

IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

LD/VC/IA/203A/2020

IN

LD/VC/203/2020

(COMMERCIAL IP SUIT (L) NO. _____ OF 2020)

Hindustan Unilever Ltd. ...Applicant/Plaintiff vs.
Emami Ltd. ...Defendant

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Mr. Virag Tulzapurkar, Senior Advocate, a/w. Mr. Venkatesh Dhond, Senior Advocate, Mr. Hiren Kamod, Mr. Vaibhav Keni and Ms. Neha Iyer, i/b. Legasis Partners, for the Applicant/Plaintiff.

Mr. Jishnu Saha, Senior Advocate, a/w. Mr. Ranjan Bachawat, Senior Advocate, Mr. Debnath Ghosh, Mr. Sanjay Ginodia, Mr. Shwetank Ginodia and Ms. Adreeka Pandey, i/b. Mr. Lakshyaved Odhekar, for the Defendant.

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CORAM : S.C. GUPTA, J.

DATE : 17 AUGUST 2020

P.C. :

. Heard learned Counsel for the parties.

2. This interim application is made by the Plaintiff, who claims to be a proprietor and prior user of the mark "Glow & Handsome" for its well known skin cream, thus far marketed under the trademark "Fair & Lovely", seeking to restrain the Defendant, who is a rival manufacturer and trader of goods, from using the mark "Glow & Handsome" for its rival product.

3. The Plaintiff claims to be manufacturing and selling various skin care and beauty products, including the skin cream marketed under the trademark "Fair &

Lovely", since long. The trademark "Fair & Lovely" is claimed to have been adopted by the Plaintiff in 1975. The Plaintiff's case is that the product marketed under the trademark "Fair & Lovely" has become a household brand and a market leader in its category. The Plaintiff holds registration for the mark "Fair & Lovely" together with various other formative marks in relation to it. The Plaintiff claims to have marketed and advertised its goods under these trademarks extensively, their aggregate sales ranging between Rs.1200 crores for the year 2009-2010 to over Rs.2400 crores in the year 2019-2020. It is the Plaintiff's case that in keeping with the recent trend world over, so as to move away from the focus on the word "fair" as part of a beauty product, the Plaintiff has proposed to change its mark from "Fair & Lovely" to "Glow & Handsome". Sometime in September 2018 (on 7 September 2018, to be precise), the Plaintiff applied for registration of the new trademark "Glow & Handsome". The Plaintiff also proceeded to obtain permission from Food and Drugs Administration ('FDA') of its trademark "Fair & Lovely" to the new mark "Glow & Handsome". That permission appears to have come about on 2 August 2020. By a press release dated 3 July 2020, the Plaintiff announced its proposed use of the trademark "Glow & Handsome" for the product hitherto marketed under the trademark "Fair & Lovely". The Plaintiff has produced extensive material with its plaint, setting out the sales effected thus far by the Plaintiff of its product under the new trademark as also expenditure incurred for media coverage and promotion of the new trademark. It is the Plaintiff's grievance that on 27 July 2020, the Defendant purported to announce what it describes as a process of launching products under the trademark "Glow And Handsome". The Plaintiff has, in the premises, moved the present application seeking an interim injunction against the Defendant from using the trademark "Glow And Handsome". The Plaintiff's action is essentially an action in passing off, since the Plaintiff does not yet hold registration of the trademark "Glow & Handsome".

4. So far as the Defendant is concerned, its case is that it has been marketing its skin care product under the trademark “Fair & Handsome” and that the Plaintiff is not entitled to use the trademark “Glow & Handsome” for a similar product, since such user would infringe the Defendant's registered trademark “Fair & Handsome” and also amount to passing off of goods. The Defendant appears to have initiated its own infringement and passing off action seeking a perpetual injunction against the Plaintiff's user of the trademark “Glow & Handsome” before Calcutta High Court. The Defendant appears to have moved an application in that suit seeking an interim injunction against the Plaintiff in respect of the latter's use of the trademark “Glow & Handsome”. As of date, the Defendant has not been able to obtain any ad-interim order from Calcutta High Court. Be that as it may, the Defendant's case is that it is a prior adopter of the mark “Glow And Handsome”. It claims to have applied for trademark registration of the mark “Glow And Handsome” on 25 June 2020. That application has been accepted and advertised in the Trademark Journal. (The Plaintiff submits that within the time available to it for contesting the Defendant's application for registration, it would be filing an opposition.) The Defendant also claims to have digitally launched the trademark “Glow And Handsome” on 27 June 2020. That is where the matter stands as far as the Defendant's claim to the use of the trademark “Glow And Handsome” is concerned.

5. Before we assess the prima facie merits of rival cases of the parties for the purposes of this ad-interim application, one more event needs to be noted. Sometime in June-July 2020, the Defendant had threatened an action against the Plaintiff for its proposed use of the mark “Glow & Handsome”. That led to the Plaintiff filing a suit under Section 142 of the Trade Marks Act in this Court. In that suit, filed on 5 July 2020, on the Plaintiff's application (made at that stage ex-parte), a learned Single Judge of this Court directed the Defendant herein to give

a minimum seven days' notice to the Plaintiff in case any action was launched by it towards infringement or passing off in respect of the Plaintiff's use of the trademark "Glow & Handsome". After this order was served on the Defendant, the Defendant did appear. It filed an appeal from the order of the Single Judge. The appeal court refused to interfere. It, however, reserved liberty unto the Defendant to apply for reliefs before the learned Single Judge. The Defendant, thereafter, appeared before the learned Single Judge, by which time, it had already given the requisite seven days' notice to the Plaintiff for its infringement and passing off suit before Calcutta High Court. So far as other actions, if any, by the Defendant are concerned, the requirement of seven days' notice still stands.

6. In the backdrop of these facts, it is worthwhile to note at the outset that the Plaintiff prima facie appears to be a prior adopter and user of the mark "Glow & Handsome". Whether its use by the Plaintiff amounts to an infringement of the Defendant's registered trademark "Fair & Handsome" or whether sale of goods under the former trademark amounts to passing off of goods sold by the Defendant under its trademark "Fair & Handsome", are not the subject matters for this Court to decide in the present application. These are, as we have noted above, already the subject matter of the Defendant's own suit before the Calcutta High Court and would be addressed by that Court. So far as this Court is concerned, it is sufficient to note at this early prima facie stage that the Plaintiff is a prior adopter and user of the mark "Glow & Handsome"; it has already launched its goods in the market with that trademark; and so far as the Defendant is concerned, it is admittedly at the stage of adopting "a process of launching" its goods under the trademark "Glow & Handsome". Its application for registration of that mark is also of a subsequent date. The Plaintiff has submitted its sales figures as well as advertisement and promotional expenses incurred by it for the trademark "Glow & Handsome". These particulars are backed by material

produced along with the plaint. On these facts, surely the Plaintiff is entitled to an ad-interim injunction at this stage.

7. Learned Counsel for the Defendant submits that assuming that the Plaintiff first adopted the mark “Glow & Handsome” and has even used it first in relation to its goods, there is no case of sufficient reputation and public association of the product sold by the Plaintiff under that mark with the Plaintiff. In any action of passing off, just as the court considers proprietary interests of rival traders, the court is also essentially concerned with the likelihood of deception amongst the customers and public. The Plaintiff can certainly be said to have sufficiently advertised its new brand “Glow & Handsome” which replaces its earlier well-known mark “Fair & Lovely” and at this threshold stage, it is reasonable to see that there is a concrete likelihood of confusion and deception in the public, if identical marks are allowed to hold the field for popular and much sold commodities.

8. Whilst the parties may be given some time to complete their respective pleadings, it would be in the interest of justice to then take up the matter on an expeditious basis for hearing of the interim application. Till that happens, the Defendant, who has not yet brought its own goods into the market under its proposed trademark “Glow & Handsome”, deserves to be restrained from doing so.

9. Accordingly, there will be an ad-interim injunction in terms of prayer clause (a), which is quoted below :-

“(a)That pending the hearing and final disposal of the suit, the Defendant, its directors, proprietors, partners, owners, servants, subordinates, representatives, dealers, agents

and all other persons claiming under it be restrained by a temporary order and injunction of this Hon'be Court from using the alleged mark 'GLOW AND HANDSOME' and/or any other mark containing the words 'GLOW AND HANDSOME' and/or any other mark identical with and/or deceptively similar to the Plaintiff's wellknown trademark 'GLOW & HANDSOME' in respect of grooming, skincare and cosmetic products and/or allied/cognate/complimentary goods so as to pass off or enable others to pass off the Defendant's goods as and for the Plaintiff's well known goods, including online mediums or in any other manner whatsoever."

10. The Defendant to file its reply in the interim application within two weeks from today. Rejoinder, if any, within two weeks thereafter. The interim application to appear on board for hearing after five weeks.

11. It is made clear that this order shall not in any manner come in the way of the Defendant claiming in its own suit in Calcutta High Court a restraint order against the Plaintiff's use of the trademark "Glow & Handsome". So also, it is made clear that the Plaintiff cannot claim any equities so far as its use of the mark "Glow & Handsome" hereafter is concerned.

12. This order will be digitally signed by the Personal Assistant of this Court. All concerned will act on production by fax or email of a digitally signed copy of this order.

(S.C. GUPTE, J.)