



Delhi High Court: no defence under Section 30(2)(e) if defendant's registration does not cover goods for which mark is used

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- The plaintiff, which owns the mark ABZORB in Class 5, sued the defendants due to their use of ABBZORB for whey protein products
- The defendants sought shelter in the provisions of Section 30(2)(e) on the basis of their registrations in other classes
- The court held, among other things, that the defendants could not rely on Section 30(2)(e) since their marks were not registered in Class 5

In [*Sun Pharmaceutical Industries Limited v Protrition Products LLP*](#) (CS(COMM) 533/2022 & IA 12259/2022), the Delhi High Court, in a judgment dated 24 November 2023, has held that the provisions of Section 30(2)(e) of the [Trademarks Act 1999](#) cannot come to the rescue of a defendant if the latter does not hold a trademark registration for the goods for which the mark is being used. The court also applied the 'deceptive similarity' and 'likelihood of confusion' tests in granting the injunction.

Background

Plaintiff Sun Pharmaceuticals Industries Ltd is the registered proprietor of ABZORB for pharmaceutical and veterinary preparations in Class 5, and uses the mark for anti-fungal pharmaceutical preparations. The plaintiff sued the defendants for infringement due to their use of the mark ABBZORB for whey protein products, which also falls within Class 5. The second defendant claimed that it held registrations for the following marks (the 'impugned marks') in Classes 29, 30, 31 and 32:

- ABBZORB

- ABBZORB NUTRITION



However, the defendants held no registration for the impugned marks for whey protein products in Class 5; while earlier applications were abandoned after the plaintiff's registration was cited by the registry, fresh applications are still pending.

The plaintiff argued that the impugned marks were phonetically and structurally similar to its mark, and that the only difference between the marks was the inconsequential addition of the letter 'B' in the impugned marks. The plaintiff also pleaded dishonesty since the defendants had applied for registration in different classes and the previous applications in Class 5 were abandoned due to the plaintiff's registration.

The defendants, on the other hand, sought shelter in the provisions of Section 30(2)(e) of act on the basis of their registrations in other classes in order to contend there was no infringement. They also claimed that the representation of the marks was different and that the word mark consisted of a descriptive word in which no exclusive rights could be claimed.

Decision

Defence under Section 30(2)(e)

The court held that the defence under Section 30(2)(e) of the act could not come to the rescue of the defendants since the impugned marks were not registered in Class 5, which covers whey protein products. The court further held that the defence under Section 30(2)(e) can be invoked only when the defendant owns a registration for particular goods and is using the mark for the goods for which it is registered.

Deceptive similarity, likelihood of confusion and descriptiveness

The court observed that infringement must be determined based on a mark-to-mark comparison. The court held that, phonetically and structurally, the impugned marks were identical, and the addition of the letter 'B' made no difference to their appearance or pronunciation. It further held that the extra letter was unlikely to impress itself on the psyche of a consumer with average intelligence and imperfect recollection. Finally, the mark ABZORB was held to be distinctive for anti-fungal preparations.

Comment

The court correctly applied the principles of similarity and descriptiveness, and rightly interpreted the provisions of Section 30(2)(e) as preventing the defendants from relying on registrations in classes other than Class 5. However, neither the defendants nor the court seem to have tested the scope of the plaintiff's registration, which does not cover dietary substances (and, hence, whey protein products) - a relevant consideration in light of recent decisions of the Supreme Court, and probably a better defence for the defendants.

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