

**\*IN THE HIGH COURT OF DELHI AT NEW DELHI**

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**Date of decision: 30<sup>th</sup> May, 2014**

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**FAO(OS) No.241/2014**

**PROCTER & GAMBLE MANUFACTURING  
(TIANJIN) CO. LTD. & ORS.**

**..... Appellants**

Through: Dr. A.M. Singhvi & Mr. Sanjay Jain,  
Sr. Advs. with Mr. Prashant Gupta,  
Ms. Priya Rao, Ms. Taapsi Johri, Ms.  
Ruchi & Ms. Rajul Jain, Advs.

Versus

**ANCHOR HEALTH & BEAUTY CARE  
PVT. LTD.**

**..... Respondent**

Through: Mr. Sandeep Sethi with Ms. Pratibha  
M. Singh, Sr. Advs. With Mr. Mayur  
Gala, Ms. Archana Sachdeva & Mr.  
Prashanth Kumar, Advs.

**CORAM :-**

**HON'BLE THE CHIEF JUSTICE**

**HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW**

**RAJIV SAHAI ENDLAW, J.**

1. This appeal under Order XLIII Rule 1 (r) of the Code of Civil Procedure, 1908 impugns the order dated 9<sup>th</sup> May, 2014 of the learned Single Judge of this Court (exercising Ordinary Original Civil Jurisdiction) in CS(OS) No.1431/2013 filed by the respondent / plaintiff, of allowing IA No.11461/2013 of the respondent / plaintiff under Order XXXIX Rules 1&2 CPC and restraining the appellants / defendants, during the pendency of the

suit, from using the trademark “ALL-AROUND PROTECTION” / “ALLROUNDER” or any other mark deceptively similar to the respondent / plaintiff’s trademark “ALLROUND”.

2. The learned Single Judge having made the order of interim injunction aforesaid operational after four weeks from pronouncing thereof, we have with consent heard the counsels on the appeal itself at the admission stage.

3. The respondent / plaintiff instituted the suit from which this appeal arises, pleading:

- (i) that the respondent / plaintiff is a leading Fast Moving Consumer Goods (FMCG) company and a part of the Anchor Group of companies; though the said group initially entered into the electrical products, but has subsequently expanded its activities into various other products including toothpaste, tooth power, toothbrush, confectionary etc.;
- (ii) that the respondent / plaintiff has used the “ANCHOR ALLROUND PROTECTION” mark extensively including in

several regional languages in transliterated instead of translated form;

- (iii) the logo, device and expression “ALLROUND” and “ALLROUND PROTECTION” has acquired secondary meaning;
- (iv) that the respondent / plaintiff has used the mark “ALLROUND” as a trademark / brand identifier since 2005 for its dental care products, mainly toothpaste;
- (v) that the respondent / plaintiff on 2<sup>nd</sup> September, 2005 also applied for registration of the trademark “ALLROUND” and which registration was granted on 26<sup>th</sup> August, 2008 and is valid and subsisting under the Trade Marks Act, 1999;
- (vi) that the trademark “ALLROUND” is also a well known trade mark;
- (vii) that the brand “ALLROUND” and the expression “ALLROUND PROTECTION” has become extremely well known;

- (viii) that the appellant / defendant no.1 based in China is engaged in manufacturing toothpaste;
- (ix) that the appellant / defendant no.2 Procter & Gamble Business Services Canada Company is the owner of the mark “ORAL-B” and the appellant / defendant no.3 Gillette India Ltd. claims to be the importer of the products under the said trademark;
- (x) that the respondent / plaintiff in the end of May, 2013 came across news reports that the appellants / defendants who were only into toothbrush manufacturing and marketing were planning to enter into the toothpaste market under the mark “CREST”;
- (xi) that however the respondent / plaintiff in the first week of July, 2013 learnt that the appellants / defendants had on 2<sup>nd</sup> July, 2013 launched their toothpaste under the mark “ORAL-B ALL-AROUND PROTECTION”;
- (xii) that the use by the appellants / defendants of the term “ALL-AROUND PROTECTION” is a complete imitation of the respondent / plaintiff’s mark “ALLROUND” which is a

registered trademark and the expression “ALLROUND PROTECTION” used by the respondent / plaintiff;

(xiii) that the appellants / defendants were attempting to ride piggyback on the enormous reputation which the “ALLROUND PROTECTION” toothpaste of the respondent / plaintiff had earned;

(xiv) that the respondent / plaintiff on 14<sup>th</sup> July, 2013 also learnt that the appellants / defendants had also launched another product by the name “ORAL-B ALL-ROUNDER”;

(xv) that the use by the appellants / defendants of “ALL-ROUNDER” is also in complete violation of the respondent / plaintiff’s right to the mark “ALLROUND”;

Accordingly, the suit for the reliefs, of declaration that the mark / expression “ALLROUND PROTECTION” of the respondent / plaintiff is a well known mark in relation to oral care especially for toothpaste and for permanent injunction restraining the appellants / defendants from in any manner using the mark / expression “ALL-AROUND PROTECTION” /

“ALLROUNDER” and for the ancillary relief of delivery and rendition of accounts, was filed.

4. Though the suit was accompanied with the application aforesaid for interim relief but no *ex parte* ad-interim relief was granted to the respondent / plaintiff.

5. The appellants / defendants contested the suit by filing a written statement, on the grounds:

(a) that the respondent / plaintiff, despite registration had never used the expression “ALLROUND” as a trademark on the packaging of its products or in its advertisement in the print and electronic media and the use by the respondent / plaintiff of the expression “ALLROUND PROTECTION” has always been to indicate qualitative features of its “ANCHOR” brand toothpaste;

(b) that the trademark “ALLROUND” is an inherently invalid trademark, being completely descriptive expression, incapable of having characteristics of a trademark; being descriptive, it is not capable of distinguishing the goods of one person from

those of another and could not have been registered in view of the embargo contained in Section 9 of the Trade Marks Act;

- (c) that the expression “ALLROUND” had not acquired any distinctive character;
- (d) that the respondent / plaintiff has always projected “ANCHOR” as its primary mark and the suit for infringement is barred by Section 30(2) read with Section 35 of the Act;
- (e) that the appellants / defendants, after the notice of the suit, had already sought rectification of the registration of the trademark “ALLROUND” in favour of the respondent / plaintiff;
- (f) that the suit for the relief of passing off is also not maintainable for the reason that the expression “ALLROUND” has no trappings of a trademark for toothpaste;
- (g) that the respondent / plaintiff had no goodwill attached to the registered trademark “ALLROUND”;
- (h) that the appellants / defendants belong to the Procter and Gamble group of companies having reputed business

internationally in the field of consumer products such as toothbrush, toothpastes etc.;

- (i) that the brand-name “CREST” is used to retail toothpaste in certain countries and the “ORAL-B” printed toothpaste is retailed in certain other countries;
- (j) that the respondent / plaintiff has been using the byline “ALLROUND PROTECTION” only as a addendum in the nature of descriptor;
- (k) denying that the trademark “ALLROUND” or “ALLROUND PROTECTION” is a well known trademark;
- (l) that the appellants / defendants had / have no intention to use the expression “ALL-AROUND PROTECTION” as a trademark – it is used only to describe the nature of the products of the appellants / defendants;
- (m) that the adoption and use by the appellants / defendants of the expression “ALL-AROUND PROTECTION” is *bona fide*;



- (n) that the expressions “ALLROUND PROTECTION” / “ALL-AROUND PROTECTION” are descriptive and common in the trade and the third parties are also using the said expressions;
- (o) that the brand “ORAL-B” of the appellants / defendants was / is distinct from the brand “ANCHOR” of the respondent / plaintiff.

6. The learned Single Judge has allowed the application of the respondent / plaintiff for interim relief and so enjoined the appellants / defendants, finding/observing/holding:

- (I) that the appellants / defendants had not denied that they had moved an application for registration of their mark “ALL-ROUNDER” and that they have obtained registration of the mark “ALL-AROUND PROTECTION” in the United States (US);
- (II) that the contention of the appellants / defendants, that the term “ALL-ROUNDER” is a product neutral expression and that the registration of the same trademark by the appellants / defendants in United States is inconsequential to the present

proceedings as the Trade Marks Act applies to the jurisdiction of India and the appellants / defendants having so obtained the registration will not change the character of the expression “ALLROUND PROTECTION” from descriptive to distinctive, could not be accepted as the appellants / defendants could not approbate and reprobate;

(III) reliance was placed on *Automatic Electric Ltd. Vs. R.K. Dhawan* (1999) (19) PTC 81 holding that the defendant therein having got the trademark “DIMMER DOT” registered in Australia, could not contend that the word “DIMMER” is a generic expression;

(IV) it was thus held that there was no need at that stage to go into the question whether “ALLROUND” or “ALLROUND PROTECTION” are generic words;

(V) that a perusal of the trademark of the respondent / plaintiff and the packaging of the appellants / defendants showed that the mark “ALL-AROUND PROTECTION” was being used by the appellants / defendants as a stand alone mark and not to

describe any quality of the product – the quality of the products were being described separately on the packaging;

- (VI) that the judgment of the Division Bench of this Court in *Marico Limited Vs. Agro Tech Foods Ltd.* 2010 X AD (Del) 214 laying down that the mark “LOW-ABSORB” only describes the characteristics of the product and thus dismissing the application for interim injunction for infringement thereof by use of the expression “with low absorb technology” was not applicable for the reason of the appellants / defendants having themselves applied for and obtained registration of the trademark “ALL-ROUNDER” and “ALL-AROUND PROTECTION” and it being thus not open to them to claim the mark to be descriptive;
- (VII) from the use by the respondent /plaintiff of the mark “ALLROUND PROTECTION” instead of the registered mark “ALLROUND”, it could not be said that there was non-use by the respondent / plaintiff of the registered trademark “ALLROUND”;

- (VIII) that it was the plea of the respondent / plaintiff that it has used the mark “ALLROUND” per se also; it will be for the respondent / plaintiff to prove the same at the trial;
- (IX) the use of the mark “ALL-AROUND” or “ALLROUNDER” by the appellants / defendants on the same goods i.e. toothpaste, amounted to infringement of the registered trademark “ALLROUND” of the respondent / plaintiff as the broad and essential features of all the three marks are identical and the various similarities in the essential features of the marks were likely to deceive and confuse a consumer;
- (X) that the balance of convenience was also in favour of the respondent / plaintiff as, when the suit was filed, the appellants / defendants had just started marketing of their toothpaste with the impugned trademark;
- (XI) in case the appellants / defendants are not restrained, irreparable injury is likely to be caused;

(XII) the interim injunction however was made operational after four weeks from 9<sup>th</sup> May, 2014 to enable the appellants / defendants to take appropriate steps to comply therewith.

7. The senior counsel for the appellants / defendants has argued:

- (i) that the protection of the rights as attached to a registered trademark is available only when the trademark is used in the form as registered and not otherwise;
- (ii) that the registration of the respondent / plaintiff is of the trademark “ALLROUND” but the respondent / plaintiff was not using the same as a trademark but was using the expression “ALLROUND PROTECTION” as description of the product;
- (iii) that the respondent / plaintiff was not using the expression “ALLROUND PROTECTION” on its invoices also;
- (iv) that the learned Single Judge erred in holding that the statutory defences under Section 9 and Section 32 (1)(a) could be denied to the appellants / defendants for the reason of the appellants / defendants having applied for registration of the trademark

“ALLROUNDER” and having obtained registration in the United States of the trademark “ALL-AROUND”;

- (v) attention is invited to paras 2,4,6,8, 19&20 of the judgment of the Division Bench of this Court in *Marico Limited* (supra) where it was *inter alia* held that merely because the respondent therein had used “TM” after the expression “LOW ABSORB TECHNOLOGY” was not such as to wipe out statutory rights / defences of the respondent;
- (vi) that the appellants / defendants had mistakenly applied for registration of “ALLROUNDER” as a trademark and mistakenly obtained registration of the trademark “ALL-AROUND” in United States and are willing to give an undertaking to withdraw / surrender the same;
- (vii) photographic reproductions of the packaging of the products of the respondent / plaintiff and the appellants / defendants are handed over to contend that the two are clearly distinctive and there is no possibility of confusion;

- (viii) reliance is placed on the judgment of the Division Bench of this Court in *Veerumal Praveen Kumar Vs. Needle Industries (India) Ltd.* 93 (2001) DLT 600 (DB) to contend that a trademark cannot exist in vacuum and a trademark if not used is not entitled to any protection from the Court; on the basis thereof, it is argued that the respondent / plaintiff have not used the registered trademark “ALLROUND” and having instead used the expression “ALLROUND PROTECTION”, are not entitled to sue for infringement of the registered trademark; reliance in this regard is also placed on para 23 of *Fedders Lloyd Corporation Ltd. Vs. Fedders Corporation* 2005 (30) PTC 353 (Del-DB);
- (ix) that the learned Single Judge wrongly relied on the *Automatic Electric Ltd.* (supra);
- (x) that the learned Single Judge has erred in holding that the use of the expression “ALLROUND PROTECTION” as a descriptor by the respondent / plaintiff amounts to use by the respondent / plaintiff of the registered trademark;

- (xi) that the learned Single Judge erred in not considering that the use by the respondent / plaintiff of the expression “ALLROUND PROTECTION” was not as a stand alone or a trademark; the trademark used by the respondent / plaintiff was “ANCHOR” ;
- (xii) that the learned Single Judge erred in holding that the essential features were the same;
- (xiii) that the principle of approbate and reprobate applies to pleadings and has been wrongly applied;
- (xiv) that none of the documents filed by the respondent / plaintiff showed the *per se* use by the respondent / plaintiff of the registered trademark “ALLROUND”;
- (xv) that the learned Single Judge erred in relying on *Automatic Electric Ltd.* (supra) which is a judgment of the Single Judge of this Court, in the face of the contrary view of the Division Bench in *Marico Limited* (supra); *Marico Limited* ought to have been held to have overruled *Automatic Electric Ltd.*;

8. Per contra, the senior counsel for the respondent / plaintiff has argued:



- (a) That in an intra-court appeal against discretionary orders, interference should not be made unless the discretion is found to have been exercised arbitrarily, capriciously and perversely and not otherwise. Reliance in this regard is placed on ***Wander Ltd. Vs. Antox India (P) Ltd.*** 1990 (2) SCC 399;
- (b) that as per the application of the respondent / plaintiff for registration of the trademark “ALLROUND”, the respondent / plaintiff commenced user thereof in the year 2004; on the contrary, the appellants / defendants admittedly launched their product with the impugned trademark on 2<sup>nd</sup> July, 2013 and the suit from which this appeal arises was filed immediately, on 20<sup>th</sup> July, 2013;
- (c) that the appellants / defendants when applied for registration of the trademark “ALL-ROUNDER” in the year 2010, showed the same as proposed to be used;
- (d) that the Registrar of Trademarks *suo motu* raised objection to the application of the appellants / defendants for registration of the trademark “ALL-ROUNDER” on the ground of the respondent / plaintiff's registered trademark “ALLROUND”;

- (e) thus the appellants / defendants then only, if not earlier, knew of the registered trademark of the respondent / plaintiff;
- (f) that the appellants / defendants vide their response dated 21.10.2011 to the objection so raised by the Registrar of Trademarks did not contend that the word “ALL-ROUNDER” was descriptive as is being contended now; on the contrary, it was pleaded that the said expression is distinctive;
- (g) attention is invited to the registration dated 5<sup>th</sup> December, 2011 obtained by the appellants / defendants in United States of the word “ALL-AROUND PROTECTION” to show that the word “PROTECTION” was disclaimed;
- (h) that the registration in favour of the respondent / plaintiff is of word-mark “ALLROUND” and not of a label;
- (i) that *Automatic Electric Ltd.* supra, though a judgment of the Single Judge, was approved by the Division Bench in *Indian Hotels Company Ltd. Vs. Jiva Institute of Vedic Science & Culture* 2008 (37) PTC 468 Delhi;

- (j) that in response to our query as to what is meant by “descriptive”, it was stated that the trademark ‘ALLROUND’ can be used on any other product also and can be used for multifarious products and thus cannot be described as descriptive. Attention was invited to the words “Stronger Whiter Teeth”, “Fresher Breath” and “Healthier Gums” circling the expression “ALLROUND PROTECTION” on the packaging of the product of the respondent/plaintiff and it was contended that the said words are descriptive and not the expression “ALLROUND PROTECTION”;
- (k) that for a trademark to qualify as descriptive, it must *per se* describe the product in question;
- (l) that if it were to be held that the expressions “ALLROUND PROTECTION” were not to be protected, there will be no “catch phrases” in advertising;
- (m) that the principle of approbate and reprobate is a part of the doctrine of estoppel by conduct;

- (n) attention is invited to the advertisements of the product of the respondent/plaintiff in the newspaper in Tamil, Gujarati and Marathi languages to show that the respondent/plaintiff therein also has not translated the word “ÁLLROUND PROTECTION” into vernacular who has transliterated the same to “ALLROUND PROTECTION” only; it is argued that the same is indicative of its use as a trademark and not as descriptor;
- (o) attention is invited to the invoices raised by the respondent/plaintiff, where the product sold is described as “ANCHOR TOOTH POWDER ARP” and as “AWARP” and it is stated that ARP stands for ALLROUND PROTECTION and AWARP stands for ANCHOR WHITE ALLROUND PROTECTION;
- (p) attention is invited to Section 2(zb) of the Trademarks Act to contend that all the aforesaid amount to user of the trademark by the respondent/plaintiff;

- (q) attention is also invited to the slides of the TV advertisements and other advertisements of the respondent/plaintiff to show user;
- (r) that the appellant/defendant has not given any reason for adopting the words “ALLROUNDER” and “ALL-AROUND PROTECTION”—it is not their plea that they were unaware of the mark of the respondent/plaintiff;
- (s) that it is thus clear that the appellant/plaintiff wanted to encash on the respondent/plaintiff’s goodwill;
- (t) reliance is placed on *Ruston & Hornsby Ltd. Vs. The Zamindara Engineering Co.* (1969) 2 SCC 727 laying down that in an infringement action, where the defendant’s trademark is identical with the plaintiff’s mark, the Court will not enquire, whether the infringement is such as is likely to deceive or cause confusion and it is contended that the other differences, including use of other marks of ANCHOR and ORAL-B, is irrelevant;

- (u) reliance is placed on *Ruchi Pvt. Ltd. Vs. Indian Flame Enterprises* (2001) PTC 876 (Delhi) to contend that notwithstanding the fact that the plaintiff was using the mark “NUTRELA” which was registered in conjunction with “RUCHI”, the use of the word “RUCHI” along with “SAHARA” in relation to cognate goods, was held to be capable of causing deception;
- (v) that the user by the appellant/defendant of the mark during the pendency of the suit would not accrue any rights to the appellant/defendant as such user was at the own peril of the appellant/defendant and reliance was placed on *Amar Singh Chawal Wala Vs. Shree Vardhman Rice and Genl. Mills* 2009 (40) PTC 417 Delhi (DB) where it was held that the pendency of the appeal for over 12 years did not make any difference.

9. The senior counsel for the appellant/defendant has re-joined by contending, (i) that the learned Single Judge has exercised the discretion arbitrarily and capriciously by failing to apply the correct test and thus this appeal is maintainable; (ii) that the Division Bench in *Indian Hotels Company Ltd.* supra only referred to *Automatic Electric Ltd.* and did not go into the

question and thus cannot be said to have affirmed the law laid down in *Automatic Electric Ltd.*; (iii) that the appellant/defendant “may” have made a mistake in applying for registration in India of the trademark “ALLROUNDER” and in obtaining registration in the US of the trademark “ALL-AROUND”; (iv) that the appellant/defendant in its written statement in para 18 has pleaded that it had adopted the expression “ALL-AROUND PROTECTION” *bona fide*, as such expression is descriptive and common to trade and because third parties were using similar expressions and because there was no likelihood of the same causing any confusion; (v) that the Division Bench in *Marico Limited* supra has held that use of the trademark of ‘Sun-Drop’ distinguished the two products; (vi) that it can only be proved by evidence, whether the expression “ALLROUND PROTECTION” used by the respondent/plaintiff had acquired distinctiveness; (vii) reliance is placed on *Rhizome Distilleries P. Ltd. Vs. Pernod Ricard S.A. France* 2010 (42) PTC 806 Delhi (DB) laying down that the regime which applied to descriptive words would apply equally to laudatory words and that no one can claim exclusive or proprietary rights over such words; (viii) that in law relating to trademarks, the highest protection is afforded to coined marks followed by arbitrary marks, laudatory marks, descriptive marks and generic

marks; (ix) that once it is held that the trademark “ALLROUND” of the respondent/plaintiff is not entitled to protection for the reason of being descriptive, the claim of the respondent/plaintiff does not pass the test of passing off.

10. We have weighed the rival contentions aforesaid and do not find any merit in this appeal for the following reasons:

- (i) Neither the Registrar of Trademarks nor anyone else, at the time when the respondent/plaintiff applied for registration of the trademark “ALLROUND” objected thereto on any of the grounds mentioned in Section 9 of the Act;
- (ii) Even when the appellant/defendant applied for registration of the trademark “ALLROUNDER” for the same goods, though objection on the ground of the trade mark “ALLROUNDER” being not capable of distinguishing the goods of the appellant / defendant from goods of another was raised by the Registrar but in the context of the same being similar/identical to the respondent/plaintiff’s registered mark “ALLROUND” with respect to the same goods;



(iii) Not only the Registrar of Trademarks in India but even the Registrar of Trademarks in US did not consider that the trademark “ALLROUND” in relation to toothpaste was devoid of any distinctive character or was not capable of distinguishing the said goods or was descriptive;

(iv) Even if it were to be held that others interested in opposing the registration of such a trademark were not vigilant, it is primarily the duty of the Registrar of Trademarks to ensure that the trademarks which are not distinctive and which are devoid of any distinctive character are not registered; the factum of the Registrar of Trademarks in India and in US, at neither of the aforesaid times having raised any such objection, will have weightage at least at this stage of grant of interim relief, to hold that the said marks are *prima facie* not considered by the authorities having expertise in the matter as being descriptive of the said goods and being incapable of distinguishing such goods of one from another;

(v) We had during the hearing enquired from the senior counsel for the appellant/defendant that whether not his argument, of only ANCHOR and ORAL-B being trademarks, turns advertising on its

head; we enquired that if it were to be so, huge sums of money, as are known to be spent on advertising, would not be spent and only the brands such as ORAL-B and ANCHOR would be advertised—there would be no need for involving famous men and women in advertising and no need for scripting the storyline of any advertisements or copyrighting the advertisements—no reply was coming from the senior counsel for the appellant/defendant.

(vi) The use by the respondent/plaintiff of the expression “ALLROUND PROTECTION” in its advertisements and on its product is as a slogan or a tagline. Such slogans/taglines are definitely a trade mark within the meaning of Section 2(m) & (zb) of the Act, being capable of represented graphically and distinguishing the goods of one from another and used for indicating a connection in the course of trade between the goods and the person having right to use the mark.

(vii) Our experience of life shows that such slogans or taglines as “ALLROUND PROTECTION” in advertisements, grab attention and are sometimes better known than the branded products themselves; such slogans/taglines/expressions are marketing and communication

tools par excellence and directly impact the consumers by encouraging them to chose certain goods or services over others; such slogans/taglines/expressions, though may not directly designate particular goods or service but support it in commercial terms by enabling the public to link the slogan/tagline/expression to a specific company or to recall a brand—they are the first line of communication with the consumer;

(viii) The function of a slogan/tagline/expression is to crisply communicate the ability or nature of the goods or services; the same communicate to the consumers the qualities thereof; often it is found that it is such slogan/tagline/expression which lingers in the minds of the consumers and which remains as an after taste of an advertising campaign; slogans/taglines often become so distinctive of a product that the trademark affixed on the product may need no mention;

(ix) Slogans/expressions/taglines have indeed become an important tool in the branding and advertisement campaigns, specially in the visual media;

(x) An effective slogan/tagline/expression is memorable and impactful and make the customers feel good about what they are

purchasing and foster more efficient purchasing decisions by creating distinction in consumers' minds;

(xi) Such slogans/taglines/expressions used repeatedly eventually come to identify the brand and contributes to the overall brand equity;

(xii) Slogans/taglines/expressions though can be descriptive but are not necessarily descriptive; it cannot however be lost sight of that the slogan/tagline, if descriptive, does not serve the purpose for which it is coined and does not justify the high cost incurred in conceiving and popularizing the same. A distinctive as compared to descriptive slogan, conveys the company's and the product's essence as well as what it aspires to be and conveys the commercial expression to the consumers. It promotes memory recall;

(xiii) We are of the view that the argument of, "ALLROUND PROTECTION" as being descriptive of toothpaste is being raised today only because of the use of the same for a considerably long time as a tagline / slogan by the respondent / plaintiff and the resultant association thereof with the product i.e. toothpaste; till it was so used, none, from the expression "ALLROUND" or "ALLROUND

PROTECTION” could have associated it with or held the same as descriptive of a toothpaste;

(xiv) We had in fact during the hearing, in a lighter vein, enquired whether not the word “ALLROUNDER”, in the Indian context, is connected/associated more with the game of cricket than in relation to a toothpaste.

(xv) The feeling today, of the words “ALLROUND PROTECTION” being descriptive of toothpaste could perhaps be owing to the long usage thereof in relation to a toothpaste and may not have been so till it was first used in relation to toothpaste; the test, in our opinion, of descriptive is not of the day after long/repeated usage of some words in relation to a good or service, but of the day before such use; we are of the *prima facie* view that before the day of first use of the expression/words “ALLROUND PROTECTION” in relation to a toothpaste, the same could not have been said to be descriptive thereof.

(xvi) There is a difference between words/marks which would classify as descriptive, generally of the goods or services, whosoever may be provider thereof and words/marks which communicate the

particular/peculiar quality/qualities or features of product of one and which may not exist or do not exist in the same product being provided by others. In our opinion, it is only the former which are not registrable as trademark and which are not protected, and not the latter. The words “marks or indications which may serve in trade to designate the kind, quality, quantity, intended purposes, values...of the goods” in Section 9(1)(b) cannot be read to include words/marks which designate the quality, intended purpose or values, not generic to the goods and services but unique to the goods of one and which may not be present in the same goods and services provided by another. Such words/marks, highlight and communicate to the consumer the difference claimed from the same goods or services of others, also available in the market. Of course, such words or marks would also be, in a sense descriptive of those unique features, quality, character, intended purpose of goods/services of one; however they will still classify as distinctive so long as none other till then has described those as unique to the product.

(xvii) The different manufacturers/suppliers of toothpaste have attempted to market their product by boasting the feature, either of

being capable of resulting in extra white teeth or as protecting the gums or as producing a fresh breath. The respondent / plaintiff on the contrary marketed its product by highlighting its product as capable of providing “ALLROUND PROTECTION” and which was further described as, producing stronger whiter teeth, fresher breath and healthier gums. While the words stronger whiter teeth, fresher breath and healthier gums, in our opinion, are descriptive, the expression “ALLROUND PROTECTION” connotes the peculiar quality of the product of the respondent / plaintiff. Thus the words “ALLROUND PROTECTION” in our view cannot be said to be descriptive.

(xviii) As far as the argument, of the respondent / plaintiff not using the registered trade mark “ALLROUND” owing to having suffixed it with the word “PROTECTION” is concerned, again, the appellants / defendants in the US, obtained registration of the mark “ALL-AROUND PROTECTION” disclaiming the word “PROTECTION”. The same is indicative of the appellants/defendants admitted that use of the word “PROTECTION” as a suffix to the use of the registered mark “ALL-AROUND” not negating the use of the trade mark. The

same reasoning, of approbate and reprobate, applied by the learned Single Judge, in our opinion, would apply to this aspect as well.

(xix) As far as the contention, of *Automatic Electric Ltd.* (supra) having stood overruled by *Marico Limited* (supra) is concerned, we have perused *Indian Hotels Company Ltd.* (supra) and are unable to agree that the reference therein to *Automatic Electric Ltd.* is without affirming the same. It was the contention in *Indian Hotels Company Ltd.* also that the word “JIVA” therein was a descriptive word which could not be protected as a trade mark. The Division Bench however negated the said argument by holding that the appellant therein having itself applied for registration of “JIVA” as a trade mark, could not argue that the mark was descriptive. Reference to *Automatic Electric Ltd.* was made in support of the said reasoning. Unfortunately, neither *Automatic Electric Ltd.* nor *Indian Hotels Company Ltd.* were noticed in the subsequent judgment of the Division Bench in *Marico Limited*. We, at this interim stage are inclined to go along with the affirmation by the Division Bench in *Indian Hotels Company Ltd.* with the view in *Automatic Electric Ltd.*



(xx) The contention of the appellants / defendants that the registration of “ALLROUNDER” and “ALL-AROUND PROTECTION” was applied for and obtained mistakenly and the appellants / defendants are willing to surrender the same also does not impress us. The said statement came to be made only during the hearing; the appellants / defendants otherwise, neither in their written statement in the suit nor in this appeal have pleaded on oath that it was a mistake or the circumstance in which the said mistake came to be made and no explanation whatsoever therefor has been offered. The appellants / defendants, when so caught on the wrong foot, cannot be permitted to get away by, during the course of hearing call their action a mistake.

(xxi) It matters not that the trade mark “ALLROUND PROTECTION” has been used along with the trade mark “ANCHOR”. It is not the argument of the appellants / defendants that there is any bar in law to use of two trade marks together in relation to the same product. As aforesaid, the trade mark “ALLROUND” along with the suffix “PROTECTION” is in the nature of a slogan / tagline,

the use whereof particularly in visual advertising has now been accepted as enhancing the brand equity.

(xxii) As far as the reliance on ***Marico Limited*** (supra) is concerned, the decision of the Division Bench therein turned on the finding of the trade mark “LOW-ABSORB” being descriptive of the product in that case. We have herein above held that the words “ALLROUND PROTECTION” in relation to the product with which this case is concerned are not descriptive generally of toothpastes, by whosoever manufactured/supplied but show the peculiar quality, features/advantages in the product of the respondent / plaintiff which may not be present in the same product of others.

(xxiii) As far as the argument, of the third parties also using the same is concerned, neither is there any *prima facie* proof/material therefor nor does it dissuade us, after otherwise finding in favour of respondent/plaintiff, from affording protection; it is settled principle that infringement, even if any by third party is no ground to deny interim relief against the one sought (see ***Pankaj Goel Vs. Dabur India Limited*** 2008 (38) PTC 49 (Delhi) (DB), ***Castrol Limited Vs. A.K.***

*Mehta* 1997 (17) PTC 408 (DB) and *Prakash Roadline Vs. Prakash Parcel Service* 1992 (2) Arbitration Law Reporter 174);

(xxiv) We do not feel the need to elaborately discuss the case law on the subject; each case depends on its unique facts. Moreover, the entire case law has been discussed in *Stokely Van Camp, Inc. Vs. Heinz India Private Limited* 171 (2010) DLT 16 which was affirmed by the Division Bench in the judgment reported as MANU/DE/3132/2010 and SLP (Civil) No.8016/2011 preferred whereagainst was dismissed *in limine* on 8<sup>th</sup> April, 2011 and to which surprisingly neither counsel referred.

11. Resultantly, the appeal is dismissed.

12. Needless to state, nothing contained herein will influence the decision after trial.

**RAJIV SAHAI ENDLAW, J.**

**CHIEF JUSTICE**

**MAY 30, 2014**

‘gsr/bs’