
Aravind Laboratories Vs Arihant Cosmetics

Criminal Application No"s. 422 and 423 of 2001 and Application No"s. 3461 and 3462 of 2001 in C.S. No. 339 of 2001

Court: Madras High Court

Date of Decision: Feb. 21, 2002

Acts Referred:

Civil Procedure Code, 1908 (CPC) – Order 39 Rule 1, Order 39 Rule 2#Trade and Merchandise Marks Act, 1958 – Section 28, 29

Citation: (2005) 30 PTC 175

Hon'ble Judges: E. Padmanabhan, J

Bench: Single Bench

Judgement

E. Padmanabhan, J.

The plaintiff in C.S. No. 339 of 2001 has prayed for the following reliefs:-

(i)Granting permanent injunction restraining the defendants by themselves, their servants, agents or anyone claiming through or under them from

manufacturing and selling and offering for sale the collyrium with the offending mark ""EYE-TOP"" or using the device mark in the carton as shown in

document No. 3 in the plaint the registered trademark No. 124824 dated 11.09.1949 in any colour or any other trademark with the device of an

eye or word eye or which is in any way deceptively or any other colourable imitation of the plaintiffs registered trademark Nos. 124824 dated

11.09.1949, 271583 dated 24.6.1971, 296914 dated 14.9.1974 or in any manner infringing the plaintiff registered trademark numbers referred

above.

(ii) granting a permanent injunction restraining the defendant by themselves, their servants, agents or anyone claiming through or under them from

imitating the get up, colour scheme and the name ""EYE-TOP"" and passing off their goods M.O. No. 2 as the goods of the plaintiff's M.O. No. 1

herein.

(iii) directing the defendants to render a true and faithful account of the profits earned by them through the manufacturing and sale of the offending

EYE-TOP"" directing such profits to be paid to the plaintiffs by way of damages for the infringement and passing off committed by the defendants.

And for other consequential reliefs.

2. Pending the suit the plaintiff filed Application No. 422 and 423 of 2001 seeking the relief of ad interim injunction restraining the respondent/defendant, their servants, agents or anyone claiming through or under them from manufacturing and selling, stocking and offering or

advertising for sale the offending mark ""EYE-TOP"" or using the device mark in the carton as shown in Document No. 3 in the plaint the registered

trademark No. 124824 dated 11.9.1949 in any colour or any other trademark with the device of an eye or word eye or which is in any way

deceptively or any other colourable imitation of the plaintiffs registered trade mark Nos. 124824 dated 11.9.1949, 271583 dated 24.6.1971,

296914 dated 14.6.1974 or in any manner infringing the plaintiff registered trade mark numbers referred above and also for an interim injunction

restraining the respondent, their servants or agents or anyone claiming through or under them from imitating the get up, colour scheme and the name

EYE-TOP"" and passing off their goods M.O. No. 2 as the goods of the plaintiffs M.O. No. 1 herein.

3. I. DAVID CHRISTIAN, J., as he then was, by order dated 27.4.2001, passed an order granting interim injunction in both the applications. The

said order reads thus:-

Petitioner is ARAVIND LABORATORIES, Chennai. The petitioner is manufacturing Pharmaceutical drugs including collyrium which is sold by

the petitioner in the brand name ""EYE-TOP"". The petitioner is in the production of the Cosmetics and drugs for the past many years and he has

also registered his trade mark and he obtained registration certificate in the year 1940 itself. His annual turnover has reached the level of Rs. 13

crores. The petitioner is spending huge amount for advertising his products under its registered trade mark. While so, it seems that the is

respondent has recently started collyrium using the brand name ""EYE-TOP"". This trademark is deceptively similar and identical to the petitioner's

trade mark. Obviously, the reputation and goodwill attached to this trade mark is affected by the use of the respondent's trade mark. Hence,

interim injunction is granted Notice returnable in three weeks.

4. To vacate the said interim order, the defendant in the suit filed application Nos. 3461 and 3462 of 2001,

5. Heard Ms. Gladys Daniel, learned counsel appearing for the applicants and Mr. M.V.L. Narasimhan, learned counsel appearing for the

respondent.

6. Concedingly, the applicant's trade mark is not only a registered trade mark, but also a mark which the applicant has been using for over sixty

years and has build up a reputation besides a good market having substantial turnover. This is not in dispute. The respondent has started user of the

trade mark ""EYE-TOP"" very recently with a depiction of eye on the carton in the same colour with same white and green colour combination

decorative on the carton and label.

7. Admittedly, the respondent has not registered the mark which it claims. It is not as if the respondent has taken out an application for rectification

of the trade mark Registry. It is fairly admitted that the applicant has been using the trade mark ""EYETEX"" with an Eye depicted on the carton and

the white carton box is printed with a circle in the center and a green printing all around the box. Identically, the respondent/defendant had been

marketing the same commodity with the mark ""EYE-TOP"" with an Eye and using the same type of white card board with circle in the center and

green decorative printing on all sides.

8. According to the applicant, Kajal (Collyrium) is a product of the applicant company and marketed in black circular plastic capsule, on the face

of which it is embossed the words ""EYETEX"" Regd"". A plastic stick with handle is supplied with the box for applying the kajal to the eye lashes so

that the kajal does not stain the fingers. The plastic capsule is wrapped by a sheet giving directions for use and with the plastic stick is packed in a

square cardboard box. It is the profile of a face with prominent eyebrow and eye lash. The word ""EYETEX"" is written horizontally in bold,

distinctively printed letters, ""Regd"" is written at the bottom to indicate that the entire design and the legend are registered. The three colours, green,

white and black are used in artistic combination to give an arresting effect even at the first glance. The said colour scheme has been used

continuously and substantially all over India without any interruption. The reverse face of the carton contains a circle, in which the address of the

manufacturing place of the plaintiff and license number is printed. On the remaining four rectangular sides the word marks of the plaintiff,

EYETEX"" kanmai, in Tamil, Kajal in Hindi, Katuka in Telegu are printed. The picture of the eye is the dominating motive of the carton. The

expression ""EYETEX"" is registered in all the languages. It is being marketed by the applicant for over 50 years.

9. The applicant came across the same product Kajal with the trade mark ""EYE-TOP"" with the pictorial representation of the eye and the caption

in the same languages, Tamil, Telegu and Hindi having circulation in different parts of the country including the city of Madras. The container used

by the respondent is identical to that of the applicant. On the principal face of the carton is printed the device of an eye with the mark ""EYE-TOP"".

The size of the packet, colour, combination the get up the design of the box, the style of writing are practically identical. The essential features of

the plaintiff's container, apart from the impugned trade mark infringing the plaintiff's registered trade mark ""EYETEX"", with its words as well as the

design, get up etc., are identical to the applicant. According to the applicant it is. the registered owner of the trade mark consisting of the work

EYETEX"" alongwith the artistic representation of the profile of a human face has been tested in several legal proceedings before this Court and

the claim of the applicant has been sustained right through and the reported decisions being (i) 1981 1 MLJ P. 75, (ii) D. Jayaraman Vs. Govt. of

Tamil Nadu and Another, besides O.P. No. 48 of 1962, decided on 1.5.1966.

10. The respondent has no right to use the mark identical or deceptively similar to that of the applicant and it is nothing but copying the essential

features, get up, colour scheme of the applicant's container in the course of the cosmetic business and the respondent is infringing the registered

trade made and committing passing off. The respondent's action is a calculated attempt to exploit the commercial good will earned by the

applicant. Hence, the applicant is seeking for various reliefs and pending the suit has also prayed for injunction.

11. This Court granted interim injunction and to vacate the same, the respondent/defendant has taken out Application Nos: 3461 and 3462 of

2001.

12. According to the respondent the product ""EYE-TOP"" in no way infringes the trade mark of the applicant since there are distinct dissimilarities

and the applicant cannot claim exclusive right over the word ""EYE"" as it is a common name. The respondent claims that it has been using the same

mark for the past ten years. The respondent has secured a license for manufacturing of ""EYE-TOP"" from the year 1992. The respondent denies

the averment that its mark is deceptively similar in get up, colour scheming and letter arrangement of the applicant's mark. The two cartons are

different and the containers are different and therefore there is no chance of any deception or confusion in the minds of the purchaser. The

respondent further claims that it is not a recent entrant in the field of kajal and if the interim injunction is not vacated the respondent will suffer

irreparable loss and injury, besides it has to close down its business.

13. The points that arise for consideration are:-

A. Whether the respondents mark infringes the applicant's registered trade mark and deceptively similar to the applicant's mark?

B. Whether pending the suit, the applicant is entitled to continuance of injunction on the facts of the case?

C. Whether the order of interim injunction deserves to be made absolute or liable to be vacated?

14. All the three points could be considered together. The discussions or conclusions arrived at are for the limited purpose of these applications

and the same shall not prejudice the parties in any manner in the trial of the suit.

15. The learned counsel for the applicant and respondent made submissions. The counsel for the applicant produced the very carton and box

respectively used by the applicant and respondent. It is apparently even for a common man deceptively similar and there is no escape for the

respondent. The applicant is carrying on business under the style of Aravind Laboratories, while the respondent, a recent entrepreneur has styled

its business as Arihant Cosmetics.

16. To decide the question as to whether the applicant's trade mark is infringed in a particular case as has been held by the Apex Court the

approach must not be that action of passing off the goods of the respondent as and for those of the applicant. In order to come to the conclusion

whether one mark is deceptively similar to the other, the essential features of the two are to be considered. It is equally well settled that they should

not be placed side by side to find out if there are any difference in the design and if so, whether they are of such character as to prevent one design

from being mistaken for the other. It is also well settled that it would be sufficient or enough if the impugned mark bears such an overall similarity to

the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

17. This Court shall not compare the marks by keeping side by side or trying to compare the difference. The essential features of the trade mark of

the applicant has been adopted by the respondent as seen from the fact that the get up, packing and other writings on the labels and packets in

respect of the same commodity viz., kajal in which the defendant offers its goods for sale, would show that the respondent's mark bears

substantial similarity to the registered mark of the applicant and that would mislead a user of Kajal or any other trader or common woman user.

The packets are in the same size, the colour scheme of the two wrappers is identical, the design all bears a close resemblance or so and one can

be easily mislead to the other.

18. The essential features of both are that there is an eye applied with kajal besides similar circles identical and colouring and pattern as well. The

respondent's mark is deceptively similar and the applicant holds a registered trade mark and has been carrying on business for more than five

decades. The counsel for the applicant is well founded in her contentions that the respondent has infringed the trade mark and is passing off its

goods as if that of the applicant.

19. As rightly asserted and rightly contended by the learned counsel for the applicant, the respondent is selling goods so marked, putting design or

calculated to lead the purchasers to believe that they are the applicant's goods. The respondent also using a mark which is a colourable imitation of

the applicant's registered trade mark. The respondent has also set out details of the business carried on for more than five decades, besides it has

won legal battle in very many cases referred to above "and some of them are reported. The applicant has been using the trade mark on a large

scale and it has a substantial volume of business as detailed in the plaint.

20. In Amritdhara Pharmacy Vs. Satyadeo Gupta, , it is highlighted that a critical comparison of the two names might disclose some points of

difference, but unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names or

marks having regard to the nature of goods he is looking for with a somewhat vague recollection that he had purchased a similar goods on a

previous occasion with a similar name.

21. In *Tubes Investments of India Ltd. v. Trade Industries*, (1997) 6 SCC 35, it has been held thus:

An examination of the mark used by the respondent with the registered mark of the appellants shows that the mark used by the respondent is

prima facie similar to the mark used by the appellants. The mere difference that the respondent uses only one circle around his mark instead of two

concentric circles does not make much impact on the obvious similarity between the two marks. The visual similarity between the two marks

coupled with the fact that the respondent's mark is used on bicycle saddle covers, prima facie, posed a real danger that the product of the

respondent can be passed off as a product of the appellants. Use of the mark by the respondent on goods falling in Class 12 is, prima facie,

violative of the appellants' rights in respect of their registered trade mark for goods in class 12. Looking to the fact that the appellants are

registered holders of their mark which is specifically registered for bicycle parts, and in the circumstances, this is a fit case for grant of interim

injunction restraining the respondent from using his mark for any, items manufactured by him for use in connection with bicycles or falling in-Class

12.

22. Following the above pronouncements of the Apex Court, and on a consideration of the entire materials placed by the applicant this Court

holds that the applicant is entitled to an order of injunction, less the applicant will be prejudiced, since the respondent is adopting deceptively

similar mark and get up, printing as well as carton in respect of the same item Kajal. The learned counsel for the respondent admitted the

respondent's mark infringe the applicant's registered trade mark and there could be no second opinion in this respect.

23. The respondent has come to the field only recently and no material has been placed to the effect that the respondent has been carrying on the

business simultaneously for over five decades with the same trade mark ""EYE-TOP"", with the same get up, or colour combination of printing,

carton box etc., If the order of interim injunction already granted is not made absolute, the applicant will be seriously prejudiced and damaged if

any, could be only be a farce.

24. In the light of the above discussions, the first point is answered against the respondent and in favour of the applicant. The second and third

points are answered in favour of the applicant.

25. Taking into consideration of the volume of business carried on by the applicant and the respondent's attempt to market its goods with the

deceptive mark ""EYE-TOP"", this Court holds that it is a clear case of passing off and infringement of applicant's registered trade mark. Hence, the

order of interim injunction passed by this Court in Original Application Nos: 422 and 423 of 2001 is made absolute. Consequently, Application

Nos: 3461 and 3462 of 2001 are dismissed with costs.