

S no	Case Name	Citation Date	Decision Date	Court	Subject	Nature of the mark	Summary
1.	United Distillers Plc. vs. Jagdish Joshi and Ors.	2000(20)PTC 502(Del)	28.07.2000	Delhi High Court	Infringement and passing off	Colour mark	Plaintiff's Johnnie Walker Scotch Whiskey packaging bore a distinctive trade dress featuring two tone colour combination comprising of black and gold, red and gold and blue and gold. The centre label was deliberately slanted and contains a distinctive golden outline. The Court held, <i>inter alia</i> , that the Defendant had adopted a similar colour combination of black and gold and the trade dress is similar. Defendant was restrained.
2.	TI Diamond Chain Ltd. vs. Ashok Kumar and Ors.	2001(21)PTC 465(Del)	28.02.2001	Delhi High Court	Infringement and passing off (passing off in respect of colour scheme)	Colour mark	Plaintiff filed the suit being aggrieved by the use of identical/similar trademark, packing material and colour scheme, etc. in respect of its automobile chain Packet Kits under the trademark DIAMOND/DIAMOND SUPER. Defendant was proceeded ex-parte. Court held that the use of the similar colour combination, scheme and logo would create confusion. Suit was decreed and Defendant was restrained.
3.	Colgate Palmolive Company and Ors. vs. Anchor Health and Beauty Care Pvt. Ltd.	2003(27)PTC 478(Del)	29.10.2003	Delhi High Court	Passing off	Colour & Shape mark	Suit filed against use of similar trade dress and colour combination of one third red and two third white, on the container of Tooth Powder. Defendant raised the plea, <i>inter alia</i> , that the shape of the container cannot be monopolized by Plaintiff (Colgate) unless and until it is registered under the Designs Act; the shape of packaging or any combination thereof do not fall within the ambit of mark or trademark as envisaged in the TMM Act, 1958; use of red and white colour combination is neither distinctive nor capable of identifying the goods with Plaintiff; Plaintiffs have abandoned the colour combination of red and white and have used various other colour combinations in respect of different ranges of products; the essential features of the label marks is the word mark and not

							<p>the colour combination or overall get up and since the two trademarks are entirely different, Plaintiffs cannot seek protection under the garb of colour combination of the label; the colour combination red and white in respect of dental care products is descriptive in nature and has a direct reference to the character or quality of the goods, gum and teeth. This combination is common to the trade and is being used by large number of manufacturers. The Court held that It is the overall impression that customer gets as to the source and origin of the goods from visual impression of colour combination, shape of the container, packaging, etc. If illiterate, unwary and gullible customer gets confused as to the source and origin of the goods which he has been using for longer period by way of getting the goods in a container having particular shape, colour combination and getup, it amounts to passing off. Further held that may be, no party can have monopoly over a particular colour but if there is substantial reproduction of the colour combination in the similar order either on the container or packing which over a period has been imprinted upon the minds of customers it certainly is liable to cause not only confusion but also dilution of distinctiveness of colour combination. Colour combination, get up, lay out and size of container is sort of trade dress which involves overall image of the product's features. There is a wide protection against imitation or deceptive similarities of trade dress as trade dress is the soul for identification of the goods as to its source and origin. Significance of trade dress and colour combination is so immense that in some cases even single colour has been taken to be a trade mark to be protected from passing off action. Colour</p>
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							combination is a trade mark within the definition of the TMM Act as there is no exclusion in the definition. Even a single colour has been held to be a trade mark.
4.	William Grant & Sons Ltd v Mc Dowell & Co Ltd.	55 (1994) DLT 80	27.05.1994	Delhi High Court	Copyright Infringement and passing off	Colour mark	Plaintiff contended that its Glenfiddich whisky, after it is bottled and labelled, is packed in a black cylindrical container called a tube. The tube of Glenfiddich Single Malt whisky of Plaintiff bore a label with a singularly unique get-up, lay out, colour scheme and arrangement of artistic features. The predominant colours used in Plaintiff's label were golden, rust red, white and black. Defendant adopted, <i>inter alia</i> , the same colours in respect of its McDowell's Single Malt whisky. The Court held that the Defendant's use would cause confusion and hence restrained by permanent injunction.
5.	Cadbury Ltd. and Ors. vs. ITC Ltd.	MANU/GJ/0499/2005	20.07.2005	Gujarat High Court	Infringement and passing off	Colour mark	Plaintiff sold its CADBURY confectionary items in a Purple and Gold colour combination trade dress. The Court held that the use of Purple and Gold colour combination by the Defendant will cause confusion. Defendant was restrained by permanent injunction.
6.	Pfizer Products Inc. vs. B.L. and Company and Ors.	2002(25)PTC 262(Del)	10.04.2002	Delhi High Court	Passing off	Colour and Shape mark	Plaintiff's tablet was blue coloured and diamond shaped. Defendant contended that tablets are not sold on the basis of colour or shape. The Court held that the shape and colour of the rival products are similar. However, Defendant agreed to give up the colour and shape, and this issue was not deliberated upon by the Court.
7.	Jolen Inc. vs. Doctor and Company	2002(25)PTC 29(Del)	06.05.2002	Delhi High Court	Passing off	Colour mark	Plaintiff alleged that the Defendant has copied the Plaintiff's trademark, colour scheme, carton and container in respect of the sale of creame bleach. The Court held that there is uncanny similarity in the rival products. Plaintiff was able to establish a case for the colour scheme, get up, etc. of his carton and container. Defendant was restrained.

8.	R.R. Oomerbhoy Pvt. Ltd. vs. Court Receiver, High Court and Ors.	2003(27)PTC580(Bom)	28.07.2003	Bombay High Court	Infringement and passing off	Colour and Shape mark	Plaintiff contended that Defendant has adopted the identical/ deceptively similar mark, design, lay-out, colour scheme and get-up of the bottles in respect of groundnut oil. The Court held that the layout, colour scheme, trade dress and the nature of the Containers are deceptively similarity. Appeal was dismissed and stay granted by Single Judge was confirmed.
9.	Zippo Manufacturing Company vs Anil Moolchandani & Ors.	2011(48)PTC 390(Del)	31.10.2011	Delhi High Court	Infringement and passing off	Shape mark	Plaintiff filed the suit to protect the three dimensional shape of its Zippo lighters. The Court accepted the Plaintiff's rights in the shape of lighter and held that on account of the similar shape of lighter, the consumers are likely to be misled. Defendant was restrained and suit was decreed.
10.	MRF Limited v. Metro Tyres Limited	1990 (10) PTC 101 (Mad)	15.02.1989	Madras High Court	Passing off	Shape mark	Plaintiff filed its suit to protect its tread pattern. Despite having some functional aspect attached to tread pattern, the Court held that trade patterns have trademark significance and hence liable to be protected.
11.	Gorbatschow Wodka Kg vs John Distilleries Limited	2011(47)PTC100(Bom)	02.05.2011	Bombay High Court	Passing off	Shape mark	Plaintiff filed the suit to protect the bottle shape of its Vodka product. The Court held that no one else uses a similar shape and there was no reason for Defendant to adopt a similar bottle shape. Defendant was restrained and injunction order was passed.

NTM CASES IN INDIA – 2005 TO 2008

S. no.	Case Name	Citation Date	Decision Date	Court/Authority	Subject	Nature of the mark	Summary
1.	Yahoo Yodel	Application Nos. 1270407 and 1270406 in Classes 35, 38 and 42	Registered on 29.03.2008	Trade Marks Registry	Registration	Sound mark	“The mark consists of the sound of a human voice yodeling the word Yahoo.”
2.	Nokia Corporation	Application No. 1365394	Registered on 08.09.2008	Trade Marks Registry	Registration	Sound mark	“Guitar notes on switching on the device”
3.	Gorbatschow Wodka KG	Application No. 1648594	Application date 31.01.2008. Registered on 24.07.2014	Trade Marks Registry	Registration	Shape mark	The mark consists of the shape of a transparent bottle. Approximately 2/3 rd of the bottle shape is cone-shaped followed by a ball/bowl with 22 facettes in circumference and adequate grooves featuring the embossing of a device of the pigeon.
4.	Colgate Palmolive Co v Anchor Health and Beauty Care Pvt. Ltd.	MANU/DE/1000/2003	29.10.2003	Delhi High Court	Infringement and passing off	Trade Dress and colour combination	The Plaintiff filed the suit against the Defendant for use of a similar trade dress and colour combination of red and white in relation to an identical product (tooth powder) when the trademarks being used by the two parties were

							completely different. While recognizing the concept of trade dress, the High Court of Delhi noted that it is the overall impression that a customer gets as to the source and origin of the goods from the visual impression of colour combination, shape of the container and packaging. If an illiterate, unwary and gullible customer gets confused as to the source and origin of the goods which he has been using for a longer period by way of getting the goods in a container having particular shape, colour combination and getup, it amounts to passing off.
5.	G M Pens International v. Cello Plastic Products Co.	MANU/DE/3047/2005	13.12.2005	MRTP Commission, New Delhi	Disparagement and Comparative advertising	Colour trade mark	The Plaintiff filed the Suit against the Defendant to restrain them from advertising a commercial which is alleged to have

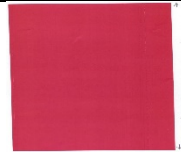
							disparaged the Plaintiff's product i.e. a ball point pen. The Court, while restraining the Defendant has observed that while the pen shown in the advertisement does not bear the name of the Plaintiff's product, the fact that the pen shown is of white colour body with a transparent mouth piece leaves no doubt in the minds of the consumers that the pen being referred to belongs to the Plaintiff.
6.	Cipla Limited v. M K. Pharmaceuticals	2008 (36) PTC 166 Del	23.07.2007	Delhi High Court	Passing off	Trade Dress, shape mark and colour combination	The Plaintiff filed the Suit against the Defendant to restrain them from marketing /selling its product in oval shape, orange colour tablets in blister packaging. The Court, while dismissing the application, noted that there can be no monopoly over a single colour or shape of the tablet.

7.	N. Ranga Rao And Sons v. Anil Garg And Ors.	2006 (32) PTC 15 Del	02.12.2005	Delhi High Court	Passing off and infringement of copyright and dilution	Trade Dress and colour marks.	<p>The Plaintiff was a partnership firm engaged in the manufacture of incense sticks under the trade name "LIA". The Defendant started selling his products under a similar trade name "DIA" and adopted packaging similar to that of the partnership firm. An amalgam of colour combinations, names and logos which creates a total identification with products was alleged to be copied. The Court laid down that to establish infringement the "trade dress" has to be seen as a whole and not in parts. Copying of the packaging of incense sticks and the colour scheme as well as trade name of a well-known product of the same range constitutes infringement and the suit for permanent injunction of the plaintiff in the case was successful.</p>
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8.	L'oreal India Pvt. Ltd. and Anr. Vs. Henkel Marketing India Ltd. and Anr.	2005 (6) Bom CR 77	16.08.2005	Bombay High Court	Passing off and infringement of copyright	Trade Dress	The packaging of the Plaintiff's products "GARNIER- COLOUR NATURALS" and the product of the Defendant, "palette- PERMANENT NATURAL COLOURS" was alleged to be identical. The Plaintiff instituted proceedings for passing-off arguing that it was a substantial reproduction and/or colorable imitation of its label/trade dress. The Court emphasized on the deceptive similarity between the trade dresses of the two products which could create confusion in the minds of the consumers. It was held that, since the trademark of both the products was clearly inscribed in the respective trade dresses, there was no chance of confusion among the consumers who are
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							mostly from the middle class or upper middle class. Thus, trade dress infringement was not made out.
9.	Annamalayar Agencies v. VVS & Sons Pvt. Ltd. & Ors.	2008 (38) PTC 37 (Mad.)	05.01.2007	Madras High Court	Comparative Advertisement and disparagement	Colour	The Plaintiff filed the Suit against the Defendant to restrain them from telecasting its advertisement which was alleged to have disparaged the Plaintiff's product. The Court held that the showing of the blue coloured bottle in an advertisement disparaged the Plaintiff's product PARACHUTE coconut oil.
10.	Colgate Palmolive Co. v. Mr. Patel and Anr.	2005 (31) PTC 583 Del	06.10.2005	Delhi High Court	Infringement and Passing off	Trade Dress and colour combination	The Plaintiff was alleged to have always marketed their products in Red Cartons which had the word COLGATE inscribed in white on it, with a particular font. The suit was filed against the Defendants for unauthorized use of the

							<p>Plaintiff's trade dress and packaging of its products in a same/similar layout and colour combination of red and white. While the Court restrained the Defendants' from passing off, it observed that the essential feature of the Plaintiffs' mark was COLGATE inscribed in white color on a red background and not merely red and white color combination alone. Further, it also affirmed the contention of the Defendants that red was a basic color and the red & white color combination is common to the tooth paste trade in the domestic as well as the international market. Hence, it was held that there cannot be any monopolization of the same by any party.</p>
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11.	Nokia Corporation	Application No. 1246341	Registered in January 2009	Trade Marks Registry	Registration	Motion	NOKIA handshake as a series trademark.
12.	Victorinox AG	Application No. 1394234	Registered on 18.03.2008	Trade Marks Registry	Registration	Single Colour	
13.	DEUTSCHE TELEKOM AG	Application No. 1462271	Application date 19.06.2006. Registered on 29.03.2010	Trade Marks Registry	Registration	Single Colour	
14.	Zippo Manufacturing Company vs. Anil Moolchandani & Ors.	Final Order: 2011(48) PTC 390 (Del)	Interim Order: 13.07.2006 Final Order: 31.10.2011	Delhi High Court	Infringement and Passing off	Shape mark	The Plaintiff filed the Suit against the Defendants to restrain them from infringing and passing off lighters which bear the name and shape of Plaintiff's lighters. The Plaintiff claimed to be the proprietor of a registration for the 3-dimensional shape of its lighters. The Court restrained the Defendants from selling, importing, distributing or marketing lighters bearing the trade mark ZIPPO or having a 3 dimensional shape identical

							or similar to that of the lighter of the Plaintiff.
15.	Allianz Aktiengesellschaft	Application No. 1421881	Application date: 16.02.2006. Registered on 28.07.2008	Trade Marks Registry	Registration	Sound mark	Sound mark registered in respect of insurance and financial services. The sound mark consists of a sequence of 5 notes lasting a total of 3.8 seconds.
16.	Allianz Aktiengesellschaft	Application No. 1421882 and 1421883	Application date: 16.02.2006. Registered on 23.10.2008 and 24.10.2008, respectively	Trade Marks Registry	Registration	Sound mark	Sound mark registered in respect of insurance and financial services
17.	M/s. Edgar Rice Burroughs Inc.	Application No. 1748778	Application date: 29.10.2008. Registered on 29.05.2015	Trade Marks Registry	Registration	Sound mark	Sound mark registered for TARZAN YELL (Application was filed with a Spectrogram as well as a CD containing recording of the sound)
18.	M/s. John Distilleries Limited	Application No. 1748771, 1748772	Application date: 29.10.2008	Trade Marks Registry	Registration	Shape mark	Trade mark registered for shape of bottle for wines, spirit, liquors and alcoholic beverages, whisky, brandy,

							<p>vodka, gin, cocktails, rum, included in class 33</p> 
19.	Lilly ICOS LLC	Application No. 1291990	Application date: 23.06.2004. Registered on 04.01.2006	Trade Marks Registry	Registration	Shape and colour mark	<p>Trade mark registered for distinctive yellow colour and almond shape of tablet</p> 
20.	Lilly ICOS LLC and Anr. V Maiden Pharmaceuticals Ltd	2009 (39) PTC 666 DEL Case No.: CS(OS) 1991/ 2007	06.03.2009	Delhi High court	Infringement and Passing off	Shape and colour mark	<p>Apart from protecting the word mark, the Delhi High Court also protected the colour and shape mark of the Plaintiff by acknowledging that distinctive yellow colour and almond shape of the tablet had trade mark significance.</p>

							The registration of the Plaintiff for distinctive yellow colour and almond shape of tablet is listed above i.e. Application No. 1291990
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S. No.	Case Name	Citation	Decision Date	Court	Subject vis-à-vis NTM	Nature of the NTM
1.	Lilly Icos LLC and Anr. Vs. Scilla Biotechnologies Pvt. Ltd. and Anr.	2009(39)PTC 573 (Del)	December 11, 2008	High Court of Delhi	Infringement and Passing off	Shape
2.	Lilly ICOS LLC and Ors. Vs. Maiden Pharmaceuticals Lim.	2009(39)PTC 666(Del)	March 06, 2009	High Court of Delhi	Infringement and Passing off	Shape
3.	ITC Limited Vs. Crescendo Tobacco Agency and Ors.	2011(46)PTC 65(Cal)	March 4, 2011	High Court of Calcutta	Passing off	Colour combination
4.	Gorbatschow Wodka K.G. Vs. John Distilleries Limited	2011(47)PTC 100(Bom)	May 02, 2011	High Court of Bombay	Passing off	Shape
5.	Castrol Limited and Ors. Vs. Amit Shah and Ors.	2012(52)PTC 590(Del)	September 14, 2011	High Court of Delhi	Passing off	Shape
6.	Zippo Manufacturing Company Vs. Anil Moolchandani and Ors	2011(48)PTC 390(Del)	October 31, 2011	High Court of Delhi	Infringement and Passing off	Shape

Lilly Icos LLC and Anr. Vs. Scilla Biotechnologies Pvt. Ltd. and Anr.

The Plaintiffs filed a suit for permanent injunction restraining the Defendants from infringing the registered trade marks of the Plaintiffs and passing off their goods as those of the Plaintiffs. *Vide ex parte* Order, the Defendants were restrained from manufacturing, selling, marketing etc. under the trade marks and trade dress of the Plaintiffs. The Plaintiff No. 1 claimed to have developed pharmaceutical preparation for the treatment of male erectile dysfunction and patented the active ingredient i.e. tadalafil in numerous countries worldwide. The Plaintiff No. 1

claimed that the said preparation was marketed under the trade mark “CIALIS” with a unique and unusual packaging, and artwork referred to as CIALIS SWIRL and that the tablet was given a unique light yellow colour and shaped in a unusual and distinctive almond shape with the inscription C20. The trade marks “CIALIS”, the “CIALIS Tablet Shape with the alphabet C20”, the “CIALIS SWIRL” and the expression “C20” were claimed to be registered as trade marks since 1999/2004 in India.

The Plaintiffs learnt that the Defendant No. 1 was marketing tadalafil tablets on its websites under a deceptively similar mark SCALIS and had copied the CIALIS tablet shape with the inscription of K20 on the tablet. The Defendant No. 2 was exporting the same from India. During the pendency of the Suit, the Plaintiffs had initiated proceedings for disobedience of the Order of injunction as the Defendants continued to export same goods under a different mark i.e. SCIFIL but with the same trade dress.

On *ex-parte* evidence being led by the Plaintiffs, the Court observed that a perusal of the trade marks and the trade dress of the Plaintiffs and the product of the Defendants shows a striking similarity, having all potential to cause confusion/deception, especially since both are with respect to the same product. The Court noted that the Defendants chose not to contest the Suit perhaps realising that they would have no defence and instead of appearing before the Court, attempted to overreach and reap benefits and pass off their goods as that of the Plaintiffs, by making a marginal difference only in the name of the product. Accordingly, Plaintiffs were awarded damages in the sum of INR 1,000,000 against the Defendants jointly and severally along with costs of the suit.

Lilly ICOS LLC and Ors. v Maiden Pharmaceuticals Lim.

The Plaintiffs filed a suit for infringement and passing off alleging that the Defendant had adopted the trade mark MCALIS which is deceptively similar to the Plaintiffs’ well known trade mark CIALIS. The Plaintiffs also claimed that the Defendant had copied the trade dress of the product including the distinctive yellow almond shape of the tablet with inscription C20 and distinctive CIALIS Swirl device. The Plaintiff No. 1 claimed to be the registered proprietor of the trade marks CIALIS, C20, Shape of the tablet and Cialis Swirl in India.

The Defendant contended that it had decided to produce the product MCALIS in the year 2004 after getting the approval of the Drug Authority and there is no similarity between the Plaintiffs’ and Defendant’s goods.

The Court observed that there is a striking similarity and affinity of sound between the words CIALIS and MCALIS and there will be a real danger of confusion if the Defendant is allowed to use the mark. The Court also noted that the Defendant had not placed any cogent evidence before the Court to establish use of the mark MCALIS since the year 2004 and had no justification to adopt and use the deceptively similar trade mark with the swirl device as well as the trade dress of the tablet. The *ex parte ad interim* order granted earlier in favour of the Plaintiffs was made absolute and the Defendant was restrained.

ITC Limited Vs. Crescendo Tobacco Agency and Ors.

The Plaintiff filed a suit for passing off alleging that the second Defendant had altered the get-up and packaging of its “Special” brand of cigarettes to mimic the metallic red and flaming gold packet of the Plaintiff’s “Gold Flake” brand.

The Plaintiff contended that the second Defendant’s adoption of colour combination is dishonest and the second Defendant is trying to appropriate the Plaintiff’s goodwill. The Plaintiff claimed that a potential customer of the Plaintiff’s “Gold Flake” brand has every likelihood of being confused at the sight of the second Defendant’s “Special” packet and be deceived into settling for that on the mistaken impression that it was the Plaintiff’s product. According to the Plaintiff, a first-time smoker, or a casual smoker has to be kept in mind since it may be assumed that the hardcore addict would seek a particular brand or, by long habit, be more discerning.

The second Defendant argued that the Plaintiff markets its “Gold Flake” brand in packets of other hues as well but has sought to give an impression that its “Gold Flake” brand is sold only in red and gold packets and that such packet has come to be exclusively associated with the brand.

The Court holding that the test is still in the eye, observed that there is substantial difference in the appearance of the two packets notwithstanding similar colour combination and that the identity in the pattern appears merely to be in the colour red taking up the top third and the rest of the packets being primarily golden. The Court was of the view that a combination of bland metallic red and flashy gold, despite the underlying suggestion of regalia, would hardly be a ticket to exclusivity, especially in the wake of the other features of distinction. The Court concluded that the second Defendant’s packet is not capable of confusion and accordingly, dismissed the interlocutory application for injunction.

Gorbatschow Wodka K.G. Vs. John Distilleries Limited

In a *quia timet* action, the Plaintiff sought to injunct the Defendant from launching its vodka in a deceptive variation of the Plaintiff’s bottle. The Plaintiff claimed that it manufactures and sells vodka in a distinctive bulbous shaped bottle which is perceived to be visually appealing and forms an intrinsic part of its goodwill and reputation. The Plaintiff also claimed to have registered the shape of its bottle in various jurisdictions worldwide and had applied for registration of the shape as a trade mark in India.

The Plaintiff learnt that the Defendant manufactures vodka under the trade mark ‘Salute’ and will offer its product in a bottle bearing deceptive similarity to the bottle of the Plaintiff. The Court granted *ex parte ad interim* relief restraining the Defendant. The Defendant contended that it is the owner of a design registration for the bottle under the Designs Act, 2000 which was applied for registration prior to the launch of the

Plaintiff's product in India. The Defendant further contended that there is no possibility of deception as the target consumer is highly educated, rich and discerning and the test of passing off which must be applied is different as compared to a situation where a product would be purchased by a consumer of average intelligence and imperfect recollection.

The Court observed that the Plaintiff has *prima facie* established both a trans border reputation as well as a reputation in the market in India and the fact that the unique shape of the bottle is an important element in tracing the source of origin of the product to the Plaintiff and that the Defendant has absolutely no plausible or *bona fide* explanation for adopting a strikingly similar shape. The Court further observed that the design registration obtained by the Defendant does not impinge the right of the Plaintiff in an action for passing off. The Court noted that shape of the Plaintiff's bottle is capricious in the sense that it is novel and originated in the ingenuity and imagination of the Plaintiff. The Court was of the view that if the submission of the Defendant regarding purchasers of Plaintiff's product having discerning capacity and education were accepted, the remedy of passing off would be rendered illusory and only available in respect of goods which the average consumer purchases for the daily necessities of life. The Court concluded that a strong *prima facie* case for injunction was made out and the order of injunction was made absolute.

Castrol Limited and Ors. Vs. Amit Shah and Ors.

The Plaintiffs sought permanent injunction, restraining infringement of their registered trade marks, copyright, passing off, damages and delivery up.

Plaintiff No. 1 averred that it is engaged in the manufacture, processing and marketing of high-grade lubricating oil products in several countries all over the world. Plaintiff No. 1 claimed to be the registered proprietor of various trade marks in India, including CASTROL, CASTROL logo and ACTIV, which is used by Plaintiff No. 1 along with the well known house mark CASTROL. The trade mark CASTROL ACTIV 4T was claimed to be continuously and extensively used and had acquired secondary meaning. Plaintiff No. 1 asserted that the product - for use in all 4 stroke motorcycles - under the trade mark CASTROL ACTIV 4T was sold in a plastic container, having unique shape and particular configuration including distinctive grey colour and red cap and that the shape and configuration of the said container had never been used by any manufacturer prior to the Plaintiffs. The packaging of the ACTIV 4T product as well as shape of the container were claimed to be the exclusive properties of the Plaintiff No. 1 and were claimed to have acquired a unique and enviable goodwill and reputation.

The Plaintiffs learnt that the Defendants were manufacturing and selling engine oil for motorcycles and other vehicles bearing the trade mark Opel AKTIVA 4T which is deceptively similar to the mark of the Plaintiffs i.e. ACTIV 4T. The Defendants had also copied the plastic container having the same shape, size, colour and configuration, and colour combination, get up and features of the Plaintiffs' sticker label. Further, the Defendants had not given their name and address on the packaging in order to confuse the trade.

On *ex-parte* evidence being led by the Plaintiffs, the Court was of the view that the Defendant's mark AKTIVA 4T was deceptively similar to the registered trade mark of the Plaintiffs and that the Plaintiffs have been able to establish the essential ingredients of infringement. The Court observed that a comparison of the two products would show that the Defendants have used similar colour scheme/combination and features and their dishonesty was evident. The Plaintiffs were also awarded punitive damages of INR 200,000.

Zippo Manufacturing Company Vs. Anil Moolchandani and Ors.

The Plaintiff had sought injunction, restraining the Defendants from manufacturing and selling lighters which are deceptively similar to the registered 3-dimensional shape mark of the Plaintiff. The Plaintiff claimed to be world leader in manufacture and trade of lighters under the trade mark ZIPPO, which was claimed to be registered and also well-known. The Plaintiff claimed that the chimney or windscreen enclosing the wick with round air holes punched into its sides in horizontal rows of three-two-three formation and shape of the lighter were unique and had acquired a secondary meaning to denote the Plaintiff's cigarette lighters.

The Plaintiff came across the Defendant No. 2 selling counterfeit lighters bearing the same word mark. The counterfeit lighters were alleged to be verbatim imitation of the product of the Plaintiff. During the pendency of the Suit, Defendants Nos. 1-3 agreed to give-up the impugned activities. The Suit continued against Defendant No. 4.

On *ex-parte* evidence being led by the Plaintiff, the Court observed that by using the name ZIPPO and/or the 3-dimensional shape, Defendant No. 4 is trying to pass off his goods as those of the Plaintiff. The Court also noted that if the said Defendant was not restrained, customer may purchase product of Defendant No. 4 under mistaken belief that he was purchasing reputed product of the Plaintiff. Further, if the quality of the product of Defendant No. 4 was not found to be as good as the quality of the products of the Plaintiff, it may prejudicially affect the financial interest of Plaintiff and tarnish the reputation of the brand ZIPPO. The Court was of the view that the Plaintiff has been able to make out a case of infringement as well and granted permanent injunction. Plaintiff was also awarded punitive damages of INR 500,000, *pendente lite* and future interest at the rate of 6% p.a. on the amount of damages.

2013-2014							
S. no.	Case Name	Citation	Decision Date	Court	Subject	Nature of the mark	Summary
1.	Hermes International and Anr. v. Sahil Malik	CS(OS) 1859/2012	February 07, 2013	High Court of Delhi	Infringement	Shape	The Plaintiff is a French brand Hermes, which is in the business of making luxury leather bags for women. The Defendant is an Indian leather bag manufacturer, Da Milano. This case of the Plaintiff was that the defendant has copied the shape and design of their Birkin Bag. The Defendant contended that the while the Birkin Bag cost upwards of Rs 6 lacs, Da Milano's purses cost approximately Rs 10,000. Further, the shape was not identical. Note: The shape of the Birkin bag has been granted protection by the United States Patents and Trademarks Office. Hermes was granted an injunction order from the Delhi High Court against Da Milano. Note: the matter was settled in 2016.
2.	Ferrero SPA and Ors. V Mahendra Dugar and Ors.	2013(55)PTC 277(Del)	July 24, 2013	High Court of Delhi	Infringement	Colour /Shape	<p>The Plaintiffs in this case, Ferrero, are world renowned chocolate makers who make distinctive chocolates with a rounded crushed gold wrappers covering nutty chocolate balls.</p> <p>It is stated that the word 'FERRERO' is a foreign surname and has no meaning in India except as a trademark for high quality, delicious chocolates and confectionery of Plaintiff No. 1. Plaintiff No. 2 is the Indian subsidiary of Plaintiff No. 1, having its registered office at Primrose Road, Gurapa Avenue, Bangalore and the branch office at Delhi.</p> <p>Shortly before the suit was filed the Plaintiff learnt that the Defendants were producing look-a-likes of FERRERO ROCHER and are selling the same under the name 'ROYS'.</p> <p>The Court was of the view that the Plaintiff has been able to prove that Defendant No. 2 is infringing the registered trademarks as well as the trade dress of the Plaintiff and that</p>

							<p>by permitting the Defendant No. 2 to continue marketing and selling its product 'ROYS, which is a look-alike of the Plaintiff's chocolate FERRERO ROCHER, there will be a continued infringement of both the registered trademark and trade dress of the Plaintiff's products.</p> <p>Hence, the Defendant was refrained from making look-alike chocolates which are similar to the Plaintiff's chocolate. Furthermore, the Court awarded damages of Rs. 10,00,000 to the Plaintiff.</p>
3.	Hindustan Unilever Ltd. Vs. Respondent: Reckitt Benckiser (India) Ltd	2014(57)PTC 78(Cal)	September 23, 2013	High Court of Calcutta	Nominative fair use / Comparative Advertisement	Colour /shape	<p>The Plaintiff filed this suit after the Defendant started an advertisement campaign wherein the products of both the parties were compared. It is the case of the Plaintiff that the antiseptic dishwasher mentioned in the advertisement is in reference to the Plaintiff's Dettol antiseptic liquid because it has 85% market share. That the colour can be easily identified with Dettol. Identification with Dettol is easier by the use of the bottle the shape of which is similar to the Dettol Antiseptic Liquid bottle containing the amber colour liquid.</p> <p>The Defendant contended that the Bottle does not resembles that of the Plaintiff's product. They also contended that the Plaintiff cannot claim any monopoly over the colours brown or amber.</p> <p>The Court observed: <i>84. Whatever may be the contentions of the learned counsel for the defendant, the emergence of the bottle with an amber liquid, in the little plot of the advertisement, would convey to any reasonable person, having knowledge of Dettol Antiseptic Liquid and dishwash, for the reasons given for</i></p>

							<p><i>advertisement I that the bottle referred to Dettol Antiseptic Liquid.</i></p> <p>The Court held that by making such advertisement the defendant has denigrated the product of the plaintiff, in the way conceptualised in the De Beers case.</p>
4.	The Coca Cola Company v Narsing Rao	2014(58)PTC 407(Del)	March 06, 2014	High Court of Delhi	Infringement	Shape	<p>The Plaintiff filed a suit to restrain the Defendants from infringing their trademark KINLEY CLUB SODA, KINLEY and DANUBE Bottle Shape. The Court concluded that the Defendant's mark KELBY is confusingly similar to KINLEY. As regards to the identical shape of the bottles of both the parties, the Hon'ble High Court followed the dicta of the Bombay High Court's Decision in Gorbatschow Wodka KG v John Distilleries Limited () in which the Bombay HC held:</p> <p><i>A manufacturer who markets a product may assert the distinctive nature of the goods sold in terms of the unique shape through which the goods are offered for sale.</i></p> <p><i>16.....The shape of the bottle which the plaintiff has adopted has no functional relationship with the nature of the product or the quality required of the container in which Vodka has to be sold. The shape, to use the language of a leading authority on the subject, is capricious. It is capricious in the sense that it is novel and originated in the ingenuity and imagination of the plaintiff.</i></p> <p>And held that the Defendant was infringing the Plaintiff's intellectual property and hence was restrained.</p>

5.	Whirlpool of India Ltd. v Videocon Industries Ltd.	2014(60)PTC 155(Bom)	May 27, 2014	High Court of Bombay	Infringement (Design) / Passing off	Shape	<p>The Plaintiff is subsidiary of Whirlpool Corporation, which is one of the world's leading manufacturers of home appliances and a pioneer in India for washing machines and manufactures all three types of washing machines viz. semi automatic, fully automatic (top loading) and a fully automatic (front loading) targeting different segments of consumers.</p> <p>In this case the Defendant was held liable for Design infringement.</p> <p>The Plaintiff also alleged that the Defendants were passing off their goods as that of the Plaintiff.</p> <p>The Hon'ble Bombay High Court observed that</p> <p><i>"47. It is not disputed that an action for passing off will lie to protect the goodwill and/or reputation stemming from shape of goods. It is also not disputed that the definition of a mark under Section 2(z) of the Trade Marks Act, 1999 includes 'shape of goods'. The only enquiry which needs to be made is whether a person who purchases the defendant's product is likely to be misled into believing that he was purchasing the Plaintiff's product."</i></p> <p><i>49. The fact that substantial goodwill and reputation inheres in the Plaintiff's machines distinctive shape and get up and/or colour scheme and/or overall appearance cannot be disputed. As already stated above, in the period of two years since the Plaintiff launched the machine, till the filing of the suit the Plaintiff sold more than 308152 pieces and enjoyed aggregate sales in excess of Rs. 308 crores. Consequently, this is sufficient to constitute actionable goodwill and/or reputation in so far as the Plaintiff's product is concerned</i></p>
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6.	Deere & Co. & Anr. vs S. Harcharan Singh & Anr.	CS(OS) No.3760/2014	December 05, 2014	High Court of Delhi	Infringement	Colour	<p>The Plaintiff in this case, referred to as John Deere claimed to be one of the leaders in the Indian Tractor market. Defendants were manufacturing and selling lookalikes of the Plaintiff's farm equipment such as Tractors, Harvesters and Combines under the trade name/mark 'SURINDERA', using the Plaintiff's logo and trade dress which bears striking resemblance with the Plaintiffs' registered colour mark of Green and Yellow.</p> <p>The Plaintiff contended that the manner of use of this colour combination by the defendants' is also deceptively similar to that adopted by the plaintiffs, i.e. the body of the vehicle being painted Green with the wheels and the seat of the vehicle being painted Yellow.</p> <p>The Delhi High Court observed that as per Section 2(m) and 2(zb) of the Trade Marks Act, 1999 that colour combinations can be trademarks if they are distinctive and exclusively associated with the trader.</p> <p>The Court, restrained the Defendants and the parties associated to them.</p>
2015-2016							
7.	Assam Roofing Ltd. & Anr v. JSB Cement LLP & Anr	2016 (68) PTC 37 [Cal]	09th December , 2015	High Court of Calcutta	Infringement	Colour	<p>The Petitioners are engaged in the business of manufacturing galvanized iron sheets, asbestos, cement sheet and roofing accessories. They were selling asbestos sheets under the mark "Rhino" in colour scheme of red, black and white. This colour scheme through continuous and extensive use has become a well-known trademark and acquired a secondary significance. The Respondents manufactured cement products bearing mark "Rhino" with red black and white colour combinations.</p>

							The Court granted injunction restraining them from manufacturing, marketing, selling, distributing, advertising and/or otherwise dealing any cement (similar trade channel) under the mark "Rhino" with the colour scheme, get up to the Petitioner and also from infringing the registered trademarks.
8.	Skechers USA Inc. & Ors. v. Pure Play Sports	2016 (67) PTC 324 [Del]	25th May, 2016	High Court of Delhi	Infringement	Colour /Shape	<p>Plaintiffs are engaged in the business of designing, developing and marketing uniquely and distinctively designed lifestyle footwear, one of them being the SKECHERS GOwalk footwear line. Defendant copied several aspects of the trade dress such as colour combination, textures, style, cut and stitching of the plaintiff's shoes.</p> <p>Court held that the copying on the soles of shoes is a give-away of the copy of the Defendant's attempt to copy. Defendants are prohibited and injunction is granted.</p>
9. 9 .	Alkem Laboratories Ltd. v. Elnova Pharma & Anr	2015 (62) PTC 465 [HP]	23rd July, 2014	High Court of Himachal Pradesh	Infringement , Passing off	Colour / Shape	<p>Respondent is a subsequent entrant in the market in relation to the GEMCAL product consisting of Calcitriol, Calcium Carbonate, Zinc etc. - introduced by the respondent in February, 2012 while the applicant had already entered the market in the year 2000. Both the products are in the market by the same name.</p> <p>Court partly allowed application and restrained the Respondent from using GEMCAL product and packaging similar to the Applicant apart from grant of interim injunction being restrained from using slogan PEARL OF CALCIUM.</p>

S no	Case Name	Citation Date	Decision Date	Court	Subject	Nature of the mark	Summary
1.	Christian Louboutin SAS vs. Pawan Kumar and Ors.	2018(73) PTC 403(Del)	12.12.2017	Delhi High Court	Infringement and passing off	Colour mark	Plaintiff's products which are shoes bear a distinctive 'red sole'. The Court held, <i>inter alia</i> , that the Defendant had adopted an identical red sole for their products. Defendant was restrained.
2.	Ferrero SPA and Ors. vs. Kamco Chew Food Private Limited and Ors.	MANU/DE/4570/2019	18.12.2019	Delhi High Court	Infringement and passing off	Trade dress/Shape	Plaintiff's products which were Chocolate egg shaped confectionaries sold with toys under the trademark KINDER JOY. The Court held that the Defendant had adopted the mark MOTU PATLU but with an identical colour combination and trade dress of the product. Defendant was restrained and damages granted.
3.	LA Opala R.G. Ltd. vs. Cello Plast and Ors.	2018(76) PTC 309(Cal)	11.10.2018	Calcutta High Court	Infringement and passing off	Trade dress	The Plaintiff's products which were cutlery include plates had specific designs on them marketed under the brand name Opala. The Defendant adopted the same designs on the plates but sold them under the mark Cello. The Court held that the trade dress was identical and the Defendant was restrained.
4.	Apollo Tyres Ltd. vs. Pioneer Trading Corporation and Ors.	2017(72) PTC253(Del)	17.08.2017	Delhi High Court	Infringement and passing off	Trade dress/Shape	Plaintiff's trade dress claim was the tread design of the tyres that it manufactured and sold. The Court held that the Defendant's products bore the identical tread and that the Plaintiff's trade dress was infringed. Defendant was restrained.
5.	Reckitt Benckiser (India) P. Ltd. vs.	MANU/DE/3783/2019	31.10.2019	Delhi High Court	Infringement and passing off	Trade dress/Shape	Plaintiff alleged that the shape and colour combination of its products which were bathroom

	Surekhaben L. Jain and Ors.						disinfectants was copied by the Defendant. The Court passed a decree based on the settlement reached by the Parties which included the cessation of the use of the Defendant's product shape including the bottle cap shape.
6.	Unilever PLC. Vs Lucky Products	darts-343-614-G-en-2	25.02.2019	Bombay High Court	Infringement and passing off	Trade dress/Shape	Plaintiff alleged that the shape and colour combination of its products which was sold under the mark VASELINE was copied by the Defendant. The Court granted an interim injunction against the Defendant citing the identical shape and colour combination of the products sold.
7.	Marico Limited vs. Aashi Personal Care	darts-828-327-G-en	26.04.2019	Delhi High Court	Infringement and passing off	Trade dress/Shape	Plaintiff alleged that the shape and colour combination of its products which was sold under the mark Parachute was copied by the Defendant. The Court granted an interim injunction against the Defendant citing the identical shape and colour combination of the products sold.
8.	SBS BIOTECH (UNIT II) & ORS vs SAMPHIRE FOOD & PHARMA (P) LTD & ANR	darts-297-942-F-en	05.07.2018	Delhi High Court	Infringement and passing off	Trade dress/Shape	Plaintiff alleged that the shape and colour combination of its packaging and bottle was copied by the Defendant. The Court granted an interim injunction against the Defendant citing the identical shape and colour combination of the products sold.