

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

LD/VC/IA/1/2020
IN
LD/VC/144/2020
(COMMERCIAL IP SUIT (L) NO. ___ OF 2020)

Hindustan Unilever Limited ... Plaintiff
Versus
Emami Limited ... Defendant

Mr. V. Tulzapurkar, Senior Advocate a/w Mr. Hiren Kamod, Mr. Vaibhav Keni, Ms. Neha Iyer and Mr. Prem Khullar i/b M/s. Legasis Partners, for the Plaintiff

CORAM: B.P.COLABAWALLA, J.

DATE: 6TH JULY 2020

(THROUGH VIDEO CONFERENCE)

P.C.:

1. Heard by video conferencing.
2. Not on board. Mr. Kamod, the Ld. Advocate for the Plaintiff mentioned this matter today stating that there is a great urgency in the matter. He submitted that an urgent application for production with necessary papers and proceedings have been filed by the Plaintiff, by email, yesterday i.e. on 5th July 2020. In view thereof, I have taken up the matter on board.
3. The Plaintiff seeks to move without notice for the reasons set out in paragraph 29 of the Plaint. The Plaintiff has filed the present suit under Section 142 of the Trade Marks Act, 1999 seeking injunction against the Defendant from issuing groundless threats to the Plaintiff in respect of the use of its trade mark "GLOW & HANDSOME".
4. Mr. Kamod submitted that the Plaintiff is seeking a limited *ad-interim* relief today that the Defendant should give at least 7 clear days prior written notice to the Plaintiff before initiating any legal proceedings in any court or claiming any interim or ad-interim reliefs against the Plaintiff as threatened in the statements issued / made on

behalf of the Defendant against the Plaintiff's use of the trade mark 'GLOW & HANDSOME';

5. It is stated that the Plaintiff is India's largest fast moving consumer goods (FMCG) company, with leadership in Home & Personal Care Products and Foods & Beverages under its established house hold brands such as Kissan, Cornetto, Lux, Lifebuoy, Dove, Clinic Plus, Sunsilk, Rin, Wheel, Surf Excel, Vim and Lakme, Fair & Lovely and many more. The Plaintiff has been using several distinctive trade marks on trade dress / packaging bearing distinctive artworks upon and in respect of variety of its various goods/products in order to distinguish the same from those of others as well as inter se. One of such trade mark / brand of the Plaintiff is 'Fair & Lovely', which was adopted in or about the year 1975 by the Plaintiff for use by self, upon and in relation to its fairness face cream with a view to distinguish the same from others. It is stated that the Plaintiff's said 'Fair & Lovely' product quickly became a household brand and continues to be a market leader in the fairness cream category in the years since its launch. It is stated that though the Plaintiffs's 'Fair & Lovely' brand was initially used for a fairness cream which was gender neutral, it was largely promoted as a fairness cream for women, though almost 30% of the men also used the same product. To specifically target the men's segment of the population, in or around the year 2006, the Plaintiff in order to extend the popularity of its 'Fair & Lovely' brand launched its product 'Fair & Lovely, Men'. The said 'Fair & Lovely Men' was later renamed as 'Men's Fair & Lovely'. Trade mark registrations acquired by the Plaintiff in respect of its Fair & Lovely trade marks are at Exhibits A to E to the Plaint.

6. It is stated that on 7th September 2018, after conducting a search in the Register of Trade Marks, the Plaintiff independently and honestly coined and adopted the trade marks 'GLOW & LOVELY' and 'GLOW & HANDSOME' in respect of its skin care products. To secure statutory rights in the 'GLOW & LOVELY' and 'GLOW & HANDSOME' marks the Plaintiff filed multiclass applications bearing Nos.3938924 and 3938925 in classes 3 and 5, respectively, on 7th September 2018 on proposed to be used basis. It is stated that in his Preliminary Examination Report dated 10th October 2018 in respect of the Plaintiff's mark 'GLOW & HANDSOME' bearing application No.3938925, the Registrar of Trade Marks raised an objection under Section 9(1)(a) of the Trade Marks Act, 1999. The Plaintiff filed its Reply to the Examination Report on

29th October 2018. Vide his order dated 26th July 2019, the Registrar of Trade Marks has refused registration of the Plaintiff's mark 'GLOW & HANDSOME' bearing application No.3938925. It is stated that the Plaintiff has preferred appeal against the said decision of the Registrar of Trade Marks before the Intellectual Property Appellate Board, which appeal is pending. Copies of the Plaintiff's applications, examination reports, replies and order passed by the Trade Marks Registry are at Exhibits H to K to the Plaintiff.

7. According to the Plaintiff, in or about June 2020, the Plaintiff filed another set of trade mark applications bearing nos.4534961 on 17th June, 2020 and 4544086 on 25th June, 2020, both in classes 3 and 5 seeking registrations of the trade mark labels

Glow & Lovely and *Glow & Handsome*, respectively on proposed to be used basis.

Printouts of online extracts of the said applications bearing nos. 4534961 and 4544086 both in Classes 3 and 5, downloaded from the website of the Trade Marks Registry are at Exhibits N and O to the Plaintiff.

8. It is stated that on 2nd July 2020, the Plaintiff made an official announcement that its trade mark / brand 'FAIR & LOVELY' is rebranded as 'GLOW & LOVELY' for its skin care range of products and the Plaintiff's skin care range of FAIR & LOVELY products for men will be called as 'GLOW & HANDSOME'. Copy of the formal announcement made by the Plaintiff on 2nd July 2020 is at Exhibit Q to the Plaintiff. Copies of papers cuttings / advertisements covering the Plaintiff's announcement on 2nd July 2020 are at Exhibit R to the Plaintiff. It is stated that the Plaintiff was granted its FDA License to manufacture its skin care products under the mark "GLOW & HANDSOME" on 3rd July 2020. Thereafter, the Plaintiff immediately issued commercial advertisements in respect of its products bearing the trade mark 'GLOW & HANDSOME' not only on social media but also in the newspapers, including the first page of the Economic Times and Business Line News Paper on 4th July 2020. Printouts of the Plaintiff's Facebook, Instagram pages advertising the Plaintiff's products under the trade mark 'GLOW & HANDSOME' as on 3rd July 2020 are at Exhibits S and T to

the Plaintiff. A copy of the first page of the Economic Times dated 4th July 2020 is at Exhibit U to the Plaintiff.

9. It is stated that immediately after the Plaintiff made announcement on 2nd July 2020, the Defendant gave statements in various newspapers inter alia threatening to adopt legal action against the Plaintiff for violating the Defendant's alleged rights in its mark 'EMAMI GLOW AND HANDSOME'. Printouts / cuttings of articles reporting the statements made by the Defendant are at Exhibit V to the Plaintiff. Mr. Kamod relied on extracts of few statements made by the Defendants as published in various electronic media / newspapers which are reproduced herein below:

The Economic Times dated 2nd July 2020

Emami Ltd on Thursday said it is evaluating legal action against Hindustan Unilever Ltd (HUL) for renaming its men cream "Glow & Handsome" which sounds similar to the Kolkata-based company's brand "Emami Glow & Handsome" which it has launched digitally a week back

The Times Of India dated 3rd July 2020

Within a couple of hours of HUL announcing the new name, Emami termed HUL's move as an "unfair business practice". Emami director Mohan Goenka, who looks after the brand, told TOI, "we will surely take legal action."

Timesnow news dated 2nd July 2020

A spokesperson from Emami said, "We are shocked to learn of HUL's decision to rename its Men's range of Fair & Lovely as 'Glow & Handsome. Emami Limited, maker of 'Fair and Handsome' brand of men's grooming products is the market leader in the men's fairness cream with legal ownership of the trademarks. We have already launched a week back our brand 'Emami Glow & Handsome' digitally and necessary application has already been made to the relevant authorities."

10. It is stated that upon coming across the Defendant's statements, the Plaintiff conducted a search in the Register of Trade Marks and for the first time learnt that (i) on 25th June 2020, the Defendant has filed a trade mark application bearing No.4544323 in Class 3 seeking registration of the trade mark 'GLOW AND HANDSOME' on proposed to be used basis and (ii) on 27th June 2020, the Defendant has filed trade mark applications bearing Nos.4546682, 4546683 and 4546684 all in Class 3 seeking registrations of the



trade marks EMAMI GLOW AND HANDSOME,

and



, respectively claiming user from 26th June 2020. Copies of the Defendant's trade mark applications bearing nos. 4544323, 4546682, 4546683 and 4546684 all in Class 3 are at Exhibits W and X to X-3 to the Plaintiff. It is stated that the Defendant has not launched its products under the impugned EMAMI GLOW AND HANDSOME / GLOW AND HANDSOME trade marks till date. Extracts from the internet and the Defendant's social media accounts and website are at Exhibit Y to the Plaintiff.

11. Mr. Kamod submitted that statements issued by the Defendant and published in various online and print media are unjustifiable and groundless within the meaning of Section 142 of the Trade Marks Act, 1999. He submitted that the Defendant's claim of proprietorship over the marks 'GLOW AND HANDSOME' / 'EMAMI GLOW AND HANDSOME' is false and misconceived. He submitted that the Plaintiff is the prior adopter and user of the trade mark 'GLOW & HANDSOME'. He submitted that the mark GLOW AND HANDSOME has not been used by the Defendant and the Defendant is not entitled to disturb the honest and bonafide use of Plaintiff's prior adopted trade mark 'GLOW & HANDSOME'.
12. Mr. Kamod submitted that since the Plaintiff's products bearing the trade mark 'GLOW & HANDSOME' are being commercially advertised across the country, the Defendant

is likely to wrongfully initiate proceedings in any court in India and try to obtain ex-parte ad-interim reliefs against the Plaintiff in respect of their trade mark 'GLOW & HANDSOME'. He submitted that the Plaintiff is pressing for a limited relief in terms of prayer clause (a) today. He submitted that no prejudice would be caused to the Defendants if such prayer is granted. In support of his submissions he relied upon the judgment of this Court in the case of *Kokanratna Holiday Resorts Limited vs. Millennium and Copthorne International Limited* reported in MANU/MH/3091/2018.

13. I have heard the submissions made by Mr. Kamod and perused the record. *Prima facie* it does appear that having filed its trade mark application in September 2018 and subsequently on 25th June 2020 for the mark 'GLOW & HANDSOME', the Plaintiff is the prior adopter of the said mark. Further, from a perusal of the newspaper cutting at Exhibit-S to the Plaint, it *prima facie* appears that the Plaintiff has already started commercial advertisements in respect of the trade mark 'GLOW & HANDSOME'. From a perusal of Exhibit W, it *prima facie* appears that the Defendant has adopted the 'GLOW AND HANDOME' mark for the first time on 25th June 2020 and has not commercially used it till date. The statements made by the Defendant and published in various newspapers annexed to the Plaint do amount to a threat, however, whether they are unlawful or groundless, that is something that will have to be decided after hearing both the sides. Today, the Plaintiff is pressing for a limited relief that the Defendant should give at least 7 clear days prior written notice to the Plaintiff before initiating any legal proceedings in any court or claiming any interim or ad-interim reliefs against the Plaintiff as threatened in the statements issued / made on behalf of the Defendant against the Plaintiff's use of the trade mark 'GLOW & HANDSOME'. Considering the facts and circumstances of the present case, I believe that no harm or prejudice would be caused to the Defendant if the said limited relief is granted.
14. In view of what is stated in paragraph 29 of the Plaint and in view of the above, I am satisfied that the object of granting the following reliefs would be defeated if notice of this application is given to the Defendant. There shall accordingly be an *ad-interim* order in terms of prayer clause (a) of the Interim Application, which reads as follows:
- “(a) *that pending the hearing and final disposal of the suit, the Defendant, its directors, proprietors, partners, owners, servants, subordinates, representatives, dealers, agents and all other persons claiming under it*

be directed by this Hon'ble Court to give atleast 7 clear working days prior written notice to the Plaintiff at the Plaintiff's advocates' address at 91-92, 9th Floor Sakhar Bhavan, Nariman Point, Mumbai - 400021 by registered post acknowledgement due (R.P.A.D) including the email address viji.malkani@unilever.com and vaibhav.k@legasispartners.com before initiating any proceedings including legal proceedings in any court or claiming any interim or ad-interim reliefs against the Plaintiff as threatened in the statements issued / made on behalf of the Defendant against the Plaintiff's use of the trade mark 'GLOW & HANDSOME';"

15. List the above Interim Application for further reliefs on 27th July 2020. Plaintiff is granted liberty to renew its application for further reliefs on the adjourned date, after giving notice to the Defendant.
16. The Plaintiff shall forthwith serve a copy of this order on the Defendant by email, courier and/or post.
17. Liberty to the Defendants to apply for variation of this order with 48 hours prior notice to the Advocates for the Plaintiffs
18. This order will be digitally signed by the Private Secretary of this Court. All concerned will act on production by fax or email of a digitally signed copy of this order.

(B. P. COLABAWALLA, J.)