

THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment delivered on: 09.07.2010

+ **FAO(OS) 222/2009**

M/S GUFIC LTD. & ANOTHER Appellants

versus

CLINIQUE LABORATORIES, LLC & ANR Respondents

Advocates who appeared in this case:

For the Appellants : Mr Sudhir Chandra Aggarwal, Sr Advocate with Mr Abhinav Vasisht, Ms Harshita Priyanka, Mr Debojyoti Bhattacharya, Mr Sumit Singh Benipal and Ms Girija V. Verma

For the Respondents : Mr Sandeep Sethi, Sr Advocate with Ms Anuradha Salhotra, Mr Rahul Chaudhry, Ms Reetika Walia, r Sindhu Sinha and Mr Sumit Wadhwa

CORAM:-

HON'BLE MR JUSTICE BADAR DURREZ AHMED

HON'BLE MS JUSTICE VEENA BIRBAL

1. Whether Reporters of local papers may be allowed to see the judgment ? YES
2. To be referred to the Reporter or not ? YES
3. Whether the judgment should be reported in Digest ? YES

BADAR DURREZ AHMED, J

1. This appeal is directed against the order passed by a learned single Judge of this court on 09.04.2009 in IA No.15425/2008 (Under Order 39 Rules 1 and 2, CPC), IA 217/2009, (Under Order 39 Rule 4, CPC) and IA No.2769/2009 [Under Section 124(1) of the Trade Marks Act, 1999] in CS(OS) 2607/2008.

2. The respondents / plaintiffs had filed IA No.15425/2008 seeking interim relief. An *ex parte* order had been passed on that application on 16.12.2008 restraining the appellants / defendants from using the mark

‘CLINIQ’ or any other mark similar to the mark ‘CLINIQUE’ of the respondents / plaintiffs till the disposal of the application. The defendants were further restrained from marketing any goods or allowing any goods to be marketed under the impugned trademark through their distributors or other agents or from advertising the same in any manner whatsoever.

3. The appellants / defendants had filed IA No.217/2009 (under Order 39 Rule 4, CPC) for vacating the said *ex parte* order dated 16.12.2008. The respondents / plaintiffs had subsequently filed IA No.2769/2009 (Under Section 124(1) (ii) of the Trade Marks Act, 1999 (hereinafter referred to as ‘the said Act’) praying that the proceedings in the suit be stayed till the final disposal of the rectification proceedings which the respondents / plaintiffs had initiated before the trademark authorities for cancellation / rectification of the registration of the trademark ‘SKINCLINIQ’ in favour of the appellants / defendants.

4. The learned single Judge, by virtue of the impugned order dated 09.04.2009, disposed of all the three said applications. The respondents’ / plaintiffs’ application under Order 39 Rules 1 and 2, CPC (IA No.15425/2008) was allowed and the *ex parte* order dated 16.12.2008 was made absolute till the disposal of the suit. The appellants’ / defendants’ application (IA No.217/2009) under Order 39 Rule 4, CPC was dismissed. The application filed under Section 124(1)(ii) of the said Act was allowed and the proceedings in the suit were adjourned pending the final disposal of

the rectification proceedings which had already been instituted and also to enable the respondents / plaintiffs to apply for rectification of the registration of other marks. Of course, the learned single Judge also observed that nothing in the order dated 09.04.2009 shall come in the way of the proceedings, pending which, the suit has been stayed.

5. The learned single Judge had observed that the respondent No.1 / plaintiff No.1 was the registered proprietor of the trademark 'CLINIQUE' since 13.07.1981 in respect of cosmetics, creams, lotions and oils used in cleansing etc, falling under class 3 of the goods and services specified in the 4th schedule to the Trade Marks Rules, 2002 (hereinafter referred to as 'the said Rules'). The learned single Judge also noted that the respondents / plaintiffs were also the proprietors of the registered trademark – "CLINIQUE WATER THERAPY", CLINIQUE MOISTURE SURGE and CLINIQUE SKIN SUPPLIES FOR MEN" in respect of cosmetic and toilet preparations with effect from 1992. The respondents / plaintiffs were also the registered proprietors in respect of the trademark "CLINIQUE & C DEVICE" with effect from 04.05.1978 in respect of allergy tested cosmetics. A host of other trademarks are also owned by the respondents / plaintiffs, most of which include the word "CLINIQUE". According to the respondents / plaintiffs, CLINIQUE is the most distinguishing feature of its trademarks and the same has been in use worldwide since 1968 and has been used by the respondents / plaintiffs in India since 2007. It has also been noted by the learned single Judge, on the basis of the pleadings, that the

respondents / plaintiffs learnt about the registration of the appellants' / defendants' mark "SKINCLINIQ" and use of the label 'SKINCLINIQ STRETCH NIL' on or about September, 2006.

6. The learned single Judge, while observing that the sales by the appellants / defendants of their product "STRETCH NIL SKINCLINIQ" since 1999 could not be doubted, held against them and in favour of the respondents / plaintiffs. The learned single Judge was of the view that the appellants / defendants were engaged in the same business and a presumption could be raised with regard to their knowledge of the respondents' / plaintiff's registered trademark and consequently, he felt that the action of the appellants / defendants in adopting the mark 'CLINIQ' was not above board. According to him, there was not much distinction between the letter "Q" or "QUE" which appeared in the word 'CLINIQ' used by the appellants / defendants and the word 'CLINIQUE' used by the respondents / plaintiffs. The learned single Judge also observed that 'CLINIQ' as used by the appellants / defendants was spelt differently from the normal word 'CLINIC' and that the whole object behind this different spelling was to somehow create an association with the respondents / plaintiffs trademark. The learned single Judge also raised a doubt as regards the appellants / defendants action in using the expression "Made in India by Gufic Bio Science Ltd". According to the learned single Judge, this expression suggested that the appellants / defendants were making 'STRETCH NIL' in India under a licence from the respondents / plaintiffs. The learned single

Judge also observed that the mark 'SKINCLINIQ' is in a smaller font than the word 'STRETCH NIL' and the mark 'SKINCLINIQ' is not even visible from a distance. He also observed that all the advertisements were essentially for 'STRETCH NIL' and not using the mark 'SKINCLINIQ'. From this, the learned single Judge concluded that even if the appellants / defendants were enjoined from using the word 'CLINIQ', no loss would be caused to the appellants / defendants.

7. The learned single Judge came to the *prima facie* conclusion that the test of infringement laid down in Section 29 had been satisfied. We would also like to point out that the learned single Judge raised questions with regard to the *prima facie* validity of the registration of the appellants' / defendants' mark 'SKINCLINIQ' in the context of the bar under Section 9(2)(a) of the said Act as also the provisions of Section 11(1) and (2) of the said Act. The view taken by the learned single Judge was that the appellants' / defendants' mark has, *prima facie*, been invalidly registered and consequently, a case for infringement under Section 29 had been made out. It is in these circumstances that the learned single Judge allowed the respondents' applications under Order 39 Rules 1 and 2, CPC and under Section 124(1)(ii) of the said Act and dismissed the appellants' / defendants' application under Order 39 Rule 4, CPC.

8. Before we examine the merits of the case, it would be appropriate to set down the registered trademarks of the appellants / defendants as well as of the respondents / plaintiffs. The appellant No.1 is the registered

proprietor of the trademark 'SKINCLINIQ', SKINCLINIQ STRETCH NIL' and a series of other marks featuring the word 'SKINCLINIQ' in India as given below:

No.	Registration	Date of Registration	Trade Mark	Class	Goods
1.	832825	17-12-1998	SKINCLINIQ	3	Cosmetics & Toilet Preparation
2.	821801	05-10-1998	SKINCLINIQ	5	Pharmaceutical & Medical Preparation
3.	832826	17-12-1998	DERMACLINIQ	3	Cosmetics & Toilet Preparation
4.	821802	05-10-1998	DERMACLINIQ	5	Pharmaceutical & Medical Preparation
5.	878515	27-09-1999	SKINCLINIQ STRETCH NIL (Label)	3	Cosmetics & Toilet Preparation
6.	878512	27-09-1999	SKINCLINIQ STRETCH NIL (Label)	5	Pharmaceutical & Medical Preparation

9. The respondent No.1, on the other hand, is the registered proprietor in India of the trademark 'CLINIQUE', by itself, and a series of marks featuring the word 'CLINIQUE', the particulars of which are as under:-

Registration	Date of Registration	Trade Mark	Class	Goods
378364	13.7.1981	CLINIQUE	3	Cosmetics creams, lotion & oils in cleansing creams, lotions and make-up, astringent, face powder, foundation, bases, rouges, eye make-up preparation, mascara, eye liner eye shadow and pencil, eye make-up remover, lipsticks hair sprays, bath oils and anti-perspirants in class 3
572656	6.5.1992	CLINIQUE WATER THERAPY	3	Cosmetics and toilet preparations
572657	6.5.1992	CLINIQUE	3	Cosmetics and toilet

		MOISTURE SURGE		preparations
572658	6.5.1992	CLINIQUE SKIN SUPPLIES FOR MEN	3	Cosmetics and toilet preparations
336229	4.5.1978	CLINIQUE & C DEVICE	3	Allergy tested cosmetics & toiletries, including anti-perspirants
598136	26.5.1993	CLINIQUE IN TOUCH	9	Computer chip cards for use in the selection of cosmetics and skin care products
743399	10.12.1996	CLINIQUE EXCEPTIONALLY SOOTHING CREAM FOR UPS	5	Medicated anti-itch skin cream in class 5.
774195	31.10.1997	CLINIQUE HAPPY	3	Cosmetics, toiletries and perfumery
902703	9.2.2000	CLINIQUE ANTI-GRAVITY	3	Skin care preparations
1001157	3.4.2001	CLINIQUE GENTLE LIGHT	3	Cosmetics, toiletries and perfumery in class 3

10. Initially, the entire order passed by the learned single Judge on 09.04.2009 was the subject matter of challenge, including his decision on the application under Section 124(1)(ii) of the said Act. It had been contended by Mr Sudhir Chandra, the learned senior counsel, appearing on behalf of the appellants / defendants that Section 124 was not applicable inasmuch as the appellants / defendants had not taken the defence available under Section 30(2)(e) of the said Act nor had the appellants / defendants considered the respondents' / plaintiffs' registration and the only plea taken was that the trademarks were completely different. This contention was repelled by Mr Sandeep Sethi, the learned senior counsel appearing on behalf of the

respondents. However, in the course of the arguments, the said learned counsel agreed that the Section 124 issue be not gone into in this appeal and the same be considered only from the standpoint of injunction. It is, therefore, to be seen as to whether the respondents have been able to make out a *prima facie* case of injunction for an infringement action under Section 29 of the said Act or not. It is obvious that if we are to examine the question of grant of injunction *de hors* the issue pertaining to Section 124 of the said Act, it will have to be presumed that the appellants' / defendants' mark 'SKINCLINIQ' is unregistered. Because if we do not so presume, considerations under Section 28(3) as also those arising under Section 30(2)(e) of the said Act would have to be gone into. But, that cannot be done because Mr Sudhir Chandra himself pointed out that the appellants / defendants had not taken the defence of Section 30(2)(e). In any event, the arguments have been addressed only on the question of deceptive similarity between the marks of the contesting parties in the context of section 29(1) which reads as under:-

“29. Infringement of registered trade marks.– (1)
A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

XXXX XXXX XXXX XXXX”

11. The marks 'CLINIQUE' and 'SKINCLINIQ' are not identical. Therefore, for infringement to be made out, it must be shown that the mark

‘SKINCLINIQ’ is deceptively similar to the respondents’ / plaintiffs’ mark ‘CLINIQUE’ and is used by the appellants / defendants in such a manner as to render the use of the mark likely to be taken as being used as a trademark.

12. In this context, Mr Sudhir Chandra submitted that the marks ‘SKINCLINIQ’ and ‘CLINIQUE’ are neither identical, nor deceptively similar and that they are used in relation to different products. The appellants / defendants use the said mark in respect of their *Ayurvedic* herbal product known as ‘SKINCLINIQ STRECH NIL’, which is used for removing stretch marks acquired during pregnancy. ‘CLINIQUE’ on the other hand, is not an *Ayurvedic* herbal product, though it is used for cosmetic creams, lotions etc. Furthermore, Mr Sudhir Chandra pointed out that the price differential between the products of the appellants / defendants and those of the respondents / plaintiffs is so vast as to remove any possibility of confusion between the customers. 100 ml. of the appellants’ / defendants’ product sells for Rs 245/-, whereas 15 ml and 75 ml of the respondents’ / plaintiffs’ products sell for Rs 1,200/- and Rs 1950 respectively. He submitted that the price differential being so vast, there is absolutely no possibility of the consumers confusing the appellants’ / defendants’ products for those of the respondents’ / plaintiffs’. He further submitted that, in fact, the class of people using the two products is also different. He further submitted that the style, manner of writing and the colour combination of the two trademarks are entirely different. The label marks, which are employed by the appellants / defendants are also entirely different to those employed

by the respondents / plaintiffs. There is also no denying, as was observed by the learned single Judge himself, that the appellant has been in the business since 1999 and has been marketing its products 'STRETCH NIL SKINCLINIQ' since then as would be apparent from the numerous advertisements which appeared in the magazines from time to time. Mr Sudhir Chandra submitted that when the trademarks, which are to be compared, are not identical, then the test of deceptive similarity that would have to be employed in a case of infringement would be the same as that in a case of passing off. He submitted that employing those tests, it cannot be said that the appellants' / defendants' trademark 'SKINCLINIQ' is deceptively similar to the respondents' / plaintiffs' trademarks 'CLINIQUE'.

13. Mr Sandeep Sethi, the learned senior counsel, appearing on behalf of the respondents / plaintiffs, submitted that when a comparison of the marks is made from the standpoint of infringement, it is only the marks which are to be compared and that the price, trade dress, colour scheme etc., are all irrelevant. He submitted that the marks have to be seen as a whole and the overall structural and phonetic similarity has to be noticed. All this has to be done from the standpoint of a consumer of average intelligence with an imperfect recollection. He submitted that if a comparison is made between the two marks following the above principles, it would be clearly established that the appellants' / defendants' mark 'SKINCLINIQ' is deceptively similar to the respondents' / plaintiffs' mark 'CLINIQUE'.

14. The counsel for the parties had referred to a number of the decisions of the Supreme Court as well as of this court. They were, *inter alia*, the following:-

- 1) **Ruston & Hornsby Ltd v. The Zamindara Engineering Co.:** 1969 (2) SCC 727;
- 2) **Amritdhara Pharmacy v. Satya Deo Gupta:** AIR 1963 SC 449;
- 3) **Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories:** AIR 1965 SC 980;
- 4) **Corn Products Refining Co. v. Shangrila Food Products Ltd:** 1960(1) SCR 968 = AIR 1960 SC 142;
- 5) **Amar Singh Chawal Wala v. Shree Vardhman Rice and Genl. Mills:** FAO (OS) 138/1996 decided on 29.05.2009 [(2009) 159 DLT 267];
- 6) **Metropol India (P) Ltd v. Praveen Industries India (Regd):** 1997 PTC (17) 779 (DB);
- 7) **Parle Products (P) Ltd. v. J. P. & Company, Mysore:** 1972 (1) SCC 618.

15. It would be necessary to briefly examine each of these decisions. In *Ruston Hornsby Ltd. (supra)*, the trademarks, which were compared were ‘RUSTON’ on the one hand and ‘RUSTAM’ and ‘RUSTAM INDIA’, on the other. The plea was that the appellant’s trademark ‘RUSTON’ had been infringed by the respondent’s marks ‘RUSTAM’ and ‘RUSTAM INDIA’. The Allahabad High Court, where the matter had originated, held that the use of the word ‘RUSTAM’ by the respondent constituted infringement of the appellant’s trademark ‘RUSTON’. But, the use of the words ‘RUSTAM INDIA’ was not an infringement because the appellant’s engines were

manufactured in England and the respondent's engines were manufactured in India and that the use of the suffix 'INDIA' would be a sufficient warning that the engine sold was not a 'RUSTON' engine manufactured in England. However, the Supreme Court held that the mark 'RUSTON' had been infringed not only by the use of 'RUSTAM', but also by the mark 'RUSTAM INDIA'. The Supreme Court felt that the word 'RUSTAM' was deceptively similar to the word 'RUSTON' and that the fact that the word 'INDIA' was added to the respondent's trademark was of no consequence and the appellant was entitled to succeed in its action for infringement of the trademark. While coming to this conclusion, the Supreme Court succinctly brought out the distinction between an infringement action and a passing off action. It observed that in a passing off action, the issue is whether the defendant is selling goods so marked as to be designed or calculated to lead the purchasers to believe that they are the plaintiff's goods. However, in an infringement action, the question is whether the defendant is using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trademark. The Supreme Court observed:-

“7. In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the register, but something similar to it, the test of infringement is the same as in an action for passing-off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing-off actions.”

16. In *Amritdhara Pharmacy (supra)*, the Supreme Court held that the word “LAXMANDHARA” was likely to deceive and confuse persons into believing that they were, in fact, purchasing the product under the mark ‘AMRITDHARA’. The Supreme Court observed that the question of deceptive similarity must be approached from the point of view of a man of average intelligence and imperfect recollection. The Supreme Court further observed that: -

“.. overall structural and phonetic similarity of the two names ‘AMRITDHARA’ and ‘LAXMANDHARA’ is, in our opinion, likely to deceive or cause confusion.”

The Supreme Court also observed that:-

“The trademark is the whole thing – the whole word has to be considered.”

In *Kaviraj Pandit (supra)*, the Supreme Court, once again considered the differences between an infringement action and a passing off action. The Supreme Court observed that:-

“In an action for infringement, the plaintiff, must, no doubt, make out that the use of the defendant’s mark is likely to deceive, but where the similarity between the plaintiff’s and the defendant’s mark is so close, either visually, phonetically or otherwise, the court reaches the conclusion that there is imitation, no further evidence is required to establish that the plaintiff’s rights are violated.”

17. The marks ‘GLUCOVITA’ and ‘GLUVITA’ came up for consideration in an infringement action before the Supreme Court in *Corn Products (supra)*. The Supreme Court observed that it is well-known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression and that it is for the court to decide that

question. The Supreme Court observed that the only difference between the marks 'GLUCOVITA' and 'GLUVITA' was the syllable 'CO' in the appellants mark. Apart from that, the two marks were identical. The Supreme Court further observed that the said syllable "CO' was not, in their opinion, such as would enable the buyers in our country to distinguish the one mark from the other. The Supreme Court also held:-

“It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole.”

18. Importantly, the Supreme Court also observed that:-

“... the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. *The Aquamatic case (Harry Reynolds v. Lafferty's Ld.: 1958 R.P.C. 387)* is a recent case where the test of the commonness of the idea between two marks was applied in deciding the question of similarity between them. Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them.”

19. In *Amar Singh Chawal Wala (supra)*, the registered trademarks were 'LAL QUILLA', 'GOLDEN QUILLA' and 'NEEL QUILLA' and the infringing mark was 'HARA QUILLA'. A Division Bench of this court held that the essential feature of the registered trademark was the word 'QUILLA' and, therefore, the mark 'HARA QUILLA' was found to be deceptively similar to the registered trademark 'LAL QUILLA'. The court observed that there is every possibility of there being a confusion created in

the minds of the purchasers of rice that the product being sold by the defendant (in that case) was, in fact, a product that had emanated from or had been manufactured by the plaintiff (in that case). The court also took the view that the delay in approaching the court by itself would not be a sufficient defence to an interim injunction in the event the court takes the view that ultimately, a permanent injunction would be granted.

20. In *Metropol (supra)*, a Division Bench of this court was required to consider the marks 'CLEANZO', which was the registered mark and 'CLEANJO', which was the alleged infringing mark. In the said decision, the Division Bench held that the learned single Judge was not justified in giving a clarification that the defendant was entitled to trade its product under the trademark 'PRAVEEN CLEANJO' and the Division Bench observed that the use of the very word "CLEANJO" whether with the prefix 'PRAVEEN' or otherwise, was definitely likely to have an effect of creating confusion in respect of the cleaning goods and was likely to deceive the purchaser of the goods.

21. In *Parle Products Pvt. Ltd (supra)*, the Supreme Court observed as under:-

"9. It is, therefore, clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of

the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Glucobiscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it."

22. The following principles can be culled out from the aforesaid decisions:-

1. The test of deceptive similarity in the case of infringement is the same as in a passing off action, where the marks are not identical;
2. The question has to be approached from the point of view of a man with average intelligence and imperfect recollection;
3. In comparing the marks, it is the overall structural and phonetic similarity of the two marks that is to be seen and not by splitting them into their component parts and to consider the etymological meaning thereof;
4. The trademark is the whole thing - the whole word has to be considered; and

5. In comparing the two marks, it is also to be seen whether they both convey the same idea - (test of commonness of the idea between the two marks).

23. It is in this backdrop that we have to compare the marks of the appellants and those of the respondents. The respondents' registered trademark is 'CLINIQUE'. It also has other registered trademarks which all include the word 'CLINIQUE'. 'CLINIQUE' is a French word for the English word 'Clinic'. Both are pronounced differently. 'CLINIC' is pronounced as 'KLINIK' and 'CLINIQUE' is pronounced as "KLINECK". "CLINIQUE" is the most important constituent of the respondents' family of trademarks. The question is, whether the mark of the appellants – "SKINCLINIQ" is deceptively similar to 'CLINIQUE' or not? It is apparent, as already pointed out above, that "CLINIQUE" and "SKINCLINIQ" are not identical marks. The question, therefore, is to find out as to whether they are deceptively similar or not and this question has to be approached from the point of view of a man with an average intelligence and an imperfect recollection. In comparing 'CLINIQUE' with 'SKINCLINIQ', what has to be borne in mind is the overall structural and phonetic similarity of the two marks and the marks cannot be separated into their components. Consequently, we have to take the mark 'SKINCLINIQ' as a whole in comparison with the respondents' registered mark 'CLINIQUE'. When we do that, we do not find any overall structural or phonetic similarity. We cannot separate the mark 'SKINCLINIQ' into its component parts 'SKIN' and 'CLINIQ' and then compare the component

‘CLINIQ’ with the respondents mark ‘CLINIQUE’. If such a splitting up cannot be done, then we do not see any phonetic, visual or overall structural similarity in the two marks, ‘CLINIQUE’ and ‘SKINCLINIQ’, so as to reach to the conclusion that ‘SKINCLINIQ’ is deceptively similar to ‘CLINIQUE’. The word ‘clinic’ by itself means a place where some kind of treatment is provided. So, perhaps, it could be said that the word ‘CLINIQUE’ conveys the idea of some kind of treatment. To a certain extent, it may be said that the mark ‘CLINIQUE’ and the mark ‘SKINCLINIQ’ do convey a common idea of treatment. However, as pointed out above, while comparing the marks, we have to examine not only the commonness of the idea between the two marks, but also the overall visual, structural and phonetic similarity of the marks. Taking an overall view of the marks, we feel that a person of average intelligence and imperfect recollection would not be deceived by the mark ‘SKINCLINIQ’ into believing that it is, in fact, the mark ‘CLINIQUE’. We feel that the learned single judge fell into error in splitting the appellants’ mark “SKINCLINIQ’ into ‘SKIN’ and ‘CLINIQ’ and in then comparing the latter component (CLINIQ) with the respondents’ mark ‘CLINIQUE’. Had the appellants’ mark been only ‘CLINIQ’ then, perhaps, it could be said that it is deceptively similar to the respondents’ mark ‘CLINIQUE’. However, the appellants’ mark is not just ‘CLINIQ’ but ‘SKINCLINIQ’, which is one word and not two separate words as in Rustam’s case and Cleanzo’s case.

24. Another important circumstance is that the price differential between the two products is so vast that no consumer of products of either the appellant or the respondent would confuse one for the other. We, therefore, do not agree with the conclusion arrived at by the learned single Judge that, prima facie, a case of infringement has been made out. We would also like to point out that the conclusion arrived at by us has been on the assumption that the appellants' trademarks are not registered or if registered, such registrations were invalid. We have not gone into that question of registration and its validity for the simple reason that the rectification proceedings are pending and the suit has been adjourned in view of Section 124(1) of the said Act and the counsel agreed that the issue of Section 124 need not be gone into for deciding this appeal.

Consequently, we allow this appeal and set aside the order of the learned single Judge to the extent that he allowed IA No.15425/2008 and dismissed IA No.217/2009. The injunction granted by the learned single Judge stands vacated. The parties are left to bear their own costs.

BADAR DURREZ AHMED, J

VEENA BIRBAL, J

JULY 09, 2010

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