

# World Trademark Review *Daily*

**Marks should not be split to assess similarity**  
**India - Ranjan Narula Associates**

**Confusion**

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In *Gufic Ltd v Clinique Laboratories LLC* (FAO(OS) 222/2009, July 9 2010), the Delhi High Court has set aside an interim injunction restraining *Gufic Ltd* from using trademarks that were similar to *Estée Lauder's* CLINIQUE mark.

In 2008 US cosmetic giant *Estée Lauder* (which owns *Clinique Laboratories LLC*) successfully obtained an *ex parte* interim injunction against *Gufic*, an Indian cosmetic manufacturer, on the grounds that *Gufic's* registered trademarks SKINCLINIQ, DERMACLINIQ and SKINCLINIQ STRETCH NIL infringed its registered CLINIQUE mark and variants thereof.

Before the single judge, *Estée Lauder* had successfully argued that:

- the word 'clinique', which was the most distinctive feature of its mark, had been used worldwide since 1968, and in India since 2007;
- *Gufic's* use of the mark SKINCLINIQ infringed the CLINIQUE mark, as *Gufic's* mark was deceptively similar to *Estée Lauder's* mark and was used in relation to identical products (ie, cosmetics); and
- since both parties were engaged in the same business, there was a presumption that *Gufic* was aware of *Estée Lauder's* prior registered trademark.

The single judge accepted *Estée Lauder's* contentions, observing as follows:

- There were only few differences between the CLINIQUE and SKINCLINIQ marks;
- *Gufic* had aimed to create an association with *Estée Lauder* by using a similar mark; and
- Use of the expression "made in India by *Gufic Bio Sciences Ltd*" on *Gufic's* products created the impression that *Gufic* was a licensee of *Estée Lauder* in India.

On appeal, *Gufic* argued as follows:

- The marks CLINIQUE and SKINCLINIQ were neither identical nor deceptively similar;
- *Gufic* used its mark in respect of an ayurvedic herbal product for removing stretch marks, while *Estée Lauder* used its mark for cosmetic products;
- There was a vast price difference between the parties' products; and
- The way in which the marks were represented on the products was completely different.

The Delhi High Court, after hearing the arguments of both parties, observed as follows:

- If the marks at issue are not identical, the 'deceptive similarity' test in infringement cases is the same as that in passing-off actions;
- The assessment must be done from the point of view of a person with average intelligence and imperfect recollection;
- When comparing the marks, the court must take into account the overall structural and phonetic similarity of the marks, but should not split them into their component parts and consider their etymological meaning; and
- When comparing the marks, the court must consider whether they convey the same idea.

Based on these criteria, the High Court recognised that the marks shared a common idea (ie, they refer to a place which provides some kind of treatment). However, when seen as a whole, the marks were not deceptively similar, either phonetically or structurally, and were thus unlikely to cause confusion in the minds of consumers. The court also gave significant weight to the fact that the price of the parties' products was very different and, consequently, consumers would not confuse one product for the other.

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