of the public establishes a link between the sign and the mark. The court also cautioned that all tests have to be cumulatively satisfied, or else the courts would be indulging in over-protection to the registered mark, affecting competition:

*‘Above all, it is necessary to give full weight to the provisions of Article 5(2) as a whole. Thus the national court must be satisfied in every case that the use of the contested sign is without due cause; and that it takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark. These requirements, properly applied, will ensure that marks with a reputation, whether or not the reputation is substantial, will not be given unduly extensive protection.’*

26. Explaining what is meant by “reputation” it was held, in **General Motors Corp v. Yplon SA, [1999] All ER (EC) 865 by the ECJ** that in



order to have a reputation a trade mark had to satisfy a 'knowledge threshold'. This was described as follows:

*"26 The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.*

*27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."*

**27.** The need to establish "linkage" or mental association of the offending mark, with that of the plaintiffs is one of the vital essentials for securing relief in any claim for dilution. This was emphasized as follows, by Professor McCarthy (McCarthy, J. Thomas. McCarthy on *Trademarks and Unfair Competition*, Vol. IV, 4th ed. 1996 (loose leaf updated December 2005, release 36):

"... if a reasonable buyer is not at all likely to think of the senior user's trademark in his or her own mind, even subtly or subliminally, then there can be no dilution. That is, how can there be any "whittling away" if the buyer, upon seeing defendant's mark, would never, even unconsciously, think of the plaintiffs mark? So the dilution theory presumes some kind of mental association in the reasonable buyer's mind between the two parties and the mark."

“On the one hand, well-known mark owners say that people should not reap where they have not sown, that bad faith should be punished, that people who sidle up to their well-known marks are guilty of dishonest commercial practice. These vituperations lead nowhere. One might as well say that the well-known mark owner is reaping where it has not sown when it stops a trader in a geographic or market field remote from the owner's fields from using the same or a similar mark uncompetitively.

- 28.** The discussion on the subject would not be complete without a reference to the judgment of the European Court, on the issue, in ***Intel Corp Inc v. CPM United Kingdom Ltd., 2009 ETMR 13***. The claimant, Intel Corp Inc, registered trademark proprietor in respect of various marks, in the United Kingdom and several European countries, sued Intel-mark, the user of “Intel” in relation to telemarketing services. The courts in the United Kingdom had refused relief, holding that there was no dilution of the mark “Intel” despite its “huge” reputation; nevertheless the Court of Appeals made a reference to the European Court, which concurred with the view of the domestic courts. In the judgment, it restated the principles governing the field, as follows:

*“44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.*

*45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.*

46 *It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.*

47 *The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see General Motors, paragraph 24).*

48 *It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later, mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.*

49 *Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.*

50 *Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.*

51 *It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.*

52 *In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.*

53 *For the purposes of assessing where there is a link between the conflicting marks, it may therefore be*

*necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.*

*54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.*

*55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.*

*56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique — that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets — it must be ascertained whether the earlier mark is unique or essentially unique.*

*57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C5-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 17, and Case C-533/06 O2 Holdings and O2 (UK) [2008] ECR I-0000, paragraph 59).*

*58 However, as is apparent from paragraphs 27 to 31 of the judgment in Adidas-Salomon and Adidas Benelux, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.*

*59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.*

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

64 The fact that:

— the earlier mark has a huge reputation for certain specific types of goods or services, and  
 — those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and  
 — the earlier mark is unique in respect of any goods or services, does not necessarily imply that there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks....”

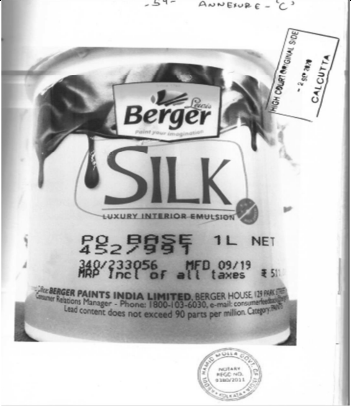



**29.** It may be seen from the preceding discussion that the dilution of trademark, is a species of infringement. Though trademarks are concerned with protection of marks which have acquired a degree of

distinctiveness, in relation to particular goods and services, courts have, over the years recognized that in relation to marks which have achieved notoriety as to have a reputation about the quality of products which the manufacturer, or services the originator (of the mark) is associated with, then, even in relation to dissimilar goods — or unrelated products, protection of such brand name, mark or acquired distinctiveness is essential. This measure of protection to marks in relation to similar junior marks, but for dissimilar goods is, in substance the protection against dilution (or Blurring or tarnishment) of the mark. Prior to the 1999 Act. Indian law had developed through case law; the new Act changed that, and has enjoined protection against dilution, if certain essential elements are established; they are:

- (1) The impugned mark is identical or similar to the senior mark;
- (2) The senior or injured mark has a reputation in India;
- (3) The use of the impugned mark is without due cause;
- (4) The use of the impugned mark (amounts to) taking unfair advantage of, or is detrimental to, the distinctive character or reputation of the registered trade mark.

Unlike in the case of infringement of trademark in relation to similar goods or services, in the case of dilution (infringement of mark by use in respect of dissimilar goods or services) there is no presumption of infringement of the mark. This means that each element has to be established.

**30.** The plaintiff here relies on exclusive materials in the form of brochures, sale figures and brand awareness of its paint Berger SILK. The mark of the plaintiff and the mark of the defendant are as follows :

Mark of the Plaintiff	Mark of the Defendant
	
	

**31.** The plaintiff has annexed registration certificate of the Trade Mark of SILK, LUXOL SILK, Berger SILK, Berger SILK DESIGNZZ, Berger SILK GLAMOR and Experience Silk.

**32.** As per the Trade Mark registration of the defendant the Trade Mark is JSW Paints HALO and Aurus. The Trade Mark image is :



- 33.** From the documents annexed by both the parties in their pleading, it is admitted that the defendant is also using the word “SILK” but the defendant submits that the defendant is not using the word “SILK” as Trade Mark. The use of the expression “SILK” for paint finish is customary in the trade and is not capable of being protected as trademark with respect of paints, emulsions and distempers.
- 34.** The judgment reported in **2004 (29) PTC 435 (Del) (Dr. Reddy’s Laboratories Ltd. -vs- Reddy Pharmaceuticals Limited)**, which reads as follows:

*“17.Learned counsel for the defendant has vehemently argued that the plaintiff is not entitled to this discretionary relief on account of its acquiescence and laches in objecting to the use of trade mark “Reddy” by the defendant company. It is submitted that since 1997 the plaintiff knew that the defendant is trading and functioning under the trade name “Reddy” but it never objected and to the contrary it kept on having*



*business dealings with the defendant and appointed him a Delcredere Agent in April, 2003. This plea of the defendant is also prima facie untenable for the reason that till August, 2003 there was no clash of interests between the plaintiff and defendant company and in fact the defendant was engaged in advancing and promoting the business of the plaintiff company by acting as its agent for the sale of bulk drugs. The threat came in August, 2003 when the defendant introduced in the market its pharmaceutical preparations and thereby threatened the business interests of the plaintiff company. This move of the defendant was mala fide on the face of it as it was not manufacturing pharmaceutical preparations earlier but now it was trying to market the pharmaceutical preparations manufactured by others under the trade mark "Reddy". The plaintiff immediately raised objections, meetings were held and when nothing came out the plaintiff rushed to the Court. As such there was neither any acquiescence nor any laches on the part of the plaintiff to object to the impugned action of the defendant. It cannot be said that the plaintiff has allowed the defendant to build a reputation or goodwill in trade name "Reddy" for use on pharmaceutical preparations. Moreover, the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of "Taj Hotel", the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interests and starts misleading and confusing their customers."*

In the case of **Dr. Reddy's Laboratories**, the Court found that the plaintiff product "OMEZ" was copied by the defendant by introducing the same drug under the brand name "OMRE" with a similar strip,

design and wrapper. The defendant introduced “RECOLITE” also in place of plaintiff product “MUCOLITE”. All these actions of the defendant have no room for doubt that the intention of the defendant was to deceive and encash upon the reputation and goodwill of plaintiff in the trade mark “Dr. Reddy’s” by using the trade mark “Reddy” and thereby induce the purchasers/ consumers to purchase its products under an impression that the product have been manufactured and produced by the plaintiff company. In the present case there is no case of fraud and the defendant is not using the word SILK as trademark. The said case has no application to the facts of the present suit. The said case pertained to a case of dishonest adoption of the trade mark “Dr.Reddy” by a declared agent. The defendant, being the agent of the plaintiff, had dishonestly appropriated the mark “Dr. Reddy”. Even in the domain name, the defendant had purported to dishonestly use the mark “Dr. Reddy” with a fraudulent intent.

35. The judgment reported in **AIR 1955 SC 558 (Registrar of Trade Mark -vs- Ashok Chandra Rakhit Ltd.)**, which reads as follows:

*“8. The third thing to note is that the avowed purpose of the section is not to confer any direct benefit on the rival traders or the general public but to define the rights of the proprietor under the registration. The registration of a trade mark confers substantial advantages on its proprietor as will appear from the sections grouped together in Chapter IV under the heading “Effect of Registration”. It is, however, a notorious fact that there is a tendency on the part of some proprietors to get the operation of their trade marks expanded beyond their legitimate bounds. An illustration of an attempt of this kind is to be found in In re*

*Smokeless Powder Co.'s Trade Mark.* Temptation has even led some proprietors to make an exaggerated claim to the exclusive use of parts or matters contained in their trade marks in spite of the fact that they had expressly disclaimed the exclusive use of those parts or matters. Reference may be made to *Greers Ltd. v. Pearman and Corder Ltd.* commonly called the “Banquet” case. The real purpose of requiring a disclaimer is to define the rights of the proprietor under the registration so as to minimise, even if it cannot wholly eliminate, the possibility of extravagant and unauthorised claims being made on the score of registration of the trade marks.

**9.** *The last feature of the section is its proviso. That proviso preserves intact any right which the proprietor may otherwise under any other law have in relation to the mark or any part thereof. The disclaimer is only for the purposes of the Act. It does not affect the rights of the proprietor except such as arise out of registration. That is to say, the special advantages which the Act gives to the proprietor by reason of the registration of his trade mark do not extend to the parts or matters which he disclaims. In short, the disclaimed parts or matters are not within the protection of the statute. That circumstance, however, does not mean that the proprietor's rights, if any, with respect to those parts or matters would not be protected otherwise than under the Act. If the proprietor has acquired any right by long user of those parts or matters in connection with goods manufactured or sold by him or otherwise in relation to his trade, he may, on proof of the necessary facts, prevent an infringement of his rights by a passing off action or a prosecution under the Indian Penal Code. Disclaimer does not affect those rights in any way.”*

The above case dealt with the rectification of a mark “Shree”. It has been specifically held in the said case that the Registrar may well have thought that the fact that all other traders who had got their trade marks containing the word “Shree” registered had to submit to a disclaimer of the word “Shree”, whereas the respondent company had

got its trade mark containing the word “Shree” registered without a disclaimer was calculated to cause embarrassment to other traders and might conceivably encourage the respondent company to contend that the registration of its trade mark by itself and without further evidence gave it a proprietary right to the exclusive use of the word “Shree”. The Hon’ble Supreme Court held that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole.

36. The judgment reported in **2015 SCC OnLine Cal 3866 (Khadim India Ltd. -vs- Lifestyle International Private Ltd.)**, which reads as follows:

*“22. A trade mark is undoubtedly a visual device; but it is well-established law that the ascertainment of an essential feature is not to be by ocular test alone. Since words can form part, or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words. Thus it has long been accepted that, if a word forming part of a mark has come in trade to use to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader, for confusion is likely to result. It is sufficient to refer to the words of Lord Cranworth L.C., in *Seixo v. Provezende* (1866 LR 1 Ch. 192) ‘If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of that rival as the actual copy of his device’. The likelihood of confusion or deception in such cases is*

*not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole”.*

In the case of ***Khadim (Supra)***, the plaintiff had registration in the word mark “PRO” and the plaintiff was also the owner of a label mark comprising the word “PRO” with stylized design and was also the owner of copyright of its mark by virtue of registration. But in the present case, the registration mark of the plaintiff “SILK” is beset with disclaimers/limitations/conditions and thus the case referred by the Counsel for the plaintiff is distinguishable from the facts of the present case.

37. The judgment reported in ***ILR (2010)II DELHI 85 (Cadila Health Care Ltd.-vs- Gujarat Co-Operative Milk Marketing Federation Ltd.&Ors.)*** wherein the Delhi High Court held that :

*“14. In consonance with the above view we are also not in a position to agree with the appellant that the word Sugar Free' has become so distinctive of the sugar substitute and has acquired such a secondary meaning in the sugar substitute market that it cannot refer to any other food product except the appellant's sugar substituted product labelled Sugar Free'. There cannot be any doubt that the word sugar free' is not inherently distinctive and is clearly descriptive in nature. In fact, the word Sugar Free' in essence clearly only describes the characteristics of the appellant's product and therefore, cannot afford it the*

*protection sought in the plaint by restraining the respondent from using the phrase sugar free'. Sugar Free', prima facie has not attained any distinctiveness, as alleged by the appellant outside the field of sugar substitute artificial sweeteners and the appellant would not be entitled to exclusively claim the user of the expression sugar free' in respect of any product beyond its range of products and the respondent cannot be restrained from absolutely using the expression Sugar Free', particularly in the descriptive sense. A mere descriptive usage of the expression Sugar Free' by the respondent may thus blunt the edge of claim of distinctiveness by the appellant. However, we make it clear that if any party enters into the domain of artificial sweeteners with the trademark Sugar Free' the appellant may have a just cause in seeking restraint."*

**38. The judgment reported in 2021 SCC Online Cal 3068 (Shree Ganesh Besan Mill and Others -vs- Ganesh Grains Limited and Another)**

wherein the Hon'ble Division Bench of this Court held that :

**111.** *As the word mark Ganesh is very common to the flour trade generic, non-distinctive and moreover as it is the name of a most popularly worshipped Hindu god, the registration of this mark in favour of the respondent No. 1 prima facie appears to be invalid. The respondents do not have any exclusive right of ownership of this mark. They cannot restrain the appellants from using the word mark "Ganesh", in an infringement action.*

**112.** *However in my opinion the respondents have a proprietary right over the label mark or trade dress under which their goods are sold, containing the word mark "Ganesh" along with artistically coloured designs. Specially important in this trade dress is the character, size, font and style of writing "Ganesh" prominently, accompanied by the above colour combination and design. In my opinion the appellants have imitated the character, size, font and style of writing "Ganesh". The prominence of "Ganesh" in their label mark also containing the word mark "Ganesh" and colourful designs is such, that the*

*label resembles the trade dress of the respondents, causing deception and confusion in the trade. The appellants seem to be trading on the goodwill of the respondents. In those circumstances, an action in passing off action lies. The respondents have been able to make out a prima facie case in passing off.*

**113.** *The appellants are entitled to use the mark “Shree Ganesh” under Section 35 of the Trademarks Act, 1999.*

**114.** *Considering all the circumstances the impugned interim order granting a blanket injunction restraining use by the appellants of the respondents' trademark is modified to the extent that they will be entitled to use the label mark with the following modifications:*

**115.** *The word “Ganesh” in isolation cannot be used. The words: “Shree Ganesh Besan Mill” has to be written on the label in the same character font and style and in a non-prominent way, differently from the style in which it is written on the label of the respondents' products. The place of manufacture Raipur, Chhattisgarh should also be mentioned so as not to cause any confusion or deception in the trade.”*

- 39.** The judgment reported in **(2018) 16 SCC 632 (ParakhVanijya Private Limited -vs- Baroma Agro Product and Others)** wherein the Hon'ble Supreme Court held that :

**“5.** *The appellant is the registered owner of the label mark in Class 30 in respect of rice, flour and preparations made from cereals, bread, cakes, biscuits, pastry and spices. The appellant sells biryani rice and the most prominent feature of its label mark is the word “MALABAR”. The appellant-plaintiff is granted registration in Class 30 for its products. Class 30 of the classification of goods and services under the statute covers diverse spices and other edible materials as wheat, rice, coffee, tea, etc. In the registration under Class 30, there is a disclaimer for the word ‘MALABAR’. The disclaimer is worded thus:*



*“Condition & Limitation : Registration of this trade mark shall give no right to the exclusive use of word ‘MALABAR’ and all other descriptive matters.”*

**6.** *The appellant though claims exclusive right over the word “MALABAR” since there is a disclaimer to the exclusive use of the word “MALABAR”, the appellant has no right over the exclusive use of the word “MALABAR”. The respondents have also inter alia brought on record the materials to show the registration of other goods under Class 30 with the word “MALABAR MONSOON” granted in favour of Amalgamated Bean Coffee Trading Co. Ltd. for coffee cream, coffee included in Class 30. The registration of the mark “MALABAR MONSOON” under Class 30 also contains similar disclaimer of the word “MALABAR”. Likewise, the label “MALABAR COAST” has been registered in Class 30 for coffee, tea, cocoa, sugar, etc. in favour of Tropical Retreats (P) Ltd. which again contains a similar disclaimer for the exclusive use of the word “MALABAR COAST”. Having regard to the materials placed on record, we are of the view that the High Court rightly held that the appellant cannot claim exclusive right over the use of the word “MALABAR”.*

**7.** *Insofar as the label mark used by the parties is concerned, we have perused the label mark of the appellant selling biryani rice with word “MALABAR” and also the modified label mark of the respondents. The label of the respondents containing the words “BAROMA”, “MALABAR”, “GOLD” are circled having a different get-up from that of the appellant. By comparison of the two label marks, in our view, both appear to be substantially different. There appears to be no similarity between both the labels, more so, deceptive similarity. Keeping in view the interest of the respective parties who are said to be having substantial turnover in their respective business, the High Court rightly held that the respondents would be entitled to use the word “MALABAR” in conjunction with “BAROMA” with the different get-up as approved by the High Court. We do not find any serious infirmity warranting interference with the impugned order.*



- 40.** In the present case in the Trade Mark applications of the plaintiff being Application No.2598721, Class-02; Application No. 988901, Class-2; Application No. 2322923, Class-17 and Application No. 2641642,Class-2, conditions have prescribed as follows : *“Registration of this Trade Mark shall give no right to the exclusive use of the word silk except as depicted”*
- 41.** It is also not denied that reputed emulsion manufacturers like Asian Paints, Dulux, Shalimar, Nerolac, Crown Trade and Johnstone’s market emulsion of certain high sheen finish by describing the same as “SILK” which refers to finish of the product.
- 42.** The defendant sells its product under the mark “HALO” wherein the word “SILK” is the ultimate finish of the paint sold under the mark “HALO”. The “SILK” finish is one of many, such as matt,satin,gloss all of which are marked by the defendant under the mark “HALO”. It is the specific case of the defendant that the defendant has not applied for the registration of the mark “SILK” and the defendant does not intent to market its product under a trade mark “SILK”.
- 43.** The products of the defendant are sold under the mark “HALO”, such as, with the word “Silk” being used only to define the finish/sheen of the paint. The plaintiff’s product under the mark “SILK” are sold in the following manner.

Mark of the plaintiff	Mark of the defendant
	

Thus, the packaging, shape of container and the colour scheme of the products of the plaintiff and the defendant are completely different.

- 44.** This Court perused the label mark of the plaintiff selling Berger Paint with the word “SILK” and the label mark of the defendant selling JSW paint “HALO” containing the word “SILK”. By comparison of the two marks, in my view both appears to be substantially different and there is no similarity between both the labels.
- 45.** Upon examining the containers and labels, this Court found that there is no actual similarity between the marks “SILK” of both the plaintiff and the defendant. This Court held that the plaintiff failed to establish deceptive similarity. In view of the above, the prayer for injunction as prayed for the plaintiff is refused.
- 46. G.A. No. 1 of 2020** is thus **dismissed**.

**(Krishna Rao, J.)**