

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

+ **CS (COMM) No.890/2018**

% **Reserved on: 18th May, 2018**
Pronounced on: 25th May, 2018

CHRISTIAN LOUBOUTIN SAS Plaintiff
Through: Mr. Sudhir Chandra, Senior
Advocate with Ms. Udit Patro,
Advocate and Mr. Shamim
Nooreyedhan, Advocate.

versus

ABUBAKER & ORS. Defendants

CORAM:
HON'BLE MR. JUSTICE VALMIKI J. MEHTA

To be referred to the Reporter or not? **YES**

VALMIKI J. MEHTA, J (ORAL)

1. The plaintiff company Christian Louboutin SAS has filed this suit seeking reliefs of injunction against the infringement of its trademark, passing off, damages etc. Plaintiff has sought the reliefs as prayed for in the suit, *vide* para 54 (a) of the plaint, by pleading exclusive ownership of its registered trademarks 'RED SOLE' under the registration nos.1922048, 2341890 and 2341891 granted by the Registrar of Trademarks. The registration granted, and with respect to

which reliefs are claimed in the suit, being 'RED SOLE' is not a wordmark but it is literally a red colour shade applied to the soles of the ladies footwear manufactured by the plaintiff.

2. The relevant registrations with respect to which plaintiff claims exclusive ownership are contained in para 20 of the plaint and this para is scanned below:-

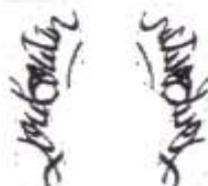
REGISTERED TRADEMARKS OF THE PLAINTIFF

20. Apart from the rights vested with the Plaintiff in common law, the Plaintiff also has statutory rights over several of its trademarks in India, including the 'RED SOLE' trademark. A list of the Plaintiff's registrations for its various Christian Louboutin marks is provided below:

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Trademark	Reg. No.	Date	Classes
	1922048	15.02.2010	25
	2341890	01.06.2012	03
	2341891	01.06.2012	14
CHRISTIAN LOUBOUTIN	1644051	22.01.2008	18 & 25
	1839047	13.07.2009	18 & 25

			
	2341895	01.06.2012	03
	2341896	01.06.2012	14
	1931553	05.03.2010	25

3. The plaintiff pleads that the defendants are carrying on its business at two outlets located at Mumbai. The defendant no.3/entity M/s Veronica is owned by the defendant nos.1 and 2. Since the defendants are selling shoes by colouring red the soles of their shoes, therefore it is the case of the plaintiff that there results infringement of the registered trademarks of the plaintiff being red colour applied to the soles of the ladies footwear as stated in paras 20 and 21 of the

plaint read with para 54(a) prayer clause. Plaintiff also pleads that defendants are passing off their footwear as that of the plaintiff because of use of the red colour in the soles of the ladies footwear sold by the defendants and that there is passing off, notwithstanding that the defendants trademark for its shoes is a wordmark VERONICA. These aspects with respect to the infringement by the defendants and comparison to the trademarks of the plaintiff, as also the aspect of passing off is stated by the plaintiff in paras 35(iv) & 35(v) of the plaint, and which paras read as under:-

“

iv) A visit to the Defendant No. 3's store at **Bandra West** on April 18, 2018 revealed that the said outlet had in stock around 40-50 pairs of footwear/ladies' shoes bearing the Plaintiff's well-known 'RED SOLE' trademark. The investigator on the said visit was able to purchase a sample of infringing 'RED SOLE' shoes from the said outlet of the Defendant No. 3 for Rs. 800/- against a cash memo and also procure a business card from the said shop. The sample product purchased from the said outlet of the Defendant No. 3 by the Investigator (shown in the below table) bear the Plaintiff's 'RED SOLE' trademark:

Outlet from which the sample was purchased	Photographs of the infringing 'RED SOLE' shoes purchased by the Investigator	Plaintiff's Registered Trademark being infringed



- v) Further, the investigator also visited the premises of the second outlet of the Defendant No. 3 located at Vile Parle West, on April 18, 2018. Upon this visit the said outlet was found to have on display a stock of around 40-50 pairs of footwear/ladies' shoes bearing the Plaintiff's well-known 'RED SOLE' trademark. The investigator was able to purchase a sample of infringing 'RED SOLE' shoes from the said outlet of the Defendant No. 3 for Rs. 500/- against a cash memo and was also able to procure a business card from the said shop. The sample product purchased from the said outlet of the Defendant No. 3 by the Investigator (shown in the below table) bear the Plaintiff's 'RED SOLE' trademark:

<p>Outlet from which the sample was purchased</p>	<p>Photographs of the infringing 'RED SOLE' shoes purchased by the Investigator</p>	<p>Plaintiff's Registered Trademark being infringed</p>
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4. In view of the causes of action pleaded in the plaint, the plaintiff seeks the following reliefs:-

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PRAYER

54. It is humbly prayed before this Hon'ble Court that it may be pleased to grant: -

- a) An order for permanent injunction restraining the Defendants, their partners, if any, officers, servants, agents, distributors, stockists and representatives from manufacturing, selling and/or offering for sale, advertising, directly or indirectly dealing in (either through their physical shop/s or online, including through social media or any e-commerce platforms, or any manner whatsoever), footwear including ladies shoes or any other goods bearing the

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Plaintiff's registered trademark no. 1922048, for the 'RED SOLE' trademark

i.e. , or any similar trademark amounting to an infringement of the said registered trademark of the Plaintiff as also the other registered trademarks of the Plaintiff as mentioned in paragraph 21 of the plaint.

-) An order for permanent injunction restraining the Defendants, their partners, if any, their officers, servants, agents, distributors, stockists and representatives from manufacturing, selling and/or offering for sale, advertising, directly or indirectly dealing in footwear including ladies shoes bearing the 'RED SOLE'

trademark *i.e.* , or any similar trademark or doing any other act amounting to passing off of the Defendants' products as those of the Plaintiff, through any of its shops, social media platform or in any manner whatsoever;

-) An order for permanent injunction restraining the Defendants, their principal officers, servants, agents, their affiliates, subsidiaries, distributors, and all others acting for and on their behalf from using trademarks, which are identical or deceptively or confusingly similar to the Plaintiff's registered trademarks,

including the 'RED SOLE' trademark *i.e.* , so as to misrepresent the quality/ origin of their goods and from taking unfair advantage of the Plaintiff's reputation and goodwill in the said trademarks or any similar trademark amounting to unfair competition, and or causing dilution of the Plaintiff's

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abovementioned trademarks;

- d) An order for delivery up to the Plaintiff by the Defendants of all finished and unfinished materials and accessories, packaging, labels, dies, blocks, stationery and other material bearing any of the Plaintiff's trademarks or bearing any other mark(s)/logo/device similar thereto, for the purpose of erasure/destruction;
- e) An order requiring the Defendants to render accounts of all sums earned by the Defendants through their unlawful and infringing activities referred to in this plaint and a decree for the same in favour of the Plaintiff and against the Defendants; or
- f) An order for damages to the sum total of Rs. 1,00,00,000/- in favour of the Plaintiff and against the Defendants on account of loss of sales, reputation and goodwill of the Plaintiff's trademarks caused by the activities of the Defendants and a decree for the said amount be passed in favour of the Plaintiff;
- g) An order declaring the Plaintiff's "RED SOLE" trademarks as enumerated in paragraph 21 of the plaint as well-known trademarks.
- h) An order for costs of the proceedings;

AND

Any further order as this Hon'ble Court may deem fit and proper in the facts and circumstances of the case.



5. This suit is coming up for admission and summons have yet to be issued to the defendants in the suit. The subject suit is a commercial suit filed under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015. On the proposition being put by this Court to the Learned Senior Counsel for the plaintiff that no legal cause of action can be said to be made out as per the averments of the plaint for the plaintiff to be granted reliefs claimed in the suit, Learned Senior Counsel for the plaintiff has in response placed reliance upon a Division Bench judgment of this Court in the case of ***Bright Enterprise Private Ltd. & Anr. Vs. MJ Bizcraft LLP & Anr.*** in RFA(OS)(COMM) No. 8/2016 decided on 4.1.2017 to argue that this Court should not act as an adversary and the present commercial suit cannot be dismissed at this stage by holding that there is no real prospect for the plaintiff to succeed inasmuch as this plea under Order XIII A CPC as applicable to commercial suits can only be taken by the defendants after they are served in the suit, and the defendants move such an application under Order XIII A CPC for dismissing the suit on the ground that plaintiff has no real prospect to succeed, with a 30 days notice being given in

terms of the application under Order XIII A CPC to the plaintiff to contest this issue. The relevant paras of the judgment in the case of ***Bright Enterprise Private Ltd. (supra)*** which are relied upon on behalf of the plaintiff are paras 17 to 24 and which paras read as under:-

“17. From the above and particularly upon examining the provisions of Section 27 and Order V Rule 1(1) CPC, it is evident that when a suit is regarded as having been ‘duly instituted’, a summons may be issued to the defendant. The use of the expression ‘duly instituted’ has to be seen in the context of the provisions of Orders VI and VII of the CPC. In the present matter, it is nobody’s case that the suit had not been duly instituted in the sense that it did not comply with the requirements of Order VI and VII CPC. It is neither a case of return of a plaint under Order VII Rule 10 nor a case of rejection of a plaint under Order VII Rule 11 CPC. The present case is one of dismissal of the suit itself on merits. Therefore, the only thing that needs to be examined is whether the Court had a discretion to issue or not to issue summons given that the suit had been duly instituted. In our view, the use of the word ‘may’ does not give discretion to the Court and does not make it optional for it to issue summons or not. This is further fortified by the fact that the first proviso to Order V Rule 1(1) itself gives a situation where summons must not be issued and that happens when a defendant appears at the presentation of the plaint and admits the plaintiff’s claim. Therefore, in such a situation, there is no requirement for issuance of summons and that is why the word ‘may’ has been used in Order V Rule 1(1). In all other cases, when a suit has been ‘duly instituted’ and is not hit by either Order VII Rule 10 or Order VII Rule 11 CPC, summons has to be issued to the defendant.

18. In the present case, the learned Single Judge has neither returned the plaint under Order VII Rule 10 nor rejected the plaint under Order VII Rule 11 CPC. Therefore, it was incumbent upon the learned Single Judge to have issued summons to the respondents /defendants, particularly because the respondents/defendants had not appeared at the time of presentation of the plaint and did not admit the claim of the appellants / plaintiffs. The Rule of audi alteram partem is embedded in Order V Rule 1 sub-rule (1) read with Section 27 CPC.

19. We may also point out that there is a clear distinction between ‘return of a plaint’, ‘rejection of a plaint’ and ‘dismissal of a suit’. These three concepts have different consequences. A dismissal of a suit would

necessarily result in a subsequent suit being barred by the principles of res judicata, whereas this would not be the case involving ‘return of a plaint’ or ‘rejection of a plaint’. What the learned Single Judge has done is to have dismissed the suit of the appellants/plaintiffs at the admission stage itself without issuance of summons and this, we are afraid, is contrary to the provisions of the statute.

20. Apart from this, we are of the view that the learned Single Judge has gone wrong in invoking the provisions of Order XIII A CPC for rendering a summary judgment. It is true that Rule 3 of Order XIII A CPC empowers the Court to give a summary judgment against a plaintiff or defendant on a claim if it considers that – (a) the plaintiff has no real prospect of succeeding on the claim or the defendant has no real prospect of successfully defending the claim, as the case may be; and (b) there is no other compelling reason why the claim should not be disposed of before recording of oral evidence. But, in our view, this power can only be exercised upon an application at any date only after summons have been served on the defendant and not after the Court has framed issues in the suit. In other words, Order XIII A Rule 2 makes a clear stipulation with regard to the stage for application for summary judgment. The window for summary judgment is after the service of summons on the defendant and prior to the Court framing issues in the suit.

21. The provisions relating to summary judgment which enables courts to decide claims pertaining to commercial disputes without recording oral evidence are exceptional in nature and out of the ordinary course which a normal suit has to follow. In such an eventuality, it is essential that the stipulations are followed scrupulously otherwise it may result in gross injustice. As pointed out above, a specific period of time has been provided during which an application for summary judgment can be made. That period begins upon the service of summons on the defendant and ends upon the court framing issues in the suit. Even if we were to accept, which we do not, the argument of the respondents that the Court had suo moto powers to deliver summary judgment without there being any application, those powers also would have to be exercised during this window, that is, after service of summons on the defendant and prior to framing of issues. In addition to this, we also reiterate that, in our view, a summary judgment under Order XIII A CPC is not permissible without there being an appropriate application for summary judgment. The contents of an application for summary judgment are also stipulated in Rule 4 of Order XIII A. The application is required to precisely disclose all material facts and identify the point of law, if any. In the event, the applicant seeks to rely on any documentary evidence, the applicant must include such documentary evidence in its application and identify the relevant content of such documentary evidence on which the applicant relies. The application must also state the reason why there are no real prospects of succeeding or defending the claim, as the case may be.

22. Rule 4(2) of Order XIII A also requires that where a hearing for summary judgment is fixed, the respondent must be given at least thirty days' notice of the date fixed for the hearing and the claim that is proposed to be decided by the Court at such hearing. Rule 4(3) of Order XIII A makes provision which enables the respondents to file a reply within the stipulated time addressing the matters set forth in clauses (a) to (f) of the said sub-rule. In particular, the reply of the respondent ought to precisely disclose all the material facts and identify the point of law, if any, and the reasons why the relief sought by the applicant for summary judgment should not be granted. Just as in the case of the applicant, the respondent is also given the opportunity to rely upon documentary evidence in its reply which must be included in the reply and the relevant content identified. The respondent's reply is also required to give reason as to why there are real prospects of succeeding on the claim or defending the claim, as the case may be. Importantly, the reply must also concisely state the issues that should be framed for trial and that it must identify what further evidence would be brought on record at trial that could not be brought on record at the stage of summary judgment. The reply should also state as to why in the light of the evidence or material on record, if any, the Court should not proceed to summary judgment.

23. From the provisions laid out in Order XIII A, it is evident that the proceedings before Court are adversarial in nature and not inquisitorial. It follows, therefore, that summary judgment under Order XIII A cannot be rendered in the absence of an adversary and merely upon the inquisition by the Court. The Court is never an adversary in a dispute between parties. Unfortunately, the learned Single Judge has not considered the provisions of Order XIII A CPC in this light.

24. In view of the discussion above, since no summons had been issued and obviously no application had been filed by the respondents for a summary judgment, the learned Single Judge could not have dismissed the suit invoking the provisions of Order XIII A CPC.”

6.(i) In my opinion, the contention urged by the Learned Senior Counsel for the plaintiff by placing reliance upon the judgment of the Division Bench of this Court in ***Bright Enterprise Private Ltd.'s*** case (*supra*) is a misconceived one because this Court is not proceeding under Order XIII A CPC, but this Court is proceeding by

applying the provision of Order XII Rule 6 CPC. The provision of Order XIII A CPC is an additional provision applicable to commercial suits filed in commercial courts thereby entitling dismissal of a suit inspite of existence of disputed questions of fact on the ground that plaintiff has no real prospect of succeeding, but existence and applicability of Order XIII A CPC does not take away the existence and application of Order XII Rule 6 CPC. This Court is not hearing the lack of maintainability of the suit on the ground that the plaintiff has no “real prospect” of succeeding as stated under Order XIII A CPC as applicable to commercial cases and that trial will be required on disputed questions of fact, but the lack of maintainability of the suit on the ground of lack of merits in the suit and for it to be dismissed on the ground that the suit plaint even if is taken as completely correct with respect to its averments of the causes of action pleaded i.e even if the contents of the plaint are deemed to be correct, yet a legal cause of action is not made out and consequently this Court by applying Order XII Rule 6 CPC is entitled to dismiss the suit at this stage itself without issuing of summons in the suit. A decree is defined under Section 2(2) CPC to include a dismissal of a suit and therefore Order

XII Rule 6 CPC can be invoked by the Court for dismissal of the suit even without issuing of summons to the defendants. I really fail to understand that when the Court put a proposition to the plaintiff that the suit is not maintainable and the same is liable to be dismissed inasmuch as even if the contents of the plaint are taken to be correct still no legal cause of action is made out for granting of the reliefs claimed in the suit, then how by putting such a proposition would the Court become an “adversary”. This argument of the plaintiff in my opinion is a completely misconceived one, and in fact is raised only as an attempt to get summons issued in the suit, although the suit plaint does not make out a legal cause of action for grant of the reliefs prayed. This argument is therefore rejected that the suit cannot be dismissed without issuing of summons, because, the Court can do so by invoking and applying Order XII Rule 6 CPC.

(ii) Also, it is not necessary that a Court can only apply Order VII Rule 11 CPC and reject the plaint when it discloses no cause of action, because, there would be many situations which may though fall under Order VII Rule 11 CPC may yet also fall under Order XII Rule 6 CPC, and once that is so, the Courts are surely not prohibited from

dismissing the suit at the threshold by calling in aid Order XII Rule 6 CPC. No provision of law has been shown to this Court, contrary to Order XII Rule 6 CPC, that where the suit plaint does not disclose any legal cause of action for granting the reliefs claimed in the suit, then why the suit cannot be dismissed by applying Order XII Rule 6 CPC.

(iii) In view of the above reasoning, the judgment in the case of *Bright Enterprises Private Ltd. (supra)* relied upon by the plaintiff does not help the plaintiff because that judgment dealt with the issue that the ingredient of “real prospect” contained in Order XIII A CPC applicable to commercial suits is to be invoked only by the defendant and after the defendant is served the summons of the suit, whereas in the present case this Court is not proceeding under Order XIII A CPC but it is proceeding under Order XII Rule 6 CPC, and which latter provision applies to every suit filed in a civil court including a commercial suit filed under the Commercial Courts Act.

7. Let us now therefore examine as to whether the suit plaint makes out a cause of action as required by law i.e whether taking the contents of the plaint as correct whether there exists a legal entitlement in the plaintiff to claim the reliefs as prayed in the suit. In

order to decide this aspect the following provisions of the Trade Marks Act, 1999 would be relevant:-

“**Section 2(m)** "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or **combination of colors** or any combination thereof.

Section 2(zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and **combination of colors**, and-

(i) in relation to Chapter XII (other than section 107), a registered trade mark or mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark, and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate to a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

Section 9. Absolute grounds for refusal of registration.- (1) The trade marks -

(a) Which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person.

(b) Which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

(c) Which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Shall not be registered :

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

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xxxxx

xxxxx

Section 29. Infringement of registered trade marks. (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a

mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of-

(a) its identify with the registered trade mark and the similarity of the goods or services covered by such registered trade mark or,

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark, or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which-

(a) is identical with or similar to the registered trade mark, and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered, and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name is his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he-

(a) affixes it to goods or the packaging thereof,

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark.

(c) imports or exports goods under the mark, or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labeling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising-

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters, or
- (b) is detrimental to its distinctive character, or
- (c) is against the reputation of the trade mark

(9) Where the distinctive elements of a registered trade mark consists 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 reference in this section to the use of a mark shall be construed accordingly.

Section 30: Limits on effect of registered trade mark.- (1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use-

- (a) is in accordance with honest practices in industrial or commercial matters, and
- (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

(2) **A registered trade mark is not infringed where-**

(a) **the use in relation to goods** or services **indicates** the kind, quality, quantity, intended purposes, value, geographical origin, the time of production of goods or rendering of services or other **characteristics of goods** or services.

(b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place of country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

(c) the use by a person of a trade mark-

(i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk or which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and user conforming to the permitted use has applied to the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark, or

(ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark is to

indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark.

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be,

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

(3) Where the goods bearing a registered trade mark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person or by a person claiming under a through him is not infringement of a trade by reason only of-

(a) the registered trade mark having been assigned by the registered proprietor to some other person, after the acquisition of those goods, or

(b) the goods having been put on the market under the registered trade mark by the proprietor or with his consent.

(4) Sub-section (3) shall not apply where there exists legitimate reasons for the proprietor to oppose further dealing in the goods in particular, where the condition of the goods, has been changed or impaired after they have been put on the market.

Section 31. Registration to be prima facie evidence of validity.-(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

(2) In all legal proceeding as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

Section 32. Protection of registration on ground of distinctiveness in certain cases.- Where a trade mark is registered in breach of sub-section (1) of section 9, it shall not be declared invalid if, no consequence of the use which has been made it, it has after registration and before commencement of any legal proceedings challenging the validity of such

registration, acquired a distinctive character in relation to the goods or services for which it is registered.” (emphasis added)

8.(i) Firstly it is seen that the word trademark consists of two words, i.e trade and mark. It is because a mark is used in the course of trade to designate the goods of the manufacturer or the seller, therefore the mark is taken as being identified with the source of goods, and hence the mark becomes a trademark. The purpose of a trademark is to distinguish the goods or services of one person from those of the others. In view of the definitions of ‘mark’ and ‘trademark’ under the Trade Marks Act, a trademark for becoming a trademark will firstly have to be a mark under Section 2(m) of the Trade Marks Act i.e before the trademark would be a trademark under the Trade Marks Act there must be a mark and which falls within the definition of ‘mark’ under the Trade Marks Act.

(ii) When we read the definition of ‘mark’ it is crystal clear that the legislature has categorically used the expression ‘combination of colours’ with or without its combination with the other ingredients of the definition of ‘mark’ being a device, brand, heading, label, ticket, name, signatures, word, letter, numeral, shape of goods and packaging. Combination of colours is *sine qua non*, and meaning

thereby that quite obviously one single colour, as contra-distinguished from combination of colours, cannot be a mark falling in the definition of 'mark'. Hence, a single colour not being a mark, the single colour cannot be claimed as a trademark. Once the legislature has intentionally and deliberately used the expression combination of colours, and it has not used the word colour in singular, it is clear that a single colour cannot be a mark for being elevated to the status of a trademark. In the present case, there is no dispute that we are only dealing with a single colour viz the red colour shade which the plaintiff is using in the soles of its goods being ladies footwear. I therefore hold that by the very language of the definition of mark contained in the Trade Marks Act, a single colour cannot under any circumstances be given the benefit for being used as an exclusively owned trademark of a manufacturer/seller etc.

9.(i) On behalf of the plaintiff, reliance was placed upon the judgment of the Appeals Court of USA in the case of *Qualitex Co. Vs. Jacobson Products Co., Inc.* case no.93-1577 decided on 28.3.1995 to argue that a single colour is recognized for being granted the status of a trademark in USA, and therefore this Court also should hold that

single colour is entitled to protection as a trademark under the Trade Marks Act of this country.

(ii) I cannot agree with this argument urged on behalf of the plaintiff inasmuch as a judgment passed by a court not of this country, is a judgment as per the statute applicable with respect to the law of trademarks in that other particular country, whereas this Court has to decide as per the statute of this country viz the Trade Marks Act, 1999. The judgment in the case of *Qualitex Co. (supra)* was given under the Trade Marks Act of USA where there is no prohibition of one colour being adopted as a trademark. I have gone through the definition of the trademark in the Trade Marks Act of USA as provided by the plaintiff and which reads as under:-

“The term “trademark” includes any word, name, symbol, or device, or any combination thereof-

- (1) used by a person or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify any distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

(iii) A reading of the aforesaid definition shows that it is not provided in this definition of trademark in the US law that a single colour cannot be used as a trademark. Therefore in accordance with

this definition of the trademark as per the USA laws the judgment in the case of *Qualitex Co. (supra)* was passed, and hence the plaintiff cannot seek any benefit of and place reliance upon the judgment in the case of *Qualitex Co. (supra)* so far as the law applicable to India is concerned because in India a single colour cannot be adopted as a trademark inasmuch as the legislature mandates that trademark has to be definitely of more than one colour viz a combination of colours. Of course whether a particular combination of colours is so unique or has achieved distinctiveness as regards the goods of a manufacturer or seller will depend upon facts of each case for such colour combination to be a trademark of a manufacturer/seller, and this Court does not have to go into that aspect of the matter for the purposes of the present case and judgment. I therefore reject the argument urged on behalf of the plaintiff in placing reliance upon the judgment in the case of *Qualitex Co. (supra)* that thereby in India a single colour is entitled to have protection as a trademark under Trade Marks Act.

10.(i) On behalf of the plaintiff then reliance was placed upon the judgment of the Learned Single Judge of this Court in the case of *Deere & Company & Anr. vs. Mr. Malkit Singh & Ors, CS(COMM)*

738/2018 decided on 23.4.2018, and it was argued that by this judgment dated 23.4.2018 in the case of *Deere & Company (supra)* the Learned Single Judge of this Court has held that a single colour is entitled to protection as a trademark, and that this judgment binds this Court as it is of a co-ordinate bench of this Court. In the case of *Deere & Company (supra)* the use of green colour was held to be exclusive entitlement of a manufacture of agricultural machinery and such plaintiff's application under Order XXXIX Rules 1 & 2 CPC was accordingly allowed thereby restraining the defendant from using the green colour on his agricultural/farm machinery.

(ii) The plaintiff has also pleaded reliance upon a judgment in its own case passed by an another Learned Single Judge of this Court in the case of *Christian Louboutin Sas vs. Mr. Pawan Kumar & Ors., CS(COMM) 714/2016* decided on 12.12.2017, and in this judgment the Learned Single Judge of this Court has passed a decree in favour of the present plaintiff by holding the plaintiff's entitlement to exclusive ownership of the trademark of red colour on the soles of its ladies footwear.

11.(i) Before I deal with the judgments of the two Learned Single Judges of this Court in the cases of *Deere & Company (supra)* and *Christian Louboutin Sas (supra)*, it would be apposite to refer to the judgment of the Constitution Bench of the Supreme Court in the case of *Padma Sundara Rao (Dead) and Others Vs. State of Tamil Nadu and Others (2002) 3 SCC 533* which holds that a ratio of judgment is facts dependent and even difference of a single fact can make difference in the ratios of two cases. It has been held in this judgment that a judgment of the court of law cannot be read like a statute. The relevant para 9 of this judgment reads as under:-

“9. Courts should not place reliance on decisions without discussing as to how the factual situation fits in with the fact situation of the decision on which reliance is placed. There is always peril in treating the words of a speech or judgment as though they are words in a legislative enactment, and it is to be remembered that judicial utterances are made in the setting of the facts of a particular case, said Lord Morris in *Herrington vs. British Railways Board*. Circumstantial flexibility, one additional or different fact may make a world of difference between conclusions in two cases.”

(underlining added)

(ii) In accordance with the binding observations of the Constitution Bench Judgment of the Supreme Court in the case of *Padma Sundara Rao (supra)* now let us examine the judgments in the cases of *Deere & Company (supra)* and *Christian Louboutin Sas (supra)* passed by

two Learned Single Judges of this Court as to whether they are binding on this Court.

12.(i) So far as the judgment in the case of *Deere & Company (supra)* is concerned, it is seen that the said judgment does not refer to or consider the provision of Section 2(m) of the Trade Marks Act which prohibits a single colour for being given the status of the trademark and thus for the exclusive ownership of such a trademark to a manufacturer or seller. The provision of Section 30(2) of the Trade Marks Act has also not been considered in this judgment, and a very detailed discussion thereof is given in the later part of this judgment. In the light of the aforesaid direct provisions of law being not considered by the Learned Single Judge who decided the case of *Deere & Company (supra)*, therefore for this very reason, with all due respect, the judgment in the case of *Deere & Company (supra)* cannot be said to be laying down a binding law that a single colour can be given a benefit of trademark and for the single colour to fall in the exclusive ownership and use of a manufacturer or seller. Supreme Court in the judgment in the case of *N. Bhargavan Pillai (Dead) by Lrs. and Another vs. State of Kerala, (2004) 13 SCC 217* has held

that if a judgment passed by a court does not consider the direct provision of law, then that said judgment passed ignoring the direct provision of law would have no binding effect. The relevant para of the judgment of the Supreme Court in the case of *N. Bhargavan Pillai (supra)* is para 14 and which para 14 reads as under:-

“14. Coming to the plea relating to benefits under the Probation Act, it is to be noted that Section 18 of the said Act clearly rules out application of the Probation Act to a case covered under Section 5(2) of the Act. Therefore, there is no substance in the accused-appellant's plea relating to grant of benefit under the Probation Act. The decision in *Bore Gowda case* does not even indicate that Section 18 of the Probation Act was taken note of. In view of the specific statutory bar the view, if any, expressed without analysing the statutory provision cannot in our view be treated as a binding precedent and at the most is to be considered as having been rendered per incuriam. Looked at from any angle, the appeal is sans merit and deserves dismissal which we direct.”

(ii) With utmost humility and respect I am therefore of the view that the judgment of the Learned Single Judge of this Court in the case of *Deere & Company (supra)* will not be binding on this Court to decide as to whether the plaintiff in the present case is entitled to claim that just one single colour is its trademark and therefore the plaintiff will be the exclusive owner of the single colour as its trademark.

13. So far as the judgment passed in the case of *Christian Louboutin Sas (supra)* is concerned, once again with due respect, the

said judgment will not be applicable because the said judgment has also not considered the definition of the expression 'mark' as found in the Trade Marks Act as also Section 30(2) of the Trade Marks Act and therefore for the self same reasons given for inapplicability of the judgment in *Deere & Company's* case (*supra*), the judgment in the case of *Christian Louboutin Sas* (*supra*) will not prevent this Court from deciding that single colour cannot be exclusively appropriated by a manufacturer or seller for use of that one single colour as its trademark.

14. I would like to reiterate, at the cost of repetition, that the two judgments of two Learned Single Judges of this Court in the cases of *Deere & Company* (*supra*) and *Christian Louboutin Sas* (*supra*) would also not be binding on this Court for the reason that the overriding provision of Section 30(2)(a) of the Trade Marks Act has not been discussed in these two judgments, and with respect to this aspect a detailed discussion is given in the later part of this judgment.

15. Learned Senior Counsel for the plaintiff for holding the plaintiff to be an exclusive owner, and hence exclusively entitled to use the red colour sole in ladies footwear by the plaintiff, has

vehemently argued that inspite of the bar contained in Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act of registration of a single colour as a trademark, however a single colour is capable of achieving distinctiveness i.e capable of distinguishing the goods and services of one person as being the source of the goods, and once distinctiveness is achieved, the single colour can become a valid trademark, and therefore it is argued that the issue of whether distinctiveness has been achieved cannot be decided at this stage as it is a triable issue to be decided during the course of trial in the suit. And, it is also further argued that the bar under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act is not absolute firstly because of the Proviso to Section 9(1) of the Trade Marks Act which states that in spite of the bar contained in Section 9(1)(b) of the Trade Marks Act, registration will be not be refused if the trademark has achieved distinctiveness as a result of use made of it, and secondly because of the provision of Section 31 of the Trade Marks Act and which provides that distinctiveness can be achieved by means of use of the trademark although distinctiveness did not exist at the time of registration. On behalf of the plaintiff it is further argued that Section 32 of the Trade

Marks Act ought to be held by this Court to be determinative of matter that even if there is an absolute bar for registration of a single colour as a trademark because of Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act, once however on account of the use of such a trademark, which ought not to have been granted registration, a distinctiveness is acquired for the trademark because of its use in relation to the goods for which the trademark is registered, then such a trademark cannot be declared as invalid.

16. No doubt Learned Senior Counsel for the plaintiff is *prima facie* justified in placing reliance upon the Proviso to Section 9(1) of the Trade Marks Act read with Sections 31 and 32 of the Trade Marks Act to contend that even though there is an absolute bar for registration of trademark, yet if distinctiveness is achieved by using of such a trademark which ought not to have been registered as a trademark, then such a trademark on achieving distinctiveness because of user, will become a valid trademark, and its registration cannot be cancelled, however, this argument ignores the first basic *sine qua non* of a thing becoming a trademark i.e of whatever is sought to be claimed as a trademark must first also be a mark. The benefit of

Proviso to Section 9(1) of the Trade Marks Act read with Section 32 of the Trade Marks Act would be available to the plaintiff only if first of all the red colour which the plaintiff claims to be the exclusive owner is at all capable of being a mark and hence a trademark because it is a trademark which is the subject matter of Sections 9(1)(a) and 9(1)(b) and Proviso to Section 9(1) of the Trade Marks Act. It has already been discussed above that unless there are combinations of colours i.e more than one colour is sought to be used as a trademark, it cannot be held that a single colour is a mark, and since a single colour cannot be a mark it therefore cannot be a trademark under the Trade Marks Act. Once a single colour cannot be a mark and therefore cannot be a trademark, the issue of a plaintiff claiming use of a single colour as a trademark by getting benefit under the Proviso to Section 9(1) of the Trade Marks Act read with Section 32 of the Trade Marks Act will not arise, because these provisions will only come into play if there is first of all a trademark because of a mark being used in the course of a trade as a trademark.

17. It is argued by the plaintiff that its registration of red sole is as a device trademark and thus a device is capable of being a mark

and therefore a trademark. This argument is fallacious and has to be rejected because the expression device appearing in the definition of a mark has to be interpreted that a thing is not brought within the meaning of a device that, that would bring about a result in permitting what is otherwise prohibited or intended to be prohibited by the legislature on account of the other parts of the definition of 'mark' or on account of other provisions of the Trade Marks Act including the provision of Section 30(2)(a) of the Trade Marks Act. What cannot be done directly cannot be done indirectly. When the legislature has intended that a single colour cannot be allowed to be appropriated exclusively by a manufacturer or seller, then by an indirect method the same cannot be allowed to be achieved by ingenious arguments urged by a manufacturer or a seller. The expression device will thus have to be interpreted and read that the same must have independent existence by itself and if what is sought to be got included in the meaning of device will result in making a part of the product/goods; and which is an inseparable part of the product itself; as a device, then such an endeavour of a manufacturer or seller should be held as being impermissible. In other words what is sought to be got included in the

expression 'device' for the device to be a trademark, such a device must have standalone independent existence in itself so as to have an identity of its own even without being part of the product/goods. Therefore it is held that by simply applying of a single colour to the sole of a footwear, it will not result in making the single coloured sole as a device. No doubt a manufacturer or seller has a right to further his interest by convenient and preferable interpretations of the words of a statute, however it is equally the right of a court; and in fact it is a duty; that an interpretation should not be given to the words of a statutory provision which will negate the public interest and circumvent the intention of the legislature. Registration of a trademark is only *prima facie* evidence of its validity *vide* Section 31(1) of the Trade Marks Act and therefore once what has been got registered as a trademark, could legally not have been got registered as a trademark results in an illegality because what is registered as a trademark could legally not have been got registered as a trademark, then when that matter comes up before the court then the courts are surely entitled to reject the claim of ownership and entitlement to a trademark which is not capable of being a trademark under the Trade Marks Act.

18.(i) Another argument of the plaintiff for claiming exclusive ownership of a single colour as its trademark is by placing reliance on Section 10(2) of the Trade Marks Act. It is argued by the plaintiff that Section 10(2) of the Trade Marks Act permits a single colour for being a trademark. Section 10 of the Trade Marks Act reads as under:-

"10. Limitation as to colour.—

(1) A trade mark may be limited wholly or in part to any combination of colours and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours."

(ii) This argument of the plaintiff is absolutely baseless firstly because Section 10(2) of the Trade Marks Act has to be read in the context of Sub-Section (1) of Section 10 of the Trade Marks Act. Section 10(1) of the Trade Marks Act uses the expression 'combination of colours' and which is the same expression used in the definitions of 'mark' and 'trademark' in the Trade Marks Act, and therefore the trademark being combination of colours is the same as the expression 'colour' found in Section 10(2) of the Trade Marks Act i.e the expression colour in Section 10(2) of the Trade Marks Act though is used in singular, the same is actually used for combination of colours because the subject matter talked of in both the Sub-

Sections of Section 10 of the Trade Marks Act is the same and not different.

(iii) The second reason for holding as misconceived the argument raised by the plaintiff by referring to colour i.e in singular colour in Section 10(2) of the Trade Marks Act is that when in Section 10(2) of the Trade Marks Act the expressions/words 'trademark' and 'colour' are used, they are used for referring to the trademark used which is not a colour and therefore the entitlement to use a trademark which is not a colour for all colours to be applied to a trademark. For example when a wordmark which is registered as a trademark then since it is only a wordmark trademark with limitation for use of the trademark only to be used in a particular colour or combination of colours of the trademark, then while depicting the wordmark trademark, the same can be depicted/shown/displayed in any colour or combination of colours. The use of colour in singular in Section 10(2) of the Trade Marks Act has therefore no purpose to enable/entitle that a single colour can be a trademark, and especially so when the definition of mark and trademark under the Trade Marks Act require combination of colours and that a single colour is not and cannot be a mark and a

trademark. The reason for existence of Section 10(2) of the Trade Marks Act is not to add to the definitions of mark and trademark under the of the Trade Marks Act.

19(i). In the opinion of this Court an extremely important aspect which will conclusively show the disentitlement of the plaintiff to the reliefs claimed in the suit is the supervening provision of Section 30(2)(a) of the Trade Marks Act. Section 30 of the Trade Marks Act in its entirety has been already reproduced above. The provision of Section 30 contains the limits of a registered trademark. Section 30 of the Trade Marks Act with its various sub-sections provides exceptions to the rights which a registered owner of a trademark claims. Section 30 of the Trade Marks Act provides that although a plaintiff may be an owner of a particular trademark, yet if the registered trademark of the plaintiff is used by any other person, whose use of the registered trademark is as per the entitlements of the different sub-sections of Section 30 of the Trade Marks Act, then such use cannot be prevented by the registered owner of the trademark.

(ii) The relevant Sub-Section of Section 30 of the Trade Marks Act which would be applicable to the facts of the present case for

disentitlement of the plaintiff to the reliefs claimed in the suit present is Sub-Section 2(a) of the Trade Marks Act. As per this Sub-Section even if a person is a registered owner of a trademark but if the trademark of the registered owner pertains to the characteristic or characteristics of the goods, then another person when he uses such characteristic or characteristics of the goods for the goods manufactured and marketed by that another person, the same would not result in infringement of the registered trademark. In the opinion of this Court a characteristic or characteristics of goods will include such functional aspects of the goods which would give an appeal or looks to the products/goods. Whenever a trademark is of the nature that it can also be a characteristic or characteristics of the goods, then in such a case merely because the characteristic of the goods which is used by the registered owner of the trademark is a trademark, the same will not be able to successfully prevent any other manufacturer or seller from using the characteristic or characteristics of the goods which is manufactured and sold by such other person if that characteristic(s) is not used as a trademark but as a feature of the product/goods. The object of the law is that if a person gets a

trademark registered in his name, but the trademark which is registered is one which would pertain to the characteristic of the goods, then in such a case the person who adopts the characteristic of the goods as a trademark does so by knowing and understanding because of Section 30 of the Trade Marks Act that such registered trademark owner will not be able to prevent another person from using the characteristic or characteristics of the goods simply because that characteristic or characteristics is used as a trademark by the registered owner of the trademark. Object of the law is to discourage adoption and use of a trademark by a manufacturer or seller which pertains to various aspects as stated in Section 30(2)(a) of the Trade Marks Act including the aspect of the trademark being only characteristic or characteristics of the goods.

(iii) A single colour which is applied to the goods which are sold would in normal and ordinary circumstances pertain to the characteristic or characteristics of the goods. Colour is applied to certain goods for the purpose of the appeal of the goods or for the looks of the products/goods. Such application of colour is a function being performed for the goods to give an appeal to the goods. The

characteristic performs a non-trademark function as a feature of the product, and therefore a feature of a product cannot be prevented from being used by the other manufacturers and sellers in the market for their goods, even though the feature or characteristic or characteristics or a functional aspect is got registered by a manufacturer or seller as his trademark for his product/goods.

(iv) In fact even in the judgment in the case of *Qualitex Co. (supra)* which is relied upon by the plaintiff to argue that a colour can become a registered trademark, the U.S. Courts of Appeal has categorically observed that where a trademark serves a significant function or the trademark is such that there is a competitive need for the colours to remain available in the industry and the colour in fact serves a function other than a trademark, then there exists special reasons which militates against use of colour alone as a trademark for being exclusively owned by a person who adopts the colour as his trademark. This is stated in the following words in the judgment in the case of *Qualitex Co. (supra)*:-

“..... It would seem, then, that color alone, at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm's goods and identifies their source, **without serving any other significant function**. See U. S. Dept. of Commerce,

Patent and Trademark Office, Trademark Manual of Examining Procedure § 1202.04(e), p. 1202-13 (2d ed. May, 1993) (hereinafter PTO Manual) (approving trademark registration of color alone where it "has become distinctive of the applicant's goods in commerce," **provided that "there is [no] competitive need for colors to remain available in the industry" and the color is not "functional"**); see also 1 McCarthy §§ 3.01[1], 7.26, pp. 3-2, 7-113 ("requirements for qualification of a word or symbol as a trademark" are that it be (1) a "symbol," (2) "use[d] ... as a mark," (3) "to identify and distinguish the seller's goods from goods made or sold by others," but that it not be "functional"). Indeed, the District Court, in this case, entered findings (accepted by the Ninth Circuit) that show Qualitex's green-gold press pad color has met these requirements. The green-gold color acts as a symbol. Having developed secondary meaning (for customers identified the green-gold color as Qualitex's), it identifies the press pads' source. **And, the green-gold color serves no other function.** (Although it is important to use *some* color on press pads to avoid noticeable stains, the court found "no competitive need in the press pad industry for the green-gold color, since other colors are equally usable." 21 U. S. P. Q. 2d, at 1460.) Accordingly, **unless there is some special reason** that convincingly militates against the use of color alone as a trademark, trademark law would protect Qualitex's use of the green-gold color on its press pads.

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The upshot is that, where a color serves a significant non-trademark function-whether to distinguish a heart pill from a digestive medicine or to satisfy the "noble instinct for giving the right touch of beauty to common and necessary things," G. Chesterton, *Simplicity and Tolstoy* 61 (1912) **courts will examine whether its use as a mark would permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient.** That examination should not discourage firms from creating esthetically pleasing mark designs, for it is open to their competitors to do the same. See, e. g., *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 343 (CA7 1985) (Posner, J.). But, **ordinarily**, it should prevent the anticompetitive consequences of Jacobson's hypothetical "color depletion" argument, when, and if, the circumstances of a particular case threaten "color depletion." (emphasis added)

- (v) Therefore, no doubt the plaintiff by virtue of Proviso of Section 9(1) and Section 32 of the Trade Marks Act can claim to have become owner of the trademark having the red colour applied to the soles of

its shoes, yet even if the plaintiff is the owner of such trademark being a single colour red applied to soles of ladies footwear, then because of and by virtue of Section 30(2)(a) of the Trade Marks Act, other manufacturers or sellers are not prohibited from using the colour red on their goods/shoes/footwear if the colour is serving a non-trademark function i.e colour is a feature of the product or goods. In the present case colouring of the soles of the footwear by the defendants as red is a feature of the defendant's products inasmuch as the defendants to sell their footwear are using a wordmark trademark being 'VERONICA'. The colour red applied by the defendants to the soles of their footwear being sold, adds to the appeal or the looks of the products, and therefore such a feature which is not used as a trademark will not entitle the plaintiff to seek injunction against user of such feature of the products by the defendants simply on the ground that the plaintiff is the owner of the trademark red colour shade applied to the soles of the ladies footwear being sold by the plaintiff.

20. The arguments of the plaintiff are therefore rejected by observing, *inter-alia*, that the rights of the plaintiff will arise as per Proviso to Section 9(1), Section 31 and Section 32 of the Trade Marks

Act only if what is claimed by the plaintiff as a trademark is at all a trademark under the Trade Marks Act and once the trademark of the plaintiff falls foul of the meanings of the words 'mark' and 'trademark' under the Trade Marks Act, there arise no rights in the plaintiff of its trademarks merely because plaintiff is successful in getting them registered under the Trade Marks Act.

21(i). It is then argued on behalf of the plaintiff that the plaintiff has not only pleaded the cause of action of infringement but it has also pleaded the cause of action of passing off, and that even if plaintiff cannot be granted the relief of injunction etc on account of infringement, yet the plaintiff would be entitled to reliefs on the basis of the cause of action of passing off, and that passing off issue can only be decided after issuing of summons in the suit and after trial i.e evidence being led by both the parties. To further buttress this argument reliance is placed upon para 10 of the judgment of the Supreme Court in the case of *Laxmikant V. Patel Vs. Chetanbhai Shah and Anr.*, (2002) 3 SCC 65 and in which para Supreme Court has observed that once there is an association of a particular aspect of a trademark with the particular manufacturer or seller, then there

arises a case of passing off. Para 10 of the judgment in the case

Laxmikant V. Patel (supra) which is relied upon reads as under:-

“10. A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.”

(underlining added)

(ii) The contention of the plaintiff that use of the colour red by the defendants on the soles of ladies footwear being sold by the defendants will cause passing off is a misconceived argument for three reasons. Firstly, as already discussed above a single colour cannot become a trademark. Once a single colour is not capable of being a trademark, then the plaintiff cannot claim rights in one colour as a trademark for exclusive use of the plaintiff simply because the plaintiff may have got/used the single colour as its trademark. Secondly, the issue of passing off would arise only if there was

disentitlement in the defendants to not use the red colour shade in the soles of the ladies footwear being manufactured and sold by the defendants, but there is no such disentitlement for the defendants because the user by the defendants of the red colour shade on the footwear is pursuant to the legal rights conferred upon the defendants under Section 30(2)(a) of the Trade Marks Act as already discussed above. The defendants are entitled in view of Section 30(2)(a) of the Trade Marks Act to use red colour in the soles of their footwear, even if the plaintiff is held to be the owner of their trademarks stated in para 20 of the plaint, as the use of red colour in the soles is a characteristic of the product shoe and as already discussed in detail above. The third aspect is that the issue of passing off and deception would arise if the defendants were not selling their goods under any wordmark trademark, and simply by applying red colour to the soles of the ladies shoes/footwear, but that is not the case herein, since the defendants are very much using a wordmark trademark being 'VERONICA'. It bears note that admittedly plaintiff is also using a wordmark trademark viz "CHRISTIAN LOUBOUTIN", and which wordmark trademark of the plaintiff is completely different than the wordmark trademark of the

defendants *viz* 'VERONICA' and therefore there does not arise any question whatsoever of any deception or confusion.

(iii) Clearly therefore there will not arise any scope for the plaintiff to allege and urge passing off in the facts of the present case because even if all contents of the plaint are taken to be correct no passing off arises. There is therefore no need of any trial on the cause of action and reliefs claimed by the plaintiff by pleading passing off in the plaint.

22. In view of the aforesaid discussion, it is held that taking the contents of the plaint as completely correct, yet the plaintiff will not be entitled to the reliefs urging infringement of its trademark or the defendants passing off its goods as that of the plaintiff or that the plaintiff can claim existence of dilution, unfair competition etc. As already stated above, use of a single colour of the plaintiff does not qualify the single colour to be a trademark in view of provisions of Sections 2(m) and 2(zb) of the Trade Marks Act. Also Section 30(2)(a) of the Trade Marks Act, in the facts of the present case, is a complete disentitlement to the reliefs claimed by the plaintiff on the basis of causes of action pleaded in the plaint. Accordingly, the suit

does not contain any legal cause of action because even if whatever are the causes of action in the plaint are taken as correct, even then such causes of action taken as true, will not entitle the plaintiff for the reliefs as claimed in the present suit.

23. The suit is therefore dismissed.

MAY 25, 2018

VALMIKI J. MEHTA, J

