

IN THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment delivered on: 21.12.2022

+ **FAO(OS) (COMM) 67/2022 and CM No. 13491/2022**

**HAMDARD NATIONAL FOUNDATION
(INDIA) & ANR**

.... Appellants

versus

SADAR LABORATORIES PVT LTD

.... Respondent

Advocates who appeared in this case:

For the Appellants : Mr Praveen Anand, Mr Dhruv Anand
and Ms Udit Patro, Advocates.

For the Respondent : Mr Kirti Uppal, Senior Advocate with Mr
N.K. Kantawala, Mr Pravez Sharma, Mr
Prakhar Sharma, Ms Riya Gulati, Ms Ikshita
Parihar, Mr Amaya M. Nair, Mr Kunal
Khanna and Mr Swapnil Chaudhary,
Advocates.

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**HON'BLE MR JUSTICE VIBHU BAKHRU
HON'BLE MR JUSTICE AMIT MAHAJAN**

JUDGMENT

VIBHU BAKHRU, J

Introduction

1. Hamdard National Foundation (India) and Hamdard Dawakhana, also trading as Hamdard Laboratories (India) – Food Division, have filed the present appeal impugning an order dated

06.01.2022 (hereafter '**the impugned order**') passed by the learned Single Judge, whereby the appellants' application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (being I.A. 12032/2020 in CS (COMM) 551/2020 captioned *Hamdard National Foundation (India) & Anr. v. Sadar Laboratories Pvt. Limited*), seeking an interim injunction against the respondent, Sadar Laboratories Pvt. Ltd. (hereafter '**the respondent**'), from infringing the appellants' registered trademarks, was rejected.

2. The appellants have filed the aforementioned suit, CS(COMM) 551/2020, *inter alia*, seeking a permanent injunction restraining the respondent from using the trademark 'SHARBAT DIL AFZA', which, the appellants claim, is deceptively similar to the registered mark 'ROOH AFZA'. The appellants claim that use of the impugned trademark 'SHARBAT DIL AFZA'/'DIL AFZA' is likely to cause confusion and amounts to infringement of the registered trademark 'SHARBAT ROOH AFZA'/'ROOH AFZA'. The appellants further claim that use of the said mark, in respect of any goods, particularly syrups/*sharbats*, is intended to deceive customers; constitutes unfair competition; would result in dilution of the trademark 'ROOH AFZA'; and amounts to passing off.

3. The controversy, in the present case, relates to the word trademark 'SHARBAT DIL AFZA' (hereafter also referred to as '**the impugned trademark**'), which is registered in favour of the respondent in Class 5 as well as Class 32. The particulars of the said registrations are set out below: -

S. No.	Trade Mark	Registered Trade Mark Number & Class	Goods	Validity
01	SHARBAT DILAFZA	3855931 in Class 32	Syrups and Beverages	Registered and Valid Upto 10.06.2028
02	SHARBAT DILAFZA	3878751 in Class 5	Unani Medicines and Unani Medicated Syrups	Registered and Valid upto 04.07.2028

4. The appellants claim that the trademark 'SHARBAT ROOH AFZA' has been used continuously since the year 1907 in respect of a sweet beverage concentrate, manufactured and sold by the appellants. The respondent has recently launched a similar product (sweet beverage concentrate) under the brand name 'SHARBAT DIL AFZA'.

Appellants' case

5. The appellants state that they are engaged in the business of manufacturing and selling Unani and ayurvedic medicines, oils, syrups and non-alcoholic beverages amongst other products for over a century. They claim that they trace their history as far back as the year 1906, when Hakeem Hafiz Abdul Majeed, a Unani practitioner, had set up a Unani clinic under the name of 'HAMDARD DAWAKHANA'. Appellant no.1 is the owner of the trademarks 'HAMDARD' and 'ROOH AFZA', which are used in respect of a

large number of goods and services offered by the Hamdard Group. They claim that the trademark 'HAMDARD' is now recognized as a house mark of the Hamdard Group of entities. It is a well-known mark within the meaning of Section 2(zg) of the Trade Marks Act, 1999 (hereafter '**the Act**') and is included in the list of such well-known marks.

6. The appellants claim that appellant no.2 has been using the trademark 'ROOH AFZA' in relation to a wide range of products including Unani and ayurvedic medicines, syrups and non-alcoholic sweet beverages under the license from appellant no.1 (under Deed of Agreement dated 11.08.1975).

7. The appellants claim that they developed a *sharbat* from a unique combination of herbs and elements and are manufacturing and marketing the same under the brand name mark 'ROOH AFZA'. They claim that the mark 'ROOH AFZA' is amongst the most reputed marks used in relation to *sharbats*. Further, the appellants claim that they also secured registration of the trademark 'ROOH AFZA' and other formative marks. These are provided as under:-

S. No.	Trademark	Reg. No.	Dt. of Appln./Regn.
1.	ROOH AFZA	3007	03.08.1942
2.	ROOH AFZA	109335	10.04.1945
3.	ROOH AFZA	109337	10.04.1945
4.	ROOH AFZA	109338	10.04.1945
5.	ROOH AFZA	109340	10.04.1945

6.	ROOH AFZA	138780	17 .05.1949
7.	ROOH AFZA FRUIT DEVICE LABEL	173555	14.03.1956
8.	ROOHAFZA FUNFULL	1789048	24.2.2009
9.	ROOHAFZA LABEL	1789050	24.2.2009
10.	SHARBAT ROOH AFZA	1202383	29/5/2003
11.	ROOH AFZA(Label)	1932900	03-09-2010
12.	ROOH AFZA	266280	08-10-1970
13.	ROOH AFZA (BOTTLE)	1211357	07-03-2003
14.	ROOH AFZA FUSION	3307139	07-12-2016
15.	ROOH AFZA FUSION	3515546	28/03/2017
16.	ROOH AFZA RED RUSH	3307140	07-12-2016
17.	ROOH AFZA FRUTOZ	3156070	01-01-2016
18.	ROOH AFZA FRUIT BLASTZ	3156069	01-01-2016
19.	ROOH AFZA FRUIT BLASTZ	3156068	01-01 -2016
20.	ROOH AFZA SHOTZ	3156067	01-01-2016
21.	ROOHAFZA FRUIT SHOTZ	3156066	01-01 -2 016
22.	ROOH AFZA FRUNCH	3307141	07-12-2016

8. The appellants claim that the mark 'ROOH AFZA' is a highly

reputed mark and has acquired immense goodwill in relation to *sharbats* (non-alcoholic sweet beverages) sold under the said trademark. They claim that they have been spending significant amounts in publicity of the products under the brand name ROOH AFZA and their sales turnover has increased to ₹309,83,57,000/- (during the financial year 2020). They claim that the promotional expenses in respect of the products covered under the trademark in question has increased from ₹42.70 lacs in the year 2009-10 to ₹577.89 lacs for the period from April to August, 2020.

9. The appellants claim that on 27.04.2020, they became aware from an advertisement in a daily newspaper that the respondent is launching its *sharbat* bearing the mark 'DIL AFZA'. The appellants claim that the trademark 'DIL AFZA' is deceptively similar to their trademark 'ROOH AFZA'. Further, the trade get-up and design of the product, including the bottle used by the respondent, is deceptively similar to the trade dress and get-up of the appellants' product.

10. The appellants issued a Cease and Desist Notice to the respondent on 16.03.2020 to prevent the respondent from infringing the appellants' registered mark. The respondent responded by a letter dated 14.07.2020, denying the claims of the appellants. This led to the appellants filing the present suit

Respondent's defence

11. The respondent contends that the appellants' suit for infringement is not maintainable against the respondent. The respondent is a registered proprietor of the trademark 'SHARBAT DIL AFZA' and contends that, by virtue of Section 29 of the Act, an action

for infringement is not maintainable. The respondent further claims that the appellants have no cause of action as no confusion has been caused on account of their use of the mark 'SHARBAT DIL AFZA'.

12. The respondent claims that it has been using the said impugned trademark in respect of its Unani medicines and Unani medicated syrups since the year 1949 and for syrups and beverages since the year 2019.

13. The respondent claims that it has coined the impugned trademark by joining separate words 'DIL' and 'AFZA'. These are words from the vocabulary of the Urdu language and freely translated in English mean "heart" and "increasing"/ "giver of plenty". The appellants cannot claim any exclusive right over the word 'AFZA' solely by virtue of being a proprietor of a composite mark 'ROOH AFZA'. The registration of the mark 'ROOH AFZA' does not grant an exclusive right of use in respect of any part of the said trademark.

14. The respondent further claims that there are several other persons using the word 'AFZA' or composite trademarks which include the words 'AFZA' or 'ROOH'. And the use of the word 'AFZA' by the respondent as a part of its trademark does not infringe the appellants' trademark 'ROOH AFZA'.

15. Next, it is submitted that the trademarks 'ROOH AFZA' and 'SHARBAT DIL AFZA' are also used by the parties in conjunction with their respective house marks 'HAMDARD' and 'SADAR'. It is contended that the two competing trademarks are dissimilar as there is no phonetic or visual similarity between the marks. The spoken sound of both the marks is different.

16. The respondent claims that the meaning and the idea that the two marks convey are entirely different. Therefore, there is no possibility of anyone mistaking the respondent's product as that of the appellants.

17. In addition, it is submitted that the two trademarks are also different on various other counts; they are entirely different in their colour scheme, artistic work and other features. It is pointed out that while the appellants' label bears the images of various flowers, the respondent's label depicts images of fruits as the said product uses added fruit flavour.

18. Insofar as the similarity between bottles is concerned, the respondent states that the bottles used by the respondent are also completely different from those used by the appellants and the colour of the bottle cap is also not similar.

19. Lastly, the respondent states that that the impugned trademark was duly advertised in the trademark journals but the appellants had not preferred any opposition to the same. This indicates that the appellants had no objection to the use of the impugned trademark at the material time and are precluded from objecting to the same at this stage.

Impugned Order

20. On 31.10.2020, the appellants filed the suit against the respondent under the provisions of the Act seeking permanent injunction against the respondent from infringing the appellants' registered trademark.

21. By an order dated 15.12.2020, the learned Single Judge recorded the undertaking given by the respondent that it would not manufacture and sell syrups and beverages falling under Class 32 bearing the mark 'DIL AFZA'. Subsequently, on 13.07.2021, the learned Single Judge directed that the above-mentioned undertaking given by the respondent would continue until further directions. This undertaking operated as a temporary injunction till the date of the impugned order.

22. The learned Single Judge, after evaluating the material placed on record, concluded that, *prima facie*, the appellants' claim of having built huge reputation and goodwill in respect of the trademark 'ROOH AFZA', cannot be rejected. The learned Single Judge, following the earlier decisions in *Cadila Laboratories Ltd. & Anr. v. Dabur India Ltd.*¹, *Schering Corporation & Ors. v. Alkem Laboratories Ltd.*² and *Vardhman Buildtech Pvt. Ltd. & Ors. v. Vardhman Properties Ltd.*³, held that the appellants can claim exclusivity only in respect of the complete trademark 'ROOH AFZA' and not the two words – 'ROOH' and 'AFZA' – that constitute the trademark.

23. The learned Single Judge also rejected the contention that the two competing marks are similar. The court observed that the appellants are claiming similarity on the ground that the words 'DIL' and 'ROOH' entail deep emotion and the word 'AFZA' was common to both. The learned Single Judge observed that buying a bottle of *sharbat* would not entail any deep emotion and in any event, the

¹ 1997 SCC OnLine Del 360.

² 2009 SCC OnLine Del 3886.

³ 2016 SCC OnLine Del 4738.

consumers would be able to distinguish between ‘ROOH’ and ‘DIL’.
The Court’s reasoning in this regard is set out below-

“22. But there are fundamental differences between that case and the case at hand. In that case, the defendant had sought to use 'Rooh Afza' for his own product whereas, in the present case, the defendant's sharbat is called 'Dil Afza'. Thus, there is no identical mark that has been used. The similarity is sought on the ground that 'Dil' and 'Rooh' entail deep emotions and that the word 'Afza' is common to both. As has been repeatedly held by the courts, the standard to be adopted while determining confusion arising in the mind is of a consumer of imperfect memory or recollection and of ordinary sensibilities. It would be taking an extreme position, even if the consumers were connoisseurs, to believe that the use of the word 'Rooh' and 'Dil' would cause confusion because they connote deep emotion. Buying a bottle of sharbat may involve emotions, but not deep to the extent hoped for by the learned counsel for the plaintiffs. In any case, those who appreciate this deep emotion would be the first to be able to distinguish between 'Rooh' and 'Dil'. However, we are concerned with the common consumer, to whom, in ordinary use of the words, 'Dil' and 'Rooh' do not denote the same thing. There cannot be a confusion being created on account of the meaning of the two, words. This plea raised on behalf of the plaintiffs deserves rejection and is rejected.”

24. The Court found that in order for the appellants to claim any right in respect of the word ‘AFZA’, it would be necessary to show that the said mark had acquired a secondary meaning to denote the appellants’ product ROOH AFZA. The Court held that whilst the words ‘ROOH AFZA’ may have acquired a secondary meaning to indicate the appellants’ product, the word ‘AFZA’ by itself did not appear to have acquired any such secondary meaning.

25. The learned Single Judge found that, *prima facie*, the respondent had been using the mark at least since 1976 and both marks have existed without any confusion in the minds of the consumers. Thus, notwithstanding that the respondent had begun selling and manufacturing *sharbats* under the mark ‘DIL AFZA’ in the year 2020, *prima facie*, there is no case to restrain them from using the impugned trademark.

26. In view of the aforesaid reasoning, the application for seeking an interim injunction, restraining the respondent from using the impugned trademark in respect of its products, was rejected. However, the learned Single Judge directed the respondent to file a quarterly report in regard to its accounts till the disposal of the suit. Since the respondent had filed a rectification application, the said suit was stayed in view of Section 124(1)(b)(i) of the Act.

Reasons and Conclusions

27. The question whether there is any likelihood of confusion is required to be considered bearing in mind several factors. In the United States of America, the statute, Restatement of Torts § 729 (1938), lists out the following four factors:

- “(a) the degree of similarity between the designation and the trade-mark or trade name in (i) appearance; (ii) pronunciation of the words used; (iii) verbal translation of the pictures or designs involved; (iv) suggestion; (b) the intent of the actor in adopting the designation; (c) the relation in use and manner of marketing between

the goods or services marketed by the other; (d) the degree of care likely to be exercised by purchasers.”⁴

28. The three tests of sound, sight and meaning are now well accepted for determining the similarity between competing marks. And, similarity in any of the three aspects – visual impression, verbal sound, and meaning – may be sufficient to result in confusion. The question of similarity and the likelihood of confusion between two competing marks is determined on the basis of their overall commercial impression.

29. In *re E.I. du Pont de Nemours & Co.*⁵, the United States Supreme Court had set out the following factors to be considered for ascertaining whether there is likelihood of confusion:

- “1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
2. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
5. The fame of the prior mark.
6. The number and nature of similar marks in use on similar goods.

⁴ McCarthy, J. Thomas, McCarthy on Trademarks and Unfair Competition, § 23:21 (5th ed. 2019).

⁵ *476 F.2d 1357, 177 USPQ 563 (CCPA 1973)*.

7. The nature and extent of any actual confusion.
8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used.
10. The market interface between the applicant and the owner of a prior mark.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion.
13. Any other established fact probative of the effect of use.”

30. In *Polaroid Corp. v. Polarad Elecs. Corp.*⁶, the United States Court of Appeals, Second Circuit mentioned the following eight factors, relevant for considering the question as to the likelihood of confusion:

“Where the products are different, the prior owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.”

31. Insofar as the similarity between the two competing trademarks in this case is concerned, the learned Single Judge correctly observed that the two trademarks are composite marks and the words ‘ROOH

⁶ 287 F.2d 492 (2d Cir. 1961).

AFZA’ and ‘DIL AFZA’ cannot be dissected. The similarity must be determined on the marks as a whole. However, in viewing whether composite marks are deceptively similar, it is permissible to examine a dominant part of the mark.

32. In *Estate of P.D. Beckwith v. Commissioner of Patents*⁷, the United States Supreme Court had observed as under:-

“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.....”

33. The rationale for the anti-dissection rule is that a prospective buyer retains the overall commercial impression of a trademark and not one part of the same. However, it is not impermissible to examine the dominant part of the mark for determining the overall impression that a composite mark may carry. McCarthy explains the aforesaid principle in the following words:

“The rationale of the rule [anti dissection rule] is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composite as a whole.... Thus, the conflicting marks must be compared in their entireties. A mark should not be directed or spilt up into its component parts and each part then compared with the corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the

⁷ 64 L.Ed. 705.

average reasonably prudent buyer and not the parts thereof, that is important.”⁸

34. In *re National Data Corp*⁹, the United States Court of Appeals, Federal Circuit had observed as under:-

“.....in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has to be given to a particular feature of a mark, provided the ultimate conclusion rests on the consideration of the marks in their entirety.”

35. In the facts of the present case, the word ‘AFZA’ is an integral part of both the trademarks. The word ‘AFZA’ is from the Urdu vocabulary and means “increasing” or “giver of plenty”. The learned Single Judge noted that the words ‘AFZA’ means “increasing: adding” as per the Gem Pocket Twenty First Century Dictionary - Urdu to English (New Edition). The word ‘AFZA’, as understood in the Urdu language, is neither descriptive of *sharbats* nor any of its attributes. The use of the said word by the respondent, in respect of *sharbat*, requires to be examined bearing the aforesaid as well as the fact that it is a significant part of the appellants’ trademark.

36. *Prima facie*, the appellants’ trademark ‘ROOH AFZA’ was a source identifier for the appellants’ product for over a century. The appellants have also set out their sales turnover of the said product which has increased consistently to over ₹309 crores in the year 2020. The appellants also claimed that they have been consistently incurring promotional expenses in respect of the said product and the annual

⁸ McCarthy, J. Thomas, McCarthy on Trademarks and Unfair Competition, § 23:41 (5th ed. 2019).

⁹ 753 F.2d 1056.

promotional expenses for the year 2021 were in the vicinity of ₹5.8 crores. The appellants have also referred to a decision of the Lahore High Court – *Unani Dawakhana v. Hamdard Dawakhana*¹⁰. The said decision was rendered in a civil appeal filed in the year 1926 (Civil Appeal No.106/1926). The respondent (Hamdard Dawakhana) in the said case had filed a suit alleging infringement of the trademark ‘ROOH AFZA’ and seeking a perpetual injunction restraining the appellant (defendant) from selling a preparation under the trademark ‘SHARBAT ROOH AFZA’ and further claiming damages of ₹500/- on the ground of infringement of its trademark. It is not necessary to examine the rival contentions. It is sufficient to note that the respondent (Hamdard Dawakhana) had prevailed in securing an injunction and the appeal filed by the appellant was dismissed. The Court had noted that the reputation of the plaintiffs’ product ‘SHARBAT ROOH AFZA’ was extended beyond the confines in Delhi. The plaintiff was also granted nominal damages of ₹100/-.

37. The said decision does indicate that the appellants (or their predecessors) had actively defended the infringement of the trademark ‘ROOH AFZA’ as way back as in the early 1920s. The quantum of sales also indicates that the appellants’ product has acquired immense goodwill.

38. The word ‘AFZA’ is not descriptive of the product or one that one would normally associate with non-alcoholic beverages. In this view, the respondent’s use of the word ‘AFZA’ – which is a significant part of the appellant’s composite trademark – as a part of a trademark

¹⁰ *AIR 1930 Lah 999.*

in respect of a competing product, is material in determining whether the two competing marks are similar. This is also relevant to determine whether the respondent's intention is to deceptively pass off its goods as those of the appellants.

39. The learned Single Judge had also referred to the decision of the Division Bench of this Court in *Vardhman Buildtech Pvt. Ltd. & Ors. v. Vardhman Properties Ltd.*³ and in *Schering Corporation v. Alkem Laboratories Ltd.*² and observed that the plaintiff / appellant could claim exclusivity only in respect of the complete trademark and not to either of the two words constituting the wordmark 'ROOH AFZA'.

40. The learned Single Judge also noted that 'AFZA' is not descriptive of the *sharbat*; however, proceeded to hold that the plaintiffs would have to show that they have built a reputation leading to acquisition of a secondary meaning where 'AFZA' denotes only 'ROOH AFZA'. We are of the view that this view is, *ex facie*, erroneous. As noted above, the anti-dissection rule provides that a composite mark cannot be dissected and the fact that a part of the trademark is similar to part of the competing mark does not necessarily lead to the conclusion that the two marks are similar. But that does not mean similarity between significant part of the two competing marks is required to be disregarded while ascertaining whether the two composite marks are similar. The question whether the two composite marks are similar must be adjudged by examining the two marks as a whole and not by dissecting the same; but for the purpose of examining whether the two marks are similar, it may be expedient to examine the dominant part of the marks and it is also settled that a composite mark may have more than one dominant part.

41. When one examines the question whether the words ‘ROOH AFZA’ and ‘DIL AFZA’ are similar, the fact that both the composite marks end with ‘AFZA’ does lend an element of similarity to both the marks. As noted above, this also acquires a higher significance since ‘AFZA’ is not a descriptive word of the product in question. But the use of the word ‘AFZA’, as a part of the impugned trademark, may not be dispositive of the question – whether the overall commercial impression of the impugned trademark is confusingly similar.

42. In *M/s Kirorimal Kashiram Marketing & Agencies Pvt. Ltd. v. M/s Shree Sita Chawal Udyog Mill*¹¹, the Division Bench of this Court had allowed the appeal, and restrained the respondent from using the trademark “Golden Deer” or any other mark deceptively similar to the appellant’s/plaintiff’s registered trademark “Double Deer” in respect of rice. The Court observed that “*it is not permissible to copy a prominent part of the registered trademark of another person, more so, when the said word mark is arbitrarily adopted with respect to the product in question*”. Although the said proposition has been worded in wide terms, the same has to be read restrictively and in conformity with the anti-dissection rule.

43. It is also relevant to compare the trade dress of the competing products as that is also relevant to determine whether the overall commercial impression is confusingly similar to that of the trademark ‘ROOH AFZA’.

¹¹ 2010 SCC OnLine Del 2933.

44. In *Vornado, Inc. v. Breuer Electric Mfg. Co.*¹², the United States Court of Appeal Federal Circuit observed as under;

“[O]rdinarily, for a word mark we do not look to the trade dress, which can be changed at any time. But the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression.”

45. The question whether there is any propensity of confusion must be viewed considering the overall commercial impression that the impugned trademark may leave on a person of average intelligence and imperfect recollection.

46. The courts have, in a number of cases, found similarities between the meaning of the two marks to be dispositive of the question whether the competing marks are deceptively or confusingly similar. In *Standard Oil Co. v. Standard Oil Co.*¹³, the United States Court of Appeals, 10th Circuit had observed as under:

“....It is not necessary for similarity to go only to the eye or the ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or the ear.”

47. The meaning of the trademark also leaves an impact in the mind and when a mark of somewhat similar meaning is presented to a person of imperfect recollection, the person may recall the meaning of the word mark and may confuse the source of product as that of the senior

¹² 390 F.2d 724.

¹³ 252 F.2d 65.

mark. In *American Lead Pencil Co. v. L. Gottlieb & Sons*¹⁴, the United States Circuit Court for the Southern District of New York accepted that the mental impact of a similarity in meaning may be so pervasive as to outweigh any visual or phonetic difference.

48. There are several examples where competing marks have been found to be similar on the basis of similarity of the meaning of the said marks. Some of the oft cited examples of such competing marks are: ‘Acoustic Wave’ (for audio equipment) and ‘Power Wave’ (for video and audio amplifiers)¹⁵; ‘Aqua Care’ (for equipment and chemical for water treatment) and ‘Water Care’ (for water conditioning equipment)¹⁶; ‘Arise’ (for breakfast drink) and ‘Awake’ (for an orange juice)¹⁷.

49. The mental impact of certain competing marks may be similar although their meaning may not be identical. In such cases as well, the courts have found marks to be confusingly similar. A few examples of such cases would be ‘Blue Nun’ as compared to ‘Blue Angel’¹⁸ and ‘Blue Chapel’¹⁹ for wines. The meaning of the word ‘nun’, ‘angel’ and ‘chapel’ are different. But ‘Blue Angel’ and ‘Blue Chapel’ were held to be confusingly similar to ‘Blue Nun’. The words ‘chapel’, ‘angel’ and ‘nun’ have different meanings but they are connected and can be categorized as terms associated with a religion. The courts have found that there is likelihood of confusion in view of the mental

¹⁴ 181 F. 178.

¹⁵ *Bose Corporation v. Audio Products, Inc.*, 293 F.3d 1367.

¹⁶ *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 U.S.P.Q. 696 (T.T.A.B. 1971).

¹⁷ *General Foods Corp. v. General Mills, Inc.*, 161 U.S.P.Q. 638 (T.T.A.B. 1970).

¹⁸ *H. Sichel Sohne, GmbH v. Michael Monzain Selected Wines, Inc.*, 202 U.S.P.Q. 62 (T.T.A.B. 1979).

¹⁹ *H. Sichel Sohne, GmbH v. John Gross & Co.*, 204 U.S.P.Q. 257 (T.T.A.B. 1979).

impression that a person of imperfect recollections may carry. Yet another interesting case is that of the two competing marks ‘Chicken of the Sea’ (for Tuna fish) and ‘Tuna O’ The Farm’ (for canned chicken)²⁰. The products are dissimilar as one is fish and the other is chicken but there is unmistakable similarity in the idea that the two marks throw up. Tuna is the seafood but is referred to as Chicken of the Sea; Chicken is farm bred but is sold under the mark ‘Tuna O’ The Farm’. The idea of terming a product of the farm as one that is from the sea is conceptually similar to terming a product of the sea as one that is from the farm.

50. In *Kenner Parker Toys Inc. v. Rose Art Industries, Inc*²¹, the United States Court of Appeals for the Federal Circuit had found that the trademark ‘FUNDOUGH’, which was used in respect of toy molding compounds and related accessories was likely to cause confusion with famous trade mark ‘PLAY-DOH’. Although the meaning of the words ‘FUN’ and ‘PLAY’ is not identical, however, the ideas that the two words throw up may be common. Thus, the overall commercial impression of the trademark ‘FUNDOUGH’ was found to be similar to that of the trademark ‘PLAY-DOH’.

51. The Coordinate Bench of this Court in *Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt. Ltd.*²² had examined the question of likelihood of confusion in the context of two competing marks ‘Officer’s Choice’ and ‘Collector’s Choice’ used in respect of alcoholic beverages. The Court found that there was

²⁰ *Ralston Purina Co. v. Old Ranchers Canning Co., 199 U.S.P.Q. 125.*

²¹ *963 F. 2d 350.*

²² *2015 SCC OnLine Del 10164.*

likelihood of confusion even though the composite marks were not identical. The word 'Choice' was common to both the competing marks. The Court considered whether a person of average intelligence and imperfect recollection would confuse the word 'Collector' and 'Officer'. Both these words are phonetically different. However, on the anvil of similarity of ideas, the Court found that both the words denoted persons of authority and therefore, it was possible to a person viewing the trademark 'Collector's Choice' to mistake it as the product covered under the brand 'Officer's Choice'. The Court also referred to an article titled 'Distinctive Brand Cues and Memory for Product Consumption Experiences' published in the International Journal of Research in Marketing [22 (2005) 27-44]. The article referred to a study of five brands of orange juice named after different Islands in the Caribbean (Bahamas, Bermuda, Aruba, Dominica and Barbuda). The study found that the ability of consumers to distinguish between the said brands was poorer because of the shared conceptual background. The consumers would readily recall that their favourite brand of orange juice was named after the Caribbean Island; but would have to further exercise their mind to recall the specific Island. Thus, the Court held that in cases where the identity of the product had a similarity in the conceptual background, there would be likelihood of confusion. In that case, the confusion arose since Officer and Collector are both persons of authority. It was possible for one to be mistaken for the other as the consumer would generally recall that the brand name referred to a person of authority.

52. The learned Single Judge did not accept that there could be any confusion between the words 'ROOH' and 'DIL'. The Court observed

that 'ROOH' means "spirit" and 'DIL' means "heart" and they would not denote the same thing. The learned Single Judge did not accept that the words 'DIL' and 'ROOH' entail deep emotions and therefore, may cause some confusion on account of their meaning. The learned Single Judge also observed – one may add with a hint of humour – that *"buying a bottle of sharbat may involve emotions, but not deep to the extent hoped for by the learned counsel for the plaintiffs"*. The question whether buying a bottle evokes deep emotions is, clearly, not the point in issue. The relevant question to be addressed is whether meaning of the words 'ROOH' and 'DIL', at some level, have a mental impact that would lead a person of imperfect recollection to be confused between the two trademarks. It is well recognized that words with a similar meaning or a close connection may leave mental impressions that may lead one to confuse one with the other. It would, thus, be relevant to address whether there is any close relation between the meaning of the two words 'ROOH' and 'DIL'.

53. When one considers that the literal meaning of the Urdu word 'ROOH' in English language is "soul" and that of 'DIL' is 'heart', the connection becomes clear at once. The words 'heart' and 'soul' are part of the commonly used phrase of the English language and the words 'heart' and 'soul' are used commonly in conjunction. The term "heart and soul" is said to have originated in the 1700s. Harper Collins Dictionary defines the said phrase, when incorporated in a sentence, as *"if you put your heart and soul into something, you do it with great enthusiasm and energy"*. It also signifies the essence or core of a matter. Over the years, it has been used in several contexts. 'Heart and Soul' was an American silent film in the year 1917. Thereafter, there

have been many movies, tv series, albums, novels/books, songs titled 'Heart and Soul'. 'Heart and Soul' is the title of a popular song composed by Hoagy Carmichael with lyrics by Frank Loesser. The said song gained immense popularity and has been performed by other artists between 1938-1961. BR Ambedkar has also popularly referred to Article 32 of the Constitution of India as "*the heart and soul*" of the Constitution.

54. The propensity for confusion on account of a similar meaning has to be understood in a wider sense. It is not essential that the competing brands be synonymous. Given that the chords of memory are also connected by association of ideas and subjects; a wider conceptual association between the meaning of the competing brands may be sufficient to add to consumer confusion.

55. Hugh Chisholm has explained the theory expounded by Sir W. Hamilton and suggests that Hamilton has advanced four general laws of mental succession. An excerpt from Chisholm's article²³ is given below:

"Hamilton's own theory of mental reproduction, suggestion, or association is a development, greatly modified, of the doctrine expounded in his *Lectures on Metaphysics* (vol. ii. p. 223, seq.), which reduced the principles of association first to two—Simultaneity and Affinity, and these further to one supreme principle of Redintegration or Totality. In the ultimate scheme he posits no less than four general

²³ Chisholm, Hugh, ed. (1911). "Association of Ideas". *Encyclopædia Britannica*. Vol. 2 (11th ed.). Cambridge University Press. pp. 784.

laws of mental succession concerned in reproduction:

(1) *Associability* or possible co-suggestion (all thoughts of the same mental subject are associable or capable of suggesting each other);

(2) *Repetition* or direct remembrance (thoughts coincidental in modification, but differing in time, tend to suggest each other);

(3) *Redintegration*, direct remembrance or reminiscence (thoughts once coincidental in time, are, however, different as mental modes, again suggestive of each other, and that in the mutual order which they originally held);

(4) *Preference* (thoughts are suggested not merely by force of the general subjective relation subsisting between themselves, they are also suggested in proportion to the relation of interest, from whatever source, in which they stand to the individual mind).”

56. It is thus not difficult to conceive that a person who looks at the label of DIL AFZA may recall the label of ROOH AFZA as the word ‘AFZA’ is common and the meaning of the words ‘ROOH’ and ‘DIL’, when translated in English, are commonly used in conjunction.

57. At this stage, it would be relevant to set out the two labels and the images of the two products. The same are set out below:-

Appellant's label	Respondent's Label
	

58. It is clear from the aforesaid images that there is a similarity in the trade dress of the two products. Both the products have the same deep red colour and texture. It was contended that the colour of the concentrate is common to the product and cannot be taken into account to consider the question of infringement or passing off. However, if one considers the overall impression of the product, the fact that both the bottles are transparent and the colour of the liquid is the same would, undoubtedly, add to the impression of the product that may be recalled by any consumer. In addition, it is relevant to note that the structure of the bottles is not materially different. Both the bottles also have circular rings and the position of the trademark label is similar.

59. The appellants claim that the shape of the bottle with circular

rings is also their registered trademark. The same is mentioned in the plaint but not considered by the learned Single Judge because the same was not urged.

60. The impression of the label is also somewhat similar in view of the colour used. The ROOH AFZA label uses colourful flowers, leaving an oval space for the mark to be depicted; and the label DIL AFZA uses has colourful fruits on the boundaries, leaving an oval patch on which the trademark 'DIL AFZA' is written. Both the competing labels can be described as busy considering the number of images captured therein. The overall impression of the trade dress is quite similar.

61. If one considers the above factors cumulatively, it is apparent that the commercial impression of the impugned trademark is deceptively similar to the appellants' trademark. First of all, the impugned trademark has certain phonetic similarities inasmuch as the trademarks end with the word 'AFZA'. The last syllables, which form the majority of the syllables, in both the competing mark are thus similar. Second, the word 'AFZA' is a significant part of the trademark 'ROOH AFZA.' Undoubtedly, it is a contributing feature to the overall commercial impression of the trademark 'ROOH AFZA' as well as the impugned trademark. Third, if recall from memory is triggered by the English meaning of the words 'ROOH' and 'DIL', the fact that heart and soul is a commonly used phrase, provides a common conceptual background. Fourth, the trade dress, which includes the shape of the bottle, the overall design of the bottle, the placement of the house mark, the colourfully busy design of the label, are the material contributors to the overall commercial impression of the competing

trademarks.

62. The value of the product is another factor to be considered. The product is a consumable item and is a low-priced product. Thus, the attention that the customer may devote to the product on a shelf or on an online marketplace would, at best, be cursory. It is not expected that the average customer would deliberate on the details of the product as one would do while taking a high value investment decision.

63. As noted above, the trademark 'ROOH AFZA' has been used in respect of the appellant's product for over a century. *Prima facie*, it is a strong mark. It is also well settled that the requirement of protection varies inversely with the strength of the mark; the stronger the mark, the higher the requirement to protect the same. Trademarks serve as source identifiers. It is also well-settled that in case of a well-known mark, which has acquired a high degree of goodwill, the mark requires higher protection as it is more likely to be subjected to piracy from those who seek to draw an undue advantage of its goodwill. In the present case, the appellants claim that the trademark 'ROOH AFZA' is a well-known mark.

64. In *Planters Nut & Chocolate Co. v. Crown Nut Co.*²⁴, the United States Court of Appeals for the Federal Circuit had observed that a mark's fame is an incentive for competitors "to tread closely on the heels of a very successful trademarks". In cases of a weak trademark, where the trademark has not acquired significant goodwill, a higher degree of similarity is permissible. However, strong marks which have acquired immense goodwill are vulnerable from

²⁴ 305 F.2d 916.

competitors seeking to ride on their goodwill. Such marks require a higher degree of protection and it is necessary to ensure that the marks of a competitor do not come close to the said senior marks.

65. In *Kenner Parker Toys v. Rose Art Industries*²⁰, the United States Federal Court has observed as under:-

“A strong mark, on the other hand [as opposed to weak marks] casts a long shadow which competitors must avoid.”

66. *Prima facie*, the word ‘ROOH AFZA’ has served as the source identifier for the appellant’s product for over a century and it has acquired immense goodwill. We are of the view that the said mark requires a high degree of protection and it is essential to ensure that the competitors keep a safe distance from the said mark.

67. Given the overall commercial impression, *prima facie*, we are of the view that the impugned trademark lacks sufficient degree of dissimilarity, which is required to protect the appellant’s trademark.

68. The learned Single Judge had also proceeded on the basis that the respondent had used the mark ‘DIL AFZA’ at least since 1976 and therefore, the two competing marks had co-existed for a considerable period without any allegation of confusion. First of all, there are no invoices or material to indicate the sale or volume of sales of product under the mark ‘DIL AFZA’. More importantly, the impugned trademark was stated to be used in respect of a medicinal syrup and not in respect of a non-alcoholic beverage. The respondent had applied for registration of the mark ‘SHARBAT DIL AFZA’ in Class 32 for ‘syrups and beverages’, on 10.06.2018, on a ‘proposed to be used’

basis. The respondent also applied for registration of the impugned trademark in Class 5 for ‘Unani Medicines and Unani Medicated Syrups’, claiming use since 01.01.1949. The appellants do not seek to interdict the respondent’s use of the mark for Unani medicinal syrups; their case of infringement of trademark and passing off is in respect of non-alcoholic beverages. The question whether the use of the impugned trademark is likely to cause confusion is required to be considered in the context of its use in respect of the product in question – beverage concentrate and not medicinal syrup. The two products – medicated syrups and beverages concentrate – cater to different markets. In any view, the reasoning that there is no likelihood of confusion as the competing marks had coexisted is, *ex facie*, erroneous as the same is based on use of the impugned trademark in respect of medicated syrups without examining the trade dress, the label, the size of packaging etc. of that product.

69. Concededly, the medicinal syrup is sold in smaller bottles and with a completely different trademark. As noted above, the markets for the two products (medicinal syrup and non-alcoholic beverage) are different. *Prima facie*, absent any cogent material, the respondent cannot draw any benefit from the use of the impugned trademark in respect of the medicinal syrup. There is also no material to indicate the volume of the sales of the medicinal syrup to ascertain whether the impugned trademark has acquired any goodwill in respect of that product. The appellants have also filed an affidavit of an investigator affirming that the medicinal products of the respondent available in the market do not include a syrup under the impugned trademark.

70. The respondent had also relied on registration of various marks

using the word 'AFZA.' The appellants have strongly contested that any of the said marks have any presence in the market of beverages. The appellants have also filed an affidavit of an investigator indicating that the market presence of products sold under brand names incorporating the word 'AFZA' is not significant. Most of them are not available or do not relate to beverages. Absent any material to show that there are significant sales of products under the brand names that include the word 'AFZA', it would be erroneous to accept that the word 'AFZA' is common to trade.

71. In view of the above, the impugned order is set aside. By an *ad interim* order dated 15.12.2020, the learned Single Judge had recorded the statement made on behalf of the respondent (defendant) that the respondent would not manufacture and sell syrups and beverages falling under Class 32 under the impugned trademark 'DIL AFZA'. The said *ad interim* order is made absolute and shall continue till the disposal of the suit. The respondent shall not manufacture and sell any product under Class 32 under the impugned trademark 'DIL AFZA' till the disposal of the suit.

72. The appeal is allowed in the aforesaid terms. All pending applications are also disposed of.

VIBHU BAKHRU, J

AMIT MAHAJAN, J

DECEMBER 21, 2022
GSR/RK