

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% Reserved on : 15th February, 2024

Pronounced on : 22nd March, 2024

+ **C.O. (COMM.IPD-TM) 371/2022**

PIDILITE INDUSTRIES LTD Petitioner

Through: Mr. Manish Dhir, Adv.

versus

SANJAY JAIN & ANR..... Respondents

Through: Mr. Mrinal Litoria, Adv. for R-1.

Mr. Harish Vaidyanathan, CGSC
along with Mr. Srish Kumar Mishra,
Mr Alexander Mathai Paikaday,
Mr. Lakshay Gunawat, and Mr.
Krishnan V. for R-2



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CORAM:

HON'BLE MR. JUSTICE ANISH DAYAL

JUDGMENT

ANISH DAYAL, J.

1. This rectification application has been filed under Sections 47 and 57 of the Trade Marks Act, 1999 (“**the Act**”) for removal/cancellation of



the impugned mark

bearing no. 2223608

in the Register of Trade Marks.

Signature Not Verified

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By: MANISH KUMAR
Signing Date: 22.03.2024
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2. The said matter was initially filed before the Intellectual Property Appellant Tribunal (“**IPAB**”) and transferred to this Court, consequent to the abolition of IPAB in 2021.

3. The impugned mark of which removal is sought, ‘POMA-EX



KIWKHEAL’ (device) , was applied for on 21st October, 2011, with user claimed from 01st July, 2011, and was granted on 16th December, 2014 to the respondent.

4. The petitioner claims to, *inter alia*, have the following registrations:

Trademark	Registration No. and Date	Class
FEVIKWIK	464651 06.01.1987	1
FEVIKWIK	689062 04.12.1995	1
FEVIKWIK (label)	705500 02.05.1996	1
FEVIKWIK (label)	1643621 21.01.2008	1
FEVIKWIK (label)	1643620 21.01.2008	16

5. The trademarks are applied to their product which is instant adhesive and bears the following packaging/label:



6. The petitioner is a company incorporated in India, having its registered office in Mumbai. It claims to be world-renowned in the field of adhesives and sealants, construction, paint chemicals, art materials, industrial adhesives, *et al.*

7. Petitioner's products are sold under well-known trademarks 'FEVIKWI', 'FEVICOL', 'FEVISTIK', 'FEVICRYL', 'FEVI BOND', 'FEVIART', 'FEVIGUM', 'FEVITITE', 'M-SEAL' and 'DR. FIXIT', *et al.*

8. Petitioner's products are claimed to have been developed through in-house research and sold internationally. However, in particular, the products sold under the aforementioned marks enjoy a major market share in India.

9. Petitioner's trademark 'FEVIKWIK' as noted above has a distinctive trade dress, colour scheme, and layout and has been used extensively and continuously by the petitioner since 1987. The said trademark was popularised over a period of time through various sales promotion measures.

10. Petitioner claims to be the registered proprietor of the mark 'FEVIKWIK' bearing registration no. 465651 dated 06th January, 1987 in class-1, the said registration is valid and subsisting.

11. Aside from the fact that the earliest registration of the 'FEVIKWIK' mark was in 1987, in November, 2007 the petitioner adopted a new, unique, and distinctive packaging for its 'FEVIKWIK' products being



The essential features comprise of the following:

- i. a unique and distinctive colour combination of yellow and shades of blue;
- ii. the mark 'FEVIKWIK' written in red lettering;
- iii. a blue ball device depicted at the right-side top end of the mark 'FEVIKWIK';
- iv. the words "one drop instant adhesive" on top of the mark and;
- v. a depiction of the product container bearing the house mark 'PIDILITE' on the left side of the packaging (*hereinafter referred to as the FEVIKWIK Distinctive Packaging*).

12. Registration of the labels was obtained in class 1 (no. 1646321 dated 21st January, 2008), as well as in class 16 by (no. 1643620). The petitioner, therefore, claims copyright ownership in respect of the trademark 'FEVIKWIK' with its distinctive packaging.

13. The petitioner claims that the moment it came to know of respondent's infringing products using trademark 'KWIKHEAL', it filed Suit no. 653/2014 in the High Court of Judicature at Bombay. The High Court granted an *ad-interim* injunction on 05th May, 2014 against the respondent which was made absolute on 02nd August, 2017.

14. The injunction was granted *inter alia* in the following terms:

"(b) that pending the hearing and final disposal of the suit, the Defendants by itself, its partners, its directors, proprietors, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming under them be restrained by an order and injunction of this Hon'ble Court from infringing any of the Plaintiff's trademark comprised in the FEVIKWIK Distinctive Packaging bearing registrations Nos. 1643621 in class 1 and 1643620 in class 16 in any manner and from using in relation to any products / Impugned Products the Impugned Packaging or any other mark which is similar to any of the aforesaid marks of the Plaintiff including, the FEVIKWIK Distinctive Packaging or any of the ' essential features thereof and from manufacturing, importing, selling, advertising, offering to sell or dealing in Impugned Products/any products under or bearing any of the impugned marks or any mark which is similar to any of the Plaintiff's aforesaid registered trademarks or any essential features thereof;"

(emphasis added)

15. The said injunction was granted in respect of the earlier packaging used by the respondent which was as under:



16. Later the respondent changed his packaging and was using the new



device on their packaging . It was this device in which registration was obtained and is impugned herein.

Submissions by Petitioner's Counsel

17. Rectification/removal is sought on *inter alia* the following grounds:

17.1. The essential feature of the impugned mark is similar, or deceptively similar, to the petitioner's prior mark and the goods for which it is registered are identical or similar. Accordingly, by use of the impugned mark, there exists a likelihood of confusion on the part of the public, and of association with the petitioner's prior registration mark.

17.2. The petitioner's marks are well-known trademarks in India and the impugned mark, being a subsequent mark, would take unfair advantage of the same and would be detrimental to the distinctive character of the petitioner's mark.

17.3. The impugned mark was applied for in bad faith since the earlier mark which was enjoined by the Bombay High Court, had already given the benefit of projecting to customers that they were associated with the petitioner's mark, and now by migrating to the impugned mark, the respondent continues to derive benefit.

17.4. The respondent continues to use 'KWIKHEAL' in the same red lettering as that of 'FEVIKWIK' in the petitioner's mark.

17.5. The user claimed by the respondent for the impugned mark is July, 2011. However, as per the pleadings in the Bombay High Court, it had commenced the use of the earlier mark (*which was injuncted*) in 2011, and only subsequently after the injunction in 2014, they migrated to the impugned mark.

17.6. The respondent ought to have informed the registry about the continued operation of the order of the Bombay High Court which had injuncted them from using 'KWIKHEAL' or any label bearing the mark 'KWIKHEAL'.

17.7. The use of impugned mark was liable to be prevented by virtue of law of passing off.

17.8. The impugned mark was registered without any *bona fide* intention to use the mark and there has been no use of the impugned mark, therefore, the mark is liable to be expunged under Section 47 of the Act.

17.9. Counsel for petitioner, in light of the above, further submitted that 'KWIK' was an essential feature of the mark, as had been held by the Bombay High Court.

17.10. As regards the respondent's contention that 'KWIK' was common to trade, the burden of proof is on the respondent to show that it is in fact being used.

17.11. The respondent himself registered 'KWIKHEAL', therefore, cannot claim a lack of distinctiveness in the 'KWIK' part of the mark.

17.12. Reference was made by counsel for the petitioner to the registration no. 1643620 in class 16 of the petitioner's mark 'FEVIKWIK' in which a disclaimer/limitation was provided on the following terms "*registration of the trademark shall give no right to the exclusive use of the word KWIK*"

17.13. It was submitted that out of five trademarks applied for and registered in favour of the petitioner eventually, two of these registration certificates were registered with a disclaimer/limitation, and could not, therefore, give an absolute right in favour of the respondent.

17.14. Counsel for petitioner relied heavily on the final decision of the Bombay High Court dated 02nd August, 2017 in Suit (L) No. 653/2014 titled *Pidilite Industries Limited v Poma-Ex Products & Ors.*

17.15. An injunction was sought against the respondent from using the mark 'KWIKHEAL' and other marks identical or similar thereto.

17.16. The issue of disclaimer/limitation was also addressed by the Bombay High Court. The following paragraphs of the reasons and conclusions of the Bombay High Court have been adverted to by the petitioner.

"77. A perusal of the record indicates that out of four certificates of registration in question, there was no disclaimer in respect of two registration certificates. Three trademarks of the plaintiff were registered under Class 1 and one trademark was registered under Class 16. There is also no dispute that the mark of the defendant was registered later than the registration of the marks of the plaintiff. Application for cancellation of the registration of the defendant filed by the plaintiff is pending before the Intellectual Property Appellate Board.

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83. In my view, merely because the application of the plaintiff for rectification of the registration of the trademark of the defendant is pending before the Intellectual Property Appellate Board, that cannot be a bar against this Court from deciding issue of infringement under Section 28 (1) of the Trade Marks Act, 1999 and to render a prima facie finding on the issue of validity of the registration for a limited purpose for granting interim relief against the defendant. Such prima facie finding, however, rendered by the Court would not affect the outcome of the final conclusions, as may be drawn by such Intellectual Property Appellate Board in the said application filed by the plaintiff. The principle of law laid down by the by Full Bench of this Court in the case of **Lupin Ltd. Vs. Johnson & Johnson** (supra) squarely applies to the facts of this case. I am respectfully bound by the said judgment.

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90. In so far as the submission of the learned counsel for the defendant that the word mark “KWIK” is common and is misspell of the word “QUICK” and thus no right of any nature can be claimed by the plaintiff thereon and thus no suit could have been filed alleging infringement of the said word mark “kwik” is concerned, learned counsel for the defendant placed reliance on the statement alleged to have been obtained from the website of the trademark registry to buttress his arguments that the word “FEVI” has been registered by the plaintiff with 18 combinations. In my view, the said statement obtained from the website of the trademark registry showing that the word “FEVI” has been registered by the plaintiff with 18 combinations would not assist the case of the defendant in any manner whatsoever. Reliance placed on the said statement by the defendant is totally misplaced. The defendant could not point out any dictionary meaning of the word “kwik.” The defendant did not produce any document before this Court in support of its submission that the said word mark “KWIK” is common. On the contrary, it is an admitted position that the defendant itself had applied for registration of the word mark “KWIKHEAL” containing the said word “KWIK” which was common in the registered trademark of both the parties and obtained registration for the same.

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93. This Court in the case of *Cadila Pharmaceuticals Limited Vs. Sami Khatib of Mumbai and Anr. (supra)* has rejected the contention of the defendant that the part of the mark was common to the trade on the ground that pleadings in support of that allegation was not sufficient to establish this defence on facts, nor was there any evidence to prove the same. This Court has held that since there was no material of extensive use and/or availability of such rival marks bearing the alleged common feature, it could not be said that the part of the mark was descriptive or common. In my view, there is no substance in the submission of the learned counsel for the defendant that since the mark “KWIK” is used by the plaintiff as suffix to the mark “FEVIKWIK” whereas the defendant has used the mark “KWIK” as prefix to his mark “KWIKHEAL” and thus there would be no likelihood of deception or confusion. Principle of law laid down by the Division Bench of this Court in the case of ***Cadila Pharmaceuticals Limited Vs. Sami Khatib of Mumbai and Anr. (supra)*** applies to the facts of this case. I am respectfully bound by the said judgment.

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96. In my view, the judgment of this Court in the case of ***Pidilite Industries Ltd. Vs. S.M. Associates & Ors. (supra)*** relied upon by the plaintiff would assist the case of the plaintiff on the issue of disclaimer. In the facts that case, this Court has held that the disclaimer in that case did not affect the plaintiff's right to obtain an injunction for infringement. In my view, the facts before this Court in the said judgment are almost identical to the facts of this case.

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98. In so far as the submission of the learned counsel for the defendant that two trademarks of the plaintiff with disclaimer were to be associated with other trademarks without disclaimer and thus the terms and conditions of the disclaimer in the two trademarks stood incorporated in the remaining trademarks and thus the plaintiff could not file a suit alleging infringement of the trademark of the plaintiff or cannot seek interim reliefs based on such associated mark is concerned, learned counsel for the plaintiff placed reliance on the definition of “associated trade marks” under Section 2(c) read with Section 16 which clearly indicates that to avoid any confusion in a situation where an application for

registration in respect of any goods or services is identical with another trade mark which is registered or in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services or so nearly resembles it, the Registrar may at any time require that the trademarks shall be entered on the register as associated trade marks.

99. A perusal of Section 2(c) and Section 16 of the Trade Marks Act, 1999 does not indicate that the terms and conditions of the registration in registration certificate of one trademark can be read into the terms and conditions of the another certificate or registration of the trademark. In my view, reliance placed by the learned counsel for the defendant on the Trade Marks Journal No.1359 in support of this submission is totally misplaced. In my view, every registration granted by registering authority in respect of each trademark is separate and independent and thus the condition of the registration of one trademark cannot be imported into the certificate of registration of another trademark.

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103. In so far as the submission of the defendant that in view of the defendant already having registered its trademark as “KWIKHEAL” and on that ground, is entitled to statutory protection under Section 30 of the Trade Marks Act, 1999 is concerned, it is the case of the plaintiff that the defendant is deliberately not using the registered trademark of the defendant in toto but has removed the words “Poma-Ex Products” and has been using the label similar to the label of the plaintiff.

104. A perusal of the affidavit-in-reply dated 8th March 2017 filed by the defendant indicates that it is the case of the defendant itself that certain insignificant alterations are made on the label according to the requirement of bulk buyers of the said products bearing trademark “KWIKHEAL” label. Though the said statement made in the affidavit dated 8th March 2017 appears to be incorrect, even if the said statement is considered since the defendant is not manufacturing and marketing products by using bearing trademark “KWIKHEAL” on labels same and similar to the registered trademark and has copied the dominant part of the registered trademark of the plaintiff i.e. “KWIKHEAL,” the defendant is not entitled to protection under Section 30 of the Trade Marks Act, 1999.

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129. In my prima facie view, there exists a high degree of phonetic similarity between the mark of the plaintiff “FEVIKWIK” and the mark of the defendant “KWIKHEAL.” The word “KWIK” has dominant part of the trademark of the plaintiff “FEVIKWIK.” The mark used by the defendant “KWIKHEAL” is a prima facie deceptive or misleading. In my view, the balance of convenience is in favour of the plaintiff and against the defendant. The plaintiff has made out a prima facie case.”

(emphasis added)

17.17. It is stated that no appeal has been filed by respondent against the said order, which has now become final, and therefore, will be binding *qua* the respondent herein.

Submissions by Respondent’s counsel

18. In response counsel for respondent stated as under:

18.1. The observations of the Bombay High Court were merely *prima facie* in nature, as is evident from the para 83 of the said decision:

*“83. In my view, merely because the application of the plaintiff for rectification of the registration of the trademark of the defendant is pending before the Intellectual Property Appellate Board, that cannot be a bar against this Court from deciding issue of infringement under Section 28 (1) of the Trade Marks Act, 1999 and to render prima facie finding on the issue of validity of the registration for a limited purpose for granting interim relief against the defendant. Such prima facie finding, however, rendered by the Court would not affect the outcome of the final conclusions, as may be drawn by such Intellectual Property Appellate Board in the said application filed by the plaintiff. The principle of law laid down by the by Full Bench of this Court in the case of **Lupin Ltd. Vs. Johnson & Johnson** (*supra*) squarely applies to the facts of this case. I am respectfully bound by the said judgment.”*

(emphasis added)

18.2. Counsel for respondent relied upon the limitations which were given in the two-registrations noted above and stated that with regard to ‘KWIK’, petitioners cannot claim exclusivity.

18.3. Reliance was placed on the following list of marks on the trademark register which have ‘KWIK’ as part of the registered marks:

Sr. No.	Name of the Marks	Class
1.	STIKWIK	1
2.	SOLKWIK	1
3.	KWIK MIX WITH LABEL	1
4.	ULTRAKWIK	1
5.	KWIKER	1
6.	KWIKSEEL	1

18.4. Reliance was placed on Section 31 of the Act which stated that registration was *prima facie* evidence of validity, and the counsel drew attention to the fact that the registration was made without any objections.

18.5. It was contended that it was not the ‘KWIK’ part that was an essential and dominant part of the petitioner’s mark, considering that the petitioner's house mark was clearly ‘FEVI’, used on most brands. The dominant aspect was, therefore, ‘FEVI’ and not the other part relating to the sub-brand.

Analysis

19. At the outset, it would be imperative to deal with the main thrust of the petitioner's contention relying upon the decision of the Bombay High Court in granting *ad interim* injunction on 5th May, 2014 against the respondent, made absolute on 2nd August, 2017.

20. It is quite clear from the record, as extracted above in para 18.1 that the injunction was granted in relation to the packaging used by the respondent which was *prima facie* found to be infringing the petitioner's distinctive packaging. Reliance on this *interim* injunction may not be acceptable for the purposes of this rectification petition for the following reasons:

Firstly, the respondent's packaging which was enjoined by the Bombay



High Court , has since been revised.

Secondly, as rightly pointed out by the counsel for the respondent, para 83 of the said decision (*extracted in para 18.1 above*) records that the *prima facie* findings of the Court could not affect the outcome of the final conclusions as may be drawn by the IPAB relating to the rectification application. It is this application which is now before this Court.

Thirdly, the context in an infringement suit was focused on the trade dress and that of possible deceptive similarity, but no conclusive finding can be

asserted by the petitioner in their favour till a final judgment is obtained from the Bombay High Court.

21. What needs to be assessed for the purpose of rectification is to assess rectification of the new device mark of the respondent namely



which post the injunction of 5th May, 2014 was



granted on 16th December, 2014



22. The new mark therefore has departed and moved away from the plaintiff's mark and packaging in the following aspects:

- i. The trade name 'POMA-EX' has been prominently displayed on the top of 'KWIKHEAL' thereby distinguishing itself from the 'FEVI' range of brands;
- ii. It does not use the blue and yellow pattern which is used by the petitioner for its trade dress, instead it uses a combination of red, green, black, and yellow;
- iii. The placement of the wording on the said label is different from the petitioner's device/packaging;

- iv. New artwork including the red, green, and blue circles are used on the left and right sides of the main label;
- v. The device displays an animated man, dressed in red and green, holding the product out of which a drop of adhesive is displayed to be falling out, hinting at the nature of the product;
- vi. The descriptive image of the product is in a cylindrical shape, whereas the plaintiff's product displays a different contoured shape with a dropper which can be twisted to break open.

Plaintiff's Packaging/Device Mark	 The image shows the packaging for Fevikwik One Drop Instant Adhesive. It features a blue and yellow color scheme. The text on the packaging includes "ONE DROP INSTANT ADHESIVE", "Fevikwik", and "₹ 5 only!". There is also a small illustration of a person using the product.
Respondent's Packaging/ Device Mark	 The image shows the packaging for Kwikheal Instant Adhesive. It features a yellow and green color scheme. The text on the packaging includes "Kwikheal", "INSTANT ADHESIVE", "₹ 5 only!", and "500MG. + 40% EXTRA". There is also a small illustration of a person using the product.

Therefore, considering that the rectification is sought of the device mark and that on a comparative assessment of the device mark of the petitioner and that of the respondent, when viewed as a whole, has apparent dissimilarity, the two marks cannot be said to be deceptively similar.

23. It has been held in *M/S South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr.* 2014 SCC OnLine Del 1953 that in comparing device marks they have to be taken as a whole and not dissected. The '*anti dissection rule*' therefore applies to the impugned mark and the

application of rule has been articulated well in *M/S South India Beverages Pvt. Ltd (supra)*.

24. Most importantly, it is evident from various marks which are sold by the petitioner including 'FEVIKWIK', 'FEVICOL', 'FEVISTIK', 'FEVICRYL', 'FEVI BOND', 'FEVIART', 'FEVIGUM', 'FEVITITE'. The common and dominant part of this mark is 'FEVI' which is suffixed with a sub-brand depending on the nature of the product. The recall, therefore, of a customer is on the basis of the 'FEVI' family of marks and not the sub-brand forming part of the suffix.

25. What is of critical relevance is that in registration of the mark of petitioner in 'FEVIKWIK', there is a limitation imposed on the word 'KWIK'. Two registrations being no. 164320 in class 16 of petitioner's mark 'FEVIKWIK' (Label) and 164321 in class 01 of the mark 'FEVIKWIK' (Label) a limitation was provided on the trademark registration categorically stating that "*registration of the trademark shall give no right to the exclusive use of the word KWIK*". Even though three other registrations did not have the said limitation, it is evident that even the Registrar, to sustain the purity of the Register, imposed a limitation for the word KWIK and that the petitioner would have no exclusive use for it. The fact that respondents registered device mark has the word 'KWIK' as part of 'KWIKHEAL' would not estop the respondent from claiming commonality in the word KWIK. It is acceptable that a part of a distinctive mark may have a common element and comparisons are therefore insulated from a portion of the mark applying the '*anti-dissection Rule*'. Even if qualified by the '*dominant markprinciple*', KWIK would certainly not be

the dominant portion of the marks of the petitioner. It is already noted above that 'FEVI' is by far the dominant part of the petitioner's marks.

26. In respect of disclaimer/limitation, reference may be made to the decision in *Registrar of Trade Marks v. Ashok Chandra Rakhit* (1955) SCC OnLine SC 12. In this decision, the Hon'ble Supreme Court noted as under:

"8. The third thing to note is that the avowed purpose of the section is not to confer any direct benefit on the rival traders or the general public but to define the rights of the proprietor under the registration. The registration of a trade mark confers substantial advantages on its proprietor as will appear from the sections grouped together in Chapter IV under the heading "Effect of Registration". It is, however, a notorious fact that there is a tendency on the part of some proprietors to get the operation of their trade marks expanded beyond their legitimate bounds. An illustration of an attempt of this kind is to be found in In re Smokeless Powder Co.'s Trade Mark [LR (1892) 1 Ch 590 : 9 RPC 109] . Temptation has even led some proprietors to make an exaggerated claim to the exclusive use of parts or matters contained in their trade marks in spite of the fact that they had expressly disclaimed the exclusive use of those parts or matters. Reference may be made to Greers Ltd. v. Pearman and Corder Ltd. [(1922) 39 RPC 406] commonly called the "Banquet" case. The real purpose of requiring a disclaimer is to define the rights of the proprietor under the registration so as to minimise, even if it cannot wholly eliminate, the possibility of extravagant and unauthorised claims being made on the score of registration of the trade marks.

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14. It is true that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. As said by Lord Esher in Pinto v. Badman [8 RPC 181 at p 191] :

“The truth is that the label does not consist of each particular part of it, but consists of the combination of them all”.

Observations to the same effect will be found also in In re Apollinaris Company's Trade Marks [LR (1891) 2 Ch 186] , In re Smokeless Powder Co., In re Clement and Cie [LR (1900) 1 Ch 114] and In re Albert Baker & Company and finally in the Tudor case referred to above which was decided by Sargant, J. This circumstance, however, does not necessarily mean that in such a case disclaimer will always be unnecessary. It is significant that one of the facts which give rise to the jurisdiction of the tribunal to impose disclaimer is that the trade mark contains parts which are not separately registered. It is, therefore, clear that the section itself contemplates that there may be a disclaimer in respect of parts contained in a trade mark registered as a whole although the registration of the mark as a whole does not confer any statutory right with respect to that part.”

(emphasis added)

27. In these circumstances, it would be difficult to accept that the respondents' mark be removed from the Register. Petitioner's claim is, as noted in *Ashok Chandra Rakhit* (*supra*) expansive beyond legitimate bounds and mere use of the work KWIK on one of their many sub-brands cannot give them dominance over what has already been disclaimed as that of general use. 'KWIK' being a colloquial variation of the word 'QUICK' can find its presence in many other marks as already been noted above. Reference, in this regard, is also made to the decision of the Hon'ble Supreme Court in *Parakh Vanijya (P) Ltd. v. Baroma Agro Product*, (2018) 16 SCC 632.

28. On the issue of part of a registered mark, it would be instructive to refer to decision of a Division Bench of this Court in *Vardhman Buildtech*

Pvt. Ltd. v. Vardhman Properties Ltd., 2016 SCC OnLine Del 4738,
wherein it was held as under:

“8. On a plain reading of Section 15(1), it is evident that where a proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he is permitted to apply to register the whole and the part as separate trade marks. In the present case, the respondent is the proprietor of the label/mark which includes the words ‘VARDHMAN PLAZAS’. The respondent is claiming exclusivity in respect of the word ‘VARDHMAN’. It is clear that he had the option to make an application for registering the word ‘VARDHMAN’ as a separate trade mark. Assuming that he could have had the word mark registered, it is an admitted fact that the respondent made no such application. Section 17 of the said Act makes it clear when a trade mark consists of several matters, as it does in the present case, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole. There is no dispute that the label/mark, taken as a whole, is the exclusive property of the respondent. The learned counsel for the appellants has no quarrel with this at all. The issue arises when the respondent claims exclusive right to a part of the label/mark and particularly to the word ‘VARDHMAN’. Section 17(2) is a non-obstante provision [vis-à-vis sub-section(1)], which stipulates that when a trade mark contains any part which is not the subject matter of a separate application by the proprietor for registration as a trade mark or which is not separately registered by the proprietor as a trade mark or contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered. In the present case, neither has the respondent separately registered ‘VARDHMAN’ as a trade mark nor has any such application been made. Furthermore, the word ‘VARDHMAN’ is itself of a non-distinctive character and is not only common to this trade but to several other businesses. Consequently, the registration of the label/mark which contains the words ‘VARDHMAN PLAZAS’ does not confer any exclusive right on the respondent insofar as a part of that mark, namely, ‘VARDHMAN’ is concerned.”

9. We now come to Section 28 of the said Act which deals with the rights conferred by registration. It is clear that by virtue of Section 28, the registration of a trade mark, if valid, gives to the registered proprietor of the trade mark the exclusive right to the use of the mark in relation to the goods or services in respect of which the trade mark is registered and, importantly, to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. What is important to notice is that Section 28(1) begins with the words 'subject to the other provisions of this Act'. In other words, Section 28 would have to be read as subject to Section 17 of the said Act. Consequently, in our opinion the registration of the label/mark in favour of the respondent, which includes the words 'VARDHMAN PLAZAS', does not confer an exclusive right on the respondent insofar as part of the mark, which has reference to the word 'VARDHMAN', is concerned.

10. The learned counsel for the respondent, as pointed out above, sought to take the benefit of Section 29(9) of the said Act. That provision stipulates that where 'distinctive elements' of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and the reference in Section 29 to the use of a mark is to be construed accordingly. First of all, the stress in the said provision is on the words 'distinctive elements'. Neither is 'VARDHMAN' nor the word 'PLAZAS' a distinctive element of the trade mark. The word 'VARDHMAN' has not been registered as a trade mark nor could it be because it is commonly used and, as pointed out above, is the name of Lord Mahavir. Secondly, the word 'PLAZAS' is also commonly used and cannot be appropriated by the respondent. Therefore, the distinctive elements are neither the word 'VARDHMAN' nor the word 'PLAZAS'. But, the two words taken together - 'VARDHMAN PLAZAS' - is a distinctive element of the label/mark. Thus, if the appellants were to use words 'VARDHMAN' and 'PLAZAS' in conjunction, then the respondent may have had a right to restrain them from using the same. We are, therefore, of the view that Section 29(9) of the said Act also does not come in aid of the respondent.

(emphasis added)

29. Accordingly, even in this case, even though the petitioner has a statutory right in its registered mark 'FEVIKWIK', it does not confer an exclusive right over part of the mark in 'KWIK'. Moreover, this was the express limitation imposed by the Registrar of Trademarks. Having no such exclusive right on 'KWIK' there cannot be a right of rectification against 'KWIKHEAL'. In any event, rectification sought is of the respondent's device mark which, as noted above, has distinctive dissimilarities. The petitioner cannot have monopoly over the mark 'KWIK' and all its variations. The petition for rectification has to stand on its own legs and not take the crutch of the Bombay High Court's *prima facie* findings in a suit for infringement/passing off against the respondent's earlier packaging, now superseded by a new device/packaging. The petitioner never opposed the registration of the respondent's new device, which was granted after the Bombay High Court injunction, despite the suit being still pending.

30. Accordingly, the rectification petition is dismissed as not allowed.

31. Pending applications, if any, are rendered infructuous.

32. Judgment be uploaded on the website of this Court.

(ANISH DAYAL)
JUDGE

MARCH 22, 2024/RK/ig