IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION NO. 1880 OF 2021

IN

COMMERCIAL IP SUIT NO. 240 OF 2021

Jyothy Labs Ltd. ...Applicant/Plaintiff

Versus

Dabur India Ltd. ...Defendant/Respondent

WITH

COMMERCIAL IP SUIT NO. 293 OF 2023

WITH

INTERIM APPLICATION NO. 909 OF 2024

WITH

INTERIM APPLICATION NO. 3077 OF 2025

Mr. Virag Tulzapurkar, Senior Advocate, a/w. Mr. H. W. Kane, Mr. Ashutosh Kane, Ms. Vedangi Soman and Ms. Avani Panchabhai i/b. W. S. Kane & Co. for Plaintiff.

Mr. Sharan Jagtiani, Senior Advocate, Mr. Rashmin Khandekar, Mr. Siddharth Joshi, Ms. Charu Shukla, Ms. Reeti Shetty, Mr. Vishal Narichania i/b. Ms. Charu Shukla for Defendant.

Mr. Akash Joshi a/w. Mr. Jerone Johnson for Defendant No.3.

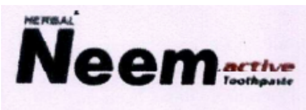
CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 7th MAY 2026

PRONOUNCED ON : 10th AUGUST 2026

P.C.

1. The captioned Commercial Suit has been filed for infringement and passing off in respect of the Plaintiff's registered trade marks all of which contain the word **'NEEM'** as their leading and essential feature, and for other consequential reliefs. The Plaintiff's registrations ("**Suit Marks**") on which the Suit is premised are set out below, viz.

TABLE A					
Sr. No.	Trade Mark	Reg. No.	Date of Reg.	Goods	Exhibit
1.		1283910	14.5.2004	Dentifrices	Ex. B2 @ Pg. 63 of the Plaint
2.		3163208	18.1.2016	Toothpaste; Dentifrices	Ex. B3 @ Pg. 65 of the Plaint
3.		3972013	12.10.2018	Dentifrices	Ex. B4 @ Pg. 66A of the Plaint

2. The Applicant, who is the Plaintiff in the captioned Suit, has, by way of the present Interim Application sought the following reliefs, viz.

> *"(a) An Order and injunction restraining the Defendant, its directors, partners, proprietors, servants, agents, distributors and stockists from infringing the Plaintiff's registered trade mark Nos. 1283910, 3163208, and 3972013, all in Class 3, by using the impugned trade mark/label, or any other mark deceptively similar thereto, in relation to toothpaste/dentifrices; and*
>
> *(b) An Order and injunction restraining the Defendant, its directors, partners, proprietors, servants, agents, distributors and stockists from passing off its goods as and for the goods of the Plaintiff by the use of the impugned trade mark/label, or any mark deceptively similar to the Plaintiff's registered trade marks."*

3. Before adverting to the rival contentions, it is useful to set out the following facts for context.

   i. The Plaintiff manufactures, markets and sells a wide range of household, personal care and fabric care products, including various well-known brands such as Ujala, Pril, Maxo, Margo and Henko, among others.

   ii. It is the Plaintiff's case that, in about the year 1920, the Plaintiff's predecessor, i.e., Calcutta Chemical Company Ltd, had adopted and has since used **'NEEM'** in relation to the manufacture and sale of toothpaste. In addition to the Suit Marks, set out in Table A, the

Plaintiff, including through its predecessor, had obtained registrations set out in Table B, below, viz.

TABLE B			
Sr. No	Trade Mark	Reg. No.	Date of Reg.
1.	CALCHEMICO'S NEEM TOOTH PASTE	142532	23.2.1950
2.		146242	24.11.1950

It is, however, not in dispute that the Plaintiff’s registration set out in Table "B", both of which disclaimed ‘**NEEM**’, had lapsed before the Suit was filed.

iii. It is the Plaintiff’s case that each of the Suit Marks has **‘NEEM’** as the leading and essential feature and that, on account of extensive, uninterrupted and continuous use, the aforesaid marks ‘**NEEM**’ have acquired a secondary meaning and are distinctive solely of the Plaintiff's.

iv. It is the Plaintiff's case that, in about the second week of August 2020, the Plaintiff came across the Defendant's application for registration of the following label mark viz. 

, ("**the impugned label mark**"), bearing Application No. 4513355 filed on 29th May 2020 on a proposed-to-be-used basis. The Plaintiff accordingly opposed the Defendant's application for registration of the impugned label, which is presently pending.

v. It is the Plaintiff's case that in the last week of December 2020, despite the fact that the application for registration of the impugned label mark was pending, the Defendant had commenced use of the impugned label mark. The Plaintiff has therefore filed the captioned Suit.

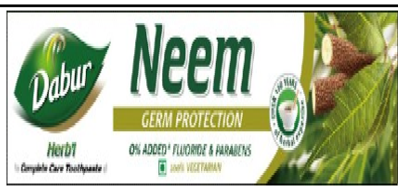
<u>Submissions on behalf of the Plaintiff:</u>

4. Mr. Tulzapurkar, Learned Senior Counsel appearing on behalf of the Plaintiff, at the outset submitted that the present Suit was premised only on the registrations set out in Table A above. He pointed out that each of

the Suit Marks is in Class 3 and related to toothpaste/dentifrices, and that in none of the Suit Marks had the Plaintiff disclaimed ‘**NEEM**’.

5. He submitted that the Plaintiff’s registrations, set out in Table “B”, both of which had disclaimed ‘**NEEM**’, were not the basis on which the present Suit was filed and had lapsed well before the present Suit was filed.

6. Mr. Tulzapurkar then invited my attention to both labels and pointed out that the Defendant had in the impugned label clearly adopted and used the ‘**NEEM**’ as the leading and essential feature of the impugned label thereby infringing the Plaintiff’s registered trade mark. Both the labels are for ease of reference reproduced in Table C below, viz.

TABLE C	
Plaintiff’s registered label mark	Defendant’s impugned label mark
	

Vaibhav

7. Mr. Tulzapurkar submitted that an action for infringement rests on three basic integers, namely (i) valid and subsisting trade mark registration; (ii) the offending trade mark/label must be identical with, or deceptively similar to, the Plaintiff's registered trade mark in question; and (iii) the goods bearing the infringing mark must be identical with, or similar to, the Plaintiff's goods covered by the registration in question.

8. In the present case, he submitted that the Plaintiff had clearly established all three requirements necessary to sustain an action for infringement. First, he pointed out that the Plaintiff was admittedly the registered proprietor of valid and subsisting trade mark registrations, as evidenced by the Legal Proceedings Certificates issued by the Trade Marks Registry and annexed at Exhibits B-1 to B-4 to the Plaint. Second, on a comparison of both labels, there could be no doubt that the Defendant had adopted the leading and essential feature of the Plaintiff's registered trade marks. Third, he pointed out that there was no dispute that the Defendant was using the impugned label for toothpaste, the very goods for which the Plaintiff's registered trade marks were used for. It was thus that he

submitted that the Plaintiff was entitled to an injunction restraining the Defendant from using the impugned label or any other mark deceptively similar to the Plaintiff's registered trade marks, in relation to toothpaste or allied goods.

9. Mr. Tulzapurkar then submitted that in order to establish passing off, the Plaintiff was required to show (i) goodwill, (ii) misrepresentation, and (iii) actual damage or a likelihood of damage. He submitted that there could be no doubt that the Plaintiff was the prior adopter of '**NEEM**' and had used it openly, continuously, and extensively since 1920 in relation to toothpaste/dentifrices. He submitted that the Chartered Accountant's Certificate showing the sales figures, along with sales invoices, stock transfer notes, and advertising bills placed on record, demonstrated the Plaintiff's substantial goodwill, commercial success, and long-standing market reputation.

10. He further submitted that, having regard to the deceptive similarity between the rival labels and the fact that both parties were using their respective labels in relation to identical goods, namely toothpaste, there

existed an inevitable likelihood of confusion and deception amongst consumers and members of the trade. He therefore submitted that the Defendant’s adoption and use of the impugned label mark clearly amounted to a misrepresentation which would lead consumers and members of the trade to believe that the Defendant’s goods were those of the Plaintiff or were associated with or originated from the Plaintiff. He submitted that such misrepresentation would cause damage to the Plaintiff’s goodwill and reputation, and hence, apart from establishing a case of infringement, the Plaintiff had also clearly made out a case of passing off.

11. Mr. Tulzapurkar then submitted that the documents filed with the Plaint and the Affidavit in Rejoinder amply established the Plaintiff’s long-standing use, extensive reputation, goodwill and substantial commercial presence in relation to its **‘NEEM’** toothpaste. He pointed to the sales turnover and advertising/promotional expenditure figures placed on record for the period 2002 to 2020, which showed aggregate sales of Rs. 162,34,95,496/- (Rupees One Hundred and Sixty-Two Crores

Thirty-Four Lakhs Ninety-Five Thousand Four Hundred and Ninety-Six) in respect of its **'NEEM'** toothpaste, together with advertisement and promotional expenditure aggregating Rs. 2,98,42,805/- on the advertisement and promotion of its **'NEEM'** toothpaste for the same period. He also placed reliance upon the domestic sales invoices dating back to 1994 and export invoices dating back to 1996, which he submitted evidenced continuous and extensive sales over several decades. He also placed reliance upon newspapers, magazines, and online articles, the earliest of which dated back to 1947, which described the Plaintiff's '**NEEM**' mark as a heritage and legacy mark.

12. Basis the above, he submitted that the Plaintiff had made out a strong case for both infringement and passing off and that the balance of convenience was in favour of the Plaintiff. He submitted that the Defendant's use of the impugned label was, as on the date of institution, recent, limited and commercially insignificant by comparison. Refusing an injunction, he submitted, would cause the Plaintiff irreparable loss and injury, and the injunction sought ought therefore to be granted.

13.In addition to the above, Mr. Tulzapurkar submitted that the Plaintiff would also be entitled to an injunction for the reasons elaborated in (**I**) to (**IV**) below.

I.The Defendant's dishonest, inconsistent and self-contradictory conduct

14.Mr. Tulzapurkar invited my attention to the Defendant's international label and compared it with the impugned label, both of which are reproduced below.

<table>
<tr><th colspan="2">TABLE D</th></tr>
<tr><td>Defendant's International Label</td><td>Impugned Label</td></tr>
<tr><td>
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</td></tr>
</table>

He pointed out that, on the Defendant's international packaging, '**NEEM**' appeared inconspicuously, in small font at the bottom right, purely as a descriptor of an ingredient used by the Defendant in the toothpaste, while the mark "Dabur Herb'l" received far greater prominence. In contrast, he pointed out that, in the impugned label, '**NEEM**' was placed centrally in large, bold, uppercase letters and was clearly the leading, essential and most memorable feature of the impugned label. He therefore submitted that the Defendant had in the impugned label used **‘NEEM’** as a trade mark and source identifier and not merely a descriptor of the ingredients of the product.

15. He then submitted that, had the Defendant genuinely intended to use ‘**NEEM**’ descriptively, there was no reason for the Defendant to have departed from its existing international packaging and to have made ‘**NEEM**’ the most prominent and leading feature of its domestic packaging. He submitted that the only explanation offered by the Defendant in the Affidavit in Reply was that the Defendant had done so “*in order to easily distinguish between the local and international packaging while also conforming to the requirements of the Indian market/consumer.*” This explanation he submitted amounted to an admission that the Defendant had used **‘NEEM’** as a product identifier and, hence, as a trade mark. He submitted that in any event the explanation was unconvincing and lacked any credible justification. In

the absence of any plausible explanation for this departure, particularly since the Defendant continued to use its original packaging in other markets, he submitted that an adverse inference be drawn against the Defendant.

II. The Defendant had sought registration of the impugned label/packaging, in which 'NEEM' is the leading, essential, prominent and memorable feature

16. Mr. Tulzapurkar submitted that since the Defendant had, itself sought registration of the impugned label (Application No. 4513355 in Class 3), which had '**NEEM**' as its leading and essential feature, it was not open to the Defendant to contend that '**NEEM**' was generic, descriptive, or merely an ingredient name incapable of monopolisation. He pointed out that the Defendant had the option, under Entry No. 7 of Form TM-A, to disclaim '**NEEM**' but had consciously chosen not to do so. This, he submitted, was wholly inconsistent with the stand taken by the Defendant in the present case, i.e., that '**NEEM**' was generic or descriptive.

17. He further submitted that any attempt by the Defendant to now disclaim '**NEEM**' was a clear afterthought and would not in any manner detract from the conscious stand taken by the Defendant in the Defendant's Trade Application. Learned Senior Counsel, therefore, submitted that the Defendant, having treated '**NEEM**' as a trade mark, could not now claim that '**NEEM**' was generic. In support of his contention, he placed reliance upon the decision of this Court in ***Hem Corporation Pvt. Ltd. v. ITC Limited***[1] and ***Venetianaire Corporation of America v. A & P Import.***[2]

III. The Defendant had sought exclusivity over "BABOOL" and "MESWAK" in relation to toothpaste, notwithstanding that these were also names of trees traditionally used in oral hygiene

18. Mr. Tulzapurkar then submitted that the Defendant had conveniently suppressed the fact that the Defendant had itself consistently used and enforced the Defendant's proprietary rights in "**MESWAK**" and

[1] 2012 (52) PTC 600.
[2] 302 F. Supp. 156 (S.D.N.Y. 1969).

“**BABOOL**”, which, like ‘**NEEM**’, were also names of Indian trees traditionally associated with oral hygiene.

19. He pointed out that the Defendant had successfully restrained “Bajaj Herbal” from using “TAJ MESWAK” and that the defence taken by Bajaj Herbal to justify its use of ‘TAJ MESWAK’ was virtually identical to the defence taken by the Defendant in the present proceedings. Similarly, he pointed out that the Defendant had also successfully opposed the registration of “ARYAN BABOOL” for toothpaste notwithstanding the fact that Aryan Naturals Pvt. Ltd. had expressly disclaimed “BABOOL” and had also prominently displayed its house mark “ARYAN” alongside “BABOOL”.

20. He, therefore, submitted that the Defendant had taken an inconsistent stand when dealing with “MESWAK” and “BABOOL”, treating them as being distinctive and protectable trade marks when asserting its own rights. However, the Defendant had taken a diametrically opposite stand in the present proceedings by contending that ‘**NEEM**’ was generic and incapable of functioning as a trade mark. He submitted that there was no

rational basis for such a distinction and that the same legal principles which the Defendant had invoked to protect "MESWAK" and "BABOOL" also applied equally to '**NEEM**'.

21. Mr. Tulzapurkar then submitted that the proprietor of a composite or label mark is not precluded from maintaining an action for infringement merely because a particular feature is not independently registered. He submitted that Section 17 must be construed harmoniously with the essential-feature doctrine rather than literally. He submitted that Section 17 must not be construed in a manner that would defeat the protection of a mark's distinguishing or essential feature merely because that feature was not the subject of a separate, independent registration.

22. He placed reliance upon the decision of the Division Bench in ***Reckitt & Colman of India Ltd. v. Wockhardt Ltd.***[3] in support of his contention that deceptive similarity must be assessed not merely by comparing marks as a whole but also by identifying the distinguishing or essential features of the mark in question so as to assess whether such feature was incorporated in the offending mark. He submitted that this well-settled

[3] Order passed by the Bombay High Court on 8th July 1992 in Appeal No. 1180 of 1991 in NM No. 2141 of 1991 in Suit No. 2970 of 1991.

principle was traceable to the English decision in ***Saville Perfumery Ltd. v. June Perfect Ltd.***[4], in which he pointed out that a sword device was protected notwithstanding the fact that it formed only one element of a larger composite label, since it was the sword device, and not the label as a whole, by which the goods were identified and asked for in the market.

23. Mr. Tulzapurkar also placed reliance upon the decision of this Court in ***Jagdish Gopal Kamath & Ors. v. Lime & Chilli Hospitality Services***[5] to submit that the said decision reaffirmed the settled principle that the proprietor of a registered composite mark was entitled to restrain the use of its leading, essential or memorable feature, notwithstanding that such feature was not separately registered. He submitted it was on this basis that this Court had granted protection to the mark "Café Madras".

24. He then also placed reliance upon the decisions in ***Ruston & Hornsby Ltd. v. The Zamindara Engineering Co.,***[6] ***Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.***[7]***, South Indian Beverages Pvt. Ltd. v. General Mills Marketing Inc.***[8], and ***James Chadwick & Bros.***

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[4] [1941] UKHL J0402-1.
[5] 2015 62 PTC 23.
[6] AIR 1970 SC 1469.
[7] MIPR 2014 (1) 0109.
[8] 2015 (61) PTC 231.

Ltd. v. The National Sewing Thread Co.[9]***,*** in support of the contention that the proprietor of a registered composite or label mark was entitled to protection against the appropriation of its essential or distinguishing features, whether such features were separately registered or not.

25. Mr. Tulzapurkar also then pointed out that this Court had in ***Brihan Karan Sugar Syndicate Pvt. Ltd. v. Lokranjan Breweries Pvt. Ltd.***[10], likened the leading feature of a composite mark to a synecdoche and had specifically held that the anti-dissection rule does not license an "*open hunting season*" on such a feature merely because it is not registered independently. He submitted that this principle was reiterated in the case of ***Ultra Tech Cement Ltd. v. Alaknanda Cement Pvt. Ltd.***[11] and affirmed by the Division Bench in ***Alaknanda Cement Pvt. Ltd. v. Ultra Tech Cement Ltd***[12]***.***

26. Mr. Tulzapurkar reiterated that none of the three registrations on which the present Suit was premised carried any disclaimer of '**NEEM**'. He submitted that where the Registrar intended to disclaim a specific word or

[9] AIR (38) 1951 Bom 147.
[10] MIPR 2014 (3) 0107.
[11] 2011 (5) Bom CR 588.
[12] 2011 SCC OnLine Bom 1487 (Division Bench).

numeral, such disclaimer was expressly recorded. He therefore submitted that the general disclaimer, i.e., "*other descriptive matter*" which was to be found on Registration No. 3163208, could not be extended to cover '**NEEM**', which had not been disclaimed by the Plaintiff. In support of his contention, he placed reliance upon the decisions in the case of ***Sab Miller India Ltd. v. Jagpin Breweries Ltd.***[13]***, Skol Breweries Ltd. v. Som Distilleries***[14], and ***Shaw Wallace & Co. Ltd. v. Mohan Rocky Spring Water Breweries***[15].

27. Mr. Tulzapurkar, then, in the alternative, submitted that even where a mark is subject to a disclaimer, the rival marks must still be compared as a whole, including the disclaimed matter. He submitted that disclaimers do not travel into the marketplace and are unknown to consumers. In support of his contention, he placed reliance upon the decision in ***Pidilite Industries Ltd. v. Riya Chemy***[16] and ***Serum Institute of India Ltd. v. Green Signal Bio Pharma Pvt. Ltd***[17]**.** He also submitted that as held in

[13] Order passed by the Bombay High Court on 6th February, 2014 in NM No. 92 of 2012.
[14] 2012 (49) PTC 231.
[15] MIPR 2007 (2) 0185.
[16] 2022 SCC Online Bom 5077.
[17] Order passed by the Bombay High Court on 14th June 2011 in NM No. 2696 of 2010 in Suit No. 2564 of 2010.

the case of ***Shaw Wallace & Co. Ltd. v. Castle Douglas Industries Ltd***[18] a disclaimer in respect of one registration does not automatically extend to other registrations of the same or a similar mark, and that in any event a disclaimer has no bearing on a passing-off action, since a disclaimer restricts only statutory rights and not common law rights.

28. Basis the above, Mr. Tulzapurkar submitted that the Plaintiff had clearly made out a case for the grant of interim relief in respect of both infringement and passing off. He, however, clarified that the Plaintiff was not seeking to restrain the Defendant from using '**NEEM**' *per se* but only to restrain the manner in which the Defendant had used '**NEEM**' on the impugned label, i.e., its leading and essential feature.

<u>Submissions on behalf of the Defendant:</u>

29. Mr. Jagtiani, Learned Senior Counsel appearing on behalf of the Defendant, at the outset submitted that the Plaintiff's case had progressively shifted. He submitted that the Plaintiff had in the Plaint pleaded that **'NEEM'** had acquired secondary meaning, whereas in the Rejoinder, pleaded that '**NEEM**' was inherently distinctive. He submitted

[18] Order passed by the Bombay High Court on 5th April 2006 in Notice of Motion No. 1259 of 1994.

that, on a proper application of the Trade Marks Act, 1999, and the law laid down by this Court and the Hon'ble Supreme Court, the Plaintiff had failed to establish either infringement or passing off. In support of his contentions, he made the following submissions set out in **(I)** to **(VII)** below.

I. No statutory monopoly over the word 'NEEM' per se

30. Mr. Jagtiani submitted that none of the Plaintiff's three registrations were for **'NEEM'** *per se* and that the Plaintiff had never applied for or obtained registration for only **'NEEM'** on a standalone basis. Relying on Section 17 of the Trade Marks Act, 1999, he submitted that registration conferred exclusivity only in respect of the mark as a whole and not of any individual features unless such part or feature was separately registered. He therefore submitted that Section 17 would not afford any protection to any matter forming part of a registered mark that was common to the trade or was otherwise non-distinctive.

31. He then placed reliance upon the decision in the case **of *Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd*[19].,** in support of his

[19] AIR 1955 SC 558.

contention that the object of a disclaimer is to prevent a proprietor from claiming an unwarranted monopoly over matter that was not entitled to exclusive protection. From the decision in ***Freudenberg Gala Household Products v. Gebi Products***[20] he pointed out that the proprietor of a label mark in that case was denied exclusivity over the use of "LAXMI" because the registration was of a composite label/device mark in which "LAXMI" appeared in a distinctive, stylised, vertical font and form. He submitted that the Court held that, where the registration was of a label or device mark incorporating the name of a Goddess, it was impermissible to dissect the mark by extracting the name and claiming exclusivity over it independent of the mark as a whole. He further placed reliance upon the decisions in ***Vasundhara Jewellers v. Kirat Vinodbhai Jadvani & Anr.,***[21] ***Haveli Restaurant and Resorts Ltd. v. Registrar of Trade Marks & Anr.,***[22] ***Ganesh Gouri Industries v. R.C. Plasto Tanks & Pipes (P) Ltd.,***[23] and ***Parakh Vanijya Pvt. Ltd. v. Baroma Agro Product & Ors.,***[24] in

[20] Order passed by the Bombay High Court on 1st August 2017 in NM No. 1530 of 2015 in Suit No. 758 of 2015.
[21] 2022 SCC OnLine Del 2996.
[22] 2025 SCC OnLine Del 8616.
[23] (2024) 5 HCC (Del) 425.
[24] (2018) 16 SCC 632.

support of his contention that it was not open to a party to isolate a word or any single element forming part of a composite or label mark and to assert an independent monopoly or exclusivity over such word or element. This he submitted was more so where such a word or element was incapable of separate registration or was otherwise common to the trade.

32. He then submitted that the Plaintiff's reliance on the decision in the case of ***Jagdish Gopal Kamath & Ors. v. Lime & Chilli Hospitality Services*** was misplaced, since in that case the Court granted protection of the composite mark "Café Madras" on a finding that "Café" and "Madras", used together, were not descriptive and that exclusivity was claimed only in respect of the composite expression and not in respect of either of the constituent words, i.e., "Café" or “Madras”. In the facts of the present case, he pointed out that **‘NEEM’**, viewed independently, was generic or, at the very least, descriptive and common to the trade and thus incapable of any protection.

33.He then submitted that at least two of the Plaintiff's registrations carried express disclaimers, which would disentitle the Plaintiff from claiming any monopoly over **'NEEM'**. He pointed out that Registration No. 142532 expressly disclaimed **'NEEM'**, while Registration No. 3163208 was restricted by the condition of "*no exclusive right over the other descriptive word*". He submitted that this could only apply to **'NEEM'**, as there was no other descriptive word in that mark. Relying on Sections 28(2) and 30(1)(b) of the Trade Marks Act, he submitted that the exclusive rights conferred by registration were always subject to the Registrar's conditions and limitations, and hence the Plaintiff could not claim any exclusivity or a monopoly over **'NEEM'**.

II. NEEM is generic or, in the alternative, merely descriptive

34.Mr. Jagtiani submitted that neem is the common dictionary and popular name for the Margosa tree (Azadirachta Indica), which is well known for its use in dental care owing to its astringent, antiseptic and antibacterial properties. He submitted that neem had been used for oral hygiene since ancient times, well before the invention of toothpaste.

35. He then submitted that "NEEM toothpaste" itself denoted a distinct category of products, just like "decaf coffee", "electric vehicles", "malt whisky" or "herbal tea". He submitted that these categories were each identified by such expressions rather than by their respective commercial sources. He therefore submitted that neem was generic since it identified the nature or category of the product rather than the product's trade origin. Without prejudice, he submitted that even if the relevant genus were regarded simply as toothpaste, **'NEEM'** was, at a minimum, purely descriptive, since it only conveyed that the product contains neem.

36. Mr. Jagtiani invited my attention to ***McCarthy on Trade marks and Unfair Competition***, and pointed out that marks were classified along the spectrum of distinctiveness into four broad categories, namely, arbitrary or fanciful, suggestive, descriptive, and generic. He submitted that descriptive marks were protectable only upon proof of acquired distinctiveness or secondary meaning, whereas generic terms were incapable of trade mark protection. Referring to the "degree of imagination" test discussed in ***McCarthy,*** he submitted that the greater

the imagination required to associate the mark with the goods or services, the more likely the mark is suggestive rather than descriptive. According to him, a descriptive mark immediately conveys information regarding the qualities, characteristics, ingredients, purpose, or use of the goods, whereas a suggestive mark merely hints at or suggests such characteristics and requires an exercise of imagination on the part of the consumer to perceive the connection.

37. He then invited my attention to Section 9 of the Trade Marks Act, to point out that it prohibits the registration of marks that are devoid of any distinctive character, i.e., marks incapable of distinguishing the goods or services of one person from those of another. He submitted that Section 9 also barred the registration of marks consisting exclusively of indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or rendering of the services, or other characteristics of the goods or services.

38. Placing reliance upon the decision of the Delhi High Court in ***Yatra Online Limited v. Mach Conferences and Events Limited***,[25] Mr. Jagtiani

[25] 2025 SCC OnLine Del 5610.

pointed out that the Court had refused to grant an injunction restraining use of the marks “BOOKMYYATRA” and “BOOKMYYATRA.COM” at the instance of the proprietor of the registered marks “YATRA.COM” and “YATRA” (device). He pointed out that the Court held that the word “YATRA”, being synonymous with “travel” in Hindi, was generic and commonly descriptive of travel and tourism services. He also drew my attention to the observation that a person who adopts words that are in common use as a trade mark necessarily runs the risk of others also doing so. Drawing a parallel to the facts of the present case, he submitted that, just as “YATRA” was held to be descriptive of travel services, the word **‘NEEM’** was also descriptive of toothpaste containing neem.

39. Mr. Jagtiani submitted that the Plaintiff's case wrongly assumed that every prominent component of a composite mark independently enjoys trade mark protection. He submitted that the threshold question was whether **‘NEEM’** was generic, descriptive, or inherently distinctive in relation to toothpaste. He submitted that only if **‘NEEM’** were to be descriptive would the question of secondary meaning arise, and therefore,

unless the Plaintiff discharged this threshold burden, the Plaintiff could claim no exclusivity over **'NEEM'**.

III. NEEM is common to the trade, i.e., publici juris.

40. Mr. Jagtiani submitted that, independent of its descriptive character, neem was incapable of monopoly because it had become common to the trade. He pointed out that Section 9(1)(c) of the Trade Marks Act bars registration of marks that consist exclusively of indications that have become customary in the current language or in the bona fide and established practices of the trade.

41. He then invited my attention to the material annexed to the Affidavit in Reply and the Sur-Rejoinder, i.e., third-party toothpaste brands prominently using neem (Exhibit U to the Reply); Nielsen Report showing twenty-two neem toothpaste brands (Exhibit B to the Sur-Rejoinder); tabulated manufacturer details with advertising material and e-commerce listings (Exhibits C-1, E-1 and accompanying exhibits); Google and e-commerce search results for "neem toothpaste" (Exhibits D-1 and D-2); research material describing neem toothpaste as a generic

product category (Exhibit F); and examples from personal care, home care and other sectors using neem purely as an ingredient descriptor (Exhibits G, H and I). He submitted that all of this material cumulatively established that neem is in widespread and common use across the trade and is not confined to toothpaste but spans personal care, healthcare and home care. He thus submitted that the Plaintiff could not claim any exclusivity or monopoly over neem.

IV. The Plaintiff has failed to establish that NEEM has acquired secondary meaning

42. Mr. Jagtiani submitted that, even accepting the Plaintiff's pleaded case of acquired distinctiveness at its highest, the material relied upon by the Plaintiff fell far short of satisfying the requisite legal standard. In support of his contention, he placed reliance upon the decision of this Court in ***People Interactive v. Vivek Pahwa,***[26] to point out which held that an expression acquires secondary meaning only when its original and primary meaning has been displaced to such an extent that the expression no longer conveys its ordinary meaning but, in the minds of the relevant

[26] 2016 SCC OnLine Bom 7351.

public, refers exclusively to the claimant as the source of the goods or services. He submitted that, in other words, the mark in question must come to identify only the Plaintiff rather than merely describe or identify the goods or services.

43. He then also submitted that the Court held that the commercial success, however substantial, is by itself insufficient to establish secondary meaning, as there is no legal presumption that such secondary meaning has been acquired. What was required to establish acquired distinctiveness was cogent evidence demonstrating uninterrupted and long-standing use of the mark in question over a considerable period. This he submitted must be coupled with the fact that no competitor had attempted to use the same or a similar mark or expression during that period, thereby establishing that the mark in question had come to be associated with the Plaintiff alone.

44. He also placed reliance upon the decision in ***Aegon Life Insurance Company Ltd. v. Aviva Life Insurance Company India Ltd.***,[27] to point out that this Court had rejected the contention that "iTerm" used in

[27] 2020 SCC OnLine Bom 3837.

relation to insurance policies had acquired secondary meaning despite the plaintiff in that case showing significant sales and advertising expenditure had been incurred in respect of 'iTerm'. He pointed out that the Court held that high sales and promotional expenditure alone do not suffice to establish that the mark has lost its primary, descriptive meaning and had acquired secondary significance. He submitted that what was required to be established was a market survey or comparable proof of consumer perception. Where only a component of a descriptive mark was said to have acquired secondary meaning, there must be specific evidence that the component is used independently or that consumers recognise such a component alone as denoting the proprietor of that mark.

45. He submitted that the Plaintiff's invoices, promotional expenditure, newspaper articles and twenty years of sales figures established nothing beyond commercial success and did not show that consumers associated **'NEEM'** exclusively with the Plaintiff. He submitted that the Plaintiff had therefore failed to discharge its burden of establishing that **'NEEM'**

was distinctive of the Plaintiff's goods and had acquired a secondary meaning that was exclusively associated with the Plaintiff.

V. The Plaintiff is disentitled to relief by reason of suppression of material facts and prosecution history estoppel

46. Mr. Jagtiani then submitted that the Plaintiff had amended the Plaint to introduce Registration No. 3972013 (granted 20th December 2021 on an application dated 12th October 2018) while suppressing the fact that the Plaintiff's predecessor had earlier owned an identical label mark, Registration No. 146242, dating to 1950, which remained on the Register until 2013 and was subject to a disclaimer in respect of **'NEEM'**.

47. He then relied on the hearing notes dated 6th March 1953 and the Deputy Registrar's order dated 10th June 1953, which he pointed out had recorded that registration was permitted subject to the disclaimer in respect of **'NEEM'**. He pointed out that during those proceedings the Plaintiff's predecessor had agreed to change the designation of goods in the application to read as "Neem (Margosa) Toothpaste", thereby acknowledging that neem toothpaste formed a distinct category of

toothpaste/goods. He submitted that since the Plaintiff had filed Form TM-P recording the transmission of proprietorship in respect of Registration No. 146242, the Plaintiff was fully aware of that registration's history, including the disclaimer and the representations made to the Registry. Despite this, the Plaintiff had chosen not to disclose these facts while relying on Registration No. 3972013, which clearly amounted to suppression of material facts and would also thus disentitle the Plaintiff from claiming any exclusivity over **'NEEM'** as also to any interim relief.

48. He submitted that the Plaintiff had similarly suppressed the fact that the Examination Report dated 10th November 2016 in respect of Registration No. 3163208 raised an objection under Section 9(1)(b) on the ground that the mark consisted exclusively of words or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin, or time of production of the goods or rendering of the service, or other characteristics of the goods or services. He pointed out that the Plaintiff had responded to the Examination Report by way of

a letter dated 16th June 2017, in which the Plaintiff represented that its mark was a device/label mark, with the words "HERBAL NEEM" appearing in a distinctive composite format, and **'NEEM'** depicted in a thick green font beneath the word "HERBAL". He submitted that, when considered as a whole, the impugned label did not, in any manner, designate the kind, quality or other characteristics of the goods or services. He submitted that the Plaintiff had accepted before the Registry that '**NEEM**' alone was descriptive and incapable of exclusive protection and that, despite this, the Plaintiff was now seeking to contend otherwise.

49. Mr. Jagtiani then submitted that the Plaintiff, having represented before the Trade Marks Registry that the Plaintiff's registered Trade Marks were to be considered and protected only as composite labels taken as a whole, and not by reference to the word **'NEEM'** independently, could not now be permitted to adopt a contrary stand. In support of this contention, he placed reliance upon the decisions in ***Laser Shaving (India) Pvt. Ltd. v. RKRK International Products Pvt. Ltd.***,[28] ***PhonePe Private Limited v. Resilient Innovations Private Limited***,[29] ***Liberty Oil Mills Ltd. v. BRS***

[28] (2025) 1 HCC Bom 230.
[29] 2023 SCC OnLine Bom 764.

Refineries,[30] and ***Shantappa v. Anna***,[31] which he pointed out recognised the principle that a party cannot secure registration or obtain a benefit before the Trade Marks Registry on the basis of one representation and thereafter, while seeking equitable relief in infringement proceedings, assert a position that is inconsistent with the stand earlier taken before the Registry.

VI. The Defendant is entitled to the statutory defences under Sections 30(2)(a) and 35

50. Mr. Jagtiani submitted that, even assuming the Plaintiff's registrations were valid, the Defendant's use of **'NEEM'** was protected under Section 30(2)(a) and Section 35. He submitted that the word **'NEEM'** merely identified a well-known natural ingredient used in toothpaste for its antiseptic and antibacterial properties, which he pointed out was acknowledged by the Plaintiff in paragraph 7 of the Plaint. He submitted that the Defendant's use of **'NEEM'** was, therefore, purely descriptive

[30] 2016 SCC OnLine Bom 10470.

[31] Order passed by the Bombay High Court on 30th November 2023 in Appeal from Order No. 915 of 2023.

and served only to indicate the nature and characteristics of its toothpaste, in accordance with honest commercial practices.

51. In support of the aforesaid contention, he placed reliance upon the decision of the Delhi High Court in ***Marico Limited v. Agro Tech Foods Limited***[32] to point out that the use of a descriptive word, whether as part of a sentence or alongside an independent trade mark, cannot be restrained merely because the proprietor of such mark characterises that word as a trade mark. He submitted that where the use of such a mark is genuinely descriptive and falls within the protection afforded by Section 30(2)(a) of the Trade Marks Act, any proprietor who adopts such a descriptive word mark does so at the risk of others also doing so. He therefore submitted that the Plaintiff was, in effect, seeking to expand the scope of the Plaintiff's registrations to assert a monopoly over a descriptive element which was, contrary to the scheme and object of the Trade Marks Act.

[32] Order passed by the Bombay High Court on 9th December 2025 in IA (L) No. 28667 of 2025 in Commercial IP Suit (L) No. 28094 of 2025.

VII. No likelihood of confusion when the rival marks and trade dress are compared as a whole

52.Mr. Jagtiani submitted that rival trade marks and trade dress must be compared as a whole and not by dissecting them into their individual components. When viewed as a whole, he submitted that there was no likelihood of confusion between the rival marks since the impugned packaging prominently featured the Defendant’s well-known “DABUR” house mark, the distinctive device mark, and the internationally recognised “Herb’l” branding, which led consumers to identify the product as “Dabur Herb’l Neem Toothpaste” and not merely by reference to the word **‘NEEM’**. He submitted that this was borne out even by the purchase invoice annexed at Exhibit L to the Plaint, which described the product by its full name, namely, “Dabur Herb’l Neem Toothpaste”. In contrast, he pointed out that the Plaintiff’s “Neem Active Toothpaste” packaging did not prominently display any comparable house mark or other independent source identifier. According to him, this itself demonstrated that the Defendant’s use of the word **‘NEEM’** formed only one element of an overall trade dress that unmistakably identified the product as originating from the Defendant.

53. He then placed reliance upon the decision in ***Kellogg Company v. Pravin Kumar Bhadhabal***,[33] to point out that the Delhi High Court had refused an injunction against AIMS ARISTO Corn Flakes, holding that rival cartons must be viewed as a whole and that a prominent, distinct house mark was sufficient to dispel confusion notwithstanding there being other similarities. He submitted that the Plaintiff's packaging displayed **'NEEM'** in dark green, "ACTIVE" in bright red, and "TOOTHPASTE" in green italics, with a green leaf motif, whereas the Defendant's packaging displayed **'NEEM'** centrally alongside "GERM PROTECTION", depicted a brown neem twig wrapped in a leaf, and prominently featured the DABUR house mark and Herb'l branding. He submitted that the green colour scheme is common to numerous neem-based products and cannot be monopolised and that, viewed as a whole, the rival marks and packaging were plainly distinguishable and incapable of causing confusion or deception.

[33] 1996 SCC OnLine Del 170.

54. On this basis, he submitted that the Plaintiff had neither made out a prima facie case for infringement nor for passing off, and that the Interim Application was therefore liable to be dismissed.

<u>Submissions in Rejoinder:</u>

55. Mr. Tulzapurkar, first in dealing with the allegation of suppression, submitted that the Plaintiff had, in the Plaint itself, disclosed the existence of the lapsed registrations and had expressly sought leave to rely upon them. He therefore submitted that there had been no suppression by the Plaintiff.

56. He then placed reliance upon the decision in the case of ***Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.*** to point out that disclosure in the Plaint, coupled with an express reservation of the right to refer to a registration or document at a later stage, does not amount to suppression. He also submitted that the previous registrations were all public documents, and hence the question of suppression did not arise.

57. Learned Senior Counsel, in addition to the above, submitted that suppression of facts would disentitle a Plaintiff to interim relief only where the suppression was in respect of material facts of such significance that their suppression would render the Court's decision unjust or impede a fair and proper adjudication of the dispute, which he submitted was not so in the facts of the present case. In support of this contention, he placed reliance upon the decisions in ***Sab Miller India Ltd. v. Jagpin Breweries Ltd.***, ***State of NCT of Delhi v. BSK Realtors LLP & Anr.***[34], and ***S.J.S. Business Enterprises (P) Ltd. v. State of Bihar***[35]. He also submitted that a restriction which does not form part of the registration certificate itself, such as the Registrar's handwritten hearing notes, cannot be imported into or read as a condition of the registration, as held in the case of ***Sapat International Pvt. Ltd. v. Victoria International Pvt. Ltd.***[36]

58. Mr. Tulzapurkar submitted that the Defendant's reliance upon the hearing notes recorded by the Registrar of Trade Marks in 1953 to contend that

[34] 2024 SCC OnLine SC 1092.
[35] 2004 (7) SCC 166.
[36] 2016 (65) PTC 499 [Bom].

the Plaintiff's predecessor had conceded that **'NEEM'** denoted a category of toothpaste, was misconceived. He submitted that the contemporaneous record disclosed neither any final order of the Registrar nor any concession by the Plaintiff's predecessor to that effect. He submitted that, in any event, over six decades of continuous and extensive use had independently conferred distinctiveness upon the Plaintiff's mark. Learned Senior Counsel further submitted that the anti-dissection principle and the doctrine protecting the dominant or essential features of a trade mark were complementary and not contradictory. In support of this contention, he placed reliance upon the decision in ***South Indian Beverages Pvt. Ltd. v. General Mills Marketing Inc***.

59. In dealing with the Defendant's contention that '**NEEM**' was generic or alternatively descriptive, Mr. Tulzapurkar reiterated that the Defendant was estopped from so contending since the Defendant had applied for registration of a label mark in which '**NEEM**' constituted the leading and essential feature, without any disclaimer. In support of his contention, he placed reliance upon the decisions in ***Pidilite Industries Ltd. v.***

Innovation Coatings Pvt. Ltd*[37]*., and ***Pidilite Industries Ltd. v. Riya Chemy***, ***Sky Enterprise Pvt. Ltd. v. Abaad Masala & Co.*[38]** to point out that a party who seeks registration of a mark without disclaiming any of its constituent elements cannot subsequently be heard to contend that such elements are non-distinctive, generic, or descriptive.

60. He submitted that the Defendant therefore could not be permitted to approbate and reprobate by, on the one hand, asserting proprietary rights over the word **'NEEM'** and, on the other, denying that the very same word was capable of functioning as a trade mark and source identifier when relied upon by the Plaintiff. He placed reliance upon the decision in ***Jagdish Gopal Kamath v. Lime & Chilli Hospitality Services***, which, he pointed out, followed a series of earlier decisions, all of which held that a party who seeks registration of a mark or of a particular word or feature as part of its trade mark cannot thereafter be heard to contend that the very same word or feature is generic, non-distinctive, or otherwise incapable of being the subject of exclusive proprietary rights.

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[37] (2025) 1 HCC (Bom) 390.
[38] Order passed by the Bombay High Court dated 8th January 2020 in IA No. 1 of 2019.

61. Mr. Tulzapurkar submitted that neem was, at the highest, suggestive rather than descriptive of toothpaste. He submitted that the material relied upon by the Defendant, in the Affidavit in Reply, itself demonstrated that neem was suggestive and not descriptive since it was used in relation to a wide range of products, including hair oil, soap, body mist, face wash, pet perfume, powders, tablets, fertilisers, detergents and anti-ageing creams. He submitted that, the sheer diversity of products associated with neem itself, made clear that neem did not directly describe toothpaste or its characteristics but would require an imaginative leap before a consumer could associate neem specifically with toothpaste. He therefore submitted that neem was only suggestive of toothpaste and not descriptive.

62. He then placed reliance upon the decisions in ***Hygienic Research Institute Pvt. Ltd. v. Chandan and Shah Trading LLP***[39], ***Bata India Ltd. v. Chawla Boot House***[40], and ***Bawaskar Technology (Agro) Pvt. Ltd. v. Anannya Agro Products & Ors.***[41], as well as the principles enunciated in ***McCarthy on Trade marks and Unfair Competition***, to submit that the

[39] 2025 1 HCC Bom 25.
[40] 2019 SCC OnLine Del 8147.
[41] Order passed by the Bombay High Court on 16th March 2026 in Commercial Appeal From Order No.28 of 2025 in Commercial Suit No. 9 of 2025 with Interim Application No.12806 of 2025.

distinction between descriptive and suggestive marks depends upon whether the mark immediately conveys information about the nature or characteristics of the goods or whether an 'imaginative leap' by the consumer to make that connection is required. He submitted that where a mark requires an 'imaginative leap', it falls on the suggestive, rather than the descriptive, end of the spectrum of distinctiveness, and therefore such a mark is inherently distinctive and registrable without proof of acquired distinctiveness or secondary meaning.

63. Mr. Tulzapurkar then, without prejudice to the above, submitted that even if **'NEEM'** were held to be descriptive, the Plaintiff would still be entitled to protection under the proviso to Section 9(1) of the Trade Marks Act by virtue of decades of open, continuous, and extensive use, with sales exceeding Rs. 162,34,95,496/- and advertising expenditure exceeding Rs. 2,98,42,805/- for the period 2002 to 2020, together with press coverage dating back to 1947. All of this he submitted established that **'NEEM'** had acquired a secondary meaning identifying the Plaintiff exclusively as the source of the goods.

64. He then pointed out that registration itself was *prima facie* evidence of the fact that the requirements of Sections 9 and 11 had been duly satisfied, and any challenge to registration was a matter for rectification proceedings, not a defence against infringement. In support of his contention, he placed reliance upon the decision in the case of ***Godfrey Phillips India Ltd. v. Girnar Food & Beverages (P) Ltd.***[42], ***Mangalam Organics Ltd. v. N. Ranga Rao & Sons Pvt. Ltd.***[43]***, Ashok Leyland Ltd. v. Blue Hill Logistics Pvt. Ltd***[44]***.***, and ***Sapat International Pvt. Ltd. v. Girnar Foods & Beverages Pvt. Ltd***[45]***.***

65. On the aspect of inherent distinctiveness, Mr. Tulzapurkar submitted that distinctiveness must be assessed with reference to the ordinary meaning of the mark/word in question and that such inquiry is necessarily narrow and fact-specific. In support of this contention, he placed reliance upon the decisions in ***J.L. Mehta v. Registrar of Trade Marks***[46]***, Central Camera Co. v. Registrar of Trade Marks***[47], ***Registrar of Trade Marks v.***

[42] (2004) 5 SCC 257
[43] 2025 SCC OnLine Bom 3017.
[44] 2010 SCC OnLine Mad 6126.
[45] 2016 (65) PTC 23.
[46] 1961 SCC OnLine Bom 69.
[47] Vol. 5 No. 1 (1980) IPLR 1.

Manu Subedar[48]**, and** ***Lupin Ltd. v. Johnson & Johnson***[49]. He then, without prejudice to this contention, submitted that the Plaintiff had, in any event, established secondary meaning at the interlocutory stage by placing on record substantial evidence of long-standing and extensive use, including sales and advertising figures, invoices dating back to 1994, and press material dating to 1947. According to him, this material sufficiently demonstrated the Plaintiff's goodwill, reputation, and continuous use of its NEEM toothpaste since 1920.

66. Mr. Tulzapurkar submitted that it was well settled that the mere existence of third-party marks on the Register does not *ipso facto* establish any extensive trade use. He submitted that the burden of proving extensive third-party use was entirely on the Defendant and that the Defendant had not discharged this burden in the present case. He also placed reliance upon the decisions in ***Jagdish Gopal Kamath***, ***Corn Products Refining Co. v. Shangrila Food Products Ltd.***[50], and ***Charak Pharma Pvt. Ltd. v. Glenmark Pharmaceuticals Ltd.*** in support of his contention that mere

[48] 1977 IPLR Vol. 2 No.1.
[49] 2015 (1) MhLJ 501.
[50] AIR 1960 SC 142.

registration of similar marks, absent proof of substantial market use, cannot dilute the Plaintiff's rights. Additionally, he pointed out that the Plaintiff had actively protected and enforced the Plaintiff's statutory rights which flowed from the said registrations through opposition proceedings, cease and desist notices and filing of suits for infringement and passing off. He submitted that it was well settled that the Plaintiff was under no obligation to proceed against every possible infringer. He was also at pains to point out that the material upon which the Defendant had placed reliance did not predate the Plaintiff's adoption and use of **'NEEM'**. He submitted that subsequent adoption by others cannot establish a common to the trade defence as held in the case of ***Ripley v. Bandey***[51] and ***International Great Brands LLC v. Parle Products Pvt. Ltd***.

67. On the quantum of evidence required to uphold a common-to-the-trade defence, he submitted that the threshold was very high. He submitted that proof of extensive commercial use and sales, rather than sporadic instances of sales or use, was required. In support of his contention, he

[51] (1897) 14 RPC 591.

placed reliance upon the decisions in ***Corn Products, Pidilite Industries Ltd. v. S.M. Associates***[52]***, R.R. Oomerbhoy Pvt. Ltd. v. Court Receiver, High Court, Bombay***[53]***, F.M. Diesel v. S.M. Diesel***[54], and ***Pankaj Goel v. Dabur India Ltd***[55]**.**

68. Mr. Tulzapurkar was then at pains to point out that the Defendant's reliance upon the Nielsen Report was entirely unreliable. He submitted that the so-called report relied upon by the Defendant, which was in addition to being uncertified, was also internally inconsistent since it listed entities such as "Henkel India Ltd." and "Jyothy Consumer Products Ltd." as though both were in existence as of December 2016, when in fact Henkel India Ltd. had become Jyothy Consumer Products Ltd. in 2012, which was itself amalgamated into the Plaintiff, Jyothy Laboratories Ltd., in 2013. He therefore submitted that neither of the entities, as separately named in the so-called report, existed in that form as on the date the report purported to reflect.

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[52] 2004 (28) PTC 193.
[53] 2003(27) PTC 580 (DB) (Bom).
[54] 1994 PTC 75.
[55] 2008 (38) PTC 49.

69. He submitted that the statutory defences under Sections 30(2)(a) and 35 of the Trade Marks Act were confined only to bona fide descriptive use and do not extend to the use of a mark as a trade mark or badge of origin. According to him, the contrast between the Defendant's domestic and international packaging clearly demonstrated that the Defendant was using **'NEEM'** in the impugned label as a trade mark and not in a descriptive sense.

70. Mr. Tulzapurkar submitted that the Defendant's subjective intention was wholly irrelevant and the only material factor was how the consumers and members of the trade would perceive the impugned label. From the decision of this Court in ***Hem Corporation Pvt. Ltd. v. ITC Ltd.***, he pointed out that this Court had rejected the distinction sought to be drawn between a "brand" and a "sub-brand" and held that the test was whether the use of the mark distinguished, or was capable of distinguishing, the goods or services of a person, and that the fact that the mark was a sub-brand made no difference. Applying that principle to the facts of the present case, he submitted that **'NEEM'** was the only element in the

impugned label capable of functioning as a product identifier, and that the remaining expressions, namely, “Herb’l”, “Complete Care Toothpaste”, “Germ Protection”, “0% Added Fluoride & Parabens”, “100% Vegetarian”, and the device of a neem leaf, were merely descriptive of the product or its characteristics, while “DABUR” functioned only as the Defendant’s house mark.

71. He then placed reliance upon the decision of ***Meher Distilleries Pvt. Ltd. v. S.G. Worldwide Inc.***[56] and ***CCE v. Kalvert Foods*** to submit that the presence of the DABUR house mark also did not distinguish the rival products, since a house mark identifies the manufacturer while a product mark identifies the particular product in the marketplace. He also submitted that more than one prominent or essential feature may co-exist within a composite mark, pointing out that the Defendant had itself opposed registration of the mark ARYAN BABOOL, despite the fact that the equally prominent house mark ARYAN appeared thereon. On the colour scheme, he clarified that the Plaintiff claimed no exclusivity over

[56] Order passed by the Bombay High Court on 28th August 2021 in COMAP(L) No. 10963 of 2021.

the colour green but only over the Defendant's adoption of the manner, style, font, colour and placement of the word **'NEEM'**.

72. Mr. Tulzapurkar therefore submitted that the Plaintiff had established all three ingredients to establish a case of passing off, as recognised in ***Laxmikant V. Patel v. Chetanbhai Shah***[57], and ***S. Syed Mohideen v. P. Sulochana Bai.***[58] On the aspect of public interest underlying the law of passing off, Mr. Tulzapurkar placed reliance upon the decision in ***Lokhandwala Construction Industries Pvt. Ltd. v. Lokhandwala Infrastructure Pvt. Ltd. & Ors***[59]***,*** to submit that the determinative question is whether an ordinary consumer of average intelligence and imperfect recollection is likely to distinguish between the rival marks and submitted that in the present case there could be no manner of doubt that consumers would have difficulty in doing so. On the aspect of dishonest adoption, he placed reliance upon the decisions in ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia***[60] and ***Khoday India Ltd. v. Scotch Whisky Association***[61] to point out that these decisions recognise that,

[57] AIR 2002 SC 275.
[58] (2016) 2 SCC 683.
[59] 2016 (1) Mh. L.J. 221.
[60] 2004 (28) PTC 121.
[61] AIR 2008 SC 2737.

once dishonest adoption is established, the grant of an injunction ordinarily follows. In the alternative, he submitted that dishonesty is not an essential ingredient of an action for passing off and that the Plaintiff's claim would succeed even on the assumption that the Defendant's adoption was honest.

73. Mr. Tulzapurkar accordingly reiterated that the Interim Application deserved to be allowed and that the Plaintiff was entitled to maintain an infringement action based on the leading and essential feature of its registered composite marks.

<u>Submissions in Sur-Rejoinder:</u>

74. Mr. Jagtiani pointed out from the decision of the Hon'ble Supreme Court in ***Laxmikant V. Patel v. Chetanbhai Shah*** that an action for passing off would lie only where the Defendant's adoption was calculated to deceive, divert business, or cause confusion; failing which, no case for passing off would arise. He also, from the decision in ***Ruston & Hornsby Ltd. v. Zamindara Engineering Co.***, pointed out the distinction between an action for infringement, which is concerned with the imitation of a

registered trade mark, and an action for passing off, which is concerned with whether the Defendant's goods are passed off as those of the Plaintiff. He reiterated that, in the present case, the Plaintiff had not made out a prima facie case of either infringement or passing off.

75. Relying on *Professor Christopher Wadlow's The Law of Passing-Off*, he pointed out that a *prima facie* descriptive mark is protectable in an action for passing off only if it has acquired a secondary meaning. He reiterated that the burden of establishing this was significantly higher than what was required for a fanciful or arbitrary mark. He submitted that even where a descriptive term has acquired sufficient secondary meaning to warrant protection, a Defendant cannot be restrained from using such term in its genuine descriptive sense, provided such use does not amount to misrepresentation. He placed reliance upon the decision in ***Reddaway v. Banham***, to submit that, in the said case, although a wholly descriptive term was held to have become distinctive, and such finding was a factual finding grounded in cogent evidence of acquired distinctiveness in that

case. He submitted that this cogent evidence was conspicuously absent in the facts of the present case.

76. He submitted that the Plaintiff's case for passing off, as pleaded in paragraphs 9 and 13 of the Plaint, rested on the same foundation as the Plaintiff's case for infringement. He reiterated that **‘NEEM’** was generic or, at most, descriptive, and that the Plaintiff had failed to establish the secondary significance that a descriptive term requires to support a passing-off claim.

77. He also reiterated that no misrepresentation could arise in the facts of the present case since the Defendant’s packaging prominently displayed the well-known DABUR house mark and the Herb'l brand, such that consumers would identify the product as originating from the Defendant rather than the Plaintiff. He also submitted that the differences in the parties' trade dress were substantial and immediately apparent. He also pointed out that the Plaintiff had neither issued a cease-and-desist notice nor initiated proceedings against the Defendant. He submitted that the Plaintiff had instituted the present Suit only after the Defendant

commenced opposition proceedings, after a considerable and unexplained delay. This itself, he submitted, would disentitle the Plaintiff to interim relief.

78. On this basis, he submitted that none of the essential ingredients of passing off, namely goodwill exclusively associated with the mark, misrepresentation, and resultant or likely damage, had been established, either individually or cumulatively, and that the passing-off claim was liable to fail for substantially the same reasons as the infringement claim. He accordingly submitted that the Plaintiff had failed to make out a prima facie case of either infringement or passing off, that the balance of convenience lay with the Defendant, and that no case for an injunction had been established.

Reasons and Conclusions:

79. Having considered the rival contentions, the record, and the extensive case law upon which reliance has been placed, I find that the Plaintiff has made out a case for the grant of interim relief. I say so for the following reasons, viz.

A. The principal contention of the Defendant is that, notwithstanding the Plaintiff's registrations, the Plaintiff is not entitled to protection in respect of the expression '**NEEM**' since (i) '**NEEM**' is not separately registered; (ii) '**NEEM**' is generic or descriptive of toothpaste; (iii) the use of '**NEEM**' has become common to the trade or *publici juris*; and (iv) the Plaintiff had, in respect of certain earlier registrations, disclaimed '**NEEM**'. In my *prima facie* view, none of these contentions would, at this interlocutory stage, disentitle the Plaintiff to interim relief. It is well settled that at the interlocutory stage, the Court is not required to carry out a mini trial. In my view and from the material that has been placed before the Court, these are all issues which would require evidence to be led and would have to be determined at trial.

B. In the present case, it is not in dispute that (i) the Plaintiff is the registered proprietor of the three Suit Marks in which '**NEEM**' is clearly the leading and essential feature; (ii) the present Suit is founded solely upon these Suit Marks; (iii) none of these registrations contains any disclaimer in respect of ‘**NEEM**’; and (iv) none of the registrations have been challenged by the Defendant. The Defendant’s contention that the Plaintiff is seeking to monopolise or claim exclusivity over ‘**NEEM**’ is plainly untenable. It has been expressly clarified that the Plaintiff is not seeking to restrain the Defendant from using the word ‘**NEEM**’ *per se* but is only aggrieved by the manner in which the Defendant had adopted and is using ‘**NEEM**’ on the impugned label, i.e., as its leading and essential feature.

C. It is well settled that once a trade mark is entered on the Register, such registration constitutes *prima facie* evidence that all statutory requirements for registration have been duly satisfied. As held by this Court in ***Ashok Leyland Ltd. v. Blue Hill Logistics Pvt. Ltd***., objections that pertain to the validity or registrability of a registered mark, must ordinarily be pursued through the statutory remedy of rectification and not as a defence to an infringement action. As already noted in (**B**), the Defendant has not assailed any of the Plaintiff’s Suit Marks. All three Suit Marks have at all times remained valid and subsisting, and the Plaintiff is therefore entitled to invoke the statutory rights conferred upon a registered proprietor under Sections 28 and 29 of the Trade Marks Act, 1999, which flow from these registrations.

D. The Division Bench of this Court in ***Reckitt & Colman of India Ltd. v. Wockhardt Ltd****.,* held that although competing marks must ordinarily be compared as a whole, the Court is entitled, while assessing deceptive similarity, to identify the distinguishing or essential feature of a registered mark, since it is often such feature that remains fixed in the recollection of the average consumer. This principle has been consistently applied in ***Ruston & Hornsby Ltd. v. Zamindara Engineering Co.***, ***Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.***, ***Jagdish Gopal Kamath v. Lime & Chilli Hospitality Services***, ***South Indian Beverages Pvt. Ltd. v. General Mills Marketing Inc.***, and ***James Chadwick & Bros. Ltd. v. National Sewing Thread Co***.

E. Crucially, this Court has, in the case of ***Brihan Karan Sugar Syndicate Pvt. Ltd. v. Lokranjan Breweries Pvt. Ltd.***, likened the essential feature of a composite mark to a "synecdoche", i.e., a part which uniquely represents the whole. The said decision also goes on to hold that permitting third parties to freely appropriate the essential feature of a composite or label mark merely because it had not been separately registered would effectively create an "*open hunting season*" in respect of the distinctive components of composite marks. This principle has been reiterated in ***Ultra Tech Cement Ltd. v. Alaknanda Cement Pvt. Ltd***. and affirmed by the Division Bench in ***Alaknanda Cement Pvt. Ltd. v. Ultra Tech Cement Ltd.***

F. In the present case, there can really be no doubt that **'NEEM'** is the leading and essential feature of the Suit Marks as also the impugned label. This is plainly apparent from a comparison of both the labels set out in Table C, which is once again for ease of reference reproduced below, viz.

<table>
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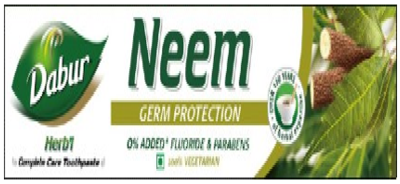
</td><td>
</td></tr>
</table>

Hence, from the above, the Plaintiff’s contention that the Defendant has adopted and is using the leading and essential feature of the Plaintiffs' registered trade marks is well founded.

G. Additionally, as held by this Court in the case of ***Sky Enterprise Pvt. Ltd. v. Abaad Masala & Co.,*** the relevant inquiry is the perception of the average consumer and not the subjective intention of the Defendant. What the Court is therefore required to consider is the prominence, placement, visual emphasis and overall presentation of the impugned expression, as recognised in ***Hem Corporation Pvt. Ltd. v. ITC Ltd., Venetianaire Corporation of America v. A & P Import Co***., and ***Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.***

H. The Defendant's reliance upon Section 17 of the Trade Marks Act is, also in my *prima facie* view, equally misplaced. Section 17(1) confers upon the registered proprietor, the exclusive right to the trade mark taken as a whole. Section 17(2) prevents the proprietor from asserting an independent monopoly or exclusivity over a part of the mark which is common to the trade, non-distinctive or otherwise incapable of separate protection. It does not, however, mean that the proprietor of a composite or label mark is precluded from relying upon the appropriation of its essential and distinctive feature while establishing deceptive similarity. This, in my view, is covered by the decisions upon which the Plaintiff has placed reliance and which are referred to in (**D**) and (**E**). Even otherwise, the interpretation which the Defendant seeks to propound would substantially denude the protection given to composite marks.

I. I am also, at this stage, unable to accept the Defendant's contention that the Plaintiff is not entitled to relief on account of the disclaimers recorded in Registration Nos. 142532 and 146242. *First*, the present

Suit is admittedly not founded upon those registrations, both of which were not even valid and subsisting by the date on which the Suit was filed. *Second*, none of the Suit Marks upon which the Suit is founded contains any disclaimer in respect of **'NEEM'**. As held in ***Sab Miller India Ltd. v. Jagpin Breweries Ltd.***, ***Skol Breweries v. Som Distilleries***, and ***Shaw Wallace and Co. Ltd. v. Mohan Rocky Spring Water Breweries***, a disclaimer must be expressly recorded by the Registrar in relation to the registration in question and cannot merely be inferred. *Third*, even in cases where disclaimers are present, the comparison of the marks does not involve excluding the disclaimed element. As held in ***Pidilite Industries Ltd. v. Riya Chemy***, ***Pidilite Industries Ltd. v. S.M. Associates & Ors.***, and ***Serum Institute of India Ltd. v. Green Signal Bio Pharma Pvt. Ltd. & Anr.***, the comparison must be undertaken on the basis of how a mark appears in the marketplace and how it is perceived by consumers since consumers are unaware of disclaimers recorded on the Register. *Fourth*, a disclaimer attached to one registration does not automatically attach to another registration, nor does such a disclaimer curtail the proprietor's independent remedy in passing off. In this regard, the Plaintiff's reliance upon ***Shaw Wallace & Co. Ltd. v. Castle Douglas Industries Ltd.***, ***Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd.***, and ***Pidilite Industries Ltd. v. Poma-Ex Products*** is apposite. Therefore, in my prima facie view, the disclaimers that the Defendant seeks to rely on would not *ipso facto* be sufficient to deny the Plaintiff interim relief if a case is otherwise made out.

J. Equally, the Defendant's contention that the Plaintiff is not entitled to interim relief on the ground of suppression is also equally untenable. The Plaintiff has, in paragraph 6 of the Plaint, expressly disclosed that its predecessor had applied for and obtained registrations of other marks containing **'NEEM'**. As held in ***Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.***, a party who discloses entries on the Register and reserves its right to rely upon them cannot ordinarily be accused of suppressing those entries. In any event, and as held in ***Sab Miller India Ltd. v. Jagpin Breweries Ltd.***, ***State of NCT***

v. BSK Realtors LLP & Anr., and ***S.J.S. Business Enterprises v. State of Bihar,*** suppression which justifies the refusal of equitable relief, must be such that its non-disclosure would render the grant of the relief sought unjust, or render it impossible for the Court to arrive at a just decision on the application. In my *prima facie* view, the Defendant has not shown that the alleged non-disclosure in the present case meets that threshold.

K. Additionally, and significantly, Registration No. 3972013 was granted in 2018 without any disclaimer in respect of '**NEEM**', notwithstanding the fact that the Registrar had the entire record of the earlier registrations at hand. The Defendant's reliance upon handwritten note-sheets dating back to 1953 would also at this stage not assist the Defendant since as held in ***Sapat International Pvt. Ltd. v. Victoria International Pvt. Ltd.***, internal or handwritten notations of the Registrar cannot be read into a registration unless they are reflected in the final order. Admittedly, the final order dated 10th June 1953 does not contain any finding regarding "NEEM toothpaste" and does not impose any limitation or fetter upon the registration. The specification of goods simply reads “Dentifrices”. Hence, in these facts, the Defendant’s reliance upon the decisions in ***Laser Shaving (India) Pvt. Ltd. v. RKRK International Products Pvt. Ltd, PhonePe Private Limited v. Resilient Innovations Private Limited,*** and ***Liberty Oil Mills Ltd. v. BRS Refineries*** would not assist the Defendant since they are all distinguishable on facts.

L. I am also unable to accept the Defendant's contention that the Plaintiff has adopted mutually destructive pleas. In my view, a holistic reading of the Plaint and the Affidavit in Rejoinder shows that the Plaintiff has pleaded its case in the alternative. The Plaintiff has in paragraphs 8 to 11 of the Plaint relied on acquired distinctiveness and secondary meaning resulting from extensive and uninterrupted use, sales and promotion. The Plaintiff has, in paragraph 6 of the Rejoinder, asserted the inherent distinctiveness of ‘**NEEM**’, while in paragraph 22 relied upon the Plaintiff’s registered composite marks in which ‘**NEEM**’ is said to constitute the leading and essential feature. Hence, at this stage I am unable to accept these pleas as being inconsistent or mutually destructive.

M. I am also, *prima facie*, unable to accept the Defendant's contention that '**NEEM**' is generic in relation to toothpaste broadly for three reasons. *First*, the material relied upon by the Defendant itself demonstrates use of '**NEEM**' in relation to a wide variety of goods, including hair oil, soap, body mist, face wash, pet perfume, powders, tablets, prickly heat powder, plant fertilisers, laundry detergents and anti-ageing cream. This material does not establish that '**NEEM**' is the generic name of toothpaste; it in fact indicates otherwise. *Second*, the Defendant has itself sought registration of the impugned label marks in which '**NEEM**' is prominently featured, thereby asserting proprietary rights in the mark as it appears on its packaging. Hence, the Defendant is estopped from contending that neem is generic. *Third*, the Defendant has itself enforced statutory rights in respect of "MESWAK" and "BABOOL" against third parties, notwithstanding the presence of the third- party house marks appearing on the labels in question. The

Defendant has not offered any explanation, much less a satisfactory explanation as to why "**NEEM**", which, like “MESWAK” and “BABOOL”, is associated with oral hygiene, must necessarily be treated differently. At the interim stage, such conduct on the part of the Defendant is most certainly a factor that would militate against the Defendant and in favour of the Plaintiff.

N. As already noted in (**M**), however, to elaborate, the material relied upon by the Defendant, far from conclusively establishing that '**NEEM**' is descriptive of toothpaste, *prima facie* supports the Plaintiff’s contention that it is suggestive. The use of neem in connection with a wide range of unrelated goods indicates that the word does not directly and immediately associate neem with toothpaste. For such an association to be made, a consumer would have to make an “imaginative leap” as referred to in ***McCarthy on Trademarks and Unfair Competition*** and adopted by this Court in ***Hygienic Research Institute Pvt. Ltd. v. Chandan and Shah Trading LLP & Anr.***, ***Bata India Ltd. v. Chawla Boot House and Another***, and ***Bawaskar***

Technology (Agro) Pvt. Ltd. v. Anannya Agro Products and Ors. Hence, neem would clearly only be suggestive of toothpaste and not generic or descriptive. The Plaintiff is therefore not required to at this stage establish secondary meaning as held in ***Sapat International Pvt. Ltd. v. Girnar Foods & Beverages Pvt. Ltd.***, ***J.L. Mehta v. Registrar of Trade Marks***, ***Central Camera Co. v. Registrar of Trade Marks***, ***Registrar of Trade Marks v. Manu Subedar***, and ***Lupin Ltd. v. Johnson & Johnson***, upon which, in fact, the Defendant itself has placed reliance.

O. In any event, even accepting that '**NEEM**' is descriptive, the proviso to Section 9(1) of the Trade Marks Act expressly recognises that a descriptive mark is also capable of registration if it has acquired distinctiveness through use. The Plaintiff has pleaded nearly a century of use as on the date of the Suit and has placed substantial material on record concerning sales, promotion and continuous commercial use. Such prior adoption and continuous and longstanding use is plainly a relevant circumstance, at least at the interim stage. In these circumstances, I find that the Plaintiff's reliance upon the decision of the Supreme Court in ***Godfrey Phillips India Ltd. v. Girnar Food & Beverages (P) Ltd.*** is apposite.

P. I am also at this interim stage unable to accept the contention that '**NEEM**' has become common to the trade or *publici juris*. The Defendant has in support of this contention principally relied upon a search report identifying third-party registrations which have '**NEEM**'. However, as held in ***Jagdish Gopal Kamath & Ors. v. Lime & Chilli Hospitality Services***, the mere presence of marks upon the Register does not establish that an expression or mark has become common to the trade. The burden lies on the party asserting such a defence to establish actual and substantial commercial use of the third-party marks relied on. In my prima facie view, the Defendant has not at this stage sufficiently discharged this burden.

Q. Also, in my view, another very relevant circumstance, more so at this interlocutory stage, is that the Plaintiff's adoption and use of '**NEEM**' for toothpaste predates the third-party marks relied upon by the

Defendant. As held in ***Ripley v. Bandey*** and ***Intercontinental Great Brands LLC v. Parle Products Private Ltd.***, subsequent third-party adoption do not *ipso facto* extinguish rights which accrue from prior adoption and use. The Plaintiff has also placed material on record indicating that it has consistently asserted and protected the Plaintiff's statutory rights, which flow from the said registrations by filing oppositions, issuing cease-and-desist notices and instituting proceedings for infringement and passing off. In these circumstances, and given that the third-party registrations are unsupported by evidence of prior or substantial commercial use, they would not be sufficient to establish that '**NEEM**' has become *publici juris*.

R. It is equally settled that the proprietor of a registered trade mark is not obliged to proceed against every infringer. The long line of decisions relied upon by the Plaintiff in the case of ***Corn Products Refining Co. v. Shangrila Food Products Ltd.***, ***Pidilite Industries Ltd. v. S.M. Associates & Ors.***, ***R.R. Oomerbhoy Pvt. Ltd. v. Court Receiver, High Court, Bombay***, ***M/s F.M. Diesel v. M/s S.M. Diesel***, and ***Pankaj Goel***

v. Dabur India Ltd., clearly supports this contention and makes it clear that mere inaction against some third parties does not, by itself, establish abandonment, loss of distinctiveness, or that the mark has become common to the trade.

S. The Defendant's reliance upon "the Nielsen Report" also does not at this stage inspire confidence. As pointed out by the Plaintiff, what the Defendant has claimed to be the Nielsen Report is *firstly* not authenticated or certified and clearly appears to be a compilation prepared by the Defendant. *Secondly*, the said material is not confined to the use of '**NEEM**', but contains sales data pertaining to manufacturers marketing toothpaste under various brands. *Thirdly*, there are also apparent inconsistencies, including entries attributing products to manufacturers who did not exist during the relevant period and sales figures which do not correspond with the stated launch dates of certain products. Crucially, the Defendant has left all of this entirely unexplained. Therefore, the evidentiary value of this material, which is relied upon in the guise of a Nielsen Report, would have to be tested at trial.

T. The Defendant's reliance upon the decision in ***Yatra Online Ltd. v. Mach Conferences and Events Ltd.,*** also does not assist the Defendant. In that case “YATRA” was held to be the Hindi dictionary equivalent of the very service in question, namely travel, thereby creating a direct and immediate nexus between the mark and the service. Crucially, in that case, “YATRA” was itself the subject of an express disclaimer, and hence the said decision would not apply. Equally, the decisions in ***Freudenberg Gala Household Products v. Gebi Products***, ***Vasundhara Jewellers v. Kirat Vinodbhai Jadvani & Anr.***, ***Haveli Restaurant v. Registrar of Trade Marks & Anr.***, and ***Ganesh Gouri Industries v. R.C. Plasto Tanks & Pipes (P) Ltd.***, would not apply. In ***Freudenberg*** the Plaintiff had claimed exclusivity over the standalone name of Goddess LAXMI simpliciter, without any registered label mark in which that name featured as a leading and essential feature, and without the defendant in that case having sought registration of the impugned mark, which is not so in the present case. In ***Vasundhara Jewellers*** the Plaintiff was denied relief since the Plaintiff had not established sufficient evidence of extensive and exclusive use. In the present case, the Plaintiff has over a century of longstanding use. ***Haveli Restaurant*** pertained to a case of refusal of registration and not infringement or passing-off and the issue of acquired distinctiveness was not considered in that case. The Plaintiff in ***Ganesh Gouri Industries*** was bound by an earlier settlement under which the Plaintiff had consented to the use and registration of marks containing "PLAST". Hence, the same would not apply.

U. The Defendant's reliance upon ***Aegon Life Insurance Company Ltd. v. Aviva Life Insurance Company India Ltd.,*** is likewise distinguishable since the "iTerm" in that case was not used as an independent trade mark but as part of the composite expression and was therefore not treated as an independent source identifier. In the present case, I am *prima facie* satisfied that the Defendant has on the impugned label used '**NEEM**' as a trade mark. Also, the period of use considered in ***Aegon***

Life was relatively short, whereas the Plaintiff has *prima facie* established use for almost a century.

V. I am also at this stage unable to accept the Defendant's contention that its use of '**NEEM**' is protected as bona fide descriptive use under Sections 30(2)(a) and 35 of the Trade Marks Act. In my view, the answer is clear from a comparison between the Defendant's international and the impugned label. On the Defendant's international packaging, '**NEEM**' appears in a relatively inconspicuous manner on the bottom right, clearly used only descriptively. However, on the impugned label, '**NEEM**' is displayed centrally and in large, bold lettering clearly as the leading and essential feature of the impugned label. The Defendant has therefore on the impugned label clearly used **'NEEM'** as a trade mark and not in a descriptive manner. What I find most telling is the explanation offered by the Defendant for the change between the international packaging and the impugned label. The Defendant has plainly stated that the domestic packaging, i.e., the impugned label, was designed "*to cater to the Indian market*" without so much as offering any explanation, let alone a satisfactory explanation as to why this change was necessitated in the first place. In my *prima facie* view, therefore, this unexplained difference between the Defendant's two labels is a strong indicator that **'NEEM'** has been consciously adopted and used as a source identifier (and not descriptively) on the impugned label. Hence, I prima facie find that the defences under Sections 30(2)(a) and 35 of the Trade Marks Act would not at this stage and in these facts be available to the Defendant.

W. Also, and crucially, the Defendant's conduct before the Trade Marks Registry is also inconsistent with its present plea of bona fide descriptive use of **'NEEM'**. As held in ***Jagdish Gopal Kamath***, Section 30(2)(a) protects bona fide descriptive use and does not extend to use of the impugned expression as a trade mark. As already noted, the Defendant has itself sought registration of labels in which '**NEEM**' appears as a leading and essential feature without disclaiming **'NEEM'**. In my prima facie view this is inconsistent with the Defendant's contention that the Defendant is using '**NEEM**' descriptively on the impugned label. The same would also apply to the defence under Section 35.

X. For the reasons already recorded in (**V**) and (**W**), above I *prima facie* find that the Defendant's use of '**NEEM**' is as a trade mark. The Defendant's reliance upon the decision in ***Marico Limited v. Agro Tech Foods Limited*** is therefore, in my view misplaced, since in that case the impugned expression was found to have been used in a purely descriptive sense and not as a trade mark. At this stage, therefore, the Defendant cannot claim protection under either Section 30(2)(a) or Section 35.

Y. Also, the presence of the Defendant's house mark "DABUR" does not, by itself, distinguish the rival labels or dispel the likelihood of confusion. As noted by the Division Bench of this Court in ***Meher Distilleries Pvt. Ltd. v. S.G. Worldwide Inc.***, while approving ***CCE v. Kalvert Foods,*** a house mark and a trade mark perform distinct commercial functions. The house mark ordinarily identifies the manufacturer, whereas the trade mark identifies the particular goods by which they are recognised, advertised and purchased in the marketplace. To accept the Defendant's contention that the addition of its house mark necessarily avoids confusion would substantially dilute the protection afforded to composite and label marks and would embolden an infringer to appropriate the leading and essential feature of a registered mark merely by appending its own house mark to the same. Therefore, as already noted in paragraph (**F**) above, to accept the Defendant's contention would, in my *prima facie* view, be inconsistent with the settled principles of trade mark law.

Z. Also and crucially, I cannot lose sight of the Defendant's own conduct in opposing registration of the mark "ARYAN BABOOL". In this context, the decision of this Court in ***Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.,*** is instructive. There, although "FEVICOL" was prominently displayed in the registered mark, the Court held that "MARINE", appearing alongside "FEVICOL" with comparable prominence, constituted an essential and distinctive feature in its own right. The Court emphasised that the impugned mark must be compared with the registered mark as a whole, with due regard to all its essential and distinctive features, rather than by isolating only its single most prominent component. The same principle applies here. The prominence accorded to the house mark “DABUR” does not, *prima facie*, diminish the significance of '**NEEM**', which has been adopted and used as the leading and essential feature of the impugned label.

AA. I am also satisfied that the Plaintiff has made out a *prima facie* case in passing off by satisfying the test laid down in ***Laxmikant V. Patel v. Chetanbhai Shah***, ***S. Syed Mohideen v. P. Sulochana Bai***, and ***Reckitt & Colman v. Borden Inc.***, The Plaintiff’s long, continuous and extensive use of the Suit Marks *prima facie* establishes substantial goodwill. For the reasons already recorded, the Defendant’s prominent adoption of '**NEEM**' as a source-identifying feature is likely to lead consumers to believe that its goods are commercially associated with, connected to, or originate from the Plaintiff. Injury to the Plaintiff’s goodwill and business reputation are natural and probable consequences of such misrepresentation.

BB. I am also conscious of the distinction between infringement and passing off recognised by the Supreme Court in ***Ruston & Hornsby Ltd. v. Zamindara Engineering Co.*** However, in my *prima facie* view, the Plaintiff has independently established both causes of action. I find much merit in the Plaintiff's reliance upon the decisions in ***Lokhandwala Construction Industries Pvt. Ltd. v. Lokhandwala Infrastructure Pvt. Ltd.***, ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia***, and ***Khoday India Ltd. v. Scotch Whisky Association*** since these decisions recognise that the law of passing off protects not only the proprietary interests of traders but also the consuming public against deception and confusion.

80. For all these reasons, I am satisfied that the Plaintiff has made out a *prima facie* case of infringement as well as passing off. The balance of convenience also lies in its favour. I am satisfied that if interim protection is refused, the continued use of the impugned label would, in addition to

the violation of the Plaintiff's statutory rights, also cause loss, harm and injury to the Plaintiff. The Plaintiff is therefore entitled to interim protection.

81. Hence, for the aforesaid reasons, I pass the following Order:

i. The Interim Application is allowed in terms of prayer clauses (**a**) and (**b**).

ii. It is, however, clarified that there shall be no fetter on the Defendant from using **'NEEM'** *per se* in a descriptive manner on the impugned label or otherwise.

[ARIF S. DOCTOR, J.]

<u>After pronouncement:</u>

82. Mr. Khandekar, the Learned Counsel appearing on behalf of the Defendant has prayed for a stay to this Order and the same is granted for a period of 6 weeks from the day on which this Order is uploaded.

[ARIF S. DOCTOR, J.]