



## 2023 OVERVIEW – TRADEMARK LAW IN INDIA

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### INTRODUCTION

2023 was an exciting year for brand holders in India in that the courts were extremely sensitive to new issues including that of social media disparagement and trade dress protection. The courts also appear to hold the Trademark Registry to a higher standard when denying trademark applications, advising the Registry to look at other registrations of the same brand and thoroughly investigate documentation submitted by applicants. Some key cases that now shape trademark law in India have been highlighted.

### KEY CASES

#### TRADE DRESS PROTECTION

*Dabur India Ltd. Vs. Good Luck Ayurveda Pvt. Ltd.*

*Date of Judgment: 01/07/2023*

The Plaintiff, Dabur India Pvt. Ltd. is the largest manufacturer of ayurvedic medicines and wellness/healthcare products in India and is the largest company in the organized sector for ayurvedic products. It owns registrations for the trade dress/labels/packaging of the cough syrup 'HONITUS'. Dabur filed applications for interim injunctions against Good Luck Ayurveda Pvt. Ltd. and Vibcare Pharma Pvt. Ltd. in two separate suits.

The Delhi High Court in both cases found that the packaging and trade dress of MADHU JOSHANDA AYURVEDIC COUGH REMEDY and NURACUFF-AYURVEDIC MEDICINE FOR COUGH RELIEF were identical and deceptively similar to that of HONITUS. It held that Dabur had established a prima facie case of infringement of trademark and copyright against the defendants in each case. As the balance of convenience was in favour of Dabur, the Court granted the interim injunctions and restrained the respective defendants from using any trademark or trade dress which was identical, deceptively similar or confusingly similar to the Plaintiff's registered trademark HONITUS or bearing its well-known registered trade dress/label until further orders.

#### RECTIFICATION AND CANCELLATION OF A TRADEMARK

*Macleods Pharmaceuticals Ltd. v. Union of India and others.*

***Date of Judgment: 15/02/2023***

The Petitioner, Macleods Pharmaceuticals Limited, challenged the order passed by the Intellectual Property Appellate Board, Chennai (Respondent-2), which allowed a Rectification application filed by Sun Pharmaceutical Ltd (Respondent-4) to cancel Macleods' registered trademark OFLOMAC. The Bombay High Court considered various principles set out by the Apex court in its judgments and agreed with the decision of the IPAB. The Court held that the rectification was in the interest of the general public as the marks were concerned with medicinal/pharmaceutical products and the decision was not without jurisdiction or in excess of its jurisdiction as it was passed after giving full opportunity to both the parties.

It was held that a stricter test should be applied while arriving at a conclusion with respect to the similarity and confusion of pharmaceutical or medicinal products, and the point of view of an ordinary common man of average intelligence should be considered instead of a specialized medical practitioner in judging the issue.

Further, the Court found that Macleods was unable to establish the actual use of its OFLOMAC mark prior to Sun Pharma's use of its OFROMAX mark, and/or honest and concurrent use and therefore was not entitled to protection under Section 34 and/or Section 12 of the Trademarks Act.

## **COURT RELIED ON PREVIOUS CONSENT ORDER**

***KRBL Ltd. v. Vikram Roller Flour Mills Ltd.***

***Date of Judgment: 19/01/2023***

The Plaintiff KRBL Limited was a market leader in the business of processing, distribution, and sale of rice under the trademark "INDIA GATE". It had acquired rights to the mark through registration and an assignment deed from the predecessors who had been using the mark since 1979, and the Plaintiff itself had been using the mark continuously since 1993. The Plaintiff submitted that the Defendant's act of selling dalia under the mark "INDIA GATE" was infringing upon the Plaintiff's rights. The Defendant submitted that it was the prior user of the INDIA GATE mark in respect of various wheat products, and relied on a consent order between the two parties. The Defendant claimed a right to expand its range of products, as 'dalia' was an allied and cognate product of 'atta'.

The Delhi High Court agreed with the contentions of the Defendant, and relying upon the consent order, passed an interim order permitting the Defendant to sell 'dalia' bearing the mark in respect of packaging of 20 kgs and above only. However, the court also stated that such a consent order would not prejudice the exclusive right of the plaintiff to sell rice or any other product under the same mark.

## **COMPOSITE MARK WAS ONLY SUGGESTIVE – NOT DESCRIPTIVE**

***Umang Dairies Limited vs Registrar Of Trade Marks***

***Date of Judgment: 21/02/2023***

Umang Dairies Limited had filed a trademark application for a device mark for milk and milk products in Class 29. The subject mark was a composite device mark, comprising of two words 'WHITE' and 'MAGIK', along with graphic representation of milk being poured in a hot cup of tea/ coffee. The Senior Examiner had rejected the mark on the following grounds:

- Section 9(1)(b) of the Act for being descriptive;
- Sections 11(1)(a) and 11(1)(b) of the Act due to the existence of similar cited marks;
- No supporting documents on record claiming the use of the mark.

Umang Dairies appealed this decision before the Delhi High Court.

The Court determined that, although 'WHITE' may be associated with milk and milk products, the combination of 'WHITE' and 'MAGIK' (alternative spelling of 'MAGIC'), the resulting mark 'WHITE MAGIK' was suggestive, not descriptive, of the applied goods. Further, the Court found one cited mark to be abandoned, and other conflicting cited marks not to be similar to the subject mark except for the common word 'MAGIC'/ 'MAGIK' used in all of them. In addition, on perusal of the court record, the Court noted that an affidavit demonstrating use had been filed for the subject mark, which escaped the attention of the Senior Examiner, despite being on record on the date of hearing i.e., 24th April, 2019.

The Court set aside the order of the Examiner and ordered the Trademarks Registry to process the application for the subject mark and advertise it within 3 months, with a clarification that the subject mark will not grant any exclusive rights to the words 'WHITE' or 'DIARY CREAMER', either separately or individually.

## **TRADEMARK OFFICE MAY NOT DENY REGISTRATION WHEN THERE ARE OTHER VARIED REGISTRATIONS OF THE MARK**

*VR Asset Management Pte. Ltd. vs Examiner Of Trade Marks*

*Date of Judgment: 23/02/2023*

An order was passed by the Examiner of Trademarks, Delhi, rejecting a trademark application under Section 9(1)(b) of the Act, which stated that the mark VIRTUOUS RETAIL was devoid of distinctive character and there were no affidavit and supporting documents on record. This was appealed by the owner, as the company already owned a word mark registration in the same class.

The Court set aside the order, holding that it was not appropriate for the Trade Marks Office to refuse the registration of the mark/logo in the subject application when there were various registrations granted to the appellant in respect of the mark/logo and other formative marks in various classes.

## **TRADEMARK REGISTRY MUST CONSIDER PREVIOUS SETTLEMENT AGREEMENT BEFORE PASSING ORDERS**

*Surender Kumar vs Registrar Trade Marks*

***Date of Judgment: 17/02/2023***

An appeal under section 91 of the Trade Marks Act, 1999 was filed against an order refusing registration for the Appellant's mark "CANON". The senior examiner had objected to the registration under Sections 11(a) and (b) of the Trademarks Act, on the ground that the mark looked identical or similar to an earlier registered trademark.

The Court held that passing orders without considering a binding agreement of settlement with the proprietor of the earlier registered mark despite it being brought to notice was not sustainable. It directed the Trade Marks Registry to process the registration of application and set aside the impugned order.

## **REFERENCE TO A BRAND IN SOCIAL MEDIA AMOUNTS TO INFRINGEMENT**

***Dabur India Limited vs Dhruv Rathee and Ors.***

***Date of Judgment: 15/03/2023***

In a case filed by Dabur, the Calcutta High Court asked a social media influencer to remove reference to Real fruit juice products from his video. In the video, Dhruv Rathee, who claims to be a social media influencer, compared the health effects of consuming Real packaged fruit juice with consuming soft drinks and fresh juice and opined that packaged fruit juice has negative health effects. Aggrieved, Dabur went to Court, and the Court agreed with Dabur that the reference to its real brand was denigrating and disparaging and that the use of the brand and packaging amounts to trademark and copyright infringement. The Court, therefore, ordered the removal of the brand references from the video.

## **CONTACT DETAILS**

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