
(2012) 12 DEL CK 0201

Delhi High Court

Case No: CS (OS) 258 of 2012

Bourjois Limited

APPELLANT

Vs

Mr. Naunihal Singh and Others

RESPONDENT

Date of Decision: Dec. 3, 2012

Acts Referred:

- Trade Marks Act, 1999 - Section 2(c)

Citation: (2013) 5 AD 311 : (2013) 196 DLT 189 : (2013) 133 DRJ 439 : (2013) 53 PTC 632

Hon'ble Judges: V.K. Jain, J

Bench: Single Bench

Advocate: Vaishali Mittal and Ms. Abhilasha Nautiyal, for the Appellant;

Final Decision: Dismissed

Judgement

V.K. Jain, J.

The plaintiff before this Court is a foreign company and claims to have coined and adopted the trademark BOURJOIS. The plaintiff is engaging in the business of selling cosmetic products and claims presence in over 120 countries including India. The plaintiff company had the following global turnover and advertising expenditure during the period 2004-2010:

The plaintiff claims the following turnover and advertising expenditure in India during the period 2004-2009.

The plaintiff company is the registered proprietor of the following trademarks in India:

2. The defendant no. 2 is stated to be an in-house concern of defendant no. 3 and believed to be engaged in providing spa services, beauty services, manicures, pedicures, bridal spa and makeup under the name "Bourjois Spa". The defendant no. 1 is stated to be the Chief Executive Officer of Defendant no. 2 and also a Director in defendant no. 3 company. The defendants are also operating a website

having domain name <http://bourjois.co.in/>. The plaintiff sent notices to the defendants in December, 2009 and February, 2010 asking them to stop the use of the name BOURJOIS, but the defendants did not respond to the notices. The case of the plaintiff is that the use of the mark BOURJOIS by the defendants as a trade name and trademark for running its services and as a part of its domain name constitutes infringement of its registered trademark, besides constituting passing off of their services as those of the plaintiff. The plaintiff has accordingly sought injunction restraining the defendants from using, depicting or displaying the trademark and domain name BOURJOIS or any other mark which is deceptively similar to the mark of the plaintiff. The plaintiff has also claimed damages amounting to Rs. 20,05,000/- from the defendants, besides rendition of account.

3. Defendants were proceeded ex parte vide order dated 15.2.2012, since they did not put in appearance despite service and did not file any written statement.

The plaintiff has filed affidavit of Mr. Martin Hamilton, the Constituted Attorney of the plaintiff company, by way of evidence. In his affidavit, Mr. Martin Hamilton has supported on oath the case set out in the plaint and has proved the documents relied upon by the plaintiff company. He has further stated that the plaintiff company had following sales turnover during the period 2003-2010:

4. Ex. PW1/21 is the certified copy of the Trademark Register which shows that the plaintiff company is the proprietor of the trademark BOURJOIS in India since 25.11.2003 in respect of preparations for application to or care of the skin, scalp, hair or nails, soaps, perfumes, essential oils, cosmetics, non-medicated toilet preparations, tissues impregnated with cosmetics, cotton wool and makeup sticks for cosmetics purposes.

There are two trademark registration in favour of the plaintiff is trademark number 85461 valid since 31.08.1943 in respect of perfumery, soap, cosmetics, hair lotion and dentifrices and trademark no. 1252141 since November 25th, 2003 in respect of preparations for application to or care of skin, scalp, hair or nails soaps, perfumes, essential oil, cosmetics, non-medicated toilet preparations, tissues impregnated with cosmetic cotton wool and cotton sticks for cosmetic purposes.

5. A perusal of Ex. PW1/5 which are the photographs of the various products of the plaintiff company would show that the plaintiff company is selling large number of cosmetic products including healthy mix foundation, mineral matte foundation, sleep effect foundation, bio detox foundation, anticorne healthy mix, brush concealer, bronzing compact powder, compact powder, new blush, elastic mascara, French manicure, nail polish remover, new khol and eyeshadow.

6. A perusal of Ex. PW1/19, which is the certificate issued by the Chartered Accountant of the plaintiff company would show that the plaintiff had sale turnover of USD 169M, 161M, 180M, 184M, 212 M, 261M, 290M, 235M and 257M in the year 2002-2010. It would thus be seen that the plaintiff company has a big presence in

cosmetics etc. which it is selling under the trade name BOURJOIS and it also holds two registrations of the said trademark in India in respect of various products which are applied on human body and are meant for its upkeep, maintenance and beautification.

7. A perusal of the documents filed by the plaintiff would show that the defendants are running a Spa under the name BOURJOIS SPA at Chandigarh. The defendants also appear to be running a saloon and spa under the name "Strands". The brochures of the defendants would show that the Spa being run under the name BOURJOIS SPA also have advertised along with the broacher of "Strands Saloon and Spa" by them. The visiting card filed by the plaintiff also shows that "Strands Saloon & Spa" and "Bourjois Spa" are sister concerns having presence in London, New Delhi, Chandigarh, Panchkula, Ludhiana, Trivandrum. Thus, the defendants claims to be running Spa and Saloon services under the name BOURJOIS at various places including Delhi.

8. Ex. PW1/10 is an article published in the Magazines "Vogue India" in respect of the products of the plaintiff being sold under the name BOURJOIS; and Ex. PW1/11 is a printout from the website <http://www.indianvanitycase.com> taken on 26.6.2012 which would show that the products of the plaintiff company under the name BOURJOIS are being advertised on the said website. Ex. PW1/16 is a copy of the advertisement in "The Times of India, Illustrated Weekly" dated 16.1.1927 wherein products of the plaintiff company were advertised. This would show that the plaintiff company has presence in India since 1927.

9. The law relating to passing off, which is an action in Common Law is by now well settled. Every person, whether natural or juridical, is entitled to carry and promote his business, under such mark or trade name as he may choose to adopt for the purpose so long as such use does not give rise to a belief that the said business is being carried by some other person or has some business association or connection with that person. No one is entitled to use a trademark or a trade name which is likely to deceive the members of the public and divert the business of another person to him, on account of use of such trade mark/trade name. If a trademark/trade name has acquired a reputation in the mark, use of an identical or similar mark by other person for carrying his business is likely not only to be detrimental to the business of the person who adopted and built the mark, but is also likely to mislead and deceive the members of the public. Such use, besides being injuries to the owner of the trademark is also likely to create confusion with respect to origin/source of the goods since a person coming across goods and/or services in respect of which the impugned mark is used, may, on account of use of the same or similar trademark/trade name, believe that the goods/services being offered to him emanate from the owner of the trademark/trade name in question and that is why they were being sold under that trade mark/trade name. Everyone is entitled in law to work for and build a commercial goodwill for his business, but no

one has a right to trade upon the goodwill and reputation of another person and exploit the same to his advantage.

10. In the case before this Court the mark "BOURJOIS", being used by the defendants for rendering Spa and Saloon services and as a part of its domain name bourjois.co.in is identical to the registered trademark of the plaintiff company.

11. It can hardly be disputed that the cosmetics which are the products being sold by the plaintiff company under the name BOURJOIS are used in Spa as well as saloon. The cosmetic products being used by the plaintiff under the mark BOURJOIS are beauty products which are applied on human skin. The Spa and Saloon services being provided by the defendants are also the services primarily meant for toning up and beautifying human skin and hair. Cosmetic products are necessarily required for providing spa and hair saloon services and in that sense are the "raw material" required for rendering these services. It can hardly be disputed that the persons visiting Spas and Saloons would also be the customers of the various cosmetic products. It is not possible to render quality spa and saloon services without use of the cosmetic products.

It would be difficult to deny that a person seeking to avail saloon/spa services, on coming to know of the spa/saloon being run under the name BOURJOIS is likely to believe that the Spa/Saloon being visited by him was being run by the plaintiff or at least had some kind of association such as that of a franchisee/agent with the plaintiff company and that is why it was being run under the name BOURJOIS. In any case, use of the name BOURJOIS for providing spa and saloon services is likely to create confusion in the minds of the customers with respect to origin of the services being provided by the defendants. On account of use of the mark BOURJOIS by the defendants, the customers visiting their spa/saloon are likely to be deceived into believing that the outlet belongs to the plaintiff company or has been authorized by it.

12. Considering the connection between the cosmetic products which the plaintiff company is selling under the trademark BOURJOIS and the spa and saloon services which the defendants are providing using the same trademark, it would be immaterial that the registration of the plaintiff is in respect of the products whereas the defendants are using the impugned mark in respect of services and not products. What has to be seen in such like cases is as to whether the services in question are so closely connected with the products that the products and the services can be said to be complementary to each and the use of the mark in respect of the services is likely to cause confusion and give an impression of the two marks being associated with each other or not.

13. If the product and service are closely related to each other in the sense that not only are they likely to be used by the same class of persons, but they also have a trade connection such as the material being sold under a particular trade mark

being used for providing services under an identical/similar mark, it would be difficult to say that the goods and services are not closely related to each other. There can be many examples of the goods and services being closely related to each other. For instance, food products and catering services; clothes and dry cleaning services; mobile telephones and mobile telephony services; automobile sale and automobile repair services; TV/Fridge/AC/Washing Machine sale and TV/Fridge/AC/Washing Machine repair services. It would be pertinent to note here that in terms of Section 2(c) of Trademarks Act, 1999, the use of a mark in relation to the services shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services. Therefore, use of the mark BOURJOIS by the defendants to advertise availability of spa/saloon would certainly amount to use of this mark in relation to such services.

14. In the case before this Court, since cosmetics are the products extensively used in a spa/saloon, the customers coming across advertisements of the defendants or visiting their spa/saloon are likely to get confused and think that spa/saloon was being run or had been promoted by the plaintiff-company. In fact, on account of use of the trademark/trade name BOURJOIS by the defendants, the customer visiting the spa/saloon being run under the name BOURJOIS spa is also likely to believe that it is BOURJOIS cosmetics which would be used in the spa/saloon visited by him.

15. It is difficult to dispute that when the parties are engaged in common, overlapping or closely related commercial activities, there is grave and immense possibility of confusion and deception on account of the trademark/trade name of one person being used by the other person. The same will be the position when the domain name of one person is used by another person or the trademark/trade name of one person is used by another person as a part of his domain name. The domain name serves the same purpose which a trademark serves and cannot be said to be merely an Internet address to identify a particular website. If some comes across the website of the defendants being run under the domain name <http://bourjois.co.in>, he would naturally assume that it was the website of the plaintiff and that is why the word BOURJOIS was being used as a part of the domain name. If allowed to happen this, besides causing confusion, is also likely to deceive the persons seeking to access the website of the plaintiff-company. In fact, a stricter vigil needs to be kept with respect to the domain name, since a website can be accessed from anywhere and at any point of time.

The domain names of the plaintiff are <http://www.bourjois.com> and <http://www.bourjois.co.uk>, whereas domain name of the defendant is <http://bourjois.co.in>. The domain name being used by the defendants so closely resembles the domain names of the plaintiff that use of the word "in" the domain name of the defendants as against use of the word "U.K." in the domain name of the plaintiffs is of no consequence.

In [Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.,](#) , it was held that if there is close resemblance between the two marks and they are deceptively similar to each other, the word "India" added to one mark was of no consequence. On account of use of the name BOURJOIS as a part of domain name, the Internet users are likely to believe that <http://bourjois.co.in> is yet another website of the plaintiff-company, meant primarily for India and thus there is every possibility of confusion being created and those seeking to access the website of the plaintiff-company end up accessing the website of the defendants.

16. The word BOURJOIS is not a word commonly used in India and has no connection with the saloon and spa services which the defendants are offering and which the plaintiff company claims to have coined and adopted. The defendants have not come forward to contest the suit and to tell as to why they chose to use this particular name for providing spa and saloon services and as part of their trade name and domain name. The plaintiff company is a large multinational company having presence in more than 120 countries. It has presence in India since 1927 as is evident from the advertisement before published in "Times of India Illustrated Weekly" dated 16.1.1927. The BOURJOIS is thus a well-established trademark in respect of cosmetic and skin care products. It is obvious that by using the word BOURJOIS for providing spa and saloon services and as a part of its trade name and domain name, the defendants are seeking to encroach upon goodwill and reputation which the brand of the plaintiff company enjoys in a large number of countries including India. The use of the mark BOURJOIS by the defendants as part of their trade name and domain name as a trademark/service mark, besides being injuries to the interest of the plaintiff is also likely to deceive members of the public who may avail services being offered by the defendants under a false impression that they were buying the services of the plaintiff company. If the quality of the services being provided by the defendants is not found to be of the requisite standard, this is likely to substantially impair the brand equity which the mark BOURJOIS enjoys in the market.

17. Another important circumstances in this regard is that it is very much possible that the plaintiff company may, in near future, diversify into providing services such as spa and saloons services, so as to make full use of the mark BOURJOIS which they have been using in respect of cosmetic products for the more than last 100 years. In fact, there are quite a few companies which are selling cosmetic products and also providing such services under the same brand name such as Lakme, Loreal, VLCC, Shahnaaz Hussain etc. The defendants cannot be allowed to take unfair advantage of the well-established brand name of the plaintiff company by entering into these services using the same brand name/trade name.

18. In [T.V. Venugopal Vs. Ushodaya Enterprises Ltd. and Another,](#) , Supreme Court observed that the plaintiff's adopted name would be protected if it has acquired a strong enough association with the plaintiff and the defendant has adopted such a

name in common field of activity i.e. the purchasers test as to whether in the facts of the case, the manner of sale, surrounding circumstances etc. would lead to an inference that the source of product is the plaintiff.

Since BOURJOIS is not a word found in English dictionary, is stated to have been coined by the plaintiff and the defendants have not come forward to explain why they have chosen this particular name for providing spa/hair salon services, it would be difficult to dispute the contention of the learned counsel for the plaintiff that use of the impugned mark by the defendant is founded in dishonesty and actuated by mala fide so as to ride upon the goodwill and reputation which the plaintiff-company enjoys amongst the customers of such services. Refusing to injunct the defendants from using the impugned mark would amount to ignoring such dishonest and illegal acts and encouraging practices aimed at defrauding the consumers besides prejudicially affecting the reputation and goodwill which the plaintiff-company has built over last more than 100 years.

19. For the reasons stated hereinabove, I am of the view that the defendants are passing off their services as those of the plaintiffs by using the impugned trademark/trade name for rendering saloon/spa services and as a part of their domain name. The defendants are accordingly liable to be injuncted from using the impugned trademark/trade name. As noted earlier, the visiting card of the defendants clearly indicates that they are providing spa services under the trademark/trade name BOURJOIS in various places, including Delhi. Therefore, this Court has territorial jurisdiction to entertain the suit and grant injunction on account of passing off. For the reasons stated hereinabove, a decree for perpetual injunction with proportionate costs is hereby passed restraining defendant No. 3 from providing, offering or advertising spa/hair salon services under the trademark/trade name BOURJOIS or any other trademark/trade name, which is identical or deceptively similar to the said trademark. Defendant No. 2 does not appear to be a legal entity, it being only a spa being run by defendant No. 3. Defendant No. 1 is stated to be a director of defendant No. 3-company, but a company being a separate legal entity, no cause of action against him is made out. The suit against defendants 1 and 2 is, therefore, dismissed with no order as to costs. No other relief was pressed during arguments.

Decree sheet be drawn accordingly.