

In the Supreme Court of Bangladesh
High Court Division
(Civil Appellate Jurisdiction)

First Miscellaneous Appeal No. 76 of 2021.

With
Civil Rule No. 485 (FM) of 2020.

In the matter of:

Asian Consumer Care (Pvt.) Limited,
represented by its Director, Rakesh
Kumar Agrawal of South Breeze
Square (5th Floor), 52 Gulshan Avenue,
Gulshan, Dhaka-1212.

..... Defendant No.1-Appellant.

Vs.

Marico Limited & others.

....Respondents.

Mr. A.F. Hassan Ariff with

Mr. Ariful Islam with

Mr. Md. Monowar Hossain, Advocate.

...For the Defendant No.1-Appellant

Mr. A.M. Amin Uddin, Attorney General
(appearing in personal capacity) with

Mr. Kazi Ershadul Alam, Advocate

..For the respondent Nos. 1 and 2.

Heard on 18.11.2021, 02.02.2022,

02.03.2022, 03.03.2022 and

06.03.2022.

Judgment on: 14.03.2022.

Present :

Mr. Justice Sheikh Hassan Arif

And

Mr. Justice Ahmed Sohel

SHEIKH HASSAN ARIF, J

1. This appeal, at the instance of the defendant No. 01 in Title Suit No. 30 of 2020 pending before the Court of District Judge, Dhaka, is directed against Order No. 08 dated 17.11.2020 passed by the said Court in the said Suit,

thereby, rejecting defendant No. 01's application under Order 39, rule 4 read with Section 151 of the Code of Civil Procedure for setting aside the ad-interim order of status-quo passed by the said Court on 27.09.2020.

2. Background Facts:

2.1 Facts, relevant for the disposal of the appeal, in short, are that the respondent Nos. 01 and 02 (Marico Limited and Marico Bangladesh), as plaintiffs, filed the said Title Suit No. 30 of 2020 before the Court of District Judge, Dhaka under Sections 96, 97 and 24(2) of the Trademarks Act, 2009 seeking permanent injunction against the appellant (defendant No. 01) and its servants, employees etc. for restraining them from infringing the registered trademarks of the plaintiffs, namely "PARACHUTE" and "PARACHUTE ADVANCED" along with the bottle design, colour etc.

2.2 The case of the plaintiffs, in short, is that:

(a) Plaintiff No. 01 (Marico Limited) is the leading consumer goods company operating in more than 25 countries across Asia and Africa. That among various products, it produces and sells/markets various leading brands including "PARACHUTE" and

“PARACHUTE ADVANCED”, which are high quality hair oils. That the said products are produced in Bangladesh through plaintiff No. 02, who markets them in Bangladesh, and the said two products have in the meantime become household items in Bangladesh. That the trademark “PARACHUTE” has been registered in India under the Indian Law and plaintiff No. 01, through plaintiff No. 02, is the registered owner of trademarks **PARACHUTE** and **PARACHUTE ADVANCED** in Bangladesh in respect of coconut oil and hair oil products.

- (b) That in 1997, after extensive research, the plaintiff No. 01 came up with new look and logo of the said products and, accordingly, the same were registered as copyrights in Bangladesh in 2003 and 2004. That the said products are marketed in Bangladesh in blue colour plastic bottles and it has registration of its design, being design Nos. 04047, 06787 and 08643, for its blue bottles. That the plaintiff No. 01 has also obtained registration of its trade dress including bottle with blue colour and distinctive shape from the Department of Patents, Design & Trademarks and

Government of the People's Republic of Bangladesh bearing Registration Nos. 182024 and 182025. That the plaintiff No. 01 has also obtained registration of trademarks in respect of the said **PARACHUTE** and **PARACHUTE ADVANCED**, being registration No. 45634 dated 30.12.1995, registration No. 75614 dated 03.06.2002 and registration No. 45636 dated 13.12.1995 in respect of the said coconut oil and related products in class 03, 05 and 29, and the specimen of the products of the plaintiff's registered trademarks are shown in schedule-A to the plaint. That the bottle shape, cap, configuration, design, blue colour get-up of the bottle are the hallmarks of plaintiffs' products and that they together constitute the trade dress of the plaintiffs.

- (c) That while the plaintiffs were dominantly marketing the said products in Bangladesh under the said registered trademarks, defendant No. 01, by launching their products of coconut hair oil, namely Dabur গোল্ড খাঁটি নারিকেল তেল, started infringing the registered trademarks and trade dress of the plaintiffs' said products inasmuch as that the blue bottle, colour scheme,

arrangement of design elements, artistic and graphical representation of the said products of defendant No. 01 are deceptively similar to the registered trademarks of the plaintiffs and that the said products are confusingly similar to the trade-dress and get-up of plaintiffs' said products. That the defendant No. 01 has been doing the same in order to cause damage to the business of the plaintiffs in a very deceptive way and that it has also used similar colour of packaging along with coconut splash, colour combination, placement or arrangement of artistic elements, shape, size of the bottle and overall get-up on its products in order to confuse the people. That the specimen of defendant No.1's product is given in Schedule B to the plaint.

- (d) That some other entities also tried to infringe the trademarks of the plaintiffs in the past and accordingly, the plaintiffs obtained permanent injunction against them in Title Suit No.17 of 2015, Title Suit No.21 of 2018, Title Suit No.35 of 2019 and Title Suit No.26 of 2019 on the ground of using trade-dress/get-up/packaging deceptively similar to plaintiffs' said products. That the plaintiffs issued notice in national

dailies, namely in the Daily Samakal and the Daily Swadesh Pratidin, cautioning about such infringements, but got no positive response. Accordingly, the plaintiffs filed the said suit seeking permanent injunction against the defendant No.1 with the aforesaid prayers.

2.3. Along with the said suit, the plaintiffs filed an application seeking temporary injunction under Order XXXIX, rules 1 and 2 of the Code of Civil Procedure read with Section 151 of the Code. Thereupon, the Court below, vide order dated 27.09.2020, issued show-cause notices upon the defendants and, by the same order, passed an ex parte ad-interim order of status-quo restraining the defendant Nos. 1-4 from infringing the trademarks of the plaintiffs. Upon knowing about the said ad-interim order of status-quo, defendant No.1 entered appearance and filed an application under Order XXXIX, rule 4 read with Section 151 of the Code for setting aside the said ad-interim order of status-quo dated 27.09.2020. The defendant No.1 also sought early disposal of the said application by filing applications and, at one stage, filed First Miscellaneous Appeal (being FMAT No. 560 of 2020) before the High

Court Division challenging inaction of the Court below in disposing of the said application. Thereupon, the High Court Division directed the Court below to dispose of the said application filed by the defendant No.1 on the next fixed date i.e. on 17.11.2020. As against such application for setting aside the said ad-interim order, the plaintiffs filed written objection. Thereupon, the Court below, after hearing the parties, rejected the said application filed by the defendant No.1 vide impugned order dated 17.11.2020. Being aggrieved by such rejection, defendant No.1 preferred this appeal. Thereafter, on an application of the defendant-appellant, this Court issued the connected Rule, being Civil Rule No. 485(FM) of 2020, vide order dated 13.02.2020. At the time of issuance of the said Rule, plaintiff-respondents entered appearance. Thereupon, this Court fixed the Rule for hearing upon treating the same as ready for hearing. Thereafter, upon reconstitution of the bench by the Hon'ble Chief Justice, this Bench of the High Court Division has fixed the appeal and connected Rule on the prayer of the defendant-appellant.

2.3 The appeal and the connected Rule are contested by the respondent Nos. 1 and 2 (plaintiffs).

3. Submissions:

3.1 Mr. A.F. Hassan Ariff, learned senior counsel, along with Mr. Ariful Islam, learned advocate, has made the following submissions on behalf of the defendant No.1-appellant:

- (1) That as per the definitions of the terms “Mark” and “Trademark”, as provided by Section 2(23) and 2(8) respectively of the Trademarks Act, 2009, a bottle or a particular colour of a bottle cannot be regarded as trademark. Therefore, any other entity may sell or market the same product by using similar coloured bottle. This being so, the product of the defendant-appellant, namely Dabur গোল্ড খাঁটি নারিকেল তেল, in a blue bottle cannot be held to be infringement of registered trademarks of the plaintiffs.
- (2) By referring to the said definition of the term “Mark” again, Mr. Ariff submits that no single colour can be monopolized by any entity as its trademark in respect of a particular product. Rather, it has to be a combination of colours or combination of various things, namely device, brand, heading, level etc. as mentioned in the said definition. Therefore, according to him, the Court below committed illegality in granting injunction or in refusing to

set aside the status-quo order granted earlier in favour of the plaintiffs.

- (3) By referring to Section 7 of the said Act, in particular subsection (2) thereof, he submits that since the products of the plaintiffs have not been registered in respect of a particular colour or in respect of blue colour, there cannot be any restriction on other entities like the defendant No.1 in marketing same product using the said blue colour on its bottles.
- (4) By referring to the averments in the plaint as well as the application filed by the defendant No.1 before the Court below, he submits that the admitted position is that both the 'PARACHUTE' and 'Dabur গোল্ড খাঁটি নারিকেল তেল' are widely sold and marketed in India as both the companies are Indian domiciled companies doing business in Bangladesh through their representatives or agents. Therefore, he submits that since the plaintiffs never brought any infringement action or proceedings against Dabur in India, they have been doing so in Bangladesh only to monopolize the market in order to avoid fair competition. In support of his such submissions as regards illegality in monopolizing a particular colour, Mr.

Ariff has referred to a decision of Delhi High Court in **Christian Louboutin SAS vs. Abubaker and ors** [CS (COMM.) No. 890/2018] (copy obtained from manupatra). According to him, in the said case, a Division Bench of the Delhi High Court did not allow a party to use a particular red colour in the sole of ladies shoes as trade mark. He has also cited another decision of Delhi High Court in **Colgate Palmolive Co. Limited and ors. vs. Patel and ors.**[CS(OS) No. 672/03](copy obtained from manupatra). Thus, he submits that the Court below has committed illegality in refusing to set-aside the order of status-quo granted earlier in favour of the plaintiffs.

3.2 As against above submissions, Mr. A.M. Amin Uddin, learned Attorney General (appearing in personal capacity), has made the following submissions on behalf of the plaintiff-respondents:

- i) That the basic test for determining the infringement is provided under sub-section (5) of Section 10, as amended, of the said Act, which, according to him, is “confusingly similar” in that such similarity may confuse the unaware people to regard the products of

defendant No.1 as the products of the plaintiffs. Therefore, he submits that since the shape of bottle, colour and design, including the splash of the broken coconut used by the defendant No.1 on its bottles, are confusingly similar to the design, layout, colour and bottle of the plaintiffs' products, this is a clear case of infringement of trademarks.

- ii) By referring to the visual look of both the products of the plaintiffs and defendant, he submits that, admittedly, the products of the plaintiffs entered the market of Bangladesh long before the products of the defendant and that the trademark of plaintiffs' products have already been registered, but the design, colour or whatever of the defendant's product has not yet been registered. This being so, according to him, being registered trademarks, the plaintiffs' trademarks will get legal protection from the Court, particularly when there is a clear case of infringement of such trademarks by the defendant's product. Accordingly, he submits that the Court below has committed no illegality either in granting the ad-interim order of status quo in favour of the plaintiffs or in

rejecting the application filed by the defendant No.1 for setting aside the said ad-interim order of status quo.

- iii) By referring to a single bench decision of our High Court Division in **Jamal Uddin Ahmed vs. Abdul Haque, 55 DLR(2003)-102**, in particular paragraph 23 of the reported case, he submits that this Court has already decided that the test to determine such similarity should be whether the member of public is at risk of getting confused and, in such case, actual confusion or deception is not necessary. Rather, mere likelihood of confusion or deception is enough. In support of his such submissions, he has also referred to two other decisions of our jurisdiction in **N.L. Chem. Inds. vs. Registrar, Trade Mark, 13 DLR(1961)-657** and **A B. Biscuit Co. Ltd. vs. Haque Broghers Ltd. 36DLR (1984)-107**.

4. Deliberations, Findings and Orders of the Court:

- 4.1 To address the issues raised by the parties, let us first examine, in short, relevant provisions of the Trademarks Act, 2009. Since the definitions of two terms, namely 'Mark' and 'Trademark', as provided by the said Act,

have been referred to repeatedly by Mr. Ariff, we are reproducing the same for our ready reference:

২(২৩) “মার্ক” অর্থ কোন ডিভাইস (device), ব্র্যান্ড (brand), শিরোনাম (heading), লেবেল (label), টিকেট, নাম, স্বাক্ষর, শব্দ, অক্ষর, প্রতীক, সংখ্যা, সংখ্যায়ুক্ত উপাদান, রং এর সমন্বয় বা এইগুলির যে কোনরূপ সমন্বয়ও উহার অন্তর্ভুক্ত হইবে;

২(৮) “ট্রেডমার্ক” অর্থ—

(ক) ধারা ৭৭ ব্যতীত দশম অধ্যায়ের বিধানের ক্ষেত্রে,-

(অ) কোন নিবন্ধিত ট্রেডমার্ক অথবা কোন পণ্যের সহিত ব্যবহৃত এমন কোন মার্ক যাহাতে ব্যবসায় উক্ত পণ্যের উপর মার্ক ব্যবহারকারী স্বত্বাধিকারীর অধিকার রহিয়াছে মর্মে প্রতীয়মান হয়;

(আ) কোন সেবার সহিত ব্যবহৃত এমন কোন মার্ক যাহাতে ব্যবসায় উক্ত সেবার উপর মার্ক ব্যবহারকারীর স্বত্বাধিকারীর অধিকার রহিয়াছে মর্মে প্রতীয়মান হয়;

(খ) এই আইনের অন্যান্য বিধানের ক্ষেত্রে, কোন সেবা বা পণ্যের সহিত ব্যবহৃত বা ব্যবহারে জন্য প্রস্তাবিত এমন কোন মার্ক যাহার স্বত্বাধিকারী বা নিবন্ধিত ব্যবহারকারী হিসাবে ব্যবহারের অধিকার রহিয়াছে বলিয়া প্রতীয়মান হয়;

(গ) সার্টিফিকেশন ট্রেডমার্ক;

(Underlines supplied)

4.2 It appears from the above two definitions, in particular the definition of the term ‘Mark’ that the said definition is not an exhaustive one. Rather, it includes any word or words, letter or letters, numeral or numerals, device or devices, brand, tickets, heading, signature, name, surname, combination of colour or even any combination of some

of them or all of them. Therefore, the term 'Mark' may be of anything which has distinctive feature because of the words, label, brand, name, signature etc. or colours or combination of colours used therein.

4.3 Again, the term "trademark" signifies a connection between the said 'mark', on the goods with some persons having the right as proprietors to use that 'mark' in his trade or business. Therefore, *"A trademark is a visual symbol in the form of a word, a device, or a label applied to articles of commerce with a view to indicate to the purchasing public that they are the goods manufactured or otherwise dealt in by a particular person as distinguished from similar goods manufactured or dealt in by other persons"* (see P. Narayanan, Intellectual Property Law, Eastern Law House (Second Edition), page 119). Therefore, the inherent requirement is that a trademark should be descriptive enough so as to be indicative of the nexus between the goods and the mark owner [Nirlex Spares (P) Ltd. vs. CCE, (2008) 2 SSC 628].

4.4 Be that as it may. In order to get registration of a particular trademark, someone needs to pass various hurdles set by our Legislature, namely the prohibitions

provided by our Legislature against such registration under Section 8 of the Trademarks Act, 2009. One of such hurdles, as provided by Section 8(Ga), is that such registration cannot be given when the use of such mark would be likely to deceive or cause confusion. Further restrictions have also been provided by our Legislature under Section 10 of the said Act. Sub-section (1) thereof, particularly, provides that such registration should not be given in respect of any goods or description of goods which is identical with or deceptively similar to a trademark already registered in favour of a different proprietor. Not only that, sub-section (5) of Section 10 has given extended meaning of such deception or confusion by particularly providing that if such trademark is one to be similar to any already registered well known trademark or if it is found to be confusingly similar to such already registered well known trademark, such registration cannot be given which may create a false conception that there is a connection between those goods and the owner of the said already registered trademark.

4.5 Admittedly, once a trademark is registered in favour of a particular entity in respect of a particular product, such trademark automatically gets some legislative protection as provided by Chapter IV of the said Act. As per the provisions under Sections 96 and 97 of the said Act, the proprietor or owner of such registered trademark may bring an action against a delinquent party alleging infringement of his trademarks and seek permanent injunction or any temporary injunction against that party. The case in hand, in particular the Title Suit No. 30 of 2020 filed by the plaintiffs, is such an action brought by them seeking protection of their trademarks alleging that such trademarks are being infringed by the defendant No.1 by marketing/selling its product ‘Dabur গোল্ড খাঁটি নারিকেল তেল’, the specimen of which has been given in Schedule B to the plaint.

4.6 Now, the question is, whether this particular product, which is physically available before, is confusingly similar to the trademarks of the plaintiffs’ products, namely ‘প্যারাসুট অ্যাডভান্সড’, which is, admittedly, an already registered well-known trademark in Bangladesh. Apart from reports in the newspapers as mentioned by the

plaintiffs in the plaint as regards dominance of the products of the plaintiffs in the market of Bangladesh, learned counsel appearing for the defendant-appellant has frankly admitted that the products of the plaintiffs, namely ‘প্যারাসুট অ্যাডভান্সড’ and ‘প্যারাসুট কোকোনাট অয়েল’, have a lion’s share in the market of Bangladesh. It has also been admitted by the parties that the ‘Dabur গোল্ড খাঁটি নারিকেল তেল’ of defendant-appellant has not only entered long after the plaintiffs’ products, it is yet to be a registered trademark in Bangladesh.

4.7 Now, let us examine whether the product of the defendant-appellant, namely ‘Dabur গোল্ড খাঁটি নারিকেল তেল’, has any likelihood to confuse the unwary public or consumers in Bangladesh to treat the same as product of the Plaintiffs or same product. As stated above, subsection (5) of Section 10, as amended vide Act No. 23 of 2015, has made it clear that the similarity between two products need not be a deceptive similarity, rather if the product in question is confusingly similar, that will also be barred even from getting registration. In this regard, it may be noted that the two ‘marks’, when compared side by side, may exhibit many points of dissimilarity. Yet, the

idea left by both in the mind may be the same. One of the examples of such similar ideas of two marks, as has been given by the text book **P. Narayanan, Intellectual Property Law, Eastern Law House (Second Edition), page-150**, may be referred to. The said text book has used an example of the pictorial representation of a game of football or hockey. According to it, one can make any number of representations by showing the players in different positions or in different dresses, but all of them would convey the idea of a game of football or a game of hockey, as the case may be. Therefore, two such representations, when used as trademarks by different persons in relation to same goods, will undoubtedly cause confusion and deception. Another such interesting example may be found in an Indian case, namely in **Gorbatschow Wodka Kg v John Distilleries Ltd, (2011) AIR 2012 NOC 53 (Bom)**. In the said case, a person used a bottle design for his vodka, which was deceptively similar to the pre-existing producer's bottle design. It was regarded as violating the trademark because the expression "trademark" includes the shapes of goods, their packing and colour combinations. In the said case, a plea was taken that

since the purchasers of vodka (alcoholic products) belonged to educated and affluent class of people, there was very remote possibility of deception. However, such plea was not accepted by the Court.

4.8 It has to be borne in mind that the suit filed by the plaintiffs is not a suit challenging the trademark registration of defendant or it is not an objection before the trademark authority not to give registration of trademark in favour of the defendant in respect of the said 'Dabur গোল্ড খাঁটি নারিকেল তেল'. According to the plaintiffs, the defendant is passing-off its products as if it is selling the products of the plaintiffs or as if the product of the defendant has any connection with the plaintiffs. In such a case, the law, as defined by **Lord Langdale** in *Perry v. Truefitt* (1842) 6 Beav 66, is very pertinent to be quoted here: *“A man is not to sell his own goods under the pretext that they are the goods of another man.”* In such a case, it was held that the goodwill of a product has to be protected. It is true that there is no right of property in the name, mark or get-up that the plaintiffs use. Rather, it is the customer connection with the product that is

protected, particularly when goodwill has no independent existence without the business.

4.9 However, such protection cannot be given in favour of the plaintiffs where it is found that such colour has a common use and has already acquired a common use in respect of a particular product. It is not the case of the defendants before us or the Court below that the blue colour has become a well-known colour for coconut hair oil. Even the parties before us have shown different photographs of coconut oil products having different colours. When a particular colour has acquired a particular identity in respect of a particular kind of goods or products, then that colour may be used by anybody while marketing that particular goods. Exactly this was the scenario in the case cited by Mr. Ariff, namely in **Christian Louboutin SAS vs. Abubaker and others**. In that case, it was particularly found by the Delhi High Court that red colour of the sole of ladies shoes had become a particular type of colour which was commonly used for ladies shoes. Therefore, no protection against the use of such colour was given in favour of the plaintiffs therein. Similar philosophy or reasons could be found in

the other case cited by Mr. Ariff, namely in **Colgate Palmolive Co. Limited and Ors vs. Patel and Ors.**, It was particularly found therein that red and white colour combination had become common to toothpaste trade in domestic and international market. Accordingly, it was held that such red and white colour combination in a toothpaste product could not be monopolized by any party.

4.10 As stated above, it is not the case of the defendant before the Court below, or before us, that blue colour bottle has become symbolic for coconut oil trade. We have not so far found any such prima-facie indication in the materials produced by the parties that blue colour on a similarly sized bottle of plaintiffs' 'প্যারাসুট অ্যাডভান্সড' product has become a symbolic colour for marketing and selling the coconut oil in Bangladesh. Therefore, the submission of Mr. Ariff on the point of monopolizing the blue colour by the plaintiffs does not have that much strength to stand. Besides, it has been decided by the superior courts of our sub-continent that such similarity does not need to be exact similarity. Rather, it is enough whether such similarity may cause a confusion among

unwary potential consumers of such products who might treat such products having any connection with the plaintiffs' products.

4.11 It is known to everyone that most of the customers of this type of coconut hair oil are very ordinary people and such people do not purchase a particular coconut oil by meticulously comparing two labels of two products of two different entities. Rather, they purchase it merely relying on normal visual representation of such products. Although we are not required to exactly compare the product of the plaintiffs with that of the defendant in a very meticulous way, yet, even if we do such comparison through our normal eyes, it will be found clearly that the defendant has very smartly used not only the blue colour on the bottle of its product, it has also used almost similar sized bottle having confusingly similar shape. Not only that, it has smartly, if not deceptively, used the combination of blue, white and green colours in a very confusing way. The splash of broken coconut, as used by the defendant on its bottle along with the aforementioned combination of colours, leaves no doubt that it has done so in order to grab some portion of the market of the

plaintiffs. Although, we do not have specific evidence for reaching such conclusion, we have prima facie found that this product of defendant, with those colour combination, design and layout, has every likelihood to cause confusion among the unwary people of Bangladesh to regard the same as having any connection with the product of the plaintiffs and/or with the plaintiffs. Therefore, we are of the view that the case for determining the infringement or passing-off has been prima-facie made out by the plaintiffs. Accordingly, the plaintiffs are entitled to get protection of law and Court at this stage.

4.12 It further appears from the impugned order that exactly the same conclusion has been reached by the Court below, although in a different way and in different languages. If we read the concluding remark of the Court below in the impugned order, it will be clear that it has not based its decision on a particular blue colour of the bottle. Rather, it has observed that *“in plain eyes it appears the bottle, design, colour, shape colour, scheme,*

arrangement of design, of artistic elements, get-up and trade dress on blue coloured bottle of the Dabur গোল্ড খাঁটি নারিকেল তেল of defendant is similar deceptively or confusingly similar to that of the parachute hair oil of the plaintiff". Therefore, we also do not find any substance in the submission of the learned advocate for the appellant that the Court below has passed the impugned order mainly relying on the 'blue colour' only. Accordingly, we do not find any merit in the appeal and as such the same should be dismissed.

4.13 In the result, the appeal is dismissed. Thus, the impugned Order No. 08 dated 17.11.2020 passed by the Court of District Judge, Dhaka in Title Suit No. 30 of 2020 is, hereby, affirmed. The connected Rule, being Civil Rule No. 485(FM) of 2020, is also disposed of. Ad-interim order, if any, thus stands recalled and vacated. Since we have dealt with an interlocutory matter and have based our decision on our prima-facie findings, our observations and findings in this judgment should not be

taken into consideration by the Court below at the time of trial and hearing of the suit on merit.

Communicate this.

.....
(Sheikh Hassan Arif, J)

I agree.

.....
(Ahmed Sohel, J)