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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
 + CS(COMM) 268/2021, I.A. 7170/2021 & I.A. 9591/2021

Reserved on: 23 May 2023
Pronounced on: 18 September 2023

PEPSICO INC. & ANR. Plaintiffs
 Through: Mr. Amarjit Singh Chandhiok,
 Sr. Adv. with Mr. Manish Jha, Mr. Dhruv
 Nagar, Ms. Avni Sharma. Advs.

versus

PARLE AGRO PRIVATE LIMITED Defendant
 Through: Mr. Sudhir Chandra, Sr. Adv.
 with Mr. Ankur Sangal, Ms. Pragya Mishra
 and Mr. Shashwat Rakshit, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T
18.09.2023

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I.A. 7170/2021 (under Order XXXIX Rules 1 and 2 of the CPC) & I.A. 9591/2021 [under Section 124 (1)(a)(ii)]

1. This judgment decides IA 7170/2021 filed by the plaintiffs, PepsiCo, Inc. and PepsiCo India Holdings Private Ltd. (who would be referred to, hereinafter, collectively as “PepsiCo”) under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC) and IA 9591/2021 filed by the defendant Parle Agro Private Limited (“Parle” hereinafter) under Section 124(1)(a)(ii)¹ of the Trade Marks

¹124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.—
 (1) Where in any suit for infringement of a trade mark—
 (a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or



Act, 1999.

The *lis*

2. The somewhat non-descript and unassuming tagline “For The Bold” forms the fulcrum of controversy in this litigation, between two corporate giants.

Proceedings

3. CS (COMM) 268/2021 has been instituted by PepsiCo against Parle, seeking a permanent injunction against Parle using the tagline “For The Bold” in relation to its products, as PepsiCo holds a valid and subsisting trade mark registration for the said tagline “For The Bold” in Class 30. With the suit, PepsiCo has filed IA 7170/2021, seeking an interlocutory injunction.

(b) the defendant raises a defence under clause (e) of sub-section (2) of Section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark, the court trying the suit (hereinafter referred to as the court), shall, —

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the High Court, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is *prima facie* tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.



4. During the pendency of the suit, Parle has filed IA 9591/2021 under Section 124(1)(a)(ii) of the Trade Marks Act, for grant of leave to Parle to file a rectification petition challenging the registration of PepsiCo's "For The Bold" trade mark.

5. This judgment disposes of IA 7170/2021 and IA 9591/2021.

Rival Stands

6. Arguments on behalf of PepsiCo were led by Mr. Amarjit Singh Chandhiok, learned Senior Counsel and arguments on behalf of Parle were led by Mr. Sudhir Chandra, learned Senior Counsel.

Submissions of PepsiCo

7. Among the products of PepsiCo which are consumed by young and old is the DORITOS range of tortilla chips.

8. DORITOS was adopted as the brand name of the tortilla chips in 1961, when its use commenced in the US. In India, the mark DORITOS stands registered in favour of Plaintiff 1 (PepsiCo Inc.) in Classes 29 and 30 with effect from 8 May 1986.

9. Plaintiff 1 claims to have launched a global marketing campaign, under the tagline "For The Bold" in relation to its DORITOS range of tortilla chips. The plaintiff avers, interestingly, that "the idea underlying the "For The Bold" campaign was to encourage



and urge the consumers of DORITOS to live boldly by seizing the moments in life and breaking out of the norm of everyday life, to experience more and live more”. Plaintiff 1 started using the “For The Bold” tagline in relation to DORITOS tortilla chips produced by it in 2013 internationally and in India since 2015 when PepsiCo’s DORITOS range of tortilla chips was introduced in this country. Since then, the plaint avers that, owing to extensive and continuous use, the tagline “For The Bold” is inalienably identified with PepsiCo’s DORITOS tortilla chips. The plaint emphasises that, in all advertising campaigns relating to PepsiCo’s DORITOS chips, the tagline “For The Bold” invariably prominently figures. PepsiCo has placed on record social media pages and YouTube videos to support its stand.

10. The tagline “For The Bold” stands registered in favour of Plaintiff 1 in Class 30, in respect of “coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; snack foods based on flour, corn, cereal, rice; processed cereal seeds” w.e.f. 21 March 2013. The registration is presently subsisting, though Mr. Sudhir Chandra would like to see it perish.

11. Local manufacture of DORITOS tortilla chips, invariably bearing the “For The Bold” tagline is stated to have commenced in India in 2017. Since then, DORITOS chips, bearing the said tagline, are stated to have been extensively sold. The plaint also provides the returns from sales of DORITOS chips from 2016 till October 2020. In



the year 2020, till October 2020 alone, sales of DORITOS chips are stated to have returned earnings of ₹ 61.1 crores. It is also asserted that PepsiCo has incurred considerable expenses towards promotion and publicity of its DORITOS range of chips. Expenses that were incurred between March and October 2020, are to the tune of ₹ 13.1 crores.

12. PepsiCo claims to have come to learn, in November 2020, that Parle launched a malt flavoured fruit juice based drink in India by the name B FIZZ, on 15 October 2020. The reason why B FIZZ is not suiting PepsiCo's palate would become apparent from the following photograph of B FIZZ:

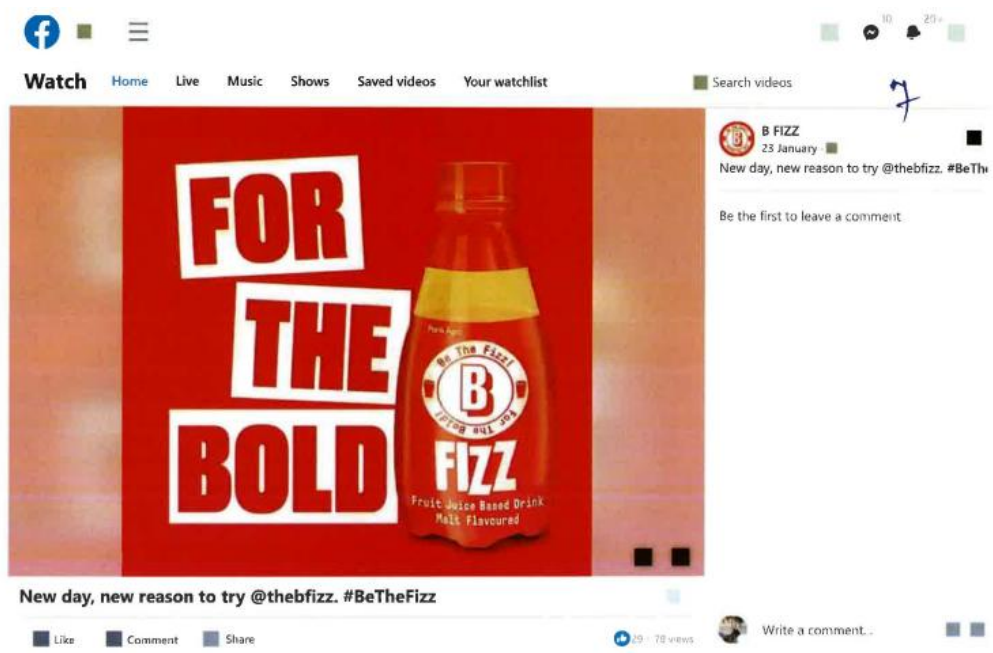
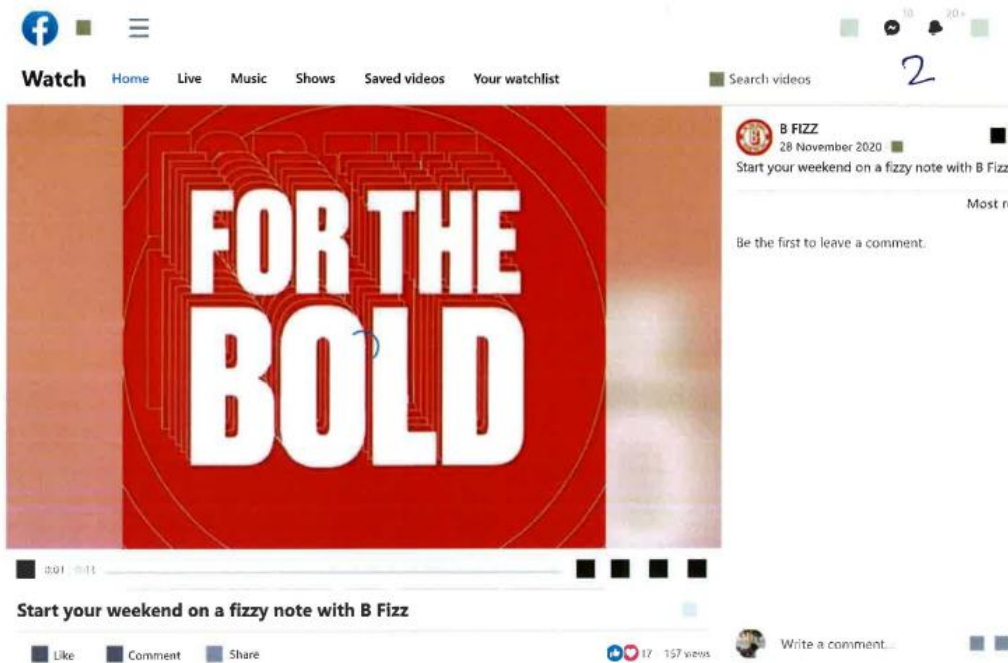


Mr. Chandhiok submits that, in Parle's label, "For The Bold" is prominent.

13. Mr. Chandhiok further submits that Parle has, in all its



advertising campaigns, emphasised the tagline “For The Bold”. He has referred, in this context, to the following advertisements, figuring on Parle’s Facebook page on 28 November 2020 and 23 January 2021:





Thus, submits Mr. Chandhiok, Parle has not only lifted the registered “For The Bold” trade mark of PepsiCo; it has also made it the basis of its own advertising campaign.

14. PepsiCo takes additional umbrage at Parle having applied, on 19 September 2020, for registration of the tagline “Be The Fizz! For The Bold!” as a trade mark, on “proposed to be used” basis. The said application, having been opposed by PepsiCo, is presently pending. At the same time, Mr. Chandhiok also submits that, having itself applied for registration of the tagline “Be The Fizz! For The Bold!” as a trade mark, Parle cannot question the validity of the registration of “For The Bold” as a trade mark in favour of PepsiCo.

15. Thus, alleges the plaintiff, Parle has infringed the registered trade mark “For The Bold”, of Plaintiff 1, within the meaning of Section 29 of the Trade Marks Act. The goods in respect of which Parle uses the allegedly infringing “Be The Fizz! For The Bold!” mark, alleges PepsiCo, are allied/cognate to the goods in respect of which PepsiCo uses its registered “For The Bold” trade mark. Chips, PepsiCo would contend, are a preferred accompaniment to an alcoholic beverage and are equally likely to be consumed by one who is preferring to imbibe, instead, the Parle’s “B Fizz” malt drink. The plaintiff also alleges that, by using “For The Bold” as part of its tagline, Parle is seeking to create an artificial inference of association with Plaintiff 1, where none, in fact, exists. This, in PepsiCo’s submission, would also amount, therefore, to Parle passing off its “B Fizz” product as PepsiCo’s. An unwary customer is, according to the plaintiff, on seeing Parle’s label with its “Be The Fizz! For The Bold!” tagline, bound to



infer an association between the said tagline and PepsiCo's "For The Bold" mark. The impugned act of Parle has, according to PepsiCo, also resulted in the illusion of PepsiCo's brand. being associated with Parle.



16. Mr. Chandhiok further submits that, in its written statement, Parle has not succeeded in raising any sustainable challenge to the case of PepsiCo. There is no substantial rebuttal to PepsiCo's assertions regarding the reputation and worldwide renown that DORITOS tortilla chips, bearing the "For The Bold" tagline, has achieved over the years. The rebuttal by Parle is merely by way of an omnibus denial, which, at the very least, would require a trial, during which PepsiCo is entitled to be protected. The fact that the trade dresses of PepsiCo's DORITOS chips and Parle's "B Fizz" beverage may be different, submits Mr. Chandhiok, is inconsequential, as PepsiCo is asserting the registration of "For The Bold" as a word mark in its favour.

17. Predicated on these allegations, PepsiCo has instituted the present suit, seeking a decree of permanent injunction, restraining Parle and all others acting on its behalf from using the tagline "For The Bold" and/or any other expression which is identical or deceptively similar to the tagline "For The Bold", registered as a trade mark in favour of Plaintiff 1, apart from delivery up, damages and costs.

Written Statement and Submissions of Mr. Sudhir Chandra



18. Mr. Sudhir Chandra handed over, at the outset, the following Comparison Chart:

Point of comparison	PepsiCo	Parle
Trade Marks applied by the Parties	FOR THE BOLD	Be The Fizz! For The Bold!
Brand Names of the products	DORITOS	B'FIZZ
Company names of the Parties	PEPSI Co	PARLE AGRO
Packaging		
Classification of Goods for which the mark has been applied	<p>Class 30</p> <p>Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices, ice; snack foods based on flour,</p>	<p>Class 32</p> <p>Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages</p>



	corn, cereal, rice; processed cereal seeds	
Sales of the products of the parties	183 Crores (Last five years)	232 (Since September 2020 – May 2021)

19. Based on the indices reflected in the above comparison chart, Mr. Sudhir Chandra submits that the features which distinguish the rival products are sufficient to militate against any possibility of likelihood of confusion between the two, irrespective of “For The Bold” figuring on the label of Parle’s product. Besides, he submits, Parle’s “B Fizz” is in the market since September 2020, which itself is sufficient to justify rejection of PepsiCo’s prayer for an interim injunction, applying the principles enunciated in *Wander Ltd v. Antox India (P) Ltd.*²

20. In its written statement, Parle contends that the vision behind its product “B Fizz” was to provide a beverage which, while being non-alcoholic, would replicate the bold flavour of beer. For this purpose, the bottle, as well as its label, were printed in bold red colour. The impugned product of Parle is stated to have earned, through sales, revenue of ₹ 184 crores during the period September 2020 to March 2021 and ₹ 48.12 crores during the months of April and May 2021. The product is stated to be widely advertised; the expenses incurred by Parle in promotion and advertising of the impugned product, during the year 2021-2022, up to the month of May 2021, is itself stated to be ₹ 35,55,82,129/–.

² 1990 Supp SCC 727



21. One of the defences that Parle has sought to urge in the written statement is that PepsiCo does not use the tagline “For The Bold” on all its packs of DORITOS chips. It is alleged that Parle came across packs of PepsiCo’s product which, instead, employ taglines such as “FOR MORE BOLD EXPERIENCES”, “SNACK BOLDLY”, “BOLD CRUNCH”, “BOLD FLAVOUR” and “DO YOU SNACK BOLD”. Photographs of some such packs have also been provided in the written statement and Mr. Sudhir Chandra handed over, across the bar, physical samples of such packs. It is, however, seen, from the said packs, that they are all manufactured abroad and intended for sale abroad. Mr. Chandhiok, learned Senior Counsel for PepsiCo has specifically stated, on instructions, that every pack of DORITOS tortilla chips, produced and sold in India, does indeed carry the “For The Bold” tagline. Mr. Sudhir Chandra has in fact not produced, before me, any pack of DORITOS tortilla chips, manufactured in India, which does not bear the “For The Bold” tagline, albeit on the reverse of the pack. Mr. Sudhir Chandra’s contention that the packs of DORITOS chips, bearing other “Bold” taglines, even if manufactured abroad, could be purchased in India, cannot, in my view, impact PepsiCo’s right to assert its “For The Bold” registered trade mark, used exclusively on all DORITOS tortilla chip packs manufactured and sold in India. Beyond this, I do not intend, for the purposes of this judgment, which merely decides the interlocutory injunction application of PepsiCo, to enter into this factual thicket. In any event, as Mr. Chandhiok points out, the tagline “For The Bold”, admittedly, stands registered as a trade mark in favour of PepsiCo.

22. Parle has also relied on the response of PepsiCo to the First



Examination Report (FER) dated 19 September 2013 of the Registrar of Trade Marks, objecting to the application of PepsiCo for registration of the “For The Bold” tagline as a trade mark. The FER invoked Section 9(1)(b)³ as well as Section 11(1)⁴ of the Trade Marks Act. Apropos Section 11(1), the ACR also annexed a list of Marks which were stated to be similar to the “For The Bold” Mark, of which PepsiCo sought registration. PepsiCo, in its reply dated 28 April 2014, contended thus:

“1. With regard to the objection raised under Section 9, we submit that the subject Mark comprises a slogan that does not convey any reference to the goods of interest to the applicant. In other words, the mark is arbitrary vis-à-vis the goods in relation to which it is intended to be used. Further, the subject mark has been especially conceived and adopted by the subject applicant in order to identify and distinguish its goods from those of others in the relevant trade circle. Hence, the subject Mark is distinctive and qualifies for registration under Section 9 of the Trade Marks Act, 1999.

2. With regard to the objection raised under Section 11, it is submitted that the objection raised is not tenable. It is a settled law that in comparison of the Marks, it is not proper to isolate a part of the mark and compare the same with the portion of another mark and then to conclude that since the parts are similar, the marks are also similar. The proper determination is that the marks must be considered in their entirety and not doing so, the subject mark (which has been adapted from the corporate identity of the subject applicant) is adequately distinguishable from the cited marks, leaving no scope for confusion or deception in the minds of the purchasing public.”

³ **Absolute grounds for refusal of registration.**—(1) The trade marks—

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

⁴ **Relative grounds for refusal of registration.**—(1) Save as provided in section 12, a trade mark shall not be registered if, because of—

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

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark



23. Besides, submits Mr. Sudhir Chandra, the very registration of the tagline “For The Bold” as a trade mark in PepsiCo’s favour is illegal, as the tagline is descriptive in nature. Registration of the said tagline as a trade mark is, according to Mr. Sudhir Chandra, violative both of clauses (a) and (b) of Section 9(1) of the Trade Marks Act. He submits that the tagline “For The Bold” is inherently incapable of distinguishing the goods of PepsiCo, in respect of which it is used, from goods of others. Mr. Sudhir Chandra points out, in this context, that the mark “For The Bold” figures on the reverse of the DORITOS packs and cannot, therefore, be regarded as constituting the trade mark under which PepsiCo sells the product. At the highest, it is merely a slogan denoting the quality of the product and the intended purpose of the contents of the pack. It does not denote the trade origin of the goods. In this context, Mr. Sudhir Chandra also relies on Section 2(2)(b)⁵ of the Trade Marks Act, which explains what use of a trade mark, within the meaning of the Trade Marks Act, connotes.

24. PepsiCo, points out Mr. Sudhir Chandra, had applied for registration of the word mark “For The Bold” on 21 March 2013 on “proposed to be used” basis. This indicates that there was no use of the “For The Bold” mark by PepsiCo prior to 21 March 2013. The mark “For The Bold” was registered in favour of PepsiCo on 19 December 2016. It could not, therefore, be said that, prior to the date of registration, the mark “For The Bold” had acquired a distinctive character as a result of use, or was a “well-known trade mark” as

⁵ (2) In this Act, unless the context otherwise requires, any reference—

(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;



defined in Section 2(1)(zg)⁶ of the Trade Marks Act. It was not, therefore, entitled to the benefit of the proviso to Section 9(1).

25. “Bold”, submits Mr. Sudhir Chandra, is a word of common English usage. Mr. Sudhir Chandra has invited my attention to the definition of “bold”, as contained in the Oxford English Dictionary, which defines the word as “courageous, enterprising, confident, stout-hearted, daring, brave, strong, big ... striking, well marked, clear; free or vigorous in conception etc.” These meanings, submits Mr. Sudhir Chandra, fit in with the purpose of use, by PepsiCo of the “For The Bold” tagline.

26. Mr. Sudhir Chandra has also referred to various webpages, which indicate use, by third parties, of the tagline “For The Bold”: Based on the above examples of use, by third parties, of “For The Bold”, Mr. Sudhir Chandra submits that the facts of the present case also attract Section 9(1)(c) of the Trade Marks Act, as they indicate that the tagline “For The Bold” has become customary in the current language and in the *bona fide* and established practices of the trade. The tagline also indicates the kind, quality and purpose of the DORITOS chips on which it is used, so that its entitlement to registration is also hit by Section 9(1)(b). As the tagline is in use by a large number of persons, Section 9(1)(a) would also apply, as it has lost all distinctive character.

⁶ “**well known trade mark**”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.



27. Mr. Sudhir Chandra submits that customers who purchase Parle's product do so because of the Mark DORITOS, and not because of the tagline "For The Bold". As such, he submits that PepsiCo cannot even be said to be using "For The Bold" as a trade mark as defined in the Trade Marks Act, as the tagline does not function as a means to identify the product with the source, i.e. PepsiCo. Obtaining of registration for the "For The Bold" tagline as a trade mark, submits Mr. Sudhir Chandra, does not *ipso facto* indicate that the tagline is in fact being used as a trade mark, or efface its inherently descriptive nature.

28. While acknowledging that his client has also applied for registration of the mark "Be The Fizz! For The Bold!" as a trade mark, Mr. Sudhir Chandra submits that the application is yet to be granted. He submits that Parle is also not using "Be The Fizz! For The Bold!" as a trade mark and that, therefore, the application of Parle, seeking registration of "Be The Fizz! For The Bold!" as a trade mark was misconceived, which, on instructions, he submits that his client is willing to withdraw.

29. Relying on the judgment of the division bench of this Court in *Marico Ltd v. Agro Tech Foods Ltd*⁷, Mr. Sudhir Chandra submits that the Court can, at the very outset while dealing with an application for interlocutory relief under Order XXXIX Rule 1 and 2 of the CPC, also examine whether the plaintiff's mark is valid.

⁷ 174 (2010) DLT 279



30. Referring to Section 29(1)⁸ of the Trade Marks Act, Mr. Sudhir Chandra submits that the tagline “For The Bold” is not used as a trade mark, either by PepsiCo or by Parle. Additionally, Section 29(1) would not apply as the impugned mark of Parle is not used in respect of the goods in respect of which PepsiCo’s mark is registered.

31. Mr. Sudhir Chandra further submits that Mr. Chandhiok is incorrect in comparing PepsiCo’s “For The Bold” registered trade mark with Parle’s “Be The Fizz! For The Bold!” and in extracting, for the purpose of such comparison, the latter “For The Bold” part of Parle’s mark. Such an exercise, he submits, is impermissible, being contrary to Section 17⁹ of the Trade Marks Act, which does not permit dissection of the mark into its individual parts, unless the individual parts are themselves registered trade marks. Mr. Sudhir Chandra cites, in this context, the judgment of a Division Bench of this Court in *Nestlé India Ltd v. Mood Hospitality Pvt Ltd*¹⁰

32. In any event, submits Mr. Sudhir Chandra, Parle’s “B Fizz” beverage is so distinct and different from the tortilla chips, in respect of which PepsiCo uses its “For The Bold” tagline, that there is no

⁸ 29. **Infringement of registered trade marks.—**

(1) 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 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.

⁹ **Effect of registration of parts of a mark.—**(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

¹⁰ 168 (2010) DLT 663 (DB)



chance of confusion between the two products whatsoever. Their appearance, too, as he points out, is completely dissimilar.

33. Thus, submits Mr. Sudhir Chandra, the case does not fall within any of the three clauses (a) to (c) of Section 29(2)¹¹ of the Trade Marks Act, so as to constitute “infringement”. Assuming, for the sake of argument, that PepsiCo uses the tagline “For The Bold” as a trade mark, Mr. Sudhir Chandra submits that Section 29(2) would, nonetheless, be inapplicable to the facts of the present case; firstly, because “B Fizz” malted beverage of Parle cannot be regarded as “similar” to the DORITOS tortilla chips of PepsiCo, and, secondly, because there is no likelihood of confusion between the two products as a result of the use, by Parle, of the impugned tagline. Besides, Mr. Sudhir Chandra submits that the aspect of the likelihood of confusion being caused is a matter of evidence, which has to await trial. Apropos these submissions, Mr. Sudhir Chandra relies on para 19 of the judgment of the High Court of Bombay in *Ajanta Pharma Ltd v. Theon Pharmaceuticals Ltd*¹² and para 48 of the report in *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai*¹³. Apropos his submission that, as PepsiCo does not use the tagline “For The Bold” as a basis to distinguish its DORITOS chips from other products, Mr. Sudhir Chandra cites paras 2, 5 to 7, 10.1 to 10.7 and 10.9 of the

¹¹ (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 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.

¹² 2017 SCC OnLine Bom 10048

¹³ (2022) 5 SCC 1



judgment of a learned Single Judge of this Court in *Stokely Van Camp v. Heinz India Pvt Ltd*¹⁴, which was affirmed, in appeal, by the Division Bench of this Court in *Stokely Van Camp v. Heinz India Pvt Ltd*¹⁵, from which Mr. Sudhir Chandra cites para 19.

34. Mr. Sudhir Chandra also seeks sanctuary of Sections 30(2)(a)¹⁶ and 35¹⁷ of the Trade Marks Act and cites, in this context, the Division Bench decision in *Stokely Van Camp*¹⁵. He submits that PepsiCo cannot claim the benefit of Section 29(4)¹⁸, as there is no evidence of any reputation, in India, of the “For The Bold” tagline, on PepsiCo’s products, before the adoption of “Be The Fizz! For The Bold!” by Parle. As such, it could not be said that Parle was taking any unfair advantage of PepsiCo by using the impugned tagline, or seeking to ride on PepsiCo’s reputation. Mr. Sudhir Chandra further submits that there is no evidence of dilution of PepsiCo’s “For The Bold” mark as the consequence of use, by Parle, of the impugned “Be The Fizz! For The Bold!” tagline and that, in any case, this would be a matter of trial and evidence.

¹⁴ 171 (2010) DLT 16

¹⁵ MANU/DE/3132/2010

¹⁶ A registered trade mark is not infringed where—

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;

¹⁷ **Saving for use of name, address or description of goods or services.**— Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.

¹⁸ 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.



35. Mr. Sudhir Chandra further cites Section 35 of the Trade Marks Act to contend that, as the use of “For The Bold”, by Parle, was in conjunction with the other prominent remarks on the impugned label, and was *bona fide*, PepsiCo could not seek to injunct such use. He relies, in this context, on paras 8 and 19 of *Marico*⁷.

36. Mr. Sudhir Chandra submits that it is only a validly registered trade mark which, under Section 28(1)¹⁹, can aspire to relief against its infringement. The validity of the plaintiff’s mark is, therefore, a prime consideration for the court while adjudicating on an application seeking injunction against infringement. Where the asserted mark reflects the characteristics of the goods on which it is used, Mr. Sudhir Chandra submits that the mark is *ex facie* invalid, as it is ineligible for registration by virtue of Section 9(1)(a) and 9(1)(b).

37. In the context of the submissions, Mr. Sudhir Chandra has placed reliance on para 10(xii) to (xiv), (xvi), (xvii) and (xxi) of *Procter & Gamble Manufacturing Co. Ltd v. Anchor Health & Beauty Care Pvt Ltd*²⁰. Despite Section 31²¹, therefore, Mr. Sudhir Chandra would submit that the Court, seized of an application under Order XXXIX Rule 1 and 2, has to necessarily satisfy itself regarding

¹⁹ 28. **Rights conferred by registration.**—

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

²⁰ 211 (2014) DLT 466 (DB)

²¹ 31. **Registration to be prima facie evidence of validity.**—

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

(2) In all legal proceedings, as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under Section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.



the *prima facie* validity of the mark which the plaintiff seeks to assert.

Submissions of Mr. Chandhiok in rejoinder

38. Arguing in rejoinder, Mr. Chandhiok submits that any rebuttal to the statutory presumption of validity conferred on PepsiCo’s “For The Bold” mark has to be by way of specific pleadings, which are totally lacking in the present case. Inasmuch as “For The Bold” is a registered trade mark, he submits that it is entitled, as of right, to presumption of validity under Section 31 of the Trade Marks Act. Mr. Chandhiok also disputes Mr. Sudhir Chandra’s contention that PepsiCo does not use “For The Bold” as a trade mark, as it is in fact registered in favour of PepsiCo as a word mark under the Trade Marks Act. Moreover, he submits that “For The Bold” is arbitrary *vis-à-vis* the goods in respect of which it is used in registration and is, therefore, entitled, even for that reason, to additional protection. Mr. Chandhiok submits that “For The Bold” is a distinctive mark in respect of the tortilla chips for which it is used. In any event, once the mark stands registered, it is presumed to be valid under Section 31, and the registrant – PepsiCo, in the present case – has already crossed the Section 9 hurdle.

39. Mr. Chandhiok questions Mr. Sudhir Chandra’s argument that Parle’s mark is not “For The Bold”, but “Be The Fizz! For The Bold!”, as it is only the latter “For The Bold” part of its mark which is extensively used by Parle in advertising its product. “Advertisement”, points out Mr. Chandhiok, also constitutes use of registered trade



mark under Section 29(6)²² of the Trade Marks Act.

40. Mr. Chandhiok emphasises the statutory construct of Section 31(1), which deems registration of the mark to be “*prima facie* evidence of its validity”. *Prima facie* evidence that PepsiCo’s “For The Bold” registration is valid is, therefore, conferred even by the very fact of such registration. While it may be open to Parle to rebut the said evidence, that is an exercise which has to await trial, submits Mr. Chandhiok. Mr. Chandhiok would submit that the presumption of validity, conferred by Section 31(1) would apply not only to infringement, but also to the rectification proceedings which Parle seeks to initiate. Though it is open to Parle to contest the validity of PepsiCo’s “For The Bold” trade mark, the bar, submits Mr. Chandhiok, is extremely high.

41. Mr. Chandhiok, nonetheless, contests Mr. Sudhir Chandra’s assertion that “For The Bold” is disentitled to registration as a descriptive mark. He submits that “For The Bold” can never be regarded as descriptive of tortilla chips, to a customer of average intelligence. It is, in his submission, *ex facie* abstract and arbitrary. Without prejudice, Mr. Chandhiok would contend that “For The Bold” might, at best, be suggestive, in which context he cites the judgment of this Court in *Bata India Ltd v. Chawla Boot House*²³, in which the mark “Power” was held not to be descriptive of shoes, but only

²² 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;
- (b) 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;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

²³ 2019 SCC OnLine Del 8147



suggestive. Mr. Chandhiok would also contend that, once PepsiCo has obtained registration of “For The Bold” as a trade mark, the FER issued by the Trade Marks Registry at the time when PepsiCo had applied for registration of the mark, and PepsiCo’s response to the said FER, cease to be of relevance.

42. Mr. Chandhiok submits, lastly, that the application of Parle, seeking leave to file a rectification against PepsiCo’s “For The Bold” registered trade mark would lie only after this Court, in the first instance, frames an issue regarding the validity of PepsiCo’s mark. An issue, on the said aspect, can be framed, under Order XIV of the CPC, only where sufficient pleadings are forthcoming. The pleadings of Parle, submits Mr. Chandhiok, are insufficient to justify framing of an issue regarding validity of PepsiCo’s “For The Bold” trade Mark; ergo, Parle’s prayer for leave to challenge the validity of PepsiCo’s “For The Bold” trade mark cannot be granted.

43. Referring to Section 2(2)(b) and Section 29(6) of the Trade Marks Act, Mr. Chandhiok submits that use of the “For The Bold” tagline by Parle even for the purpose of advertising constitutes “use” of PepsiCo’s registered trade mark, within the meaning of the Trade Marks Act.

44. Apropos IA 9591/2021, preferred by Parle under Section 124, Mr. Chandhiok submits that no tenable challenge to the “For The Bold” registered trade mark of the PepsiCo has been made out, on the pleadings of Parle. Interpreting Section 124 in the light of Order XIV of the CPC, Mr. Chandhiok submits that the framing of an issue



regarding the validity of the plaintiff's mark is, in the first instance, conditional on the defendant having raised a tenable challenge to its validity. In this context, Mr. Chandhiok submits that pleadings in commercial cases, which are governed by the CPC as amended by the Commercial Courts Act, 2015, have to conform to a much higher standard than pleadings in ordinary suits, governed by the CPC alone.

45. On the aspect of similarity, Mr. Chandhiok submits that the impugned mark of Parle subsumes, in its entirety, PepsiCo's registered "For The Bold" trade mark. Deceptive similarity is, therefore, according to Mr. Chandhiok, writ large on a comparison between the marks.

46. Inasmuch as Parle is using "For The Bold" as part of its tagline, Mr. Chandhiok submits that infringement, *ipso facto*, stands committed. The difference in appearance of the products would not, therefore, be of relevance.

47. Mr. Chandhiok also submits that Section 35 cannot be invoked by Parle, as there is no pleading, on its part, that the impugned mark "Be The Fizz! For The Bold!" describes the quality of its beverage.

48. It is further contended by Mr. Chandhiok that the "triple identity test", often used to determine whether infringement does or does not exist, stands satisfied in the present case, as the entirety of the PepsiCo's registered trade mark has been adopted by Parle, and the goods in respect of which the rival marks are used are available at the same outlets and cater to the same consumer segment. Tortilla



chips and Parle's "B Fizz" beverage are, in Mr. Chandhiok's submission, allied and cognate goods.

49. Mr. Chandhiok further submits that IA 9591/2021, filed by Parle under Section 124, deserves to be dismissed, as no tenable challenge to the validity of PepsiCo's registered "For The Bold" mark can be said to have been put up by Parle.

50. The judgments cited by Mr. Sudhir Chandra are, in Mr. Chandhiok's submission, all distinguishable.

Surrejoinder submissions by Mr. Sudhir Chandra

51. Mr. Sudhir Chandra requested for, and was granted, permission to advance submissions by way of surrejoinder.

52. Mr. Sudhir Chandra submits that no case of passing off can be said to exist, as the trade dresses of PepsiCo's DORITOS tortilla chips and Parle's B Fizz malted beverage are completely distinct, different and distinguishable. Besides, the name of the manufacturing company is prominently displayed on both labels.

53. PepsiCo, according to Mr. Sudhir Chandra, is predicating its case on an entirely wrong premise. Parle's mark, with which PepsiCo claims to be aggrieved, is not "For The Bold", but is "Be The Fizz! For The Bold!", written in a distinctive manner and style on the label of its "B Fizz" beverage, and, when compared, PepsiCo's and Parle's marks cannot be said to be deceptively similar. Mr. Sudhir Chandra



submits that the rival marks have to be compared as wholes, and it is not permissible to make out a case of infringement by comparing part of Parle's mark with the mark of PepsiCo. Non-alcoholic beverages, in respect of which Parle uses the impugned "Be The Fizz! For The Bold!" mark, submits Mr. Sudhir Chandra, is not even in Class 30, in which PepsiCo's "For The Bold" mark stands registered.

54. Mr. Sudhir Chandra further submits that Parle does not even use "For The Bold" as a trade mark. Parle's trade mark, for its beverage, is "B Fizz", which forms its main and most prominent part. Equally, he submits, PepsiCo is also not using "For The Bold" as a trade mark. The mere registration of "For The Bold" as a trade mark in favour of PepsiCo does not, in his submission, *ipso facto* imply that PepsiCo is using "For The Bold" as a trade mark.

55. Mr. Sudhir Chandra again cites *Wander*¹, and submits that Parle has been using the impugned mark since September 2020 and that, since then, sales of its "B Fizz" beverage have multiplied manifold, to the extent that they are, presently, far in excess of the sales of the DORITOS chips of PepsiCo. In these circumstances, he submits that it cannot be said that, at this point of time, the considerations of balance of convenience and irreparable loss would justify completely discontinuing use, by Parle, of its "Be The Fizz! For The Bold!" Tagline for its "B Fizz" malted beverage.

Analysis

Section 124 and IA 9591/2021



56. Parle has filed IA 9591/2021 under Section 124(1)(ii) of the Trade Marks Act, praying that an issue regarding the validity of the “For The Bold” trade mark of PepsiCo be framed, and Parle be granted leave to move for rectification of the said mark. Parle has independently filed C.O. (COMM. IPD-TM) 5/2021, seeking cancellation of the registration of the “For The Bold” word mark granted to PepsiCo on 21 March 2013. C.O. (COMM. IPD-TM) 5/2021 presently stands adjourned to 25 September 2023.

57. Mr. Chandhiok has, however, contended that Parle could apply for rectification of the register by cancellation of the “For The Bold” trade mark of PepsiCo only after this Court, in the first instance, finds the challenge to be tenable and grants leave to Parle to move for rectification. He is partly correct in his submission.

58. Section 124 does not specifically envisage the grant of leave by the Court before rectification proceedings can be filed. However, it does envisage a specific protocol being followed prior to the filing of such a petition/application. Where the challenge is by the defendant to the plaintiff’s mark, this protocol, sequentially, involves (i) a plea, by the defendant, that the plaintiff’s trade mark is invalid, (ii) satisfaction, by the Court, that the challenge is *prima facie* tenable, (iii) framing of an issue in that regard by the Court, (iv) adjournment of the proceedings by three months in order to enable the defendant to file a rectification petition challenging the plaintiff’s mark and (v) filing of such a rectification petition by the defendant within the time so provided. Where such a rectification petition is filed by the



defendant within the time so granted, Section 124(2) stipulates that the trial of the suit shall stand stayed till the final disposal of the rectification proceedings.

59. As such, the filing of a rectification petition by the defendant is only step (v), prior to which steps (i) to (iv) are sequentially required to be satisfied. In the present case, we are still at step (i). Parle has questioned the validity of PepsiCo's registered "For The Bold" trade mark in its written statement. The Court has to examine whether the challenge, as raised, is *prima facie* tenable. If the challenge is found to be *prima facie* tenable, the court has to frame an issue in that regard and adjourn the proceedings by three months. It is only thereafter that Section 124(1) envisages the filing of a rectification petition by the defendant, though the provision may not specifically contemplate the grant of prior leave of the Court before doing so. Even if grant of prior leave of the Court is not a specific pre-requisite for filing a rectification petition in Section 124(1), the provision clearly envisages filing of such a petition only after the Court has framed an issue and adjourned the proceedings.

60. In the present case, however, C.O. (COMM IPD TM) 5/2021 stands filed by Parle, seeking rectification of the register of trade marks and cancellation of the "For The Bold" trade mark of PepsiCo, even before the present judgment has come to be delivered. I would deal with this aspect of the matter somewhat later.

61. The challenge to the validity of the registration of PepsiCo's "For The Bold" trade mark is contained in the following passages of



the written statement filed by Parle:

“10. It is clear from the aforesaid that the Plaintiffs have concealed and misrepresented the most relevant / material fact from this Hon’ble Court. It is submitted that, since the Plaintiffs present suit is entirely based on the fact that the tagline “FOR THE BOLD” is distinctive to their products, as the same has been used on all their ‘Doritos’ product, the Plaintiffs, by misrepresenting and concealing that they are also using different bold formative phrases on their packaging, have clearly approached this Hon’ble Court with unclean hands and are making blatantly false statements, which amount to perjury. It is also pertinent to note that as the Plaintiffs’ basis for filing the present suit is completely false, the present suit becomes liable to be dismissed.

15. The Plaintiffs are not entitled to claim monopoly over the tagline “FOR THE BOLD” as the same is descriptive in nature and the Plaintiffs’ trade mark registration for the same is liable to be cancelled. The said trade mark is merely common English words, which are descriptive and relate to the kind and characteristic of the goods.

17. Further, it is evident from the documents filed by the Plaintiffs itself that the Plaintiffs while promoting the said product also, are using the said tagline in a descriptive manner, wherein, the Plaintiffs’ state that their product “Doritos” is made for the bold.

18. It is clear from the aforesaid that the manner of use of the said phrase/ alleged tagline by the Plaintiffs’ is only to convey that its product “Doritos” is for bold people, which is a characteristic of the Plaintiffs’ product and not to identify the Plaintiffs’ product under the trade mark “DORITOS”.

20. In view of the above, it is submitted that as the phrase ‘For the bold’ is a common English phrase which is used by various third parties, including the Plaintiffs, for describing the quality/characteristic of their goods/services, the Plaintiffs are not entitled to the exclusive use of the same and the Plaintiffs’ trade mark registration for the same is accordingly liable to be rectified / cancelled. The Defendant reserves the right to take appropriate



action accordingly, without prejudice to the submissions herein.”

2. The contents of paragraph 2.1 and 2.2 of the Plaint are wrong and denied. It is denied that the Plaintiffs use the tagline “FOR THE BOLD” internationally or in India in relation to its “Doritos” range of products. It is specifically denied that the tagline shares an inalienable association with Plaintiff No.1’s well-known brand DORITOS, including in India. It is submitted that the Plaintiffs have failed to produce documentary proof for its mark “FOR THE BOLD”, showcasing, that the use of the tagline/expression “FOR THE BOLD” brings to the mind of consumers, either the product “Doritos”, or the Plaintiffs. The Plaintiffs have failed to establish any reputation in the tagline “FOR THE BOLD” which is alleged to be distinctive of the Plaintiffs or their “DORITOS” products. In fact, it is pertinent to note that the Plaintiffs don’t even use the alleged tagline “FOR THE BOLD” as sought to be portrayed by the Plaintiffs in the present suit and in reality, they use a variety of ‘BOLD’ formative phrases on the said product such as ‘FOR MORE BOLD EXPERIENCES’, ‘SNACK BOLDLY’, ‘BOLD CRUNCH’, ‘BOLD FLAVOUR’ and ‘DO YOU SNACK BOLD’ in its place. The Plaintiffs are put to strict proof of the averments made thereof.

3. The contents of paragraph 2.3 of the Plaint are not denied to the extent that they reflect the correct records of the Trade Mark Registry. The rest of the contents of the paragraph under reply are wrong and denied. It is also submitted that the Plaintiffs are not entitled to any registration for the tagline “FOR THE BOLD” as the same is merely common English words which are descriptive and relate to the kind and characteristic of the goods. In fact, the phrase ‘For the Bold’ is used by various third parties for their products which are strong in taste and flavour or in relation to their respective characteristics and are therefore advertised as a product for the bold. Even in relation to the Plaintiffs’ product under the trade mark “DORITOS” the tagline “FOR THE BOLD” is used as an English phrase as opposed to an arbitrary trade mark. Such descriptive use of the phrase ‘FOR THE BOLD’ is evident from the fact that the Plaintiffs don’t even use the alleged tagline “FOR THE BOLD” as sought to be portrayed by the Plaintiffs in the present suit and in reality, they use a variety of other ‘BOLD’ formative phrases on their ‘Doritos’ product such as ‘FOR MORE BOLD EXPERIENCES’, ‘SNACK BOLDLY’, ‘BOLD CRUNCH’, ‘BOLD FLAVOUR’ and ‘DO YOU SNACK BOLD’ in place of the phrase “FOR THE BOLD”.



5. The contents of paragraph 2.5 of the Plaintiff are not denied to the extent of being matters of record regarding the trade mark application. The rest of the contents of the paragraph under reply are wrong and denied. It is denied that the said mark “BE THE FIZZ ! FOR THE BOLD !” in any manner evidences association with the trade mark of Plaintiff No. 1. It is denied that Plaintiff No. 1 holds any right in opposing the said application of the Defendant as the Plaintiff’s trade mark “FOR THE BOLD” is not a trade mark under the definition of “trade mark” under Section 2(zb) of the Trade Marks Act, 1999 and is liable to be expunged from the Register of Trade Marks.

6. The contents of paragraph 2.6 of the Plaintiff are denied in their entirety. It is denied that the Defendant has adopted any tagline which is similar to any tagline of the Plaintiffs. Firstly, the alleged tagline “FOR THE BOLD” is not used by the Plaintiffs as a trade mark and is merely used as a common phrase to describe the bold characteristics of the Plaintiffs’ product, and the said phrase is at best, used interchangeably by the Plaintiffs with other common phrases such as ‘FOR MORE BOLD EXPERIENCES’, ‘SNACK BOLDLY’, ‘BOLD CRUNCH’, ‘BOLD FLAVOUR’ and ‘DO YOU SNACK BOLD’. Secondly, as admitted by the Plaintiffs in their examination report reply in relation to their application for “FOR THE BOLD”, before the Trade Marks Registry, it is a settled principle of trade mark law, that while comparing the trade marks for similarity, the trade marks have to be looked at as a whole and it is not proper to isolate a part of the trade mark and compare the same with a portion of another trade mark, and then to conclude that since the parts are similar, the marks are similar. Therefore, it is clear that trade marks have to be considered in their entirety when comparing them in order to assess similarity. Pursuant to the same, the tagline of the Defendant when considered as a whole, is not similar to the Plaintiffs tagline in any manner.

It is denied that the goods of the Defendant are similar or cognate to the goods of the Plaintiffs and that the trade mark “BE THE FIZZ ! FOR THE BOLD !” is infringing the mark of the Plaintiffs. It is submitted that the Plaintiffs are using their alleged tagline on tortilla chips, whereas the Defendant is using its tagline on malt-flavoured fruit juice beverage, meaning thereby that the nature of goods is dissimilar and they have different trading channels. The present action for infringement of trade mark cannot be maintained by the Plaintiffs on the basis of their trade mark registration against goods which are not covered in its trade mark registration no. 2499660. It is submitted that the Defendant has not indulged in any illegal activity whatsoever. Reliance is placed on the Preliminary



submissions and objections hereinabove. The Plaintiffs are put to strict proof of the averments made thereof.

13. The contents of paragraph 5.1. (iii) of the Plaint are not denied to the extent that they reflect the correct records of the Trade Mark Registry. The rest of the contents in the paragraph under reply are wrong and denied. It is also submitted that the Plaintiffs are not entitled to any registration for the alleged tagline “FOR THE BOLD” as the same is merely common English words which are descriptive and relate to the kind and characteristic of the goods. In fact, the phrase ‘For the Bold’ is used by various third parties for their products which are strong in taste and flavour and/ or in relation to their respective characteristics are therefore advertised as a product for the bold. In fact, as is evident from the submissions made herein above, it is evident that even in relation to the Plaintiffs’ product under the trade mark “DORITOS” the tagline “FOR THE BOLD” is used as English phrase as opposed to an arbitrary trade mark.

14. The contents of paragraph 5.2. (i) of the Plaint are wrong and denied. It is submitted that it is clear from the alleged campaign referred to in the paragraph under reply, that the phrase “FOR THE BOLD” has been descriptively used by the Plaintiffs and not as a distinctive trade mark. It is however submitted that the Plaintiffs are put to strict proof of the truthfulness of the rest of the averments made thereof. It is denied that the ad campaign was successful and that it had an instant connection with consumers of “Doritos” and resulted in higher sales volumes for “Doritos” and that it helped unifying the presence of “Doritos” in the global market. It is submitted that the Plaintiffs have merely alluded to the revenue achieved in India and abroad with respect to its product under the brand “DORITOS”. Plaintiffs have placed no document on record to claim reputation over the alleged tagline “FOR THE BOLD”, purportedly used in relation to its product “Doritos”, evidencing it to be instrumental in achieving the sales revenue as claimed. The Plaintiffs are put to strict proof of the averments made thereof.

16. The contents of paragraphs 5.3. (i)-(ii) of the Plaint are not denied to the extent that they reflect the correct records of the Trade Mark Registry. The rest of the contents in the paragraph under reply are wrong and denied. It is also submitted that the Plaintiffs are not entitled to any registration for the alleged tagline “FOR THE BOLD” as the same is merely common English words



which are descriptive and relate to the kind and characteristic of the goods. In fact, the phrase 'For the Bold' is used by various third parties for their products which are strong in taste and flavour or in relation to their respective characteristics and are therefore advertised as a product for the bold. Even in relation to the Plaintiffs' product under the trade mark "DORITOS" the tagline "FOR THE BOLD" is used as English phrase as opposed to an arbitrary trade mark. Further, the Plaintiffs are also using the phrases such as 'FOR MORE BOLD EXPERIENCES', 'SNACK BOLDLY', 'BOLD CRUNCH', 'BOLD FLAVOUR' and 'DO YOU SNACK BOLD' in place of the phrase "FOR THE BOLD".

18. The contents of paragraphs 5.5(i)-(ii) are denied in their entirety. The Plaintiffs have failed to produce any documentary proof of the averments made thereof. It is further denied that the tagline "FOR THE BOLD" enjoys any brand recall and have generated reputation amongst general public. It is submitted that the Plaintiffs' reputation, if any, can be said to be in the trade mark "DORITOS" and not in the phrase "FOR THE BOLD" which is used by the Plaintiffs on its product in a descriptive manner and is interchangeably used with other descriptive phrases such as 'FOR MORE BOLD EXPERIENCES', 'SNACK BOLDLY', 'BOLD CRUNCH', 'BOLD FLAVOUR' and 'DO YOU SNACK BOLD'. The Plaintiffs are put to strict proof of the averments made thereof.

23. ... Furthermore, the Plaintiffs cannot claim any monopoly over the tagline "FOR THE BOLD" as the same is descriptive in nature and therefore the Plaintiffs' trade mark registration over the said tagline is not valid and is liable to be cancelled. The said trade mark is merely English words which are descriptive and relate to the kind and characteristic of the goods. In fact, the Plaintiffs are themselves using the said tagline in a descriptive manner on its products and in the promotional materials of their product, wherein, the Plaintiffs while promoting the product under the trade mark "DORITOS" state that the said product is made for the bold. Therefore, the said registration of the tagline is in contravention to the provisions of the Trade Marks Act, 1999 and is liable to be removed from the Register of Trade Marks."

27. The contents of paragraph 12 of the Plaint are denied in its entirety. It is specifically denied that the Plaintiffs are entitled to any order of damages or any relief sought there in. It is denied that



the balance of convenience is in favour of the Plaintiffs and against the Defendant. It is submitted that as the Plaintiffs' tagline is merely a descriptive phrase being used by the Plaintiffs and not a distinctive mark and the said phrase is not even used on all packets of "Doritos", but is used interchangeably with various other 'BOLD' formative descriptive phrases, the Plaintiffs' present suit is completely baseless and liable to be dismissed. Further, with regard to the contents of the paragraph under reply, the Defendant seeks leave to refer and rely upon the submissions made hereinabove and the same are not being repeated for the sake of brevity."

62. The challenge in the afore-extracted passages from the written statement of Parle seeks to invoke Section 9(1) of the Trade Marks Act, which proscribes, absolutely, registration of marks which are devoid of any distinctive character [*vide* clause (a)] or designate the kind, quality, quantity, intended purpose, values, or other characteristics of the goods in respect of which the marks are used [*vide* clause (b)], or which have become customary in the current language or in the *bonafide* and established practices of the trade [*vide* clause (c)]. Parle's case – as articulated by Mr. Sudhir Chandra – is that the registration of PepsiCo's "For The Bold" trade mark is invalid because it is purely descriptive of the tortilla chips in respect of which it is used and, inasmuch as "bold" is a word of common and customary English usage, is also a phrase which has become customary in the current language and in the *bonafide* and established practices of the trade. Mr. Sudhir Chandra invokes, therefore, all three clauses of Section 9(1).

63. Para 5.2 of the plaint provides the following *raison d'etre* for the use of the tagline "For The Bold" for its DORITOS tortilla chips:



“In the year 2013, Plaintiff No. 1 launched a global marketing campaign in relation to its DORITOS range of products/tortilla chips under tagline “For The Bold”. *The idea underlying the “For The Bold” campaign was to encourage and urge the consumers of DORITOS to live boldly by seizing the moments in life and breaking out of the norm of everyday life, to experience more and live more. Through this campaign, the consumers were also urged to try and experience intense flavours of the DORITOS products that would ignite them to seize the moment and release their inner boldness.*”

(Emphasis supplied)

64. Thus, it does appear that, in its pleadings in the plaint, PepsiCo has sought to relate the tagline “For The Bold” with the flavour of the tortilla chips in respect of which the said tagline is used and to attribute a purpose to the said tagline. What has to be seen is whether, in the backdrop of these rival assertions, as contained in the written statement of Parle and in the plaint of PepsiCo, the challenge, by Parle, to the validity of PepsiCo’s “For The Bold” trade mark is, or is not, tenable.

65. “Tenable” is not an adjective which one customarily encounters in statutory instruments. Indeed, it is an expression which is gloriously uncertain in its import and, ordinarily, should not even form part of a provision in a statute, especially one which seriously impacts commercial rights of parties. Nonetheless, it is there and, therefore, the Court has to live with it.

66. In the context of Section 87(1)(a)²⁴ of the Trade and

²⁴ **Procedure where invalidity of registration is pleaded by the accused.—**

(1) Where the offence charged under Section 78 or Section 79 is in relation to a registered trade mark and the accused pleads that the registration of the trade mark is invalid, the following procedure shall be followed :—

(a) If the magistrate is satisfied that such defence is prima facie tenable, he shall not proceed with the charge but shall adjourn the proceeding for three months from the date on which the plea



Merchandise Act, 1958 – which, though it deals with criminal prosecution, also envisages satisfaction, by the Magistrate, regarding the “tenability” of the challenge to the validity of a trade mark – P. Ramanatha Aiyar, in his classic Advance Law Lexicon, defines “tenable” as “capable of being retained, kept or defended”. That, really, is the only definition of “tenable” that I have come across, in any law lexicon. Black²⁵, Jowitt²⁶ and Stroud²⁷ are all silent on it.

67. The scope and import of the expression “tenable” as employed in Section 124(1)(a)(ii) can perhaps be better appreciated if one examines the consequences of a finding, by the court, under the said provision, that the plea of invalidity of the plaintiff’s trade mark, as raised by the defendant, is “*prima facie* tenable”. The use of the expression “*prima facie*” is also, in this connection, of no little significance. The Court, while exercising its subjective satisfaction in terms of Section 124(1)(a)(ii) is, therefore, only required to satisfy itself regarding the “*prima facie* tenability” of the challenge, by the defendant, to the plaintiff’s trade mark – or *vice-versa*. It has to be remembered that, if the court finds the challenge to be *prima facie* tenable, the court only proceeds to frame an issue and adjourn the proceedings to enable the defendant – or the plaintiff, as the case may be – to prefer a rectification proceeding. The actual issue of whether, in fact, the validity of the mark is, or is not, meritorious, is within the exclusive province of the authority which is in *seisin* of the rectification proceeding, once it is filed.

of the accused is recorded to enable till the accused to file an application before the High Court under this Act, for the rectification of the register on the ground that the registration is invalid.

²⁵ Black’s Law Dictionary

²⁶ Jowitt’s Dictionary of English law

²⁷ Stroud’s Judicial Dictionary of Words and Phrases



68. An exhaustive discussion of this aspect of the matter is contained in the judgment of the Supreme Court in *Patel Field Marshal Agencies v. P.M Diesels Ltd*²⁸. The respondent P.M. Diesels Ltd (“PMD” hereinafter) was the registered owner of three trade marks, to all of which “Field Marshal” was common. They were registered in 1964 and 1968. The appellant Patel Field Marshal Agencies (“PFM” hereinafter) applied for registration of the trade mark “Marshal”. PMD instituted Suit No. 1612/1989 before this Court, alleging that the use of “Marshal” by PFM infringed PMD’s registered “Field Marshal” trade mark. An injunction against use, by PFM, of the mark “Marshal” was, therefore, sought. PFM, in response, questioned the validity of the registration of the mark “Field Marshal” in favour of PMD. This Court framed an issue to the said effect in the suit. An application for interlocutory injunction, preferred by PMD, was allowed by a learned Single Judge of this Court. However, by a subsequent order, the learned Single Judge opined that this Court did not possess the territorial jurisdiction to adjudicate the suit and, therefore, returned the plaint or presentation before the competent court in Gujarat. The plaint was thereafter filed before the learned Additional District Judge (ADJ), Rajkot, as Civil Suit 1/2009. The controversy arose in the context of the Trade and Merchandise Marks Act, 1958 (“the TMA 1958”).

69. During the pendency of the suit before this Court, PFM initiated rectification proceedings before the High Court of Gujarat, challenging the registration of the “Field Marshal” trade marks in

²⁸ (2018) 2 SCC 112



favour of PMD. The rectification applications were dismissed by a learned Single Judge, whose decision was upheld in appeal by the Division Bench. PFM appealed to the Supreme Court.

70. In these circumstances, the Supreme Court framed the following issue as arising for consideration before it, in para 9 of the report:

“In a situation where a suit for infringement is pending wherein the issue of validity of the registration of the trade mark in question has been raised either by the plaintiff or the defendant and no issue on the said question of validity has been framed in the suit or if framed has not been pursued by the party concerned in the suit by filing an application to the High Court for rectification under Section 111 read with Section 107 of the Trade and Merchandise Marks Act, 1958, whether recourse to the remedy of rectification under Sections 46/56 of the 1958 Act would still be available to contest the validity of the registration of the trade mark.”

Broken up into its constituents, the issue as framed by the Supreme Court was this. The plaintiff files a suit for infringement. The defendant, in response, questions the validity of the trade mark that the plaintiff seeks to assert. The Court does not frame any issue regarding validity of the plaintiff’s trade mark. Else, the Court does frame an issue, but the defendant fails to proceed and filed a rectification application under Section 111 of the TMA 1958²⁹. Can the defendant file a rectification petition under Section 46 or Section 56³⁰ of the TMA 1958?

71. The following paragraphs from the judgment provide the answer:

²⁹ *in pari materia* with Section 124 of the Trade Marks Act, 1999, as is recognised in para 10 of the judgment of the Supreme Court itself.

³⁰ *in pari materia* with Sections 47 and 57 of the Trade Marks Act, 1999, as is recognised in para 10 of the judgment of the Supreme Court itself.



“28. In cases where in a suit for infringement of a registered trade mark the validity of the registration of the trade mark is questioned either by the plaintiff or by the defendant, Section 107 of the 1958 Act provides that an application for rectification shall be made to the High Court and not to the Registrar notwithstanding the provisions contained in Section 46 or Section 56 of the 1958 Act. This would seem to suggest that in such cases (where a suit for infringement is pending) the legislative scheme is somewhat different.

29. The above seems to become more clear from what is to be found in Section 111 of the 1958 Act which deals with “stay of proceedings where the validity of registration of the trade mark is questioned”. The aforesaid provision of the 1958 Act specifically provides that if a proceeding for rectification of the register in relation to the trade mark of either the plaintiff or the defendant is pending before the Registrar or the High Court, as may be, and a suit for infringement is filed wherein the aforesaid plea is raised either by the defendant or by the plaintiff, the suit shall remain stayed. Section 111 further provides that if no proceedings for rectification are pending on the date of filing of the suit and the issue of validity of the registration of the plaintiff's or the defendant's trade mark is raised/arises subsequently and the same is prima facie found to be tenable, an issue to the aforesaid effect shall be framed by the civil court and the suit will remain stayed for a period of three months from the date of framing of the issue so as to enable the party concerned to apply to the High Court for rectification of the register. Section 111(2) of the 1958 Act provides that in case an application for rectification is filed within the time allowed the trial of the suit shall remain stayed. Sub-section (3) of Section 111 provides that in the event no such application for rectification is filed despite the order passed by the civil court, the plea with regard to validity of the registration of the trade mark in question shall be deemed to have been abandoned and the suit shall proceed in respect of any other issue that may have been raised therein. Sub-section (4) of Section 111 provides that the final order as may be passed in the rectification proceeding shall bind the parties and the civil court will dispose of the suit in conformity with such order insofar as the issue with regard to validity of the registration of the trade mark is concerned.

30. Following well-accepted principles of interpretation of statutes, which would hardly require a reiteration, the heading of Section 111 of the 1958 Act i.e. “Stay of proceedings where the validity of registration of the trade mark is questioned, etc.”, cannot be understood to be determinative of the true purport, intent and effect of the provisions contained therein so as to understand



the said section to be contemplating only stay of proceedings of the suit where validity of the registration of the trade mark is questioned. Naturally, the whole of the provisions of the section will have to be read and so read the same would clearly show lack of any legislative intent to limit/confine the operation of the section to what its title may convey.

31. Rather, from the résumé of the provisions of the 1958 Act made above, it becomes clear that all questions with regard to the validity of a trade mark is required to be decided by the Registrar or the High Court under the 1958 Act or by the Registrar or the IPAB under the 1999 Act and not by the civil court. The civil court, in fact, is not empowered by the Act to decide the said question. Furthermore, the Act mandates that the decisions rendered by the prescribed statutory authority [Registrar/High Court (now IPAB)] will bind the civil court. At the same time, the Act (both old and new) goes on to provide a different procedure to govern the exercise of the same jurisdiction in two different situations. In a case where the issue of invalidity is raised or arises independent of a suit, the prescribed statutory authority will be the sole authority to deal with the matter. However, in a situation where a suit is pending (whether instituted before or after the filing of a rectification application) the exercise of jurisdiction by the prescribed statutory authority is contingent on a finding of the civil court as regards the prima facie tenability of the plea of invalidity.

32. Conversely, in a situation where the civil court does not find a triable issue on the plea of invalidity the remedy of an aggrieved party would not be to move under Sections 46/56 of the 1958 Act but to challenge the order of the civil court in appeal. This would be necessary to avoid multiple proceedings on the same issue and resultant conflict of decisions.

33. The 1958 Act clearly visualises that though in both situations i.e. where no suit for infringement is pending at the time of filing of the application for rectification or such a suit has come to be instituted subsequent to the application for rectification, it is the Registrar or the High Court which constitutes the tribunal to determine the question of invalidity, the procedure contemplated by the statute to govern the exercise of jurisdiction to rectify is, however, different in the two situations enumerated. Such difference has already been noted.

34. The intention of the legislature is clear. All issues relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court. In cases where the parties have not approached the civil court, Sections 46 and 56 provide an independent statutory right to an aggrieved party to seek



rectification of a trade mark. However, in the event the civil court is approached, inter alia, raising the issue of invalidity of the trade mark such plea will be decided not by the civil court but by the Tribunal under the 1958 Act. The Tribunal will however come into seisin of the matter only if the civil court is satisfied that an issue with regard to invalidity ought to be framed in the suit. Once an issue to the said effect is framed, the matter will have to go to the Tribunal and the decision of the Tribunal will thereafter bind the civil court. If despite the order of the civil court the parties do not approach the Tribunal for rectification, the plea with regard to rectification will no longer survive.”

72. *Patel Field Marshal Agencies*²⁸, therefore, clarifies that the challenge to the validity of the plaintiff’s mark, though raised by the defendant in the suit of the plaintiff, is to be decided, not by the Court hearing the suit (hereinafter “the suit Court”), but by the authority which the defendant would proceed to move for rectification. At the time when *Patel Field Marshal Agencies*²⁸ was rendered, the authority before whom the rectification petition could be maintained was the Intellectual Property Appellate Tribunal (IPAB). The task of the suit Court, whether under Section 111(1)(ii) of the TMA 1958 or the corresponding Section 124(1)(a)(ii) of the present Trade Marks Act, is only to pronounce on the *prima facie* tenability of the challenge, by the defendant, to the validity of the plaintiff’s trade mark. Once the suit Court finds the challenge to be tenable and frames in issue in that regard, the challenger-defendant would have to move the IPAB for rectification, and it was the IPAB alone which could decide on the aspect of rectification and, therefore, on the validity of the plaintiff’s trade mark, one way or the other.

73. It goes without saying, therefore, that the IPAB, on whom the Supreme Court conferred exclusive jurisdiction in this regard, could



not be trammelled in any manner in exercising the said jurisdiction. The court, while holding [under Section 111(1)(ii) of the TMA 1958 or the corresponding Section 124(1)(a)(ii) of the present Trade Marks Act] that the challenge, by the defendant, to the validity of the plaintiff's trade mark was *prima facie* tenable would not, therefore, be entitled to make any such observation on the merits of the said challenge, as would bind, or even influence, the IPAB in adjudicating the rectification proceeding. As such, the findings of the court under Section 124(1)(a)(ii) regarding the tenability of the challenge, whether by the plaintiff or by the defendant, to the mark of the opposite party, has to be strictly *prima facie*, and nothing more. The suit Court can, under Section 124(1)(a)(ii), therefore, only pronounce on the issue of whether the challenge is arguable or not. Any observation beyond this is bound to influence the authority which subsequently has to adjudicate on the rectification petition and which is the only authority – as per *Patel Field Marshal Agencies*²⁸ – which can pronounce on the challenge to validity.

74. “*Prima facie* tenability”, within the meaning of Section 124(1)(ii) of the Trade Marks Act, therefore, would imply only a *prima facie* view that the challenge to the validity of the mark of the opposite party, as raised in the plaint or in the written statement, is a challenge worth consideration. It cannot amount, in any manner of speaking, to an expression of opinion, even tentative or perfunctory, regarding the merits of the said challenge.

75. The view regarding the *prima facie* tenability of the challenge of the validity of the mark of the opposite party, as expressed by the



court under Section 124(1)(a)(ii) is, therefore, a mere view regarding the arguability of the challenge. It cannot pronounce, to any extent at all, on the merits of the challenge. The Court is, therefore, while examining the *prima facie* tenability of the challenge to the validity of the mark, under Section 124(1)(a)(ii), only required to satisfy itself that the pleadings are sufficient to make out a challenge worth considering, whatever be the merits of the challenge.

76. Viewed thus, the assertions in the written statement of Parle, in the backdrop of the averments contained in para 5.2 of the plaint, as reproduced *supra*, do make out a case of a *prima facie* tenable challenge by Parle, to the validity of the registration of the Persico's "For The Bold" trade mark. Whether the challenge is meritorious, or is devoid of merit, is exclusively within the province of the court before which the rectification proceedings would be filed, as clearly laid down in *Patel Field Marshal Agencies*²⁸ and this Court would be committing serious folly if it were to express even a tentative view thereon in the present proceedings.

77. I cannot, therefore, agree with the submission of Mr. Chandhiok that the pleadings in the written statement are not sufficient for the Court to frame an issue regarding the validity of the PepsiCo's "For The Bold" trade mark.

78. The invocation, by Mr. Chandhiok, of Order XIV of the CPC is also, in my considered opinion, inapposite. Section 124 of the Trade Marks Act is a self-contained provision. The framing of an issue under Section 124 as an independent exercise by the Court which is seized



of the suit, and is not trammelled, in any manner, by Order XIV or any other provision in the CPC.

79. The ingredients for framing of an issue regarding validity of the PepsiCo’s “For The Bold” trade mark and adjourning of the suit to enable Parle to file an appropriate rectification petition being satisfied, IA 9591/2021 is required to be allowed.

80. Accordingly, the court frames the following issue:

“Whether the registration of the tagline “For The Bold” as a trade mark in favour of PepsiCo is valid?”

81. Ordinarily, having thus framed the issue regarding validity of PepsiCo’s “For The Bold” trade mark, I would be required to adjourn the present proceedings by three months, in order to enable Parle to file a rectification proceeding, challenging the said mark. As it happens, however, C.O. (COMM. IPD-TM) 5/2021 stands filed by Parle even before the court has had an occasion to apply its mind to the *prima facie* tenability of the challenge, by Parle, to PepsiCo’s “For The Bold” trade mark, as raised in the written statement. It is, therefore, premature.

82. The question that arises, then, is whether the court should reject C.O. (COMM. IPD-TM) 5/2021 as premature or allow it to be prosecuted, since it has, in any case, been filed. There is something to be said for the contention that, even if the Court were to reject C.O. (COMM. IPD-TM) 5/2021 as premature, the defendant would only have to re-file the same petition, once again, were the Court to find the



challenge, by Parle, to PepsiCo's "For The Bold" trade mark to be tenable. If, therefore, the protocol envisaged by Section 124(1) is to be strictly followed in the present case, C.O. (COMM. IPD-TM) 5/2021 would have to be dismissed as premature and the proceedings in the present suit adjourned by three months, within which Parle would have to refile the very same rectification petition. C.O. (COMM. IPD-TM) 5/2021 is not even presently listed before this Court. I would, therefore, have to await the listing of C.O. (COMM. IPD-TM) 5/2021 on 25 September 2023, reject it as premature on that date and grant three months time to Parle to enable it to refile the same petition. Valuable time would, in the process, be lost, and proceedings would unnecessarily multiply. In the peculiar facts of this case, therefore, I am inclined to treat C.O. (COMM. IPD-TM) 5/2021 as having been filed under Section 124(1)(ii), and to invite reply/written submissions by PepsiCo thereto, and rejoinder/written submissions by Parle in a time bound frame so that C.O. (COMM. IPD-TM) 5/2021 could be disposed of expeditiously.

83. I am inclined to follow the above course of action in the present case only to save time and to avoid multiplicity of proceedings. There can be no gainsaying that, ordinarily, once a suit, alleging infringement by the defendant, is filed, the protocol envisaged by section 124 would have to be followed, which provides for filing of a rectification petition by the defendant, alleging the mark which the plaintiff seeks to assert only after an issue is framed by the Court. The decision, in the present case, to treat C.O. (COMM. IPD-TM) 5/2021 as a rectification petition filed under Section 124 (1)(ii) is not, therefore, to be regarded as a precedent.



Re. IA 7170/2021

Scope of Section 124(5)

84. Section 124(2) envisages stay of trial in a suit, pending disposal of the rectification proceedings, if filed in terms of Section 124(1)(ii). It is important to note that what is stayed is trial in the suit, and not the suit *per se*. The expression is, therefore, similar to what is found in Section 10 of the CPC. The power of the court to adjudicate on an application seeking interlocutory relief, therefore, stands preserved, even if a rectification petition is filed and trial in the suit is stayed.

85. Though, as Section 124(2) only envisages stay of trial in the suit, and not stay of the suit *per se*, there was no requirement for a separate provision clarifying that the court would continue to retain jurisdiction to adjudicate on interlocutory applications, such a provision has, *ex abundanti cautela*, been provided in Section 124(5), which clarifies that the stay of suit under Section 124(2) would not preclude the court from making interlocutory orders. [I may note, here, that there is some degree of inexactitude in the framing of Section 124(5). The provision uses the word “the stay of the suit”. What is envisaged by Section 124(2) is not stay of the suit, but *stay of trial in the suit*. There is a fundamental difference between stay of a suit and stay of a trial in a suit, regarding which there is authoritative law, albeit in the context of Section 10 of the CPC. This subtle distinction appears to have escaped the attention of the legislature while drafting Section 124(5). That, however, would be a matter



which the legislature would have to rectify, and this Court is powerless to do so.] The words “stay of the suit” in Section 124(5) have, however, necessarily to be read as “stay of trial in the suit” which is what Section 124(2) envisages.

86. Section 124(5) also lends itself to an interesting discourse, relevant to the issue at hand. Mr. Chander M Lall, a leading Senior Counsel with an enviable IP practice, ventured to submit before me, albeit in another case, that, while the court in *seisin* of the suit has, by virtue of Section 124(5), the jurisdiction to adjudicate on the Order XXXIX application filed by the plaintiff, even if has found the challenge to the validity of the plaintiff’s mark, as pleaded by the defendant in the written statement, to be *prima facie* tenable, and has framed the issue and adjourned the suit so as to enable the defendant to file a rectification petition in that regard, *such exercise of Order XXXIX jurisdiction would have to be restricted to the aspect of passing off*. In simple terms, what was contended by Mr. Lall is that infringement can only be of a registered trade mark. The right to remedy against infringement, as available under Section 28(1), is also conditional on the registration being valid. Validity of the plaintiff’s trade mark is, therefore, a pre-requisite to relief against infringement. Once the court has found the challenge to the validity of the plaintiff’s trade mark, as raised by the defendant, to be *prima facie* tenable, and has also enabled the defendant to file a rectification petition in that regard, the Court cannot, therefore, while adjudicating on Order XXXIX application of the plaintiff, proceed on the premise that the plaintiff’s registration is valid. That, it was sought to be contended, would be a contradiction in terms. Validity of the plaintiff’s trade



mark being an inalienable pre-requisite for relief against infringement, what was sought to be contended is that the court, under Section 124(5), read with Order XXXIX of the CPC can only examine the allegation, if any, of passing off, which is not conditional on the plaintiff's trade mark being validly registered or, for that matter, registered at all.

87. I must admit that the contention, as articulated with the persuasiveness of which Mr. Lall is justly well-known, appeared, initially, to me to be extremely attractive. On a slightly more incisive examination, however, I find myself unable to agree with it.

88. As already noted, the Court, under Section 124(1)(ii) of the Act merely opines on the *prima facie* tenability of the challenge to validity. If it is the defendant who challenges the validity of the plaintiff's mark, therefore, the court under Section 124(1)(ii) merely opines that the challenge to the validity of the plaintiff's mark, as raised by the defendant, is *prima facie* tenable.

89. I have already expressed a view that a finding of *prima facie* tenability, as returned under Section 124(1)(ii), cannot be said to be a finding which in any manner opines on the merits of the said challenge. The merits of the challenge to the validity of the plaintiff's mark, as per the authoritative pronouncement in *Patel Field Marshal Agencies*²⁸, is something which is entirely within the province of the Court or other authority which would be seized of the rectification petition, if and when it is filed. Any finding in that regard by the suit Court under Section 124(1)(ii) would, therefore, be effectively a



finding by a forum which, applying the principles of *Patel Field Marshal Agencies*²⁸, is *coram non judice*.

90. Inasmuch as the opinion expressed under Section 124(1)(ii) is merely an opinion regarding *prima facie* tenability of the challenge to validity of PepsiCo's mark, it cannot in any manner deprive PepsiCo of the rights which flow to it, under Sections 28 and 29 of the Trade Marks Act, consequent on registration. Until and unless the registration is held, in the rectification proceedings (which, for that matter, the defendant may or may not choose to initiate), to be invalid, the benefit of such registration has necessarily to enure to the registrant.

91. This position is statutorily recognised by Section 31(1) of the Trade Marks Act, which applies to "*all legal proceedings*" relating to a registered trade mark. In all legal proceedings relating to a registered trade mark, Section 31(1) unambiguously ordains that the registration of the trade mark shall be *prima facie* evidence of its validity. The expression of opinion, by the court under Section 124(1)(ii), that the challenge to the validity of the plaintiff's trade mark, as raised by the defendant, is *prima facie* tenable cannot, therefore, detract from the *prima facie* validity of the said trade mark, statutorily conferred by Section 31(1). Both provisions i.e., Sections 31(1) and Section 124(1)(ii), envisage only *prima facie* views. The difference is, however, that while Section 124(1)(b)(ii) stops at the stage of an expression regarding *prima facie* tenability of a challenge to validity, leaving the merits of the challenge to be decided by the forum before whom the rectification petition would be preferred, Section 31(1) treats, by



statutory fiction, registration of a trade mark to be *prima facie evidence of the validity of the trade mark*.

92. Mr. Chandhiok emphasises the word “evidence” and the emphasis is, in my considered opinion, well taken. Every litigation, civil or criminal, is, ultimately, a chiaroscuro of evidence. At the Order XXXIX stage, each side is required to satisfy the court regarding the *prima facie* merits of its case. The court is not, at that stage, required to deal with the suit as it would deal with it subsequent to trial. The *prima facie* evidence available on both sides is required to be weighed and, depending on the side to which the scale would tilt, interim relief is to be granted or refused – of course, after factoring in the considerations of balance of convenience and irreparable loss.

93. Once, therefore, Section 31(1) of the Trade Marks Act treats, by statutory fiat, the registration of the plaintiff’s mark *as prima facie evidence of its validity*, the initial onus on the plaintiff to establish that the mark which it seeks to assert is *prima facie* valid stands discharged. The court, has, thereafter, therefore, only to examine whether the requisite ingredients to sustain a challenge of infringement do, or do not, exist.

94. As an incidental aside, I may observe that the issue of validity of the plaintiff’s trade mark is irrelevant to the aspect of whether infringement has, or has not, taken place. Section 29 of the Trade Marks Act is a self-contained code on the aspect of infringement. It merely requires the plaintiff’s trade mark to be registered. It does not



require the registration to be a valid registration. While examining whether infringement has or has not taken place, therefore, the court would not concern itself with the validity of the plaintiff's registration. It would only see whether the plaintiff's trade mark is registered and, if it is, whether the requisite ingredients, which are required to be satisfied to constitute infringement, exist. Validity of the registration of the plaintiff's mark does, however, become a relevant consideration when it comes to obtaining relief against infringement. Where infringement within the meaning of Section 29, is found to exist, relief against infringement can be obtained by the plaintiff under Section 28(1) only if its registration is valid. Once the court finds that the defendant has infringed the plaintiff's mark, thereafter, when it comes to the issue of passing consequential orders of relief, the court can examine whether the registration of the plaintiff's mark is, or is not, valid. To that extent, Mr. Sudhir Chandra is correct in his submission.

95. At the same time, while examining the aspect of validity under Section 28(1), as the examination is merely *prima facie*, the plaintiff would be entitled to the benefit of Section 31(1). In other words, the very registration of the plaintiff's mark would suffice as *prima facie* evidence of its validity. It is only, therefore, where there is overwhelming evidence of invalidity that a Court can, at the Order XXXIX stage, refuse injunction on the ground that the trade mark asserted by the plaintiff is *prima facie* invalid.

96. Else, the issue of validity of the plaintiff's registered trade mark is to be examined only in the rectification proceedings, preferred under Section 124(1)(ii). The suit Court, while deciding the



application of the plaintiff for interlocutory relief under Order XXXIX Rule 1 and 2 of the CPC cannot, therefore, proceed on the premise that the plaintiff's mark is *prima facie* invalid or even that the validity of the plaintiff's mark is *prima facie* vulnerable to challenge.

97. The only ground on which Mr. Sudhir Chandra has attacked the validity of PepsiCo's "For The Bold" trade mark is that it is descriptive and not-distinctive in nature. Mr. Sudhir Chandra's contention is that the use of the expression "For The Bold", by PepsiCo, is admittedly relatable to the flavour of the DORITOS tortilla chips. Though the submission undoubtedly merits consideration, I am hesitant at this juncture to hold that it is so overwhelmingly convincing that, on the ground of invalidity of PepsiCo's "For The Bold" trade mark, interlocutory injunction can be denied to PepsiCo. It has been held, by this Court, in *Teleecare Network India Pvt Ltd v. Asus Technology Pvt Ltd*³¹ that, while descriptive marks are ineligible for registration, suggestive marks can be registered.

98. The aspect of invalidity, therefore, in my view, would have to be examined and decided in C.O.(COMM.IPD-TM) 5/2021, and not while adjudicating the present application.

99. As to whether "For The Bold", when used in the context of tortilla chips, is a descriptive or merely a suggestive mark is, in my considered opinion, a matter which requires debate. Suffice it to state that, solely on the ground of descriptiveness and lack of

³¹ (2019) 262 DLT 101; (2019) 79 PTC 99



distinctiveness, as urged by Mr. Sudhir Chandra, I cannot see my way to denying an interlocutory injunction to PepsiCo on the ground that registration of the mark “For The Bold” is *prima facie* invalid.

100. For the purposes of adjudication of the present application under Section XXXIX Rules 1 and 2 of the CPC, therefore, Mr. Sudhir Chandra’s submission that the court should proceed on the premise that the registration of PepsiCo’s “For The Bold” trade mark is invalid is, therefore, rejected.

The aspect of infringement

101. Which leaves for consideration, insofar as the aspect of infringement is concerned, the issue of whether Parle’s “Be The Fizz! For The Bold!” mark does, or does not, infringe PepsiCo’s “For The Bold” registered mark.

102. The distinction between infringement and passing off, as intellectual property torts, is, by now, well-defined. Infringement merely involves comparison of marks without, however, placing them side-by-side. What is to be seen is that whether a customer of average intelligence and imperfect recollection, who sees the plaintiff’s mark at one point of time and, at a later point of time, comes across the defendant’s mark, is likely to be placed in a state of wonderment as to whether the mark which he has seen on the later occasion is the same as that which he saw earlier, or whether the two marks have an association with each other.



103. No doubt, Mr. Chandhiok is correct in his submission that the impugned mark of Parle subsumes in its entirety PepsiCo’s “For The Bold” mark but that, however, is not the end of the story. “Infringement” can be said to exist only where the ingredients for infringement, as set out in Section 29 of the Trade Marks Act, are found to be satisfied.

104. Mr. Sudhir Chandra sought to contend that PepsiCo does not use “For The Bold” as a trade mark at all and that in fact, PepsiCo’s trade mark is DORITOS. “For The Bold”, in his submission, is merely an incidental tagline which is found on the reverse of the DORITOS packs.

105. This is, in fact, a contention which is raised before me in case after case, and which I have, I confess, yet fully to understand. What exactly is meant by the contention that a party does not use a mark, which is registered in its favour, “as a trade mark”? What are the definitive *indicia* on the basis of which the use of a mark can be regarded as use “as a trade mark”, *vis-à-vis* other use? Insofar as the present case is concerned, indisputably, “For The Bold” is registered as a trade mark in favour of PepsiCo. Mr. Sudhir Chandra would seek to contend, nonetheless, that PepsiCo does not use “For The Bold” as a trade mark, and, therefore, cannot plead infringement. The argument is liable to be rejected, outright, even for the simple reason, as pointed out by Mr. Chandhiok, that “For The Bold” is in fact a registered trade mark of PepsiCo. Once it is a registered trade mark, all that is to be seen is whether the ingredients of infringement, as set out in the various clauses and sub-sections of Section 29 are met.



Insofar as the plaintiff, who complains of infringement, is concerned, Section 29 does not distinguish between a registered trade mark which is used as a trade mark and a registered trade mark which is not so used. The submission of Mr. Sudhir Chandra that PepsiCo does not use “For The Bold” as a trade mark is, therefore, wholly irrelevant while examining the aspect of infringement.

106. I do not, therefore, propose, in this case, to delve into the jurisprudential intricacies of the principle of “use of a mark as a trade mark”. That may be reserved as intellectual fodder for another, more apt, occasion.

107. Trade marks cannot infringe. They are inanimate, intangible entities, which can commit neither good nor evil. Infringement is a tort manifested by a physical act, which the innocent trade mark is incapable of performing. It is for this reason that each sub-section of Section 29 refers to infringement of a registered trade mark “by a person”. It is the person, therefore, who infringes; not the trade mark. The infringement is, however, committed by the person by using the trade mark in a particular manner; for this reason, each sub-section of Section 29 envisages infringement as having occurred when the person uses a mark in a particular fashion. Section 29(6) enumerates certain instances which would amount to “use”, by the infringer, of a registered mark. These include, in clause (a), affixation of the mark on goods or their packaging and, in clause (d), use of the mark on business papers or in advertising. This aspect is of importance in the present case, as the discussion hereinafter would reveal.



108. Section 29(1) applies only where the defendant uses the impugned mark “in relation to goods or services in respect of which the trade mark” of the plaintiff is registered. Parle uses the “Be The Fizz! For The Bold!” mark for a malted beverage, which is not one of the items in respect of which PepsiCo’s “For The Bold” trade mark is registered. Section 29(1), therefore, does not apply.

109. Section 29(2) envisages three situations, in clauses (a) to (c) thereof. Clauses (a) and (c) apply where the rival trademarks are identical, with clause (c) further requiring the goods or services in respect of which the rival marks are used also to be identical. Neither of these clauses, obviously, applies in the present case, as the rival marks are *not* identical.

110. Clause (b) of Section 29(2) applies where the rival marks are similar and the goods or services covered by rival marks are identical or similar. Where both these conditions are satisfied, infringement within the meaning of Section 29(2) would be found to have taken place, if the similarity between the marks, and the identity or similarity between the goods or services, is likely to cause confusion on the part of the public or to lead the public to believe the existence of an association between the marks.

111. Mere similarity between the marks and identity or similarity between the goods or services in respect of which the marks are used would not, therefore, even if they are found cumulatively to exist, justify a finding of infringement. Such a finding can be returned, only if, additionally, (i) there is likelihood of confusion on the part of



public or likelihood of association between the marks and (ii) such likelihood of confusion or association is attributable to the similarity of the marks and the identity or similarity of the goods or services covered by the marks.

112. While examining whether Section 29(2)(b) applies, therefore, the Court is required to examine whether (i) the rival marks are similar (ii) the goods or services covered by the rival marks are identical or similar and (iii) owing to such similarity of the marks and identity or similarity of the goods or services covered by the marks, there is either (a) likelihood of confusion or (b) likelihood of association. It is only where all these *indicia* (i) to (iii) are found to cumulatively to exist, that an inference of infringement would follow.

113. It is also well-settled that, while comparing the marks, comparison has to be of the marks taken as whole marks in their entirety, and that the Court cannot vivisect the marks or compare parts thereof. Nor can the court compare the whole of one mark with the part of another. The likelihood of confusion has to be assessed by comparing the marks as wholes.³² Between PepsiCo's "For The Bold" trade mark and the impugned label on Parle's "B Fizz" bottle/can, when one undertakes this exercise in the present case, the only criterion, of the three criteria which are cumulatively required to be satisfied, delineated as (i) to (iii) *supra*, for infringement within the meaning of Section 29(1)(b) of the Trade Marks Act to be found to exist, appears, to me, to be criterion (ii), i.e. similarity of the goods or services covered by the rival marks.

³² Refer *South India Beverages Pvt Ltd v. General Mills Marketing Inc*, (2015) 61 PTC 231 (Del-DB)



114. While examining the aspect of similarity of goods or services covered by the rival marks, the view of the court is not necessarily circumscribed by the class in respect of which the marks are registered/used. Though beverages do not fall within the goods in respect of which PepsiCo's "For The Bold" mark is registered, that by itself is not determinative of the issue of whether the rival marks are used for goods which are identical or similar. Goods may be similar, even if they fall within different classes of the NICE classification applicable to registration of trade marks.

115. Viewed thus, there is substance in Mr. Chandhiok's submission that the "B Fizz" malted beverage in respect of which Parle uses the impugned "Be The Fizz! For The Bold!" mark is allied or cognate to the tortilla chips in respect of which PepsiCo uses the asserted "For The Bold" mark.

116. Consumption of items such as chips as accompaniments while imbibing alcoholic beverages is known to be a common practice. Parle's "B Fizz" is admittedly a "mock beer" which is supposed to provide the experience of consuming beer without its adverse sequelae. If that is so, Mr. Chandhiok's submission that the goods in respect of which PepsiCo's "For The Bold" trade mark is registered and the goods in respect of which Parle uses the "Be The Fizz! For The Bold!" mark is allied or cognate *prima facie* merits acceptance.

117. Insofar as the remaining two ingredients, which are also cumulatively required to be satisfied in order for "infringement"



within the meaning of Section 29(2)(b) of the Trade Marks Act to exist are concerned, Parle uses “For The Bold” both as part of the label or its “B Fizz” bottle, as well as in its advertisement campaign on its social media webpages. Both constitute “use” within the meaning of Section 29(6). The two taglines are not different. It is the same “For The Bold” tagline which figures on the label of Parle’s “B Fizz” beverage bottle as well as in its advertisement campaigns on its social media webpages. That being so, if either of the manners of use, by Parle, of the “For The Bold” tagline, is so confusingly or deceptively similar to PepsiCo’s “For The Bold” registered mark as to result in confusion in the mind of the average consumer, infringement must be held to have been committed. In other words, if the plaintiff’s mark is “used” – within the meaning of Section 29(6) – by the defendant in many different ways, and, in some of them, the plaintiff’s mark is infringed, the use of the defendant’s mark would *ipso facto* be rendered infringing in nature. Such infringing use has necessarily to be enjoined. It has to be remembered, however, that what is enjoined is not the mark, but its infringing manner of use.

118. Ingredient (i), for Section 29(2)(b) to apply, requires the rival marks to be similar. PepsiCo’s registration is for the “For The Bold” word mark. “For The Bold” is used by Parle, apropos its “B Fizz” malted beverage, both as part of the label on the bottle, as well as in its advertising campaign. Each constitutes a distinct matter of “use”, one relatable to Section 29(6)(a) and the other to Section 29(6)(d) of the Trade Marks Act.

119. The issue of whether there is similarity between PepsiCo’s



registered mark and the impugned mark of Parle has to be examined from the point of view of a customer of average intelligence and imperfect recollection, who comes across the two marks at two different points of time and not by placing the marks side-by-side. In fact, this consideration dovetails into the third ingredient (iii), which requires, for Section 29(2)(b) to apply, that a customer, who chances upon these two marks at two different points of time, is likely to be confused between them or believe an association between the marks because of the use of the impugned mark by the defendant. “Confusion”, no doubt, in this context, is required to be initial interest confusion. In other words, if at an initial glance at the defendant’s mark, the customer wonders, with proverbial head cocked to a side, whether the mark is the same as the plaintiff’s mark which he had seen earlier, or whether they are associated, then, “likelihood of confusion” within the meaning of Section 29(2) would be found to exist.

120. As used on the label of Parle’s “B Fizz” bottle, it takes an effort to notice the “For The Bold” tagline. It is printed upside down and reads right to left. The slogan is disproportionately small in size, as compared to the main brand of the product which is “B Fizz”, with “B” and “Fizz” prominently figuring one below the other. The least conspicuous part of Parle’s label is, in fact, the “For The Bold!” tagline, featuring towards the lower edge of the label. It is only a customer who is particularly searching for the tagline who, therefore, would notice it.

121. That apart, there is substance in Mr. Sudhir Chandra’s



contention that “For The Bold” is only part of the entire label on Parle’s beverage bottle. The label reflects, prominently, the bold capital letter “B”, with “Fizz” also prominently figuring below it. The “Be The Fizz! For The Bold!” tagline is relegated to the border of the label, with “Be The Fizz!” in the upper half and “For The Bold!” written upside down in the lower half. “For The Bold!”, therefore, is only a part – and a somewhat insignificant one – of the impugned label of Parle. Even if it is treated as part of the “Be The Fizz! For The Bold!” tagline, it nonetheless constitutes only the latter half of the tagline.

122. Applying the principle of comparison of two marks as whole marks, coupled with the aspect of likelihood of confusion or association between the two marks in the minds of a customer of average intelligence and imperfect recollection, I am unable to subscribe to Mr. Chandhiok’s submission that the use, by Parle, of the impugned label, and of “For The Bold!” as part of it, is infringing in nature within the meaning of Section 29(2) of the Trade Marks Act.

123. No such benefit of doubt can, however, be extended to Parle, apropos the manner in which “For The Bold” is used by it in its advertising campaign. There can be no manner of doubt that, as used in the above advertisements on Parle’s Facebook social media webpage (reproduced in para 13 *supra*), the mark “For The Bold” is unquestionably infringing in nature. There is, indeed, in one of the advertisements, nothing except “For The Bold”, without even a picture of the bottle of the beverage. In the second advertisement, though the bottle of the beverage is shown, the “For The Bold”



caption takes up nearly the whole of the screen. The most – indeed, probably the only – prominent feature of both the advertisements is, therefore, the “For The Bold” tagline.

124. As used in the above Facebook advertisements, therefore, “For The Bold” constitutes an independent mark, and not merely an insignificant part of a larger label, as on the surface of the “B Fizz” bottle. As an independent mark, it is identical to the registered “For The Bold” word mark of PepsiCo. The two marks being identical, Section 29(2)(c) read with Section 29(3) would apply, and the Court is bound to presume the likelihood of confusion as a result of the use of the “For The Bold” mark by Parle. The use, by Parle, of “For The Bold” as part of its advertising campaign for its “B Fizz” beverage is, therefore, unquestionably infringing in nature.

125. The position that results is, therefore, that Parle uses PepsiCo’s registered “For The Bold” tagline in two ways – as part of its label and in its advertising campaign – one of which is infringing, and the other non-infringing in nature.

126. The Court cannot injunct a mark. It is only the infringing use of a mark which can be injuncted. In view of the above discussion, while I am not inclined to injunct the use, by Parle, of “For The Bold” in its present form as part of the label on the “B Fizz” bottle, the manner in which Parle uses “For The Bold” in its advertising campaign on Facebook necessarily has to be injuncted.

Re. Section 30(2)(a) and 35



127. Section 30(2)(a) envisages, as an exception to infringement, the use of a mark which is indicative of “the kind, quality, quantity, intended purpose, value, geographical origin, type of production of goods or of rendering of services or other characteristics of goods or services”. One of the contentions which Mr. Sudhir Chandra sought to advance was that the “Be The Fizz! For The Bold!” tagline is descriptive of the “B Fizz” beverage in respect of which it is used and that, therefore, its use could not be regarded as infringing in nature. Mr. Chandhiok submitted that this argument of Mr. Sudhir Chandra is completely unsupported by pleadings, at least to the extent necessary to sustain it. I have gone through the written statement of Parle and find that, beside a bald assertion that “Be The Fizz! For The Bold!” was being used by it as descriptive of its beverage, as it was intended to mimic the “bold” flavour of beer, there is nothing to substantiate the contention. Though, as a non-imbiber myself, I am not in a position to comment on whether beer has a “bold” flavour, nonetheless, in the absence of any corroborative material, I am not inclined to accept Mr. Sudhir Chandra’s contention that “For The Bold” could be regarded as descriptive of the “B Fizz” malted beverage in respect of which it is used. At any rate, it appears to me that the issue would require a trial, and cannot, based on the pleadings in the written statement, constitute the basis for prima facie finding that Parle is innocent of infringement.

128. This finding would apply, *mutatis mutandis*, to Section 35 as well, as what is proscribed, by the said provision, is interference with the *bona fide* use, by a person, “of any *bona fide* description of the



character of quality of his goods or services”. The pleadings in the written statement, unsupported by evidence and prior to trial, do not make out a *prima facie* case of the use, by Parle, of “For The Bold” tagline as the basis for advertising its “B Fizz” beverage, as use of a “*bona fide* description of the character or quality” thereof. Insofar as the use of “For The Bold” as part of the label on the “B Fizz” bottle/can is concerned, I have already held it not to be infringing in nature.

Re: Passing Off

129. In view of my finding that there is no likelihood of confusion between PepsiCo’s registered “For The Bold” mark and Parle’s “Be The Fizz! For The Bold!” tagline, as used on the “B Fizz” bottle/can, no *prima facie* case of passing off can be said to be made out.

130. Besides, passing off is a common law tort, which is committed only where the defendant, by use of the impugned mark, is seeking to pass off its product as the product of the plaintiff. It cannot be said, on a comparison of the marks in the present case, that Parle is seeking to pass off its “B Fizz” product as the product of PepsiCo, especially as Parle’s identity is prominently reflected on the impugned label.

131. The distinction between passing off and infringement is thus classically captured in paras 28 and 29 of the decision of the Supreme Court in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*³³:

³³ AIR 1965 SC 980



“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the



essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's, 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 plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). 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 plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's 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."



132. Applying the test laid down in the above decision, the impugned label of the “B Fizz!” product of Parle is sufficiently distinct and different from PepsiCo’s pack which uses the “For The Bold” slogan only on its reverse, to militate against any chance of confusion between the two.

133. Besides, a finding of passing off can be returned only if the plaintiff, in the first instance, proves the existence of sufficient goodwill and reputation of the mark which it seeks to assert. In the present case, there is no evidence of any goodwill and reputation having been earned, by PepsiCo, relatable to the use of the “For The Bold” mark. No doubt, PepsiCo has placed on record sales figures of its DORITOS tortilla chips which are unquestionably formidable. That said, however, as Mr. Sudhir Chandra correctly points out, there is nothing to indicate that the sales figures are relatable to the use, by PepsiCo, of its “For The Bold” tagline. The reputation which is required to be established, to sustain a plea of passing off, is reputation of the mark and not reputation of the product bearing the mark. If anything, the sales figures of PepsiCo’s tortilla chips would be attributable to the use of the DORITOS mark, and not to the “For The Bold” which figures at the reverse of the pack. Even on the ground of want of sufficient material to establish goodwill and reputation held by the “For The Bold” tagline by PepsiCo on its DORITOS tortilla chips, therefore, the plea of passing off cannot sustain.

134. No sustainable case of passing off, by Parle against PepsiCo, is, therefore, made out in the present case.



Balance of convenience and irreparable loss

135. Parle has, indisputably, been manufacturing and selling its “B Fizz” product, bearing the impugned mark, since September 2020. According to the averments in the written statement, which presently are uncontroverted at the Bar, the sales, by Parle, of its “B Fizz” beverage, far outnumber the sales of DORITOS tortilla chips by PepsiCo. Even in the year 2020-2021, Parle’s “B Fizz” beverage resulted in returns of ₹ 232 crores, between September 2020 and May 2021, as against returns, from sales of PepsiCo’s DORITOS tortilla chips, of ₹ 183 crores between 2016 and 2020.

136. We are now in 2023 and, no doubt, the sales and reputation of both the brands would have increased manifold.

137. The principle of balance of convenience and irreparable loss cannot be forgotten while considering a plea for interlocutory injunction in intellectual property matters. In a recent order, passed by a Division Bench of this Court, in *Hi Tech Arai Pvt Ltd v. Paul Components Pvt Ltd*³⁴, this Court has emphasised that orders for interlocutory injunction in intellectual matters have also to conform to the *troika* of existence of a *prima facie* case, balance of convenience and irreparable loss and that no interim injunction can be granted solely on the ground of existence of a *prima facie* case. I may note that, even in the judgment of the Supreme Court in *Laxmikant V. Patel v. Chetanbhai Shah*³⁵ while the Supreme Court has observed that where infringement is found to exist, the normal practice is to

³⁴ Order dated 23 August 2023 in FAO (OS) (COMM) 175/2023

³⁵ 2002 3 SCC 65



pass an order of injunction, the preceding paragraph of the very same decision emphasises the requirement of fulfilment of the criteria of *prima facie* case, balance of convenience and irreparable loss.

138. Even applying the principles of *prima facie* case, balance of convenience and irreparable loss, therefore, it cannot be said that, at this point of time, the interests of justice would warrant grant of interlocutory injunction as sought by PepsiCo. Rather, the interests of justice would stand adequately safeguarded if Parle is directed to place on record the entire returns earned by the sales of its “B Fizz” beverage, using the label which contains “For The Bold” from the time the use of the said label commenced, duly certified by a Chartered Accountant. Parle would continue to file, every two months, duly certified figures of returns of sales from its “B Fizz” beverages, during the pendency of the suit.

Overall Outcome

139. IA 7170/2021 and IA 9591/2021 stand disposed of in the following terms:

- (i) The challenge, by Parle, to the registration of the “For The Bold” trade mark of PepsiCo is found to be tenable. By this, however, it is clarified that the Court only intends to convey that the challenge is arguable and requires consideration. The Court has not expressed any opinion on the merits of the challenge, even tentative. The merits of the challenge shall be examined while adjudicating C.O. (COMM. IPD-TM) 5/2021, uninfluenced by any observation contained in



this judgment. For the said purpose, and without intending it to operate as a precedent, C.O.(COMM.IPD-TM) 5/2021 is treated as an application under Section 124(1)(a)(ii) of the Trade Marks Act. Notice is deemed to have been issued thereon and accepted by Mr Manish Jha, learned counsel for PepsiCo.

(ii) The Court, accordingly, frames the following issue:

“Whether the registration of the tagline “For The Bold”, as a trade mark in favour of PepsiCo is valid?

(iii) While pre-trial proceedings, in the present suit, would continue, trial of the present suit shall, in view of Section 124(2) of the Trade Marks Act, stand stayed, pending disposal of C.O.(COMM.IPD-TM) 5/2021.

(iv) C.O.(COMM.IPD-TM) 5/2021 shall be taken up for hearing and disposal at 2:30 PM on 25 September 2023, when it is next listed. No request for adjournment would be entertained. Parle and PepsiCo would each be restricted to 40 minutes of argument, with 15 minutes to Parle for rejoinder. No surrejoinder shall be permitted. Each side is directed to place on record brief notes of their respective submissions, not exceeding five pages, accompanied by duly indexed compilations of any judicial authorities on which they may seek to place reliance, after exchanging copies with each other, at least 48 hours in advance of hearing. The arguments must be confined to the points raised in written submissions, and arguments beyond the written submissions would not be



considered.

(v) Inasmuch as the ground of challenge, by Parle, to the “For The Bold” trade mark of PepsiCo is purely legal in nature, no additional evidence shall be permitted to be led. Parties would rely on the pleadings and the documents already on record.

(vi) IA 9591/2021 stands allowed in the aforesaid terms.

(vii) IA 7170/2021 is disposed of as under:

(a) The prayer for interlocutory injunction against use, by Parle, of “For The Bold” as part of the label on its “B Fizz” bottle/can is rejected.

(b) However, Parle shall be restrained, pending disposal of the suit from altering the label on its “B Fizz” beverage bottle/can without prior approval of this Court.

(c) Parle shall also stand restrained, pending disposal of the suit, from using the tagline “For The Bold” as the predominant part of any advertising campaign for its “B Fizz” beverage. Specifically, Parle is restrained, forthwith, from airing or continuing the Facebook advertisements extracted in para 13 *supra*. The said advertisements, if continuing, shall be immediately taken down and discontinued.

(d) In the event of any fresh advertising campaign, or



advertisement, by Parle, which uses “For The Bold” as its dominant/predominant part, PepsiCo would be entitled to move this Court by means of an interlocutory application in the present suit, seeking injunctive reliefs.

(viii) Parle is directed to place on record the entire returns earned by the sales of its “B Fizz” beverage, using the label which contains “For The Bold” from the time the use of the said label commenced, duly certified by a Chartered Accountant. Parle would continue to file, every two months, duly certified figures of returns of sales from its “B Fizz” beverage, during the pendency of the suit.

140. At this stage, learned Counsel for PepsiCo prays that the next date of hearing in C.O. (COMM) IPD-TM. 5/2021 may be fixed in the second week of October.

141. Accordingly, the Registry is directed to list C.O. (COMM.) IPD-TM. 5/2021 on 17 October 2023 at 02:30 PM

142. The next date already fixed in C.O. (COMM.) IPD-TM. 5/2021 i.e., 25 September 2023, stands cancelled.

C.HARI SHANKAR, J

SEPTEMBER 18, 2023

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