



**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION (LODGING) NO. 37430 OF 2024
IN
COMMERCIAL IP SUIT (LODGING) NO. 37157 OF 2024**

Dr. Ashok M. Bhat ... Applicant/Plaintiff
vs.
Sandeep Udai Naraian Gupta & anr. ... Respondents/Defendants

Mr. Hiren Kamod a/w. Mr. Vinod Bhagat, Ms. Sonam Pradhan and Ms. Ishita Maheshwari, i/b. Mr. Vinod A. Bhagat for applicant/plaintiff.


Mr. Jehan Mehta a/w. Mr. Rahul Punjabi for respondent/defendant No.1.

Mr. Shon Gadgil for respondent/defendant No.2.

CORAM : MANISH PITALE, J.

DATE : 07th MAY, 2025

ORDER:

1. By these proceedings, the applicant/plaintiff is asserting its intellectual property rights in the context of its mark 'ECLAT' used in respect of cosmetic preparations like face cream, foundation, etc. It is the case of the applicant that by using the impugned mark 'ECLAT SUPERIOR' / , the contesting defendant No.1 is infringing upon the aforesaid registered trade mark of the applicant and it is also seeking to pass-off its goods as those of the applicant. Since defendant No.1 has obtained registration for its mark, the applicant is invoking the Full Bench judgment of this Court in the case of *Lupin Ltd. vs. Johnson and Johnson (2014 SCC OnLine Bom 4596)*, to claim that such registration can be demonstrated to be *ex-facie* illegal and fraudulent, which ought to shock the conscience of this Court.

2. The applicant claims user of its trade mark 'ECLAT' from the year 1935 onwards through its predecessor and copy of registration

certificate placed on record shows that such registration dates back to 16.12.1946 with user claimed since 01.01.1935. The registered mark shows that it is a label mark of the applicant and something turns on this, as defendant No.1 has emphasized that the nature of registration obtained by the applicant in its favour, indicates that the applicant may not be able to insist upon exclusivity with regard to the word/expression 'ECLAT'.

3. The applicant has placed on record pleadings and supporting documents to claim that through a deed of assignment dated 10.10.2006, the applicant is entitled to claim proprietary rights in the said trade mark 'ECLAT' and that the applicant is indeed recorded in the register of trade marks as the proprietor of the said mark. The aforesaid material does indicate that the applicant can assert its proprietary rights in respect of the said registered trade mark.

4. In order to demonstrate that the applicant has earned substantial goodwill over a period of time in the context of the aforesaid trade mark 'ECLAT' and 'ECLAT NOVA', a certificate of Chartered Accountant is placed on record to show the sales turnover figures as well as the amount spent towards advertising and sales promotion.

5. At Exhibit E is the certificate, which shows that in the year 2022-2023, the sales turnover was ₹ 37,59,048 and that the expenses towards advertising and promotion were to the extent of ₹ 8,98,233. In fact, the certificate shows that between the years 2011-2012 to 2022-2023, the cumulative sales turnover was to the tune of ₹ 1,56,91,412. The said data does indicate that the applicant appears to be continuously and commercially using the said registered trade mark on its cosmetic products for a considerable period of time and

it has indeed earned goodwill in that context.

6. The applicant has also placed on record copies of certain invoices beginning from the year 1999 onwards to show such continuous commercial use. The applicant has also placed on record at Exhibit G, opposition proceedings instituted against certain parties, who happen to use the word/expression 'ECLAT' in their respective trade marks, to highlight the fact that it has been vigilant in protecting its intellectual property rights.

7. It is the case of the applicant that in the last week of September 2020, it came across the impugned mark of the defendant No.1 'ECLAT SUPERIOR' in the form of publication of application for registration of the said trade mark in the Trade Marks Journal. The enquiries carried out by the applicant revealed that defendant No.1 had claimed in its application that it had been using the said trade mark from the year 2016 onwards.

8. In this situation, the applicant immediately moved a notice of opposition before the Trade Mark Registry, wherein defendant No.1 filed its counter-statement. It is the case of the applicant that a copy of the counter-statement was never served upon it and that the Registrar of Trade Marks proceeded with hearing on the said application of defendant No.1. The Registrar allegedly inappropriately held that the applicant had abandoned the opposition on account of non-filing of evidence and hence, registration was granted immediately to the said impugned mark of defendant No.1.

9. It is brought to the notice of this Court in the pleadings that in addition to the aforesaid opposition proceedings, the applicant had

initiated another set of opposition proceedings in respect of an additional application for registration of trade mark in Class 35 filed in October 2020 on behalf of defendant No.1, with user claimed since 31.05.2016. It is emphasized that in the said proceedings, upon defendant No.1 filing its counter-statement, the applicant had filed its evidence and that upon completion of pleadings, the matter is still pending before the Trade Mark Registry.

10. But, it is an admitted position that while the opposition proceedings in earlier application filed on behalf of defendant No.1, were treated to be abandoned and the said defendant was granted registration of its mark 'ECLAT SUPERIOR' in August 2022 itself, the applicant eventually filed an application for rectification after two years on 02.09.2024. This fact has been harped upon by defendant No.1 to claim that this could be said to be a case of acquiescence and that therefore, the applicant cannot press for interim reliefs in the present proceedings.

11. Be that as it may, according to the applicant, in this backdrop, the products of defendant No.1 were not noticed from the year 2022 till August 2024 and it was only in the last week of August 2024 that the applicant allegedly, for the first time, came across the impugned goods of defendant No.1, bearing the trade mark 'ECLAT SUPERIOR' as being sold on e-commerce websites and the applicant also came across domain name of defendant No.1 i.e. www.eclatsuperior.com. This led to initiation of the instant proceedings.


12. It is claimed that upon coming across the said impugned products on the e-commerce websites, the applicant carried out further enquiries and came across further applications filed on behalf of defendant No.1 for registration of word mark 'ECLAT SUPERIOR'

and it is specifically pleaded that the applicant intends to initiate opposition proceedings in respect of the said marks. In the instant application, the pleadings were completed and the application is taken up for hearing and disposal.

13. Mr. Kamod, learned counsel appearing for the applicant relied upon the pleadings and documents placed on record and after taking into account the defences raised on behalf of defendant No.1, made detailed submissions to press for interim reliefs.

14. It was submitted that since the applicant has registration through its predecessor, in the context of its trade mark 'ECLAT' from the year 1946 with first user from the year 1935 onwards, it is clear that the applicant and its predecessor were in the market, particularly in the cosmetic industry about 70-75 years prior to the defendant No.1 entering into the said market. It was submitted that even if the user claim of defendant No.1 from the year 2016, is to be taken into consideration, the fact that the applicant and its predecessor have been prior users of the trade mark 'ECLAT', cannot be doubted at all. On this basis, it was submitted that the applicant is entitled to claim proprietary rights and continuous commercial user of the registered trade mark 'ECLAT' since the year 1946. By referring to the registration certificate as also the copies of invoices and the sales turnover figures placed on record, it was submitted that the applicant is entitled to assert its intellectual property rights against any party that infringes upon its statutory rights as well as its common law rights.

15. The learned counsel appearing for the applicant severely criticized the stand of defendant No.1 that its mark 'ECLAT SUPERIOR' was coined and invented as a trade mark, as stated

before the Trade Mark Registry in the opposition proceedings initiated by the applicant, while taking a diametrically opposite stand before this Court by claiming that 'ECLAT' is a generic and common to trade term. It was submitted that defendant No.1 cannot claim that the word Eclat is common to trade, simply for the reason that the said defendant itself has applied for registration of its mark 'ECLAT SUPERIOR' and even the label mark , of which Eclat is indeed the leading and essential feature. It was submitted that defendant No.1 is blowing hot and cold at the same time, which cannot be permitted, as per settled position of law recognized in the judgment of this Court, in the case of *Hygiene Research Institute Private Limited vs. Chandan and Shah Trading LLP and another* (2025 SCC OnLine Bom 516).

16. It is further submitted that even if the impugned trade mark of defendant No.1 has been registered in the year 2022, the applicant is entitled to invoke the Full Bench judgment of this Court in the case of **Lupin Ltd. vs. Johnson and Johnson** (*supra*), as the very registration of the impugned trade mark can be said to be *ex-facie* illegal and fraudulent. The Registrar of Trade Marks surprisingly did not even cite the registered trade mark 'ECLAT' of the applicant in the examination report, while considering the application of defendant No.1. On this basis, it was submitted that a narrow window available for a registered trade mark to be attacked, is clearly available in the facts and circumstances of the present case. In this backdrop, the learned counsel for the applicant further specifically invoked Division Bench judgment of this Court in the case of *Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd. & anr.* (2001 SCC OnLine Bom 1176), wherein it was held that a party that applies for and obtains registration in respect of a mark, which is already on

the register of the Trade Mark Registry, without making proper enquiries, does so at its own risk and peril.

17. It was further submitted that the contention raised on behalf of defendant No.1 that the two marks ought to be compared as a whole, cannot take the case of the said defendant any further, simply for the reason that the leading and essential feature of both the marks is 'Eclat' and while making such comparison, the Court is expected to first narrow down on such a leading and essential feature. In this context, reliance was placed on the judgment of this Court in the case of *James Chadwick & Bros., Ltd. vs. The National Sewing Thread Co., Ltd.* (1951 SCC OnLine Bom 33), as also *Ultra Tech Cement Limited vs. Alaknada Cement Pvt. Ltd. and another* (2011 SCC OnLine Bom 783) and *Mauj Mobile Private Limited vs. Mohalla Tech Private Limited and others* (2023 SCC OnLine Bom 1094).

18. In the context of Section 17 of the Trade Marks Act, 1999 (hereinafter referred to as the said Act), invoked on behalf of defendant No.1, it was submitted that the defence under the said Section can be invoked, only when the portion of the trade mark being enforced by the plaintiff, is not the leading and essential feature of the label mark and that such a part can be said to be non-distinctive or common to trade. It was submitted that in the present case, the aforesaid conditions have not been satisfied by defendant No.1 and therefore, the said defence raised on behalf of defendant No.1 does not deserve consideration.

19. On the aspect of 'ECLAT' being *publici juris* or common to trade, on the ground that other parties were also using the said mark, it was submitted that the applicant, being the proprietor of the registered trade mark 'ECLAT', is at liberty to choose as to which

party to go against and merely because the applicant has not initiated proceedings against some other parties, cannot be a defence available to defendant No.1. It is further submitted that in any case, the argument pertaining to *publici juris* and common to trade, is required to be supported by detailed material, including proof of extensive use by other parties, showing data of sales, etc., for demonstrating extensive commercial use of the said mark by other parties. It is submitted that the aforesaid test is clearly not satisfied by defendant No.1 in the facts and circumstances of the present case and therefore, such a defence is not available to the said defendant.

20. On the aspect of delay and acquiescence, it was submitted that delay cannot be a ground available to defendant No.1 because the applicant is admittedly the registered proprietor of the trade mark 'ECLAT'. While asserting statutory protection, the question of delay pales into insignificance and that in any case, each instance of infringement gives a cause of action to the registered proprietor. As regards acquiescence, it was submitted that defendant No.1 had failed to show any positive act on the part of the applicant that may have encouraged it to use the impugned trade mark or that the defendant No.1 could be said to have been put into a false sense of security. It was submitted that the law laid down by the Division Bench of this Court in the case of *Torrent Pharmaceuticals vs. Wockhardt Limited and others* (2017 SCC OnLine Bom 9666), confirmed by the Supreme Court in the case of *Wockhardt Limited vs. Torrent Pharmaceuticals Limited and another* [(2018) 18 SCC 346], clearly inures to the benefit of applicant. It was submitted that even if the applicant failed to challenge the registration of trade mark 'ECLAT SUPERIOR' in favour of defendant No.1 in August 2022 and eventually, filed the rectification petition in September 2024, the

same cannot be said to be a positive act on the part of the applicant to inure to the benefit of defendant No.1 and that in any case, the other application for registration of trade mark 'ECLAT SUPERIOR' in Class 35 filed in October 2020, has been opposed by the applicant and the said proceeding is still pending before the Trade Mark Registry.

21. As regards the contention of defendant No.1, claiming that 'ECLAT' is an expression referring to "glow" and that it is a commonly used expression, it was submitted that the expression 'ECLAT' has origin in French language and that it cannot be said to be commonly used in India. In this regard, reliance was placed on judgment of this Court in the case of *Laboratories Griffon Private Limited vs. Griffon Biometrix Private Limited* (2022 SCC OnLine Bom 6613).

22. The learned counsel for the applicant was at pains to point out that the most crucial aspect in the present case is that defendant No.1 has dishonestly adopted the mark 'ECLAT SUPERIOR'. It is unimaginable that defendant No.1, being in the cosmetic industry, was completely unaware about the existence of applicant's products using the trade mark 'ECLAT' for years together. On this basis, it was submitted that a dishonest party cannot raise such a defence, to oppose grant of interim reliefs in the facts and circumstances of the present case. It was submitted that defendant No.1, by adopting the impugned trade mark, of which 'ECLAT' is the most leading and essential feature, has acted in dishonest manner with the intention to illegally ride over the substantial goodwill of the applicant and to pass-off its products as those of the applicant.

23. In this regard, it is submitted that merely because defendant No.1 claims to be having sales turnover figures much higher than the

applicant, cannot be of any significance, for the reason that if the use of impugned mark and initiation of business of defendant No.1 itself is seeped in deceit, the higher sales turnover figures cannot be a ground to resist interim reliefs. The learned counsel for the applicant then proceeded to distinguish the judgments upon which defendant No.1 has placed reliance. It is vehemently submitted that this Court ought to grant interim reliefs in favour of the applicant on the aspect of infringement as well as passing-off.

24. On the other hand, Mr. Mehta, learned counsel appearing for defendant No.1 submitted that the said defendant having registration for its trade mark 'ECLAT SUPERIOR', is an aspect that cannot be ignored by this Court. It was emphatically submitted that the facts and circumstances of the present case do not demonstrate that the applicant satisfies the extremely high benchmark set by the judgement of this Court in the case of **Lupin Ltd. vs. Johnson and Johnson** (*supra*), to grant interim reliefs against defendant No.1. It was emphasized that registration of trade mark of defendant No.1 shows that a statutory presumption arises in its favour, which cannot be said to have been dislodged by the applicant, in the facts and circumstances of the present case.

25. It is submitted that defendant No.1 placed on record numerous such examples of 'ECLAT' being used by entities in respect of products in the cosmetic industry itself, thereby showing that the applicant cannot claim exclusivity in the mark 'ECLAT'.

26. Much emphasis was placed on the trade mark registration certificate of the applicant to show that registration was obtained for a label mark, of which 'Eclat' forms only a part and it is depicted along with a sketch of mountain ranges, etc., thereby showing that

the applicant enjoys registration for its label mark as a whole and not for the word/expression 'Eclat'. On this basis, it was submitted that the applicant cannot claim exclusivity in the word/expression 'Eclat'. In this context, it was submitted that Eclat may be an expression having origin in French language. But, by extensive and prevalent use of the said expression in the cosmetic industry for considerable number of years by numerous parties, it was common to trade that 'Eclat' means "glow". By referring to a number of other entities using the word/expression 'Eclat' in their marks, within the cosmetic industry itself, it was emphasized that the applicant cannot invoke the law recognized by this Court in the case of **Laboratories Griffon Private Limited vs. Griffon Biometrix Private Limited** (*supra*), to claim any relief.

27. It is further submitted that the registration certificate issued in favour of defendant No.1 shows that the mark of the said defendant is 'ECLAT SUPERIOR' and that on an overall comparison between the two marks, there is hardly any ground for confusion. By comparing the registered label mark of the applicant with the registered trade mark of defendant No.1, it was emphasized that even if the two marks were to be kept side-by-side, there was hardly any ground for confusion and that therefore, the applicant can neither claim infringement nor passing-off, in the facts and circumstances of the present case.

28. The learned counsel for the defendant No.1 placed much reliance on the aspect of acquiescence, by highlighting the fact that while the said defendant was granted registration for its trade mark as far back as in August 2022, the rectification petition was filed two years later in September 2024 on behalf of the applicant. It was submitted that failure on the part of the applicant to file a

rectification petition, did result in the defendant No.1 being given an impression that the challenge had been given up on the part of applicant, due to which the said defendant proceeded to use the mark extensively and as on today, it is generating revenue of about 10 times higher than that of the applicant. It is submitted that this aspect ought not be ignored by this Court, as the sales turnover figures of the applicant can be said to be minuscule, as compared to those of defendant No.1. In this backdrop, the defendant No.1 claims that balance of convenience is clearly in its favour.

29. The learned counsel for defendant No.1 relied upon the judgement of this Court in the case of *Essel Propack Ltd. vs. Essel Kitchenware Ltd. and another* (2016 SCC OnLine Bom 937), on the aspect of acquiescence as well as balance of convenience. Reliance was also placed on the judgement of the Supreme Court in the case of *Laxmikant V. Patel vs. Chetanbhai Shah and another* [(2002) 3 SCC 65] and also on the judgement of the Delhi High Court in the case of *IHHR Hospitality Pvt. Ltd vs. Bestech India Pvt. Ltd.* (AIR 2013 Del 32).

30. As regards the action of passing-off, it was submitted that the three-pronged classic test has not been satisfied by the applicant and in this regard, reliance was placed on the judgement of the Supreme Court in the case of *Brihan Karan Sugar Syndicate Private Limited vs. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana* [(2024) 2 SCC 577].


31. The learned counsel for defendant No.1 also emphasized upon larger presence of the said defendant on social media platforms like Instagram, Facebook and You Tube. It was submitted that the domain name of the said defendant was created as far back as in June 2020.

On this basis, it was emphasized that the applicant cannot feign ignorance of dominance of defendant No.1 in the cosmetic industry for past many years, thereby demonstrating that initiation of the instant proceedings in the year 2024, is an aspect that needs to be taken into consideration by this Court, while considering the prayer for grant of interim reliefs.

32. It was emphasized that granting interim reliefs at this stage, could be extremely prejudicial to defendant No.1, which has created immense goodwill in its favour for the past about 9 years, as the trade mark 'ECLAT SUPERIOR' was adopted by the said defendant in the year 2016. It was emphasized that if eventually, the applicant/plaintiff is able to make out its case in the suit, this Court could consider the aspect of damages, instead of granting temporary injunctions, as claimed by the applicant in this application.

33. This Court has considered the rival submissions in the light of the material placed on record. There is no doubt about the fact that the applicant is entitled to assert its proprietary rights in its registered trade mark. The defendant No.1 has raised much controversy about the nature of the registered trade mark of the applicant, to contend that the word 'Eclat', which forms part of the registered label mark of the applicant, cannot be considered in isolation and that it ought to be considered as a whole, while comparing the same with the impugned mark of defendant No.1.

34. Even if that be so, this Court is of the opinion that the applicant has placed on record sufficient material to show that its predecessor and thereafter, the applicant itself has continuously commercially used the said trade mark from the year 1935, with registration dating back to 16.12.1946. Even as per the claims made

by the defendant No.1 before this Court, its use of the impugned trade mark 'ECLAT SUPERIOR'/  is from the year 2016, a good 70 years after registration of the applicant's mark. The applicant has also placed on record data to show invoices at least from the year 1997 with advertisements published from the year 1968 onwards in respect of its trade mark and the sales turnover figures placed on record do indicate continuous commercial use of the trade mark of the applicant. In that sense, the proprietary right leading to statutory protection and claim towards goodwill, can be said to be sufficiently established by the applicant in its favour, to press for interim reliefs in the present case. As to whether the applicant is entitled to interim reliefs or not, is a matter to be decided after taking into consideration the specific defences raised on behalf of the defendant No.1.

35. Taking into consideration the specific contention raised on behalf of defendant No.1 that the registered trade mark/label mark of the applicant must be compared as a whole with the registered trade mark of the applicant 'ECLAT SUPERIOR', it needs to be appreciated that when a composite or a label mark is the subject matter of consideration, the Court is still entitled to first ascertain as to what can be said to be the leading and essential feature of such a mark.

36. A perusal of the registered trade mark/label mark of the applicant would show that the same indeed consists of the elements other than the word 'ECLAT'. There is sketch of mountains in the background and some other features that indeed form part of what can be said to be a composite mark or label mark of the applicant. But, while determining as to what can be said to be the leading,

essential and prominent feature of the registered trade mark of the applicant, this Court finds substance in the assertion made on behalf of the applicant that the word 'Eclat' is indeed the most prominent feature.

37. In the case of *Jagdish Gopal Kamath and others vs. Lime and Chilli Hospitality Services P. Ltd.* (2013 SCC Online Bom 597), this Court has laid down the proposition that while comparing the marks, it is essential to determine the leading and essential feature and then, to carry out exercise of comparison. This is also recognized by this Court in the case of **Ultra Tech Cement Limited vs. Alaknada Cement Pvt. Ltd. and another** (*supra*) and much earlier in the case of **James Chadwick & Bros., Ltd. vs. The National Sewing Thread Co., Ltd.** (*supra*). As an objective observer, it needs to be examined as to when a consumer looks at the two marks, which feature is striking and would become the basis of forming an impression in the mind of such a consumer, with regard to the subject mark.

38. The applicant has made out a strong *prima facie* case to claim that the most essential, prominent and striking feature of the registered mark of the applicant is the word 'Eclat'. Therefore, while comparing the same with the impugned trade mark of defendant No.1, the Court will have to consider whether the impugned trade mark of defendant No.1 can be said to be identical/deceptively similar to the registered trade mark of the applicant.

39. In the case of **Mauj Mobile Private Limited vs. Mohalla Tech Private Limited and others** (*supra*), this Court had emphasized upon the necessity to compare the rival marks as a whole. But, at the same time, the necessity to dispassionately identify the most leading, essential and prominent features of the mark, cannot be ignored.

Therefore, defendant No.1 is not justified in placing emphasis on the fact that the trade mark of the applicant consists of features other than the word 'Eclat', to claim that the applicant cannot assert its rights in respect of the said word/expression.

40. A submission was also made on behalf of defendant No.1 that the products of the applicant did not show other features of its registered trade mark i.e. the sketch of mountains, etc. and therefore, the applicant is not entitled to assert its proprietary rights. But in this context, the applicant appears to be justified in placing reliance on Section 55 of the said Act, which specifies that use of a trade mark with alterations not substantially affecting its identity, can be taken into consideration and that use of the whole of a registered trade mark be deemed to be use of any trade mark being a part thereof. This Court is inclined to hold that the applicant has placed sufficient material on record to show that it has openly, continuously and commercially used the said registered trade mark itself and earlier through its predecessor for a period of more than 70 years before the defendant No.1 even came into the market.

41. Defendant No.1 also relied upon Section 17 of the said Act to claim that since the registered trade mark of the applicant consists of several matters, it is entitled to claim exclusive right to the use of the trade mark taken only as a whole and that the applicant is not entitled to claim exclusive right in matters forming only a part of the whole of the registered trade mark. In this connection, it would be necessary to appreciate that the applicant is asserting exclusive right in the most leading, essential and prominent feature of its trade mark, which is the word Eclat. It is only if this most leading, essential and prominent feature of its trade mark is non-distinctive in character and is common to trade, that the applicant would be dis-

entitled to assert its exclusive right.

42. As noted hereinabove, the word 'Eclat' in the registered trade mark of the applicant, is *prima facie* indeed made out to be the most essential, prominent and leading feature of the mark. Defendant No.1 would therefore, have to show that this feature can be either said to be non-distinctive in character or it can be said to be common to trade.

43. In order to assert that a particular word/expression is common to trade, the defendant No.1 cannot simply refer to certain other entities using the said word/expression, without placing on record extensive use of the same with cogent supporting material. A casual reference to such a feature and then an assertion that the same can be said to be common to trade or non-distinctive, cannot be permitted. This Court is of the opinion that the position of law in this regard indicates that exclusive use of such a word/expression in the public domain, must be proved by means of data showing extensive sales and other such parameters on the part of the entities active in such trade channels to demonstrate that use of such word/expression has become common to trade or *publici juris*.

44. The defendant No.1 has failed to place any such material on record in the present case. Equally, the said defendant cannot resist interim reliefs on the ground that the applicant has chosen not to proceed against other entities allegedly using the same feature, which is claimed to be the leading and essential feature of the trade mark of the applicant, for the reason that in such proceedings, defendant No.1 is supposed to justify its defence rather than raising such pleas.

45. The stand taken by defendant No.1 before the Registrar in the opposition proceedings initiated by the applicant, shows a contradiction when compared to the stand taken before this Court, while resisting interim reliefs. The record shows that defendant No.1 claimed to have coined and invented “ECLAT SUPERIOR’ as its trade mark before the Trade Mark Registry in the opposition proceedings initiated by the applicant. But, before this Court, it is claimed that the mark ‘ECLAT’ can be said to be generic and common to trade. This demonstrates the inherent contradiction in the approach adopted by defendant No.1, while asserting its stand as against exclusivity claimed by the applicant in respect of its registered trade mark.

46. The allegation regarding common to trade or *publici juris*, cannot lie in the mouth of defendant No.1, which has itself obtained registration for the trade mark ‘ECLAT SUPERIOR’ of which ‘Eclat’ is the most leading and essential feature. This amounts to blowing hot and cold at the same time and this is frowned upon by this Court in numerous orders. In the case of **Jagdish Gopal Kamath and others vs. Lime and Chilli Hospitality Services P. Ltd.** (*supra*), this Court has commented upon such situations, where the defendant claims that a mark can be said to be *publici juris* or common to trade and yet, the same party claiming exclusivity, has applied for registration of such a mark. This approach of defendant No.1 dilutes its right to successfully resist interim reliefs in the present case.

47. An attempt was made on behalf of defendant No.1 to claim that non-distinctiveness or common to trade nature of the word/expression ‘Eclat’ can be discerned, on the basis that the same is widely used in India and it is well-known that the said expression connotes ‘glow’, which is relevant for the cosmetic industry. The word

Eclat is not a part of English language and it is not seriously disputed even by defendant No.1 that the origin of the said word is from French language. This Court is unable to agree with defendant No.1 that for a common person in India, 'Eclat' would actually mean 'glow'.

48. In this context, reliance placed on the judgment of this Court in the case of **Laboratories Griffon Private Limited vs. Griffon Biometrix Private Limited** (*supra*) on the part of the applicant, is apposite. This Court has elaborately discussed how the words that may be common to other jurisdiction/countries, cannot be the basis to claim that they have become non-distinctive or *publici juris* in India. The applicant has made out a strong *prima facie* case to hold against defendant No.1 on this count also.

49. The defendant No.1 has placed much emphasis on the aspect of delay and acquiescence. It was alleged that when defendant No.1 was in public domain in India since 2016 and the applicant itself was aware about the application for registration of the impugned trade mark filed before the Trade Mark Registry as far back as in the year 2020, filing the present suit in the year 2024, shows that the interim reliefs can be rejected on the ground of delay as well as acquiescence. It was emphasized on behalf of defendant No.1 that the aspect of delay was pressed into service not to claim that the suit could be barred by limitation, but only to indicate that such an applicant/plaintiff ought not to be granted discretionary reliefs in the present case.

50. This Court is of the opinion that the aspect of delay in a situation, where the plaintiff has registration for its trade mark, pales into insignificance, as the highest statutory protection is available to

a plaintiff that approaches the Court to assert its statutory rights on the basis of registration of its trade mark. In the present case, the registration goes back to the year 1946 and this Court is therefore, unable to agree with defendant No.1 on the aspect of delay.

51. But, it is to be noted that the issue regarding acquiescence was emphasized upon by defendant No.1 to assert that in the facts and circumstances of the present case, the law laid down in the case of **Essel Propack Ltd. vs. Essel Kitchenware Ltd. and another** (*supra*), must apply.

52. At this stage, it must be noted that this Court, in a subsequent order passed in the case of *Abdul Rasul Nurallah Virjee and Jalalluddin Nurullah Virjee vs. Regal Footwear* (2023 SCC OnLine Bom 10), after analysing the effect of a Division Bench judgment in the case of **Torrent Pharmaceuticals vs. Wockhardt Limited and others** (*supra*), found that the position of law laid down in the case of **Essel Propack Ltd. vs. Essel Kitchenware Ltd. and another** (*supra*), is no longer good law. Therefore, the said contention raised on behalf of defendant No.1 deserves to be rejected.

53. It is to be noted that the Division Bench of this Court, in the case of **Torrent Pharmaceuticals vs. Wockhardt Limited and others** (*supra*), laid down that for a defendant to successfully resist reliefs on the ground of acquiescence, it must be shown that the plaintiff indulged in positive acts to lull the defendant into a sense of security, which resulted in the defendant proceeding to use its mark and in the process, incur expenses for building its brand and goodwill. It was specifically laid down that merely because the plaintiff fails to take any steps to assert its statutory rights or tardiness on the part of the plaintiff, cannot be a ground to claim acquiescence. The said

judgment of the Division Bench of this Court was upheld by the Supreme Court in the case of **Wockhardt Limited vs. Torrent Pharmaceuticals Limited and another** (*supra*) and therefore, this Court finds that defendant No.1 cannot claim acquiescence on the part of the applicant, in the facts and circumstances of the present case.

54. A further analysis of the said aspect shows that according to defendant No.1, failure on the part of applicant to file a rectification proceeding as regards registration of the impugned trade mark of defendant No.1 for a long period of two years, despite being aware of the order of the Registrar of Trade Marks, was an act that could be said to be a positive act, which gave an impression to the defendant No.1 that the applicant did not intend to assert its statutory rights.

55. The said contention of defendant No.1 cannot be accepted, simply for the reason that the failure to challenge the registration of the impugned trade mark of defendant No.1 for a period of about two years, in itself cannot be said to be a 'positive act' on the part of the applicant. At worst, it can be said to be an aspect of tardiness. Even otherwise, record shows that the applicant had initiated another opposition proceeding against an application filed by defendant No.1 for the impugned trade mark in October 2020. In the said opposition proceedings initiated by the applicant, it is an admitted position that evidence has been placed on record before the Registrar, the pleadings are complete and that the said proceeding is still pending for consideration. In other words, during the period when the applicant failed to challenge the registration of the trade mark of defendant No.1 between the years 2022 and 2024, it was and is still pursuing its opposition in a parallel proceeding before the Registrar. This indicates positive act on the part of the

applicant to assert its statutory right and to oppose the claims made by defendant No.1 in respect of the impugned trade mark. In such a situation, it would be a far cry to hold that acquiescence can be a ground to deny consideration of interim reliefs to the applicant.

56. Since the impugned trade mark of defendant No.1 is indeed on the register of Trade Mark Registry, in order to successfully claim interim reliefs, the applicant is required to satisfy the narrow scope available in such a situation, as per the law laid down by the Full Bench judgment of this Court in the case of **Lupin Ltd. vs. Johnson and Johnson** (*supra*). In the said judgment, it was laid down that the Court would not be powerless to grant interim reliefs on the aspect of infringement, when the rival trade mark is also registered. But, the plaintiff, in such a case, would have to satisfy a very high threshold. It was laid down that the plaintiff would have to show that the registration of the trade mark of the defendant itself is *ex-facie* illegal, fraudulent or that it shocks the conscience of the Court.

57. In the present case, this Court finds that the impugned trade mark of defendant No.1 is 'ECLAT SUPERIOR', of which 'Eclat' is clearly the leading and essential feature. It is found that before the Trade Mark Registry, the mark of applicant, of which the leading and essential feature is also 'Eclat', was not even cited and it can be said that the registration itself is *prima facie* found to be illegal and fraudulent. In that sense, a strong *prima facie* case is made out to claim that the registration ought to shock the conscience of the Court.

58. It is a matter of record that the trade mark of the applicant is on the register of the Trade Marks Registry since the year 1946 and yet, the Registrar proceeded to grant registration to the impugned

trade mark of defendant No.1. It is also to be noted that the Trade Mark Registry treated the opposition proceeding initiated by the applicant as abandoned and immediately granted registration to the impugned trade mark of defendant No.1. These are the factors that cannot be ignored by this Court, while considering the entitlement of the applicant for grant of interim reliefs. This Court is of the opinion that the applicant has been able to satisfy the requirements under the said Full Bench judgment of this Court in the case of **Lupin Ltd. vs. Johnson and Johnson** (*supra*), to press for interim reliefs, despite registration of the impugned trade mark of defendant No.1.

59. This is not to be taken as a comment on the pending rectification proceedings or opposition proceedings initiated by the applicant in the other application filed on behalf of defendant No.1 for registration of the impugned trade mark. The Registrar, in those proceedings, would certainly proceed on merits. But, for the purposes of ascertaining as to whether the applicant is entitled to interim reliefs, this Court, at the interim stage, has examined the material and it is found that the threshold specified in the Full Bench judgment of this Court in the case of **Lupin Ltd. vs. Johnson and Johnson** (*supra*), can be said to be satisfied.

60. This Court, in the facts and circumstances of the present case, is not rendered powerless to even consider the interim reliefs claimed by the applicant, in the context of infringement of its registered trade mark. In this backdrop, when this Court considers the two marks, it is found that the impugned trade mark of defendant No.1 'ECLAT SUPERIOR' can be *prima facie* said to be deceptively similar to the registered trade mark of the applicant. The manner in which defendant No.1 is depicting its own mark on the impugned products, does show that the statutory rights being enjoyed by the applicant

and its predecessor from the year 1946 onwards, can be said to be infringed upon and hence, a strong *prima facie* case is made out in favour of the applicant.

61. It is a settled position of law, as recognized by the Supreme Court in the case of *Ruston & Honsby Ltd. vs. Zamindara Engineering Co.*, [(1969) 2 SCC 727], that merely by adding a word, prefixing or suffixing the same to the most leading and essential feature of the trade mark, cannot lead to a successful defence on the part of defendant No.1 in resisting interim reliefs. In the present case, the word Superior has been merely added to the word 'Eclat', which is indeed the most leading, essential and prominent feature of the registered trade mark of the applicant, thereby indicating that on this count also, the defence of defendant No.1 must fail.

62. In this context, the judgment of the Supreme Court in the case of *M/s. Power Control Appliances and others vs. Sumeet Machines Pvt. Ltd.* [(1994) 2 SCC 448] becomes relevant, for the reason that it is indicated therein that there can be only one trade mark on the Register and it cannot have two origins. In the present case, the applicant has been able to make out a strong *prima facie* case to assert its proprietary rights, in respect of the registered trade mark of which 'Eclat' is clearly the most leading and essential feature. A comparison of the rival products makes it clear that the product of defendant No.1 bears the mark 'ECLAT' prominently, which, even on a cursory reading, shows an attempt on the part of defendant No.1 to come as close as possible to the most leading, essential and prominent feature of the registered trade mark of the applicant 'ECLAT'.

63. On the aspect of passing-off and balance of convenience between the parties, an attempt was made on the part of defendant No.1 to claim that over a period of time during which defendant No.1 has entered the market, its sales turnover has overtaken that of the applicant by a large measure. It was emphasized that the sales turnover of defendant No.1 was 10 times higher than that of the applicant and therefore, the aspect of passing-off and balance of convenience, ought to be held in favour of defendant No.1. In this regard, reliance was sought to be placed on the order of the Delhi High Court in the case of **IHHR Hospitality Pvt. Ltd vs. Bestech India Pvt. Ltd.** (*supra*).

64. This Court is of the opinion that for ascertaining as to whether the applicant has made out a *prima facie* case with regard to the action of passing-off, the classic three-pronged test recognized by the Supreme Court in various judgments, including in the case of *S. Syed Mohideen vs. P. Sulochana Bai* [(2016) 2 SCC 683], needs to be applied to the facts of the case. The three-pronged test pertains to existence of goodwill/reputation of the applicant/plaintiff in its trade mark, misrepresentation by the defendant of such a mark, which causes or is likely to cause injury or damages to the applicant/plaintiff.

65. In the present case, the applicant has placed on record positive material to show its use of the registered trade mark from the year 1935 and in any case, at least from the year 1997, as invoices for the said year have been placed on record. In fact, advertisements of the year 1968 are also on record to support such a claim. The sales turnover figures show that over the years, the applicants have been openly, continuously and commercially using its trade mark, as its products have continuously been in the market for a long period of

time. A strong *prima facie* case is made out by the applicant in respect of established goodwill/reputation.

66. In the light of the observations made hereinabove, the applicant has also made out a strong *prima facie* case in its favour to claim that defendant No.1 is misrepresenting the mark of the applicant as its own. This Court is further of the opinion that such a misrepresentation is causing and in any case, is likely to cause injury and damage to the applicant. Therefore, the applicant having *prima facie* satisfied the three-pronged test, interim relief in the context of the action of passing-off must follow.

67. The observations made hereinabove also indicate that it is unbelievable that the defendant No.1 was completely unaware about the presence of the applicant in the cosmetic industry and its use of 'Eclat' as the most essential, prominent and striking feature of its registered trade mark. The judgement of the Division Bench of this Court in the case of **Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd. & anr.** (*supra*), shows that when a party applies for registration of its mark, it is supposed to carry out a reasonable enquiry in the register of the Trade Mark Registry, to ascertain whether an identical/similar mark is already on the register. If such a party fails to carry out a reasonable enquiry, it does so at its own risk. It can be said that defendant No.1, while applying and obtaining registration for its trade mark, took such a risk at its own peril. This also leads to a *prima facie* conclusion about dishonesty on the part of defendant No.1 in adopting the impugned trade mark.

68. This Court is of the opinion that in such a situation, unless interim reliefs, as claimed by the applicant, are granted, it will continue to suffer grave and irreparable losses, thereby demonstrating

that the balance of convenience lies in the favour of the applicant.

69. On the question of balance of convenience, the defendant No.1 relied upon the said order of Delhi High Court in the case of **IHHR Hospitality Pvt. Ltd vs. Bestech India Pvt. Ltd.** (*supra*). But, the facts therein are distinguishable, for the reason that the subject word/expression, which forms part of the trade mark, was held to be *publici juris* or descriptive and in that context, comparative sales figures were taken into consideration by the Court to reach a conclusion against the plaintiff.

70. In the present case, this Court has, in fact, held that the contention regarding *publici juris* and common to trade raised by defendant No.1 is unacceptable. Further, this Court finds that if the very adoption of the impugned trade mark is *prima facie* found to be dishonest, it cannot lie in the mouth of defendant No.1 that since its sales turnover is far higher than that of the applicant/plaintiff, interim reliefs should be denied.

71. If such a contention is accepted, it would pave the way for big players in the market to identify a particular trade channel of consumer category, proceed to dishonestly infringe a trade mark and pump in sufficient financial resources to flood the market with the product bearing the impugned trade mark and then, turn around to say that due to lower sales figures of the proprietor of such a registered trade mark, balance of convenience should be held in favour of such a party, to deny interim reliefs. This Court is unable to accept such a proposition and therefore, defendant No.1 must fail on the said count also.

72. Since this Court has not accepted the aforesaid defences raised on behalf of defendant No.1 and it is found that the applicant has been able to make out a strong *prima facie* case as regards statutory rights as well as common law rights, the reliefs claimed in the interim application deserve to be granted.

73. In view of the above, the interim application is allowed in terms of prayer clauses (a) to (d), which read as follows:

- “(a) pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor/partners, servants, agents, distributors, assignees, stockists and all those connected with the Defendants in their business be restrained by an order and temporary injunction of this Hon'ble Court from manufacturing, marketing, distributing, selling and/or using in any manner whatsoever in relation to their face cream, shampoo, serum, toner and such other like cosmetic goods used in the cosmetic industry, the impugned mark E'CLAT/E'CLAT superior or any mark identical with and/or deceptively similar to the Plaintiff's trade mark ECLAT, so as to infringe upon the Plaintiff's said trade mark registered under No. 126504 in class 03;
- (b) pending the hearing and final disposal of the suit, the Defendant No. 1 by themselves, their proprietor, servants, agents, distributors, assignees, stockists and all those connected with the Defendant No. 1 in their business be restrained by an order and temporary injunction of this Hon'ble Court from marketing, distributing, selling and/or using in any manner whatsoever in relation to their face cream, shampoo, serum, toner and such other like cosmetic goods used in the cosmetic industry, the impugned domain name/website www.eclatsuperior.com or any domain name/website identical with and/or deceptively similar to the Plaintiff's trade mark ECLAT, so as to infringe upon the Plaintiff's said trade mark registered under No. 126504 in class 03;

- (c) that pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor/partners, servants, agents, distributors, assignees, stockists and all those connected with the Defendants in their business be restrained by an order and temporary injunction of this Hon'ble Court from manufacturing, marketing, distributing, selling and/or using in any manner whatsoever in relation to their face cream, shampoo, serum, toner and such other like cosmetic goods used in the cosmetic industry, the impugned mark E'CLAT /E'CLAT superior or any mark identical with and/or deceptively similar to the Plaintiff's distinctive and prior used trade mark ECLAT, so as to pass off their goods and business as and for those of the Plaintiff or in some way connected or associated therewith;
- (d) pending the hearing and final disposal of the suit, the Defendant No. 1 by themselves, their proprietor, servants, agents, distributors, assignees, stockists and all those connected with the Defendant No. 1 in their business be restrained by an order and temporary injunction of this Hon'ble Court from marketing, distributing, selling and/or using in any manner whatsoever in relation to their face cream, shampoo, serum, toner and such other like cosmetic goods used in the cosmetic industry, the impugned domain name/website www.eclatsuperior.com or any domain name/website identical with and/or deceptively similar to the Plaintiff's distinctive and prior used trade mark ECLAT, so as to pass off their goods and business as and for those of the Plaintiff or in some way connected or associated therewith;”

(MANISH PITALE, J)

Priya Kambl

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