

IN THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment delivered on: 11.07.2022

+ **FAO(OS) (COMM) 100/2022 & CAV 112/2022, CM APPL. 20947/2022, CM APPL. 20948/2022**

SOOTHE HEALTHCARE PRIVATE LIMITED Appellant

versus

DABUR INDIA LIMITED Respondent

Advocates who appeared in the case:

For the Appellant: Mr. Rajshekhar Rao, Sr. Adv. with Mr. Utkarsh Joshi, Mr. Shrey Patnaik, Ms. Mansi Sood and Ms. Anjali Menon, Advs.

For the Respondent: Mr. Manish Kumar Mishra, Mr. Srinivas Venkat and Ms. M. K., Advs.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU


HON'BLE MR. JUSTICE AMIT MAHAJAN


JUDGMENT

AMIT MAHAJAN, J

1. “Soothe Healthcare Private Limited”, hereinafter referred to as “SOOTHE”, which is in the business of manufacturing, marketing and trading of goods relating to personal hygiene including sanitary preparations and allied products, filed a suit seeking permanent injunction against the “Dabur India Limited”, hereinafter referred to as “DABUR”, from infringing / passing off, *inter alia*, the relevant trademarks of SOOTHE.

2. SOOTHE obtained trademark registration in its favour for the marks

“SUPER CUTEESTERS”  , “SUPER CUTEZ” and “SUPER CUTE’S” in the year 2019 and 2020. It then commenced the use of marks for its product, baby diapers.

3. SOOTHE claims that the trademark application in respect of the trademark / device mark  is pending registration before the Trademark Registry.

4. SOOTHE claims that DABUR commenced marketing and selling baby diapers using the deceptively similar trademark, i.e., “DABUR BABY SUPER PANTS”. It is claimed that the use of mark “DABUR BABY SUPER PANTS” is deceptively similar to its trademark for similar products, i.e., baby diapers and has, therefore, infringed SOOTHE’s registered trademark. For the ease of reference, SOOTHE’s packaging and DABUR’s packaging are produced herein:



5. SOOTHE, on being aware of the use of the mark “DABUR BABY SUPER PANTS”, issued a cease and desist notice dated 02.11.2021. DABUR responded to the said notice by a letter dated 04.12.2021.
6. SOOTHE along with the suit also filed an application under Order XXXIX Rule 1 and 2 of Code of Civil Procedure, 1908 (CPC), which was dismissed by the impugned judgment dated 03.03.2022 passed by the learned Single Judge.
7. The dismissal of the said application led to filing of the present appeal.
8. The learned Single Judge considered the rival submissions and came to a *prima facie* conclusion that DABUR has not infringed SOOTHE’s trademark and that DABUR is not passing off its goods as those of SOOTHE. The learned Single Judge held as under:

“8. A comparison of the packaging of the defendant and the plaintiff above shows that other than the word “SUPER” occurring in both the aforesaid packaging, there is no other similarity. The packaging of the defendant includes the trademark of the defendant, ‘Dabur’ which is prominently displayed. Merely because the word ‘Dabur’ is written in a slightly smaller font as compared to ‘SUPER PANTS’, in my opinion, would not make any difference. The fact of the matter is that the word ‘Dabur’ is prominently displayed on the packaging along with the word ‘baby’. The colour scheme of the packaging is also totally different. The colour scheme of the plaintiff is yellow and orange/blue and yellow, and the defendant is primarily green. From the description of the packaging of the defendant’s product, it is more than clear that there is enough added material therein to distinguish the defendant’s product from that of the plaintiff. Therefore, it cannot be said that there is a possibility of confusion or deception being caused among the customers of the two products. Hence, I am not convinced that the defendant is passing off their goods as those of the plaintiff.

9. The next issue that comes up for consideration is whether word ‘super’ is a descriptive or a laudatory word and whether it can attain distinctiveness in respect of the goods of the plaintiff. As per the Oxford’s Learners Dictionary, the word ‘super’ means

'extremely good', and as per the Cambridge Dictionary also, the word 'super' means 'excellent or extremely good'. Clearly, as per its dictionary meaning, the word 'super; is a laudatory word of the English Language.

10. There is merit in the submission of the defendant that the word 'super' has been used by the plaintiff itself in a laudatory/descriptive manner. A look at the packaging of the plaintiff clearly demonstrates that the word 'super' has been used at several places in a laudatory manner. To illustrate, the packaging of the plaintiff includes the following phrases: 'Super Soft Feel, 'Super Thinz', 'Super Bubble Technology', and 'Super Absorbent', which suggest that the products of the plaintiff have an extremely soft feel to the body and are extremely absorbent. By use of the word 'super', the plaintiff is seeking to highlight the positive quality/attributes of its diapers. This leaves no doubt in my mind that the plaintiff is using the word 'SUPER' in a laudatory/descriptive manner.

11. A bare look at the packaging/label of the defendant also clearly demonstrates that the defendant has used the word 'SUPER' in conjunction with the words 'PANTS' in a descriptive manner along with the trademark of the defendant 'Dabur'. The word 'PANTS' is used in respect of the diaper and by using the expression 'SUPER PANTS', the defendant is seeking to convey that its diapers are of extremely good quality. Therefore, in my view, the expression 'SUPER PANTS' has been used by the defendant in a laudatory/descriptive manner. Furthermore, the defendant has not sought registration in the mark 'SUPER PANTS', but in respect of the composite device mark of the entire packaging, which includes the mark 'SUPER PANTS' as well as the trademark of the defendant 'Dabur' along with the word 'Baby'. Thus, it cannot be said that the use of the mark 'SUPER PANTS' by the defendant is not bona fide."

9. SOOTHE has assailed the impugned judgment on various grounds. It claims that the trademarks "SUPER CUTESTERS", "SUPER CUTE'S" and "SUPER CUTEZ" have gained immense popularity and reputation in relation to SOOTHE's product amongst its consumers. That SOOTHE is a prior adopter and a registered proprietor of various trademarks and, thus, enjoys exclusivity in respect of the said marks.

10. It is further contended that DABUR started using the deceptively similar mark in October, 2021 in order to dishonestly benefit from the

popularity of SOOTHE's mark.

11. It is stated that DABUR is using the deceptively similar trademark, i.e., "SUPER PANTS" in respect of identical goods, i.e., diapers; therefore, SOOTHE is entitled for grant of injunction in terms of Sections 28, 29 and 31 of the Trade Marks Act, 1999.

12. It is further emphasised that DABUR has provided no credible justification for adopting the deceptively similar mark to that of SOOTHE's and, therefore, DABUR's use of the mark cannot be accepted as *bona fide* use.

13. DABUR has filed the written statement before the learned Single Judge and contends that the suit has been filed merely to prevent DABUR from carrying on its legitimate and *bona fide* business.

14. It is contended that the use of the word "SUPER" cannot be termed as infringement of the trademark of SOOTHE, which uses the word "SUPER" in conjunction with other words. Further, the term "SUPER" is laudatory and only describes the quality of the product, namely diapers. The term "SUPER" is not capable of any proprietary rights and, thus, the allegation of any infringement on the part of DABUR is without substance.

15. It is further claimed that the use of the term "SUPER" by DABUR is also protected in terms of the provisions of Section 30(2)(a) and Section 35 of the Trade Marks Act, 1999 and by virtue of the said statutory provisions, even the registered proprietor of a trademark cannot interfere with the use of any similar mark by any member of trade if the same is used to indicate the character, quality or kind of the product.

16. He stated that the trader, who adopts laudatory / descriptive mark, runs the risk of not being able to stop / restrain others from using the same

mark in a descriptive manner.

17. Learned counsel for DABUR further contends that the promotional figures produced and the fact that SOOTHE has only commenced using the mark in January, 2020, does not establish that the use of word “SUPER” in its marks has become distinctive of its goods and has attained a secondary significance.

18. Moreover, the mark “SUPER” is neither separately registered nor can it be registered even if registration is applied for and is also hit by the provision of Section 17 of the Act.

19. He further argued that no passing off can also be alleged or claimed since DABUR is using “DABUR BABY SUPER PANTS” in its packaging containing several distinctive visual features, prominently mentioning and indicating the source of the goods. Also in DABUR’s mark, overall colour scheme, layout, style and overall get-up is completely different and distinct from SOOTHE’s product. Therefore, there cannot be any confusion and deception as to the origin of the product.

20. In a nutshell, DABUR claims that the term “SUPER” is laudatory / descriptive and non-distinctive; therefore, SOOTHE cannot claim or allege any infringement on part of DABUR for using the said term in its mark which is “DABUR BABY SUPER PANTS”.

21. Various judgments have been relied upon by both the parties before the learned Single Judge as well this Hon’ble Court in appeal.

22. We have heard submissions of both the parties.

23. The law in relation to the scope and nature of appeals and the limitations of the powers of the Appellate Court to substitute its own discretion in an appeal preferred against a discretionary / interlocutory order

is well-settled. The Hon'ble Apex Court in the case of ***Wander Ltd. And Anr. vs Antox India P. Ltd. 1990 Supp SCC 727*** held as under:

“13. On a consideration of the matter, we are afraid, the appellate bench fell into error on two important propositions. The first is a misdirection in regard to the very scope and nature of the appeals before it and the limitations on the powers of the appellate court to substitute its own discretion in an appeal preferred against a discretionary order. The second pertains to the infirmities in the ratiocination as to the quality of Antox's alleged user of the trademark on which the passing-off action is founded. We shall deal with these two separately.

*14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. After referring to these principles Gajendragadkar, J. in *Printers (Mysore) Private Ltd. v. Pothan Joseph [(1960) 3 SCR 713 : AIR 1960 SC 1156] : (SCR 721)**

*“... These principles are well established, but as has been observed by Viscount Simon in *Charles Osenton & Co. v. Jhanaton [1942 AC 130]* ‘...the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case’.”*

The appellate judgment does not seem to defer to this principle.”

24. After hearing both the parties and having perused the judgment passed by the learned Single Judge and keeping in mind the above principle laid down by the Hon'ble Apex Court, we find no merit in the arguments raised by SOOTHE. SOOTHE has not been able to establish that the learned Single Judge has exercised his discretion arbitrarily or has ignored the settled principles of law regulating grant or refusal of interlocutory injunctions.

25. The learned Single Judge has dealt with the arguments and contentions raised by SOOTHE and has rightly reached a *prima facie* conclusion that DABUR's mark and packaging does not infringe SOOTHE's trademark and also does not have the effect of passing off their goods as that of SOOTHE.

26. As rightly argued by DABUR and decided by the learned Single Judge, the word 'SUPER' is descriptive and laudatory.

27. It is rightly pointed out and not denied during arguments that different companies are using the word "SUPER" in the same trade and in respect of several other goods and services. This clearly reflects that the use of term "SUPER" is only descriptive and laudatory. It is also pointed out that the said products are available / offered for sale on various online platforms in India such as Amazon, Flipkart, IndiaMART etc.

28. The bare visual comparison of the packaging of DABUR and that of SOOTHE as referred in 'paragraph 4' above shows that other than the word "SUPER" used in both the packagings, there is no other similarity. The packaging of SOOTHE and that of DABUR is not similar. *Prima facie*, there cannot be any confusion as to the origin of DABUR's product, which prominently displays the word "DABUR". Merely because the word "DABUR" is in a smaller font, cannot, *prima facie*, lead to any confusion in

the minds of the consumer.

29. The colour scheme of the packaging is also totally different. The packaging of SOOTHE's product has a prominent colour scheme in yellow and orange / blue whereas in DABUR's product, it is primarily green.

30. It is clear that no exclusivity can be claimed in respect of the expression "SUPER", which is laudatory; descriptive; and is widely used on not only the products of similar nature but in respect of various different products and services. It is also clear from the bare visual perusal of DABUR's mark that the word "SUPER" is used in conjunction with the word "PANTS" and is, thus, used in a descriptive manner along with its other well-known trademark, i.e., "DABUR". This, *prima facie*, is to convey that the diapers being manufactured and marketed by DABUR are of a good quality.

31. It is also significant to note that SOOTHE has registered various marks which consist of not one but two words. The word "SUPER" is not a separate registered trademark; it is registered in conjunction with "CUTESTERS", "CUTEZ" and "CUTE'S".

32. Section 15 of the Act provides that proprietor of a trademark claiming to be entitled to the exclusive use of any part thereof can separately apply to the Registrar for registration of not only the whole trademark but also the part thereof as a separate trademark.

33. Section 17 of the Act categorically provides that when a trademark consists of several matters, its registration confers on the proprietor exclusive right to use the trademark taken as a whole.

34. The Division Bench of this Hon'ble Court in the case of ***Vardhman Buildtech Pvt. Ltd. & Ors. v. Vardhman Properties Ltd.*** 2016 SCC Online

Del 4738 in a dispute in relation to suit for injunction filed by the plaintiff claiming the exclusive use of mark “VARDHMAN PLAZAS” had sought injunction against the use of word “VARDHMAN” as part of the corporate name by the defendant, has held as under:

“8. On a plain reading of Section 15(1), it is evident that where a proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he is permitted to apply to register the whole and the part as separate trade marks. In the present case, the respondent is the proprietor of the label/mark which includes the words ‘VARDHMAN PLAZAS’. The respondent is claiming exclusivity in respect of the word ‘VARDHMAN’. It is clear that he had the option to make an application for registering the word ‘VARDHMAN’ as a separate trade mark. Assuming that he could have had the word mark registered, it is an admitted fact that the respondent made no such application. Section 17 of the said Act makes it clear when a trade mark consists of several matters, as it does in the present case, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole. There is no dispute that the label/mark, taken as a whole, is the exclusive property of the respondent. The learned counsel for the appellants has no quarrel with this at all. The issue arises when the respondent claims exclusive right to a part of the label/mark and particularly to the word ‘VARDHMAN’. Section 17(2) is a non-obstante provision [vis-à-vis subsection(1)], which stipulates that when a trade mark contains any part which is not the subject matter of a separate application by the proprietor for registration as a trade mark or which is not separately registered by the proprietor as a trade mark or 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. In the present case, neither has the respondent separately registered ‘VARDHMAN’ as a trade mark nor has any such application been made. Furthermore, the word ‘VARDHMAN’ is itself of a non-distinctive character and is not only common to this trade but to several other businesses. Consequently, the registration of the

label/mark which contains the words 'VARDHMAN PLAZAS' does not confer any exclusive right on the respondent insofar as a part of that mark, namely, 'VARDHMAN' is concerned.

9. We now come to Section 28 of the said Act which deals with the rights conferred by registration. It is clear that by virtue of Section 28, the registration of a trade mark, if valid, gives to the registered proprietor of the trade mark the exclusive right to the use of the mark in relation to the goods or services in respect of which the trade mark is registered and, importantly, to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. What is important to notice is that Section 28(1) begins with the words 'subject to the other provisions of this Act'. In other words, Section 28 would have to be read as subject to Section 17 of the said Act. Consequently, in our opinion the registration of the label/mark in favour of the respondent, which includes the words 'VARDHMAN PLAZAS', does not confer an exclusive right on the respondent insofar as part of the mark, which has reference to the word 'VARDHMAN', is concerned.

10. The learned counsel for the respondent, as pointed out above, sought to take the benefit of Section 29(9) of the said Act. That provision stipulates that where 'distinctive elements' of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and the reference in Section 29 to the use of a mark is to be construed accordingly. First of all, the stress in the said provision is on the words 'distinctive elements'. Neither is 'VARDHMAN' nor the word 'PLAZAS' a distinctive element of the trade mark. The word 'VARDHMAN' has not been registered as a trade mark nor could it be because it is commonly used and, as pointed out above, is the name of Lord Mahavir. Secondly, the word 'PLAZAS' is also commonly used and cannot be appropriated by the respondent. Therefore, the distinctive elements are neither the word 'VARDHMAN' nor the word 'PLAZAS'. But, the two words taken together - 'VARDHMAN PLAZAS' - is a distinctive element of the label/mark. Thus, if the appellants were to use words 'VARDHMAN' and 'PLAZAS' in conjunction, then the respondent may have had a right to restrain them from using the same. We are,

therefore, of the view that Section 29(9) of the said Act also does not come in aid of the respondent.”

35. Further, Section 30(2)(a) categorically provides that a trademark is not infringed where the same is used in relation to goods or services indicating the kind, quality, quantity, intended purpose, value etc. of such goods or services.

36. Learned counsel for SOOTHE heavily relied upon the judgment passed by the Hon'ble Division Bench of this Hon'ble Court in the case of *'Ishi Khosla v. Anil Aggarwal & Anr. ILR (2007) 1 DEL 615'*. In the said case, the plaintiff claiming to be sole proprietor and engaged in the business of producing and retailing food products in India under the mark 'Whole Foods' filed a suit seeking injunction against the defendant from the use of the mark "DIET WHOLE FOODS". The Hon'ble Division Bench, in the facts of that case, found that 'Whole Foods' has acquired a secondary character and has come to be associated with the plaintiff's product. And, the defendant, in clever manipulation, had added the word "DIET" in their mark after adopting identically the entire trademark of the plaintiff, i.e., "Whole Foods". The Hon'ble Division Bench confirmed the injunction granted in the favour of the plaintiff and enjoined the defendant from the use of the mark "DIET WHOLE FOODS". Various other judgments have been cited by the learned counsel for SOOTHE to highlight the point that even an ordinary English word, even if descriptive or laudatory, can be protected if it has acquired a secondary meaning and has come to be associated with the proprietor's product / business.

37. The judgments relied upon are not applicable to the facts of the present case. There is no quarrel to the proposition that even an ordinary

word or a descriptive word, if acquires a secondary meaning and has acquired a distinctive character, can be protected by way of an injunction when identified with a particular product or being from a particular source. As discussed above, DABUR's mark, i.e., "DABUR BABY SUPER PANTS" when taken as a whole cannot be termed as deceptively similar to SOOTHE's registered marks referred in 'paragraph 2' above. As far as the use of the word "SUPER" by DABUR in its mark, the same, *prima facie* seems to be laudatory and descriptive of the product being offered by DABUR. Indisputably, the term "SUPER" is widely used in respect of various products not only of similar nature but also of different class and categories. SOOTHE cannot, therefore, *prima facie* claim that the use of the word "SUPER" by DABUR in its mark is deceptively similar to SOOTHE's registered trademark for the reason that the word "SUPER" also appears in SOOTHE's marks referred in 'paragraph 2' above. SOOTHE also cannot *prima facie* claim that the word "SUPER" appearing in its registered mark has acquired a secondary meaning or a distinctive character when used in a particular product of SOOTHE, i.e., diapers.

38. In the aforesaid terms, the appeal is dismissed and all the pending applications are also disposed of.

AMIT MAHAJAN, J

VIBHU BAKHRU, J

JULY 11, 2022

KDK/SS