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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 532/2023

EMAMI LIMITED

..... Plaintiff

Through: Mr. Abhimanyu Bhandari, Ms. Charu Mehta, Ms. Roohe Hina Dua, Mr. Harshit Khanduja and Mr. Sahib Kochhar, Advs.

versus

DABUR INDIA LIMITED

..... Defendant

Through: Mr. Rajiv Nayar, Sr. Advocate with Mr. Anirudh Bakhru, Mr. Ankur Chhibber, Mr. Prabhu Tandon, Ms. Kripa Pandit, Ms. Navreet Kaur and Mr. Christopher, Ms. Pragya Choudhary, Mr. Vijay Laxmi Rathi and Mr. Umang Tyagi, Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

ORDER

09.08.2023

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1. The plaintiff is a company established in 1974, engaged in manufacture and sale of health, beauty, personal care and allied products. It claims to have started manufacturing Ayurvedic medicines and medicinal preparations in 1982. It owns various reputed brands, such as Himani, Boro Plus, Zandu, Mentho Plus etc. Its operations span over 60 countries.

2. The plaintiff was awarded the Gold Certificate of Merit at the Economic Times India Manufacturing Excellence Awards 2013, the Certificate of Excellence for Best Financial Performance, 2018 by ET Bengal, the Golden Peacock Innovation Management Award, 2016, and the Global Performance Excellence Award for Best in Class Small

Manufacturing Organization at the 19th Asia Pacific Quality Conference, 2013, among others.

3. NAVRATNA oil, a red-coloured oil which, when applied to the scalp, produces an effect of coolness, which, as per the assertions in the plaint, is one of the flagship brands of the plaintiff, was launched in January 1989, with the catch phrase “Thanda Thanda Cool Cool”. It has admittedly been in uninterrupted use since then. The plaintiff’s products under the trade mark NAVRATNA command a market share of 66%, as of 2022, in the cooling oil segment. The NAVRATNA oil of the plaintiff is sold both in bottles as well as in sachets.

4. The plaintiff obtained various trade registrations associated with its NAVRATNA cool oil, some of which may be enumerated thus:

S. No	Trademark	Reg. No.	Class	Dt. Of Registration
1.	NAVRATNA	785156	03	6 January 1998
2.	NAVRATNA	785157	05	6 January 1998
3.		1068166	05	20 December 2001
4.		1305653	03	27 August 2004
5.		1305654	05	27 August 2004

6.		1677005	05	16 April 2008
7.	HALKA HALKA COOL COOL	1802168	03	1 April 2009
8.	THANDA THANDA COOL COOL	2146193	03	18 May 2011
9.	THANDA THANDA COOL COOL	2146194	05	18 May 2011
10.	THANDA THANDA	2146195	03	18 May 2011
11.	THANDA THANDA	2146196	05	18 May 2011
12.	COOL COOL	2146197	03	18 May 2011
13.	COOL COOL	2146198	05	18 May 2011
14.	ZYADA THANDA ZYADA COOL	2259420	05	30 December 2011
15.	ZYADA THANDA ZYADA COOL	2259421	05	30 December 2011
16.	NAVRATNA	3079175	03	14 October 2015

5. The bottle in which the plaintiff packs and sells its NAVRATNA oil is also registered as a design, *vide* Registration Nos. 253389 dated 23 April 2013 and 279325 dated 11 January 2016.

6. The plaintiff also holds the following copyright registrations:

S. No.	TITLE	Reg. No.	STATUS	DATE OF REGISTRATION
1.	HIMANI NAVRATNA OIL (LABEL)	A-58209/2000	REGISTERED	10.01.2001
2.	HIMANI NAVRATNA TEL (LABEL)	A-67884/2004	REGISTERED	01.07.2004
3.	HIMANI NAVRATNA OIL	A-86299/2009	REGISTERED	23.07.2009

	(WITH DEVICE OF SAINT)			
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7. To vouchsafe its reputation and reach in the market, the plaintiff has placed on record its annual turnover from the sale of products under the NAVRATNA trademarks which, from a figure of ₹ 14.77 lakhs in 1990-91, has arisen to a figure of ₹ 585.6 crores in 2021-22. The plaintiff also claims to have expended considerable amounts in advertisement and promotion of its products being sold under the NAVRATNA brand. In 2020-21, an amount of ₹ 37.1 crores and during 2021-20 an amount of ₹ 49 crores is stated to have been spent towards such advertisement and promotion. It is stated that the NAVRATNA cool oil of the plaintiff is stated to be sold through 9.4 lakh direct retail outlets, 45 lakh indirect outlets and 3250 distributors spread over 20500 towns.

8. These assertions, as contained in the plaint, have not been disputed by the defendant during arguments. In my considered opinion, they make out a clear *prima facie* case of considerable goodwill and reputation commanded, in the market, by the “NAVRATNA” brand of the plaintiff, for its cool red oil.

9. Mr. Abhimanyu Bhandari, learned Counsel for the plaintiff, has argued on the aspects of trademark infringement, design infringement, copyright infringement and passing off.

10. Inasmuch as I am of the considered opinion that a clear *prima facie* case in the plaintiff’s favour has been made out on the aspect of passing off, I do not deem it necessary to enter into the aspects of infringement which, frankly, appear to be arguable.

11. Passing off, as a common law tort, is said to be committed when the defendant, by its acts, seeks to pass off its products as the products of the plaintiff. Passing off may be committed by a variety of means. Section 27(2) of the Trademarks Act 1999 protects the rights of persons to sue in the event that the tort of passing off is found to have been committed, in respect of the goods of the plaintiff.

12. In the present case, when one compares the products of the plaintiff and the defendant, it is *prima facie* apparent, in my considered opinion, that the defendant has consciously imitated nearly every essential and distinctive feature of the plaintiff's product, apparently to capitalize on the goodwill and reputation earned by the plaintiff's product over a period of time. It is not in dispute that the defendant is only in the market since May 2023, as against the plaintiff, whose NAVRATNA oil is being sold since January 1989. The learned Counsel have provided, to the Court, physical samples of the two products. Photographs of the said products, packed in bottles, have been provided as Document 11 filed with the plaint and photographs of the rival sachets and rival bottles have been provided as Document 12 filed with the plaint. They may be produced thus:

Rival sachets:

Plaintiff's Product	Defendant's Product
	

Rival bottles:



13. When one compares the two products, whether in bottle or in sachet forms, the similarities are stark and glaring. Both the packs have the same red background. Both the packs use the word “Thanda” in vernacular and “Cool” in English, along with “Tail” (Oil). Both the packs have a motif of ice packs and a red flower, apparently hibiscus. Both the packs have the words, towards the lower edge “राहत आराम तरोताजगी”¹ in that order. Whereas the plaintiff’s pack contains the recitals, over these words “11 असरदार जड़ीबूटियों के साथ”². Both the packs have the word *Naya*/New in a triangular yellow background towards the upper left corner of

¹ “Raahat aaram tarotaazgi” meaning “peace comfort freshness”
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thepacks. When one sees the two bottles, they are similar in shape, the slight difference in the two shapes being so imperceptible as not to impress itself on an average customer. The oil contained in both the bottles is red in colour. Mr. Nayar sought to contend that if empty bottles are taken into account, the two bottles would look different and the similarity, if any, in appearance is to a large extent contributed by the red colour contained in the oil contained in the bottles. The submission, in my mind, does not brook acceptance as one has to consider the aspect of passing off on the basis of filled bottles, not empty bottles. The average consumer does not buy the empty bottle, but a full one”. The use of red colour for oil is also, in my opinion, lifted from the red oil which is used by the plaintiff.

14. Apart from these individual similar features of similarity between the two products, it is clear at a bare glance at the two products, placed side-by-side, that the defendant has attempted – to borrow a felicitous phrase employed by a coordinate Bench of this Court in *Marico Limited v. Mukesh Kumar*³ – to sail as close to the wind as possible. Where there is a transparent attempt at imitation of the essential feature of the product of another, the following principle enunciated by Lord Justice Lindley in *Slazenger & Sons v. Feltham & Co*⁴, would apply, which may be reiterated thus:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?”

15. In such cases, it is also settled, by the decision in *Munday v.*

² “11 *asardaar jadibootiyon ke saath*” meaning “with 11 active herbs”

³ 253(2018) DLT 8

⁴ (1889) 6 RPC 531

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*Carey*⁵ that the Court is required, in such cases, to concentrate more on the feature of similarity than those of dissimilarity. On an overall appearance, there is a clear attempt, by the defendant, to make its Cool King Thanda Tail product appear as similar to the NAVRATNA Ayurvedic Oil of the plaintiff as possible. *Prima facie*, in the opinion of this Court, this intended to create confusion in the mind of an average consumer. Where such intent is apparent, as applied in *Slazenger*⁴, the Court would proceed on the premise that the attempt is successful rather than unsuccessful.

16. The attempt of the defendant to target the plaintiff is also apparent from the following advertisement, which was brought out by the defendant:



17. The plaintiff has alleged in the present plaint, that the afore-noted advertisement is disparaging of the plaintiff's product. That, in my view, may be an arguable issue. What is clear, however, from the above advertisement is that the defendant is, in fact, targeting the plaintiff's product as the bottle, which is shown to have been replaced, in the advertisement, by the defendant's Cool King Thanda Tail bottle is apparently the bottle of the plaintiff. Open competition with the

⁵(1905) R.P.C. 273
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product of the plaintiff by the defendant is, therefore, transparently apparent. This factor also contributes to the *prima facie* impression of the Court that the defendant has consciously tried to copy the essential features of the getup and trade dress of the plaintiff so as to capture the market which the plaintiff has assiduously developed since as far back as 1989.

18. Mr. Rajiv Nayar, learned Senior Counsel for the defendant did advance every possible argument to counter the plea of passing off. He relied upon the judgment of this Court in *Bacardi and Company Limited v. Bahety Overseas Private Limited*⁶, which distinguishes between the torts of infringement and passing off. He sought to draw attention to the various features of dissimilarities between the products of the plaintiff and the defendant and their appearance, including picture of a saint on the bottle of the defendant, the word NAVRATNA which is not present on the product of the defendant, the prominent display of the house mark of the defendant “Dabur” on its product, the words “Cool King” with an adjoining crown motif, and a transparent tube towards the center of the design on the label of the defendant’s product with ice cubes in it. These, he submits, constitute over 60% of the distinctive features of the defendant’s label, which are different from those of the plaintiff. Mr. Nayar submits that the plaintiff is essentially seeking to monopolize the colour red, which the plaintiff quite obviously cannot do as in the first instance, it does not possess any trade mark registration of the colour red *per se*, and in any event, the colour red is commonly used for cool oils by various other entities in the market. Mr. Nayar has handed over a tabular depiction of various oils, which are stated to be cool oils and red in colour. He has also submitted that the defendant is also using red as a

⁶ (2021) SCC OnLine Del 4956
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common colour for various products including Dabur Lal Dant Manjan, Dabur Lal Toothpaste, Dabur Chawanprash and Dabur Ashwagandha Churna.

19. All these submissions of Mr. Nayar, even if seen cumulatively, do not dispel the *prima facie* impression of conscious imitation, by the defendant, of the layout and getup of the plaintiff's product, with a transparent attempt to make its product appear as similar to the product of the plaintiff as possible. I do not intend, especially, at this *ad interim* stage, to reiterate my findings in this regard, which already stand encapsulated hereinabove.

20. Insofar as the reference by Mr. Nayar to various other products of other manufacturers, which are also stated to be cool oils and red in colour, is concerned, the products as contained in the table handed over across the bar are not even remotely as similar to the plaintiff's product as is the defendant's Dabur Cool King. That apart, the law in this regard is well settled from the time of *Pankaj Goel v. Dabur India Ltd*⁷, in which it has been categorically held that the plea of a mark being common to the trade cannot be advanced merely by citing a number of other products having the same mark or similar marks. The defendant would have to point out the period from which the other products have been in the market, the sales achieved by such products by using similar marks and their reputation vis-à-vis the reputation of the plaintiff. The Court cannot be unmindful of the fact that the plaintiff has been in the market since 1989 and commands 66% of the market so far as red cool oil is concerned. In that scenario, the mere reference to various other products, which may also be using red as a colour for cool oils, can hardly help the defendant. There is

⁷ 2008 (38) PTC 49
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no reason why the Court should not presume that other manufacturers have, in fact, also sought to capitalize on the reputation of the plaintiff by using red as a colour for cool oil.

21. The colour red is not normally associated with a feeling of coolness. Red is certainly not a cool colour for cool products. Blue, traditionally, is cool, while red is hot. One would normally associate a cool product with a colour blue rather than red and hot product with the colour red. A case in point is Davidoff, which sells its iconic Cool Water fragrance in blue bottles, and its Hot Water variant in red bottles. The choice of red as a colour for a product which produces a cool feeling is, therefore, decidedly off the beaten track.

22. At an *ad interim* stage, therefore, I am of the opinion that the plaintiff has succeeded in making out a *prima facie* case of passing off, by the defendant, of its product as the product of the plaintiff and a conscious attempt by creating confusion in the market by adopting a trade dress which is deceptively similar to the trade dress of the plaintiff. Applying the law laid down in para 13 in *Laxmikant V. Patel v. Chetanbhai Shah*⁸, in a case where *prima facie* passing off is found to exist, the Court is bound to grant *ad interim* injunction.

23. Mr. Nayar had also placed before this Court the following changed packing which, according to him, would be non-infringing in nature:

⁸ (2002) 3 SCC 65
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24. While, to decide the present application, it is not necessary for me to pronounce on this aspect of the matter as it would be for the defendant to, should it so choose, file a proper application before this Court placing on record what it would claim to be a non-infringing packing, nonetheless, in order to avoid any confusion on that score, I have applied myself to the submission of Mr. Nayar that the suggested changed pack is non-infringing.

25. When one compares the new packs with the infringing pack, the distinction between the two are hardly perceptible. The only distinction that immediately comes to the notice of the Court is that the triangular border at the top left corner in which the word “Naya” is written is green in colour instead of yellow, and the word “राहत” has

been replaced by the word “सुकून”⁹ and the words “गहरी नींद”¹⁰ have been added.

26. On an overall appearance, I am *prima facie* opinion that the suggested new pack would also be infringing in nature. This shall not, however, inhibit the defendant from placing on record any altered packing, which is sufficiently distinct from the asserted pack of the plaintiff to dispel the possibility of the product being passed off as the product of the plaintiff.

27. Mr. Bhandari has placed reliance on the judgment of this Court in *Marico*³ and has specifically drawn the attention to paras 44, 49, 52, 54 and 70 of the said decision. The said paragraphs may be reproduced thus:

“44. Upon comparison of the aforesaid two bottles, it is evident that the background colour (same shade of blue Pantone 285C), bottle size, cap shape, nozzle, flag device, coconut tree, broken coconut device, indentation, print as well as description in white font, are very similar if not identical. This Court is of the *prima facie* opinion that if the two products are placed next to each other, it would be apparent that each and every important feature of the plaintiff's PARACHUTE Coconut Oil product had been copied by the defendants for their EVEREST Coconut Oil product. In the present case, the resemblance in get up and trade dress between the two products is so close that it can hardly occur except by deliberate imitation. In fact, this Court is of the *prima facie* view that if the two rival products were kept on a display shelf, it may be well-nigh impossible for a reasonable consumer to tell which product belongs to whom. Consequently, this Court is of the *prima facie* opinion that the defendants have copied the most relevant, material and essential features of the plaintiff's product in an attempt to pass off its products as that of the plaintiff's.

49. In fact, this Court is of the *prima facie* view that not only are the three elements of a passing off action namely, the reputation of goods, possibility of deception and likelihood of damages established in the present case, but that the adoption by

⁹ “Sukoon”, also meaning “peace”

¹⁰ “Gehri neend” meaning “deep sleep”

the defendants of the said trade mark and trade dress was in bad faith. Accordingly, the contention of the defendants that they were honest concurrent users is contrary to facts.

52. With regard to the issue of infringement and passing off in colour combination, this Court is of the view that the plaintiff is not claiming monopoly over a single colour inasmuch as the plaintiff's bottle is not only blue in colour but it also contains amongst others a coconut tree, a broken coconut device, a flag which has a dark blue background and certain descriptions written in white font. Consequently, the plaintiff is not claiming exclusivity in blue colour as a stand alone factor, but in a combination of factors, which includes the blue colour.

54. As far as the defendants' argument that the colour blue is common to the trade and/or the plaintiff has not taken legal action against such similar infringers, this Court is of the view that the defendants have not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to plaintiff's distinctiveness. No sale figures of third parties using the blue colour bottles have been placed on record by the defendant. Consequently, this Court at this stage cannot presume extensive use of the blue colour by third parties.

70. As far as the defendants' contention that it has made some changes in its packaging/trade dress and is willing to modify its get up/trade dress, this Court is of the prima facie view that the defendants have time and again made minor changes in their packaging in an attempt to continue to mislead the purchasers and make it more difficult for the plaintiff to protect its mark/trade dress. It is pertinent to mention that throughout these proceedings the defendants persisted in retaining the following elements:-

- a) Blue colour similar to that of plaintiff.
- b) Bottle shape identical to plaintiff with almost identical indentations.
- c) A flag device with the brand EVEREST written in a script almost identical to the plaintiff's PARACHUTE. In most suggestions, the Flag Device has a green outline and a dark blue interior, though in two of the proposals the defendant did agree to change to the colour Orange/Red.
- d) Almost identical device of broken coconut with a splash of coconut water.

e) Almost identical coconut tree.

f) All descriptive and other written material in white on the blue background.”

28. Mr. Nayar, on the other hand, refer this Court to para 25 of the said decision to seek to distinguish it. He submits that, in para 25, the Court has referred to various other distinguishing features between the rival products.

29. Mr. Nayar also sought to contend that the plaintiff had not specifically established any goodwill in the packing which it is asserting in the present case. I have considered the said submission. The facts of the present case are peculiar. The plaintiff has in respect of its NAVRATNA brand, which has been in the market since 1989, clearly amassed considerable goodwill in the product. The distinction between the earlier label used by the plaintiff and the present label used by the plaintiff do not appear, to me, to be so stark as to require the plaintiff to independently establish goodwill in respect of the present label. Insofar as the product is concerned, as I have already noted hereinabove, there is ample material on record to support Mr. Bhandari’s contention that the plaintiff has, over time, garnered considerable goodwill and reputation. In that view of the matter, the mere fact that the label that is presently used by the plaintiff may be somewhat different from the label used earlier, cannot, in my view, in any way mitigate the possibility of the defendant’s goods being passed off as the goods of the plaintiff.

30. The principle enunciated in *Marico*³, in my view, *prima facie*, supports the opinion expressed by me hereinabove.

31. In view of the aforesaid discussions, let the plaint be registered as a suit. Issue summons in the suit.

32. Written statement, accompanied by an affidavit of admission and denial of the documents filed by the plaintiff be filed within 30 days with an advance copy to learned Counsel for the plaintiff who may file replication thereto, accompanied by an affidavit of admission and denial of the documents filed by the defendant within 30 days thereof.

33. List before the learned Joint Registrar (Judicial) for completion of the pleadings, admission and denial of documents and marking of exhibits on 10 October 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings.

IA I.A. 14557/2023 (Order XXXIX Rules 1 and 2 of the CPC)

34. This is an application by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC), seeking interlocutory injunctive relief.

35. Issue notice, returnable before the Court on 20 November 2023. Notice is accepted on behalf of the defendant by Mr. Kripa Pandit.

36. Reply, if any, be filed within a period of four weeks with an advance copy to learned Counsel for the petitioner, who may file rejoinder thereto, if any, within a period of four weeks thereof.

37. Till the next date of hearing, the defendant is restrained from

selling its product, in any manner, in the impugned packing or in any other pack, which is confusingly or deceptively similar to the impugned packing. The replication of the essential features of the pack, which have already been noted by me hereinabove, in any other alternative pack which the defendant proposes, would also tantamount to a violation of this order.

I.A. 14558/2023 (exemption)

38. Subject to the plaintiff filing legible copies of any dim or illegible documents within 30 days, exemption is granted for the present.

39. The application is disposed of.

C.HARI SHANKAR, J

AUGUST 9, 2023

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