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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% **Date of decision: 07th August, 2024**

+ CS(COMM) 53/2019 & I.A. 2215/2021

G.D. PHARMACEUTICALS PRIVATE LIMITEDPlaintiff

Through: Mr. Afzal B. Khan and Mr. Sharad
Besoya, Advocates
Mob: 9881880037

versus

M/S CENTO PRODUCTS (INDIA)Defendant

Through: Ms. Shreya Malik and Mr. Rahul
Kumar, Advocate

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

MINI PUSHKARNA, J (ORAL)

1. The present suit has been filed for permanent injunction restraining infringement of trademark and copyright, passing off, rendition of accounts or profits, damages, delivery up, acts of unfair competition, etc.
2. The plaintiff company was founded in the year 1929, and ever since, has been engaged in the business of manufacturing, marketing, selling and exporting a variety of medicinal and cosmetic preparations, specialising in Over the Counter (“OTC”) pharmaceutical products, and health care cosmetics.
3. It is the case of the plaintiff that the plaintiff coined the word ‘BOROLINE’, which is in use since 1929, in respect of antiseptic medicinal ointments, creams, etc. The word ‘BOROLINE’ is registered both as a word mark as well as a label mark bearing no. 371269 and 14610, respectively in Class-5. Thus, it is submitted that the product of the plaintiff is sold under a distinctive dark green and white packaging for the last 90 years and has acquired distinctiveness. It is submitted that plaintiff’s products are available

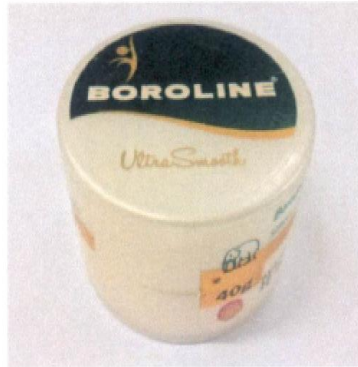


in the form of tubes and plastic pots, as follows:





(C) **BOROLINE sx Pot** – Priced at ₹22/- (10g) and ₹65/- (40g)



(D) **BOROLINE Ultra Smooth Pot** – Priced at ₹42/- (20g) and ₹75/- (40g)

4. The plaintiff's flagship brand "BOROLINE", which is the subject matter of the present suit, has been used by the plaintiff in relation to antiseptic creams, alongside a distinctive get up, packaging and colour scheme, continuously, uninterruptedly, bonafidely and exclusively, for nearly ninety years.

5. Thus, it is submitted that the entire packaging of the products of the plaintiff is of a distinctive dark green colour, and the trade mark 'BOROLINE' is presented in a stylized, white coloured font, in block capital letters across the middle of the packaging, which also features the registered mark on the right hand corner.

6. It is submitted that the use of the trademark 'BOROLINE' and



distinctive product packaging/trade dress in relation to its creams, has established the plaintiff in the market and the plaintiff occupies an eminent position in the market for antiseptic creams.

7. The present suit has been filed by the plaintiff on the premise that in or around the month of December, 2018, the plaintiff through its market sources and network of distributors and agents, was alerted about the presence of product/brand similar to the plaintiff's 'BOROLINE' products, being sold in certain markets under the mark/name of BOROBEAUTY. The comparison between the products of the plaintiff and the defendant, as given in the plaint, is as follows:

Defendant's Tube Product	
Plaintiff's Tube Product	
Defendant's Tube Packaging	
Plaintiff's Tube Packaging	
Defendant's Box/ Container Product	
Plaintiff's Box/ Container Product(s)	



Defendant's Box/ Container Label	
Plaintiff's Box/ Container Label(s)	

8. It is the case of the plaintiff that the defendant has adopted the mark/name 'BOROBEAUTY', which is used and represented in a manner, which is deceptively similar to plaintiff's use of its registered trade mark 'BOROLINE'. Being aggrieved by the fact that the defendant had imitated the plaintiff's iconic trade dress of a distinct dark green tube ending in an octagonal black cap that has come to be recognized with the plaintiff's product, the present suit has been filed.

9. The matter has been pending for long and during the pendency of the suit, the defendant has made various offers to change its trade dress, as well as, its name.

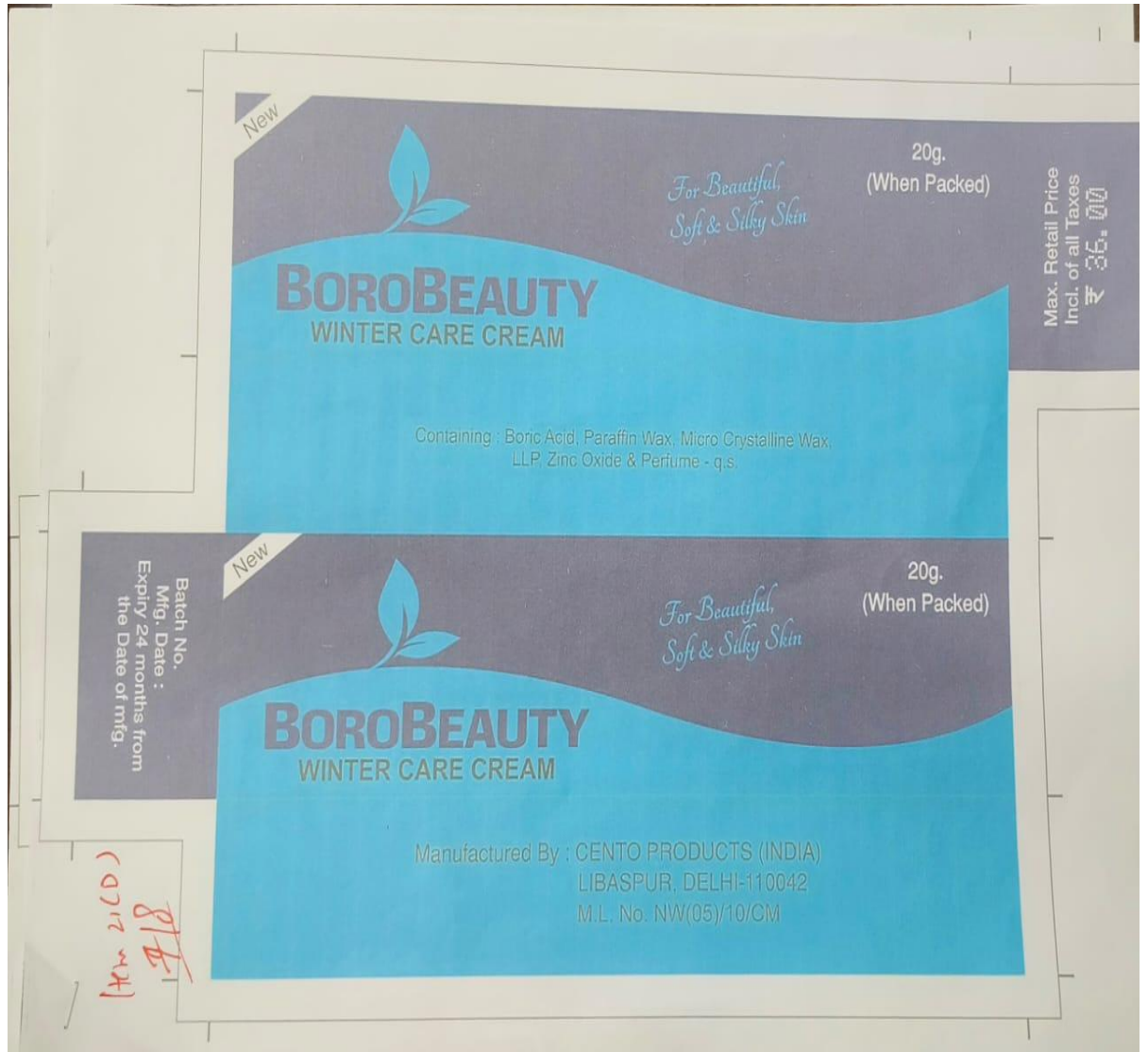
10. Today, learned counsel appearing for the defendant has handed over a copy of the photograph of a new trade dress proposed to be used by the

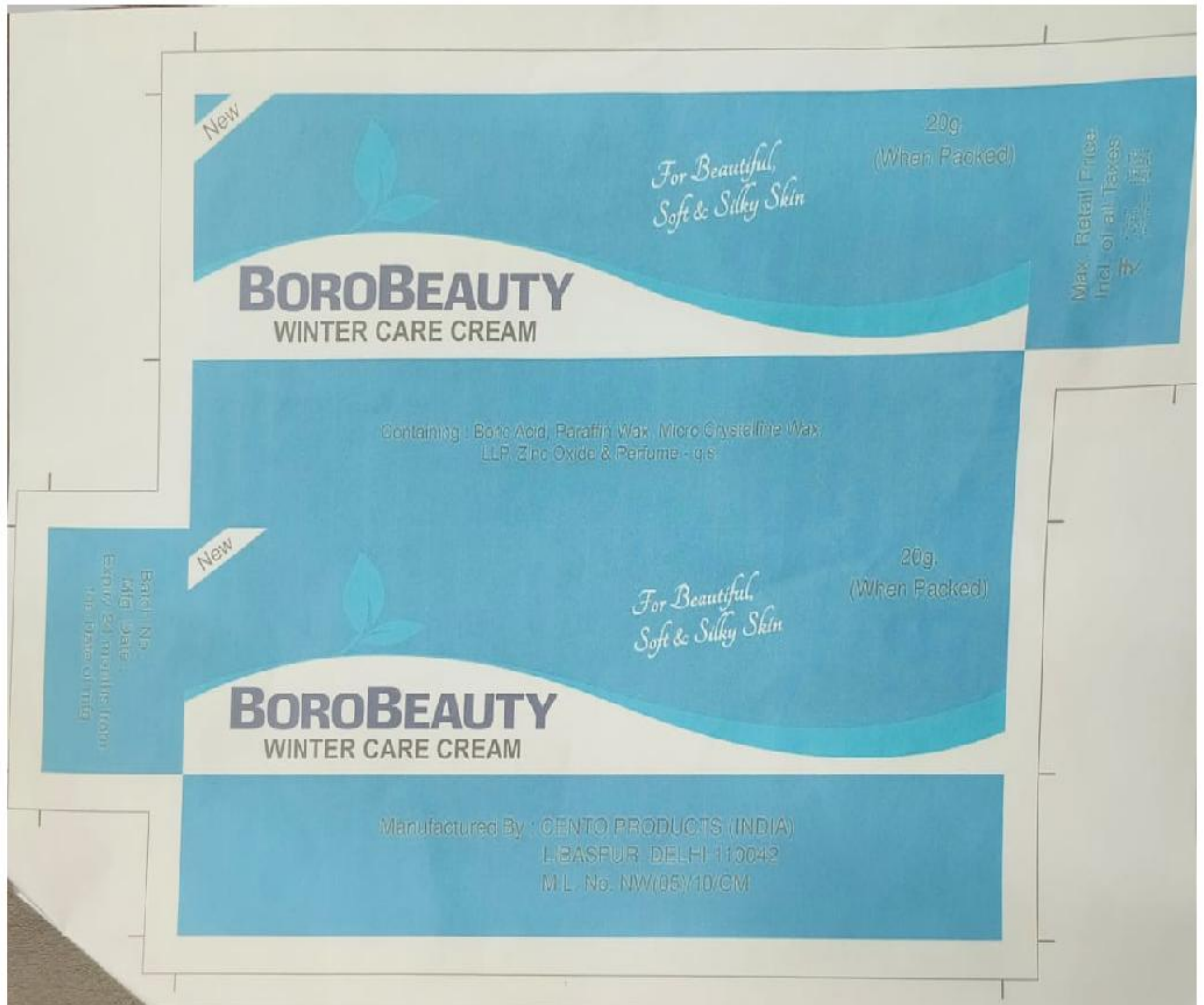


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defendant to submit that the defendant is now giving up the green colour trade dress altogether, and is adopting a new trade dress in blue colour, as follows:





11. He further submits that the defendant does not intend to even use the prefix 'BORO' and shall change the name of its product to some other name, which is distinct and different from the name of the plaintiff's product.




12. Accordingly, the suit can be decreed in favour of the plaintiff, in view of the aforesaid stand taken by the defendant.

13. At this stage, learned counsel appearing for the plaintiff presses the prayer for declaration of the plaintiff's trademark "BOROLINE", as a well-known mark.

14. Perusal of the record shows that the trademark "BORLINE" and



variations thereof, have been registered, in the following manner:

Trade mark Application No.	Class	Trade mark	Date of Registration	Status
14610	5	BOROLINE (LABEL)	14.10.1949	Registered
14611	5	BOROLINE (LABEL)	14.10.1949	Registered
198670	3	BOROLINE (WORD)	03.05.1962	Registered
371269	5	BOROLINE (WORD)	02.01.1984	Registered
1491772	5	BOROLINE (LABEL/CARTON)	25.03.2008	Registered
				
1491773	5	BOROLINE (LABEL/CARTON)	25.03.2008	Registered
				
1912811	3 & 5	BOROLINE (LABEL)	29.04.2011	Registered
				



2350129	5	BOROLINE (LABEL/TUBE)	13.01.2014	Registered
2350130	5	BOROLINE (LABEL/CARTON)	17.06.2014	Registered
2970909	3&5	BOROLINE SX 	22.05.2015	Registered
2970910	3&5	BOROLINE Ultra Smooth (Device) 	22.05.2015	Registered

15. This Court notes the submission of the plaintiff that the trademark in question was adopted by the plaintiff in or around the year 1929, and has



been used continuously, extensively, uninterruptedly, and in a bonafide manner since the year 1930. On account of its long and extensive use, the trademark “BOROLINE” has acquired immense distinctiveness and popularity.

16. This Court notes the submission made by learned counsel appearing for the plaintiff that the trademark “BOROLINE” has been selected as an Indian “Consumer Super Brand” six times consecutively between the years 2003 and 2017. It was selected as a “Master Brand” in the year 2014 and was listed among the “Most Desirable 30 Power Brands” in the year 2018.

17. Therefore, it is the case of the plaintiff that the plaintiff’s products are not only known for their superior quality, but are well recognized and immensely popular amongst doctors, chemists, patients and over three generations of loyal consumers, since 1929.

18. While expounding upon the concept of a well-known trademark having high reputation amongst the general public and the various factors which have to be considered in declaring a mark as a well-known mark, this court in the case of *TATA Sons Ltd. Versus Manoj Dodia and Others, 2011 SCC OnLine Del 1520*, has held as follows:

“xxx xxx xxx

5. A well known trademark is a mark which is widely known to the relevant general public and enjoys a comparatively high reputation amongst them. On account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising/publicity on internet, television, magazines and periodicals, which now are widely available throughout the world, of goods and services during fairs/exhibitions, more and more persons are coming to know of the trademarks, which are well known in other countries and which on account of the quality of the products being sold under those names and extensive promotional and marketing efforts have come to enjoy trans-border reputation. It is, therefore, being increasingly felt that such trademark needs to be protected not only in the countries in which they are registered but also



in the countries where they are otherwise widely known in the relevant circles so that the owners of well known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well. The relevant general public in the case of a well known trademark would mean consumers, manufacturing and business circles and persons involved in the sale of the goods or service carrying such a trademark.

xxx xxx xxx

*13. Trademarks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well known mark or not, though it does contain factors which the Registrar has to consider whether a trademark is a well known mark or not. **In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including (i) the extent of knowledge of the mark to, and its recognition by the relevant public; (ii) the duration of the use of the mark; (iii) the extent of the products and services in relation to which the mark is being used; (iv) the method, frequency, extent and duration of advertising and promotion of the mark; (v) the geographical extent of the trading area in which the mark is used; (vi) the state of registration of the mark; (vii) the volume of business of the goods or services sold under that mark; (viii) the nature and extent of the use of same or similar mark by other parties; (ix) the extent to which the rights claimed in the mark have been successfully enforced, particularly before the Courts of law and trademark registry and (x) actual or potential number of persons consuming goods or availing services being sold under that brand. A trademark being well known in one country is not necessarily determinative of its being well known and famous in other countries, the controlling requirement being the reputation in the local jurisdiction.***

xxx xxx xxx”

(Emphasis Supplied)

19. Perusal of the plaint shows that the sale of the plaintiff’s antiseptic cream with the trademark “BOROLINE” has grown phenomenally over the years. The plaintiff’s trademark “BOROLINE” has attained prominence and immense goodwill in the market and is highly popular. By virtue of extensive sales, marketing, advertising and publicity, the plaintiff’s “BOROLINE” trademark has acquired a tremendous reputation across India.

20. The Trade Marks Act, 1999 defines “well known” trademark in the following manner:



“xxx xxx xxx

2. Definitions and interpretation.

(1).....

(zg) “well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

xxx xxx xxx”

21. It is to be noted that various factors have been detailed in The Trade Marks Act, 1999 which are to be taken into account while determining whether a trade mark is a well known trademark. Thus, Section 11(6) of The Trade Mark Act, 1999 encapsulates the factors for determining a trademark as well known trademark, in the following manner:

“xxx xxx xxx

11. Relative grounds for refusal of registration

.....

(6) *The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—*

(i) *the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;*

(ii) *the duration, extent and geographical area of any use of that trade mark;*

(iii) *the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;*

(iv) *the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;*

(v) *the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.*

xxx xxx xxx”



22. Considering the aforesaid factors, with respect to the trademark “BOROLINE”, it is to be noted that the same has been in extensive use for more than ninety years. The list of registrations in favour of the plaintiff, showing the first date of registration in the year 1949, are reproduced as under:

LIST OF REGISTRATIONS

- R -

Trade mark Application No.	Class	Trade mark	Date of Registration	Status
14610	5	BOROLINE (LABEL)	14.10.1949	Registered
14611	5	BOROLINE (LABEL)	14.10.1949	Registered
198670	3	BOROLINE (WORD)	03.05.1962	Registered
371269	5	BOROLINE (WORD)	02.01.1984	Registered
917595	3	BOROLINE'S DEA (WORD)	31.12.2002	Registered
1096833	3	BOROLINE KHAS (WORD)	29.04.2005	Registered
1053356	5	BOROLINE'S (WORD)	14.06.2005	Registered
1053353	3	BOROLINE'S (WORD)	21.12.2005	Registered
1051128	3	BOROLINE'S BO (WORD)	18.12.2006	Registered
848585	3	BOROLINE'S NOPRIX (WORD)	18.12.2006	Registered
848581	3	BOROLINE NOPRIX (WORD)	09.10.2007	Registered
1491772	5	BOROLINE (LABEL/CARTON)	25.03.2008	Registered




Trade Mark

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BOROLINE[®]
Antiseptic Perfumed Cream

Special Antiseptic properties of Boroline fights germs. Works wonders to cure cuts & wounds, general skin infections and heal post-operative stitches.

Boroline's special oil-rich formula is enriched with natural lanolin, which protects and softens skin. Ensure fastest smoothening of all chapped, cracked and abraded skin.



8 901631 100011

					<ul style="list-style-type: none"> Rapidly Heals Stitches after Operations Cures General Skin Infections. Smoothens dry & chapped skin
Smoothens Chapped Lips	Cures Cuts & Wounds	Softens Elbows & Abraded Skin	For Cracked Heels & Nipples	Softens Nail Cuticles	

Net contents 21g
Mfg. Lic. No. D. L. 1420M
Exp. Date : 5 yrs. from date of Mfg.
FOR EXTERNAL USE ONLY
Keep in a dark cool place

Manufactured by :
G. D. Pharmaceuticals Private Limited
D.H. Road, Chakbagi, Elshahpur,
24 Pergana (South), INDIA
Regd. Office :
Asha Mahal, 94 N. R. Avenue, New Alipore,
Kolkata - 700 063, INDIA

Carbaning
Bark, Andhra Pradesh
Cane Cattle, etc.
White Powder, Jilla IP
Meyyachal, Andhra Pradesh

ADDRESS

Goods

System No. C
Mfg. Date
MFR: R.
1000000000

1491773	5	BOROLINE (LABEL/CARTON)	25.03.2008	Registered
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1912811	3 & 5	BOROLINE (LABEL)	29.04.2011	Registered
2350129	5	BOROLINE (LABEL/TUBE)	13.01.2014	Registered



2350130	5	BOROLINE (LABEL/CARTON)	17.06.2014	Registered
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BOROLINE[®]
Antiseptic Ayurvedic Cream

- Special Antiseptic properties of Boroline[®] fight germs. Works wonders to cure cuts & wounds, general skin infections and heal post-operative stitches.
- Boroline[®]'s special oil-rich formula is enriched with natural lanolin, which protects and softens skin. Ensure fastest smoothening of all chapped, cracked and abraded skin.

Smoothens Chapped Lips **Cures Cuts & Wounds** **Softens Elbows & Abraded Skin** **For Cracked Heels & Nipples** **Softens Nail Girdles**

Net contents 20g
Mfg. Lic. No.: AL-927-M
Exp. Date: 3 yrs. from date of Mfg.
FOR EXTERNAL USE ONLY
Keep in a dark cool place
Ayurvedic Medicine

Manufactured by: G. D. Pharmaceuticals Private Limited
D.F. Road, Chakbagi, Bishnupur, 24 Pgs (B), W.B. INDIA
Regd. Office: Ashi Mahal, 64 N. R. Avenue, New Alipore,
Kolkata - 700 053, INDIA
www.boroline.com
For consumer feedback call +91 (33) 23894011
or write to boroline@cal.vart.tel.in



1834961	5	BOROLINE'S RUKSHA	19.08.2014	Registered
2514556	3	BOROLINE ELEEN ACTIVE AMLA (LABEL)	27.05.2015	Registered
2296363	5	BOROLINE'S BAVASIRAHAT (WORD)	30.07.2015	Registered
2970909	3&5	BOROLINE SX 	22/05/2015	Registered
2970910	3&5	BOROLINE Ultra Smooth (Device) 	22/05/2015	Registered

23. Due to its extensive and continuous use, the trademark of the plaintiff, is recognized not only throughout the geographical extent of India, but is also recognized in other countries, as is manifest from the various documents placed on record showing the registration of the said trademark in various countries. The document regarding registration of the plaintiff's mark in Oman, is reproduced as under:



Sultanate of Oman
Ministry of Commerce and Industry
Directorate General of Commerce
Muscat

بِسْمِ اللَّهِ الرَّحْمَنِ الرَّحِيمِ



الوزارة العامة للتجارة والصناعة
م ٢٣/١١/٢٠١٤

شهادة تسجيل علامة تجارية

سلطنة عُمان
وزارة التجارة والصناعة
الديريّة العامّة للتجارة
مسقط

الرقم : ٨٥٧٨٢

الى : جي.دي.فارماسيو تيكالس برايفت ليميتد - هندي

عنوانه : أشا ماهال ، ٩٤ ، ناليني رانجان أفينيو ، كلكتا - ٧٠٠ ٠٥٣ ، استيت اوف ويست بنغال الهند

عملا بأحكام المادة (٣٨) ٣/أ من قانون حقوق الملكية الصناعية الصادر بالمرسوم السلطاني رقم ٦٧/٢٠٠٨ م. أشهد أن العلامة التجارية الميئه في طلبكم رقم (٨٥٧٨٢) والمقدم عنها الطلب بتاريخ ٢٠١٤/٠٢/٠٤ م قد تم نشرها في الجريدة الرسمية بالعدد رقم (١٠٧٩) بتاريخ ٢٠١٤/١١/٢٣ م وفي إحدى الجرائد اليومية ، سجلت بتاريخ ٢٠١٥/٠٢/٢٤ م باسمكم في الفئة (٠٣) من أجل المنتجات / الخدمات المدرجة في طلبكم وهي كالاتي :

مواد تجميل ، مواد زينه ، صابون ، مسحوق التالك ، زيوت عطرية ، كريمات وغسول (توشن) ، عطور ومزيلات الروائح الكريهة وجميع منتجات العناية الشخصية الأخرى التي تقع ضمن الفئة ٣.

وسيظل التسجيل نافذ المفعول مدة عشر سنوات اعتبارا من تاريخ تقديم الطلب ، ويجوز تجديد الحماية من وقت لآخر عند انتهاء مدة الحماية السارية مدة كل منها عشر سنوات وفقا لأحكام المادة (٤١) من القانون .

وقد الصقت صورة من العلامة التجارية المذكورة خلف هذه الشهادة .

تحريرا في : ٥ / ٧ / ٢٠١٤ هـ

الموافق : ٢٦ / ٢ / ٢٠١٥ م





2024:DHC:6224





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**SULTANATE OF OMAN
MINISTRY OF COMMERCE AND INDUSTRY
DIRECTORATE GENERAL OF COMMERCE
MUSCAT**

DIRECTORATE OF INTELLECTUAL PROPERTY

TRADEMARK REGISTRATION CERTIFICATE

No : 85782
To : G. D. Pharmaceuticals Private Limited.
Address : Asha Mahal, 94, Nalini Ranjan Avenue, Kolkata – 700 053, State of West Bengal, India.

Pursuant to section (38)3/A of Law on Industrial Property Rights promulgated by Royal Decree No. 67/2008, I hereby certify that the trademark appearing in your application No. (85782) filed on 04/02/2014 was advertised in the Official Gazette No. (1079) of 23/11/2014 and in one of the daily newspapers, and has been registered in your name on 24/02/2015 in class "03" in respect of the goods / services specified in your application as follows:

"Cosmetics, toiletries, soaps, talcum powder, essential oils, cream and lotion, perfumery and deodorants and all other personal care products included in class 3."

The said registration shall be valid for a period of ten years as from the date of the application and may be renewed from time to time on the expiration of such period for another ten years in accordance with section (41) of the Law.

A representation of the trademark is posted at the reverse of this certificate.

Issued on: 07/05/1436 AH
Corresponding to: 26/02/2015 AD

Director
Directorate of Intellectual Property

24. The document showing the registration of the trademark, "BOROLINE" in Turkey, is reproduced as under:



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T.C.
TÜRK PATENT ENSTİTÜSÜ

MARKA TESCİL BELGESİ

Marka No : 2008 49364 - Ticaret

BOROLINE

Marka Sahibi : G.D. PHARMACEUTICALS PRIVATE LIMITED
HİNDİSTAN CUMHURİYETİ
Asha Mahal 94 Nalini Ranjan Avenue New Alipore
Kolkata 700053 HİNDİSTAN

Emtiası : 03 , 05

Sabunlar, parfümeri, uçucu yağlar, kozmetikler, saç losyonları, diş macunları.
Farmasötikler ve tıbbi preparatlar, tıbbi amaçlı hijyenik (sıhhi) preparatlar, medikal kullanım için uyarlanmış diyetetik maddeler, bebekler için yiyecekler, mantar ve bitki yok etmek için preparatlar.

Markaların Korunması Hakkında 556 Sayılı Kanun Hükmünde Kararnameye göre 19/08/2008 tarihinden itibaren ON YIL müddetle 13/08/2009 tarihinde tescil edilmiştir.

Kıymetli Mübaşer
Enstitü Başkanı a.
Markalar Dairesi Başkanı

TÜRK PATENT [●] ENSTİTÜSÜ



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25. The document showing the registration of the trademark, “BOROLINE” in United Arab Emirates (“UAE”), is reproduced as under:

UNITED ARAB EMIRATES
Ministry Of Economy
Trade Marks Department

دولة الامارات العربية المتحدة
وزارة الاقتصاد
إدارة العلامات التجارية

112-

شهادة تسجيل علامة تجارية

عملاً بأحكام المادة ١٦ من القانون الاتحادي رقم ٣٧ لسنة ١٩٩٢م بشأن تسجيل العلامات التجارية :
تشهد وزارة الاقتصاد أن العلامة التجارية التي سبق تقديم طلب تسجيلها تحت رقم : **١٢٠٤٩٦**

من قبيل : **ش. جي. دي. فرماسيوتيكالز برايفت ليميتد**

تاريخ الإيداع : **٢٠٠٨/١٠/١٤**

الجنسية : **الهند**

الموطن : **أشما ماهال، ٩٤ ناليني رانجان أفينو، نيو ألبوري، كولكاتا
الهند ، ٧٠٠٠٥٣**

اسم العلامة : **BOROLINE**

رقم الفئة : **٣** (المنتجات موضحة خلف الشهادة)

قد تم تسجيلها تحت رقم : **١٣٤٦١٣** بتاريخ : **٢٠١١/٠٣/١٧**

وسيط التسجيل نافذ المفعول لمدة عشر سنوات اعتباراً من ٢٠٠٨/١٠/١٤ وحتى تاريخ انتهاء مدة الحماية في : **٢٠١٨/١٠/١٤**
ويجوز تجديد الحماية وفقاً لأحكام المادة ١٩ من قانون العلامات التجارية لمدد متتالية أخرى كل منها عشر سنوات .

الاشتراطات :

تحريراً في : **٢٠١١/٠٣/٢٢**

مدير إدارة العلامات التجارية

١٢٧



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114-

UNITED ARAB EMIRATES
Ministry of Economy
Commercial Registration Department
Trademark Registration Certificate

In accordance with the provisions of Article 16 of Federal Law no 37 for the year 1992 concerning the registration of trademarks, The Ministry of Economy certifies that the trademark for which an application was filed under No **120496** on behalf of **G.D. Pharmaceuticals Private Limited**

Filing date:	October 14, 2008	Priority:		BOROLINE
Nationality:	Indian			
Address:	Asha Mahal, 94 Nalini Ranjan Avenue New Alipore, Kolkata 700053, India			
Trademark name:	BOROLINE			
Class:	03			

Was registered under no **134613** on **March 17, 2011** and the registration shall remain in force for a ten year period starting from **October 14, 2008** and ending on **October 14, 2018**; and this protection may be extended indefinitely for further consecutive terms of ten years each pursuant to Article 19 of the Trademark Law.

Disclaimer:

The goods relating to the trademark filed under no **120496** in class **03: Soaps, Perfumery, essential oils, cosmetics, hair lotions, dentifrices, in class 3.**

Issued on: **May 18, 2011**

**Signature of the Director of
Commercial Registration**

**Official Seal of the Ministry of
Economy – Trademark Section**

26. The document showing the registration of the trademark, “BOROLINE” in Bangladesh, is reproduced as under:



2024:DHC:6224



T. M. R-31

গণপ্রজাতন্ত্রী বাংলাদেশ সরকার

ট্রেড মার্কস রেজিস্ট্রী, ঢাকা

GOVERNMENT OF THE PEOPLE'S REPUBLIC OF BANGLADESH
TRADE MARKS REGISTRY, DHAKA

ট্রেড মার্ক দরখাস্তের নং
Trade mark application(s) No. (s)191934, Dated 08/11/2015.....
ট্রেড মার্কের বিবরণ
Description of mark“BOROLINE বোরোলীন” (Label).....
কাহার নিকট হইতে প্রাপ্ত হইয়াছে.....
Received fromMUNSHI & ASSOCIATES, Dhaka, Bangladesh.....
চিঠির নং..... তারিখ.....
With letter No. dated.....
ট্রেড মার্ক (স) রেজিস্ট্রেশনের নিমিত্ত দরখাস্ত/দরখাস্তসমূহ।
Application (s) registration of trade mark (s) in
শ্রেণী নং.....
Class.....03.....
কাহার নামে.....
in the name of G. D. Pharmaceuticals Private Limited, Asha Mahal, 94, Nalini Ranjan Avenue,
কত ঢাকা ফিন্সসহ দাখিল হইল Kolkata – 700 053 State of West Bengal, India
together with a fee of Taka =3,500/- (Three thousand five hundred) only.
উপরোক্ত ক্রমিক নং এবং তারিখে দরখাস্ত লিপিবদ্ধ করা হইয়াছে।

The application (s) has (have) been serially numbered and dated as shown above.

To,
MUNSHI & ASSOCIATES
194/D/1, Tejkunipara, Tejgaon
Dhaka-1215, Bangladesh.

রেজিস্ট্রারের পক্ষে
ট্রেড মার্কস রেজিস্ট্রী, বাংলাদেশ।
For Registrar
Trade Marks Registry,
Bangladesh.

বাংসঃমুঃ-৯৭/৯৮-১৮০২৮-এফ—৩,০০০ বই (সি-৪৩), ১৯৯৮।



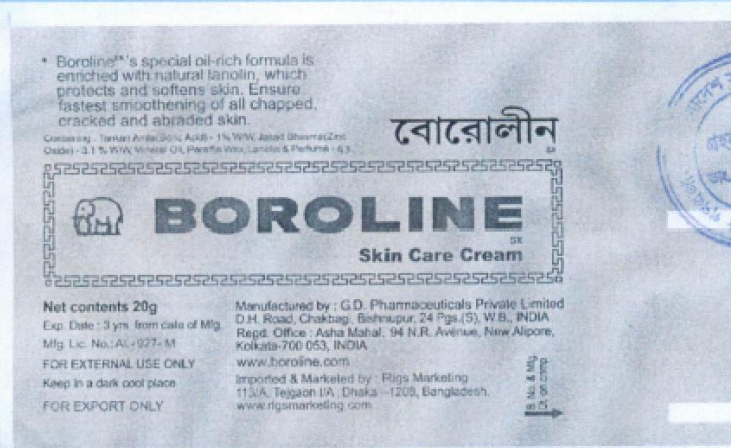
FORM TM-1

Fee: See entries Nos. 1 & 2 of the First Schedule.

TRADE MARKS ACT, 2009

Application for registration of trade mark (other than a textile mark or a defensive trade mark)

To be accompanied by a duplicate of this form and by six additional representation SECTION 15(1) & RULE 12.



In class

In respect

use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

In the name of (b) : G. D. Pharmaceuticals Private Limited, An Indian Company.

Trading as (c) : Manufacturers and Merchants.

Whose trade or business

address is (d) : Asha Mahal, 94, Nalini Ranjan Avenue, Kolkata - 700 053 State of West Bengal, India.

by whom the said mark is (e) being used in Bangladesh & who claim(s) to be the proprietors thereof.

The mark is (f) being used in Bangladesh since: 11 July, 2001.

Address for service in Bangladesh: Munshi & Associates, 194/D/1, Tejkunipara, Tejgaon, Dhaka-1215, Bangladesh.

Dated this 08th day of November, 2015.

G. D. Pharmaceuticals Private Limited by it's Agent

(g) (Md. Saifur Rahman) Advocate

For: MUNSHI & ASSOCIATES 194/D/1, Tejkunipara, Tejgaon, Dhaka-1215, Bangladesh.

To, The Registrar, Department of Patent, Design and Trade Marks, Dhaka, Bangladesh.

- (a) Specify the goods. Only goods included in one and the same class should be specified. A separate application Form is required for each class.
(b) Insert legibly the full name, description and nationality of the applicant See rule 8.
(c) Insert the trading style, if any.
(d) Insert the full trade or business address of the applicant.

27. Further, this Court also notes that the products under the trademark "BOROLINE", have been conferred with various awards. The document



showing that the plaintiff’s trademark “BOROLINE”, has been selected as super brand India for many years, is reproduced as under:



The Boroline People

Since 1929

- 134
- (1)

Boroline



Boroline Antiseptic Ayurvedic Cream is a luxuriantly rich night

repair cream to heal dry and rough skin overnight. Use Boroline every night and wake up every morning with soft, happy skin.



2003-05



Consumer Validated

2006-07



2009-10



2011-12



2014-15



2016-17

Boroline has been selected as Superbrand India continuously since 2003

28. The document showing the plaintiff’s trademark “BOROLINE”, as



being recognized as most admired/desirable brand of India, is reproduced as under:



135-

BOROLINE

Research by - White Page International

Boroline is also India's most admired brand



BOROLINE - Most Desirable 30 Power Brands 2018



I use Boroline every night.

Vidya Balan



Works Wonders to

na



29. The document regarding plaintiff's brand "BOROLINE", being conferred with the Superbrands India Award for the year 2003-04, is reproduced as under:

- 136-



Superbrands India

Awards

Superbrand 2003/04 status to



As selected by the independent
Superbrands Council


Anmol Dar
Chairman, Superbrands Council



Former Chairman of ACP/NABARD, ORG-MARG KMS (Tisco) Ahirwala
Former Managing Director & Chief Executive of Bhartiya Industries Suresh Kumar Alagh
Managing Director of Television Express & Managing Editor CNBC Raghav Bahl
Chairman of ITC Yogi C Deweshwar
President of Bharati, Colonel Pradeep Guha



The Independent Authority on Branding

Nabankar Gupta Group President & Wholesale Director of Raymond
Hilo Khanna Chief Executive & Area Director Central Asia of J Walter Thompson
Piyush Pandey Executive Chairman & National Creative Director of Ogilvy & Mather
Dilip Sehgal Executive Director of Hindustan Lever
Tara Sinha Former Chairperson of Indian Institute of Mass Communications



30. There are other documents on record, to show that the plaintiff's trademark "BOROLINE", has been conferred with the award of Superbrands, for a number of years.

31. The table showing the sales of the plaintiff's products under the trademark "BOROLINE", as given in the plaint, is as follows:

Year	Plaintiff's Sales (in ₹ Crore)
2006-2007	50.50
2007-2008	55.78
2008-2009	56.29
2009-2010	74.26
2010-2011	72.37
2011-2012	87.84
2012-2013	113.21
2013-2014	107.25
2014-2015	129.96
2015-2016	139.73
2016-2017	146.16
2017-2018	171.21

32. The plaintiff has also spent considerable amounts for advertising and promoting its products under its trademark, "BOROLINE". The table showing the expenditure by the plaintiff on promotion, advertisement and publicity of its products, under the trademark "BOROLINE", is as under:



Year	Plaintiff's Advertising & Promotional Expenditure (in ₹ Crores)
2006-2007	8.48
2007-2008	11.89
2008-2009	12.09
2009-2010	14.56
2010-2011	18.74
2011-2012	23.63
2012-2013	20.15
2013-2014	26.68
2014-2015	27.02
2015-2016	34.09
2016-2017	34.91
2017-2018	37.87

33. The duration of the use of the trademark "BOROLINE", can be gauged from the document showing the advertisement of the product under the mark "BOROLINE", as occurring in newspaper on 15th August, 1947, the day, our Country attained Independence. The said document is reproduced hereunder:



as a well known trademark. There is no denying the fact that “BOROLINE” has attained the status of a household name, and is one of the oldest trademarks, which has been in continuous use, preceding the independence of India.

35. Considering the aforesaid detailed discussion, the trademark “BOROLINE” of the plaintiff, is declared as a well-known trademark under Section 2(1)(zg) and Section 11(2) of the Trade Marks Act, 1999. Accordingly, it is directed that the Registrar of Trademarks shall add the same to the list of well-known trademarks, upon the plaintiff completing the requisite formalities.

36. Considering the submissions made by learned counsel appearing for the defendant with regard to change in its trademark and trade dress, and in view of the fact that the plaintiff’s mark “BOROLINE” has been declared as a well-known mark, prayer of the plaintiff for permanent injunction against the defendant, is liable to be allowed.

37. Accordingly, a decree of permanent injunction is issued in favour of the plaintiff and against the defendant, thereby restraining the defendant, its partners, proprietors, servants, agents, and all others in active concert or participation with them, from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in products bearing the mark/ name ‘BOROBEAUTY’, or any other mark/name consisting of the word/expression ‘BOROBEAUTY’, or any other names/ marks/ expressions that are identical or deceptively similar to the plaintiff’s registered trademarks ‘BOROLINE’ and/or ‘BOROLINE’ (Label) or dealing in products with the trade dress/packaging that are identical or deceptively similar to the plaintiff’s registered trade dress/ packaging under the trade mark ‘BOROLINE’, which may amount to infringement, passing off, or in



any manner suggest a connection or association with the plaintiff.

38. The defendant is directed to change its trade dress and trademark, which shall be totally distinct and different from the plaintiff's well-known trademark and trade dress. The defendant shall not use the trade dress of dark green colour, which is used by the plaintiff. Further, the defendant shall adopt a new trade name, which would not include the prefix 'BORO' and would not be similar to the trademark of the plaintiff, 'BOROLINE'.

39. Considering the pendency of the suit since a long time, it is directed that the defendant shall pay cost of ₹ 2,00,000/-, to the plaintiff.

40. At this stage, learned counsel appearing for the defendant submits that the defendant is a small time businessman, and that he may be granted eight weeks' time to pay the same.

41. Accordingly, the defendant is directed to pay the cost of ₹ 2,00,000/- to the plaintiff, within a period of eight weeks, from today.

42. Decree sheet be drawn up.

43. The present suit, along with the pending applications, stand disposed of.

MINI PUSHKARNA, J

AUGUST 7, 2024

Ak/Kr