

OCD-13

ORDER SHEET

IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
ORIGINAL SIDE
[Commercial Division]

IA No.GA-COM/1/2024
In
IP-COM/18/2024

EMAMI LIMITED
VS
DABUR INDIA LIMITED

BEFORE:
The Hon'ble JUSTICE KRISHNA RAO
Date : July 11, 2024.

Appearance:

Mr. Ranjan Bachawat, Sr. Adv.
Mr. Debnath Ghosh, Adv.
Mr. Sanjoy Ginodia, Adv.
Mr. Shuvasish Sengupta, Adv.
Ms. Pubali Sinha Chowdhury, Adv.
Ms. Biswaroop Mukherjee, Adv.
Ms. Mini Agarwal, Adv.
... for the petitioner

Mr. Sudipto Sarkar, Sr. Adv.
Mr. J. Lal, Adv.
Mr. S. Dasgupta, Adv.
Ms. A. Mukherjee, Adv.
Mr. Sudhakar Prasad, Adv.
Mr. Pradipta Bose, Adv.
Mr. Nilankar Banerjee, Adv.
... for the respondent

The Court: Mr. Ranjan Bachawat, learned Senior Advocate, is appearing for the petitioner. Mr. Sudipto Sarkar, learned Senior Advocate, is appearing for the respondent through virtual mode.

The petitioner has filed the present application for grant of an ad interim order. The petitioner company established in the year 1974 and is a flagship company of Emami Group of Companies and is engaged in

manufacturing and marketing of health, beauty, personal care and other allied products. The petitioner owns several reputed brands/trademarks including Navratna, Dermi Cool, Himani, Vasocare, Boro Plus, Fair and Handsome, Kesh King, HE, Zandu, She Comfort, Mentho Plus and Fast Relief. Two of the most well recognized brands of the petitioner, known extensively to the members of the trade and the consumers, the talcum powder under the mark “Navratna” and the same was launched in the year 2006. The prickly heat powder under the mark “Dermi Cool” was launched in the year 1998. Dermi Cool prickly heat powder is widely used product designed to provide relief from prickly heat and associated skin irritations. The powder contains natural ingredients like menthol, neem, tulsi, tancan amla and jasadbhasma which are intended to provide anti bacterial benefits ensuring that the skin stays protected and comfortable. Navratna cool talc is another product of the petitioner and is renowned for his cooling properties and is particularly popular in hot and tropical climates.

The petitioner is a registered proprietor of the mark “Dermi Cool” and the petitioner has obtained the registration of the mark “Dermi Cool” and also in diverse labels containing the mark “Dermi Cool” in some of which, the shape and getup of the petitioner’s bottle/container also appear. The petitioner duly acquired the mark “Dermi Cool” along with the goodwill and reputation in the said mark for an aggregated sum of Rs.432 crores. In order to popularize the Mark “Dermi Cool” and the prickly heat power sold under the said mark in a container bearing the cap registered under the Designs Act 2000, the petitioner has undertaken substantial

advertisement and publicity expenses in excess of Rs.48 crores. The petitioner sold and distributed the prickly heat powder under the mark “Dermi Cool” in several variations depending on the aroma and ingredients of the product. The most popular varieties of the petitioner’s prickly heat powder under the mark “Dermi Cool” are that of “Fresh Aloe” and “Menthol Regular”. The petitioner also sells and markets cool talcum powder under the registered mark “Navratna” bearing a sea green and white colour scheme and the mark “Navratna” along with its sea green and white getup in relation to talcum powder have been continuously and extensively used by the petitioner since 2006. The petitioner has also obtained registration of the mark “Navratna” and its getup under the Trademarks Act, 1999.

The petitioner has duly registered the artistic work in relation to “Navratna Cool Talc”. The petitioner is the owner of the copyright in the artistic words/labels used by it in relation to products marketed under the trademark “Navratna”.

The petitioner has duly registered the entirety of the shape and the configuration of its bottle with cap under the Designs Act, 2000. In order to popularize the mark “Navratna” and the talcum powder sold under the mark in a container registered under the Designs Act, 2000 and the petitioner has made expenditure for advertisement and publicity to the tune of Rs.98.24 crores. The sea green and white colour scheme in relation to cool talc and distinctive bottles and cap designs as well as the green and white colour scheme in relation to the prickly heat powder and the distinctive bottle cap designs are exclusively identifiable with the

petitioner and have a high recall value and the same have acquired secondary significance and are well known.

Mr. Ranjan Bachawat, learned Senior Advocate representing the petitioner submits that recently the petitioner came to know that the respondent has purported to market its talcum powder under the mark “Cool King” and has launched television commercial and online commercial in relation to such product on its official YouTube channel on 28th June, 2024 wherein the petitioner’s product ‘Dermi Cool’ prickly heat powder and ‘Navratna Cool Talc’ powder have been shown in a bad light, as it has been sought to be conveyed that the petitioner’s products are ineffective and useless.

Mr. Bachawat submits that the respondent has also purported to launch an advertisement in print form in relation to the product under the mark “Cool King” purporting to allege in relation to the “Cool King” powder that, on an application of the same it would “defeat heat with up to 12 hours freshness and cooling”. He submits that the purported claim of the respondent is false, incorrect and without any basis and is actuated by malice and has been launched only in a purported attempt to reinforce the inflated and false claim of the respondent.

Mr. Bachawat submits that in the impugned TV Commercial and online commercial an unhappy person is shown holding petitioner’s ‘Dermi Cool’ prickly heat powder bottle/container/dispenser still looking hot and sweaty after sprinkling the Dermi Cool powder. He submits that the respondent has used the term “sadharaannahi” referring to the petitioner’s product as ordinary.

Mr. Bachawat submits that the message which is sought to be conveyed in the said advertisement is false, untrue and incorrect and actuated by malice. He submits that the petitioner has caused analysis of the formulation of the respondent's powder marketed under the brand/mark 'Dabur Cool King' as well as petitioner's powder marketed under the mark 'Navratna Maxx Cool Talc', 'Navratna Cool Talc' and 'Dermi Cool' and it has transpired that the menthol percentage for 'Dabur Cool King' is 0.47 % as compared to 'Navratna Cool Talc' having menthol content of 0.82 % as compared to 'Navratna Maxx Cool Talc' which has a menthol content of 1.08 %, as compared to 'Dermi Cool' which has a menthol content of 0.47 %.

Mr. Bachawat submits that the container/bottle so displayed in the impugned advertisement is identical or deceptively similar to the registered mark and designs of the petitioner's container adopted and applied by it for its powder under the mark "Navratna" and "Dermi Cool" and the same is unambiguously understood and registered in the minds of viewers by a simple glance of the advertisement.

Mr. Bachawat submits that TVC purports to denigrate the petitioner's intellectual property rights comprising the trademark copyright and design in relation to the mark 'Navratna' and 'Dermi Cool' and also purports to popular the same and constitute an act of infringement of the petitioner's trademark under Section 29 (8) of the Trademark Act, 1999. He submits that respondent is continuing to wrongfully disparage the petitioner's talcum and prickly heat powder manufactured and marketed under the mark 'Dermi Cool' and 'Navratna'

through deliberate, false, fraudulent and malicious misrepresentation. He submits that comparison in the impugned advertisement is not factual or correct. He submits that the impugned advertisement denigrates and discredits the petitioner's talcum and prickly heat powder and manufactured and marketed under the marks 'Dermi Cool' and 'Navratna'. Mr. Bachawat submits that the respondent has published the said advertisement with intention only for the purpose of misleading the potential customers for inducing them to purchase 'Cool King' talcum/prickly heat powder and not purchase any other powder in general and the petitioner's talcum and prickly heat powder manufactured and marketed under the mark 'Dermi Cool' and 'Navratna' in particular and by reason whereof the petitioner has suffered special damages and the sale of the relevant products of the petitioner under the marks "Dermi Cool" and "Navratna" has dipped and/or is liable to dip. He submits that the impugned advertisement has the effect of seriously debasing and tarnishing the petitioner's talcum and prickly heat powder manufactured and marketed under the marks "Dermi Cool" and "Navratna" and is a malicious attempt to erode the equity and goodwill and reputation of the petitioner in relation to talcum and prickly heat powder.

Mr. Bachawat submits that advertisements in electric media have enormous impact and the impugned advertisement seeking to show the petitioner's product in bad light would seriously affect the petitioner's goodwill and reputation which the petitioner has generated in relation to its talcum and prickly heat powder manufactured and marketed under the marks "Dermi Cool" and "Navratna" over 25 years. He submits that the

advertisement conveyed via electronic media has a higher impact as it also has outreach through social media which could defame and denigrate the products of the petitioner much more than what an advertisement can.

Mr. Bachawat representing the petitioner has relied on the judgment reported in **2005 (79) DRJ 461 (Dabur India Limited vs. Colgate Palmolive India Ltd.)** and submitted that generic disparagement of a rival product that specifically identifying and/or pinpointing the rival product is equally objectionable. He submits that clever advertisement can indeed hit the rival product without specifically referring to it.

Per contra, Mr. Sarkar, learned Senior Advocate representing the respondent submits that the petitioner before filing the suit and the present application has not issued any cease and desist notice to the respondent so as to take appropriate steps by the respondent. Mr. Sarkar submits that the respondent will remove the bottle/container from the advertisement, if this Court permits till Monday. He submits that the respondent has directed the telecast in advance and it is not possible for the respondent to immediately remove the same and it will take some time to remove the said bottle/container from the said advertisement which the plaintiff is having objection. Mr. Sarkar submits that the petitioner is having objection with regard to the container/bottle and the respondent will remove the same but the total advertisement cannot be stopped. Mr. Sarkar further submits that under Article 19(1)(a) of the Constitution of India there is a freedom of speech and the same cannot be restrained by the order of the Court.

Heard the learned counsel for the respective parties.

Perused the materials on record.

Counsel for the petitioner has handed over the container of the Dermi Cool which is wrapped with the description of the Dermi Cool. The petitioner has also been handed over a bottle/container without wrapper having no contents of the Dermi Cool and Navratna.

This Court perused the bottles and the caps of the said bottles/containers. This Court also perused the advertisement made by the respondent which contained the said container having white colour without any contents and the cap of the said bottle is similarly deceptively to the bottle and cap of the petitioner. In the advertisement of respondent, the respondent has also used the term 'sadharannahi'. It is also found that in the said advertisement it has been shown that an unhappy person is holding the petitioner's Dermi Cool powder bottle by saying still looking hot and sweaty after sprinkling the Dermi Cool powder. The petitioner has also disclosed the details wherein the respondent has published the advertisement about more than 2000 times in different media and YouTube.

In the case of ***Hindustan Unilever Limited vs. Reckitt Benckiser (India) Private Limited*** wherein the Delhi High Court has held that while saying that his goods are better than his competitors', is not permissible.

In the instant case also the respondent in the TVC has shown an unhappy person holding the petitioner's prickly heat powder bottle by saying still looking hot and sweaty after sprinkling the Dermi Cool powder. In the said TVC the respondent has also used the term 'sadharannahi'.

Considering the above facts and circumstances, this Court finds that the petitioner has made out a *prima facie* case and the balance of convenience and inconvenience in its favour and at this stage if the respondent is not restrained from using the container/bottle of “Dermi Cool” and “Navratna” and also referring the same as ‘sadharannahi’, the plaintiff will suffer irreparable loss and injury.

In view of the above, the respondent, its men, servants, agents, representatives and/or anyone claiming through the respondent is restrained from displaying and/or playing and/or airing and/or telecasting in their advertisement “Cool King” by showing the bottle/container of “Dermi Cool” and “Navratna” of the petitioner by referring the same as “sadharan” till 9th August, 2024.

The petitioner is directed to serve the copy of the plaint, application and documents to the respondent and to file affidavit on the returnable date.

List the matter on 9th August, 2024.

(KRISHNA RAO, J.)