

---

## Protecting reputation and goodwill in interconnected world

---

Laverana GMBH & CO KG (Laverana), Germany, succeeded in restraining, Mac Personal Care Pvt Ltd (Mac Personal), from using the trademark LAVERA in respect of all kinds of cosmetic and body care products included in Class 3 till the disposal of the case. Laverana filed the suit before the Delhi High Court for permanent injunction restraining passing off, damages, delivery up, etc, against Mac Personal with regard to use of trademark LAVERA in relation to natural cosmetics and other body care products. Along with the suit Laverana also filed an interlocutory application. The Court at the stage of admission of the lawsuit, granted an ex-parte injunction in this matter. Mac Personal filed an application for setting aside the injunction and Laverana argued for confirmation of injunction.

### **Laverana in support of its case contended:**

- It is carrying on the business of manufacturing and marketing cosmetics and body care products and adopted the trademark LAVERA in 1980. LAVERA is an arbitrary mark in relation to cosmetic products.
- The trademark LAVERA was used for the first time in Germany in 1982 and since then it has been extensively used in many countries worldwide and is inherently distinctive of the goods of Laverana.
- The LAVERA mark enjoys statutory protection in several countries of the world namely Germany, Denmark, Hong Kong, Italy, France, Japan, and in India the mark is pending registration.
- Laverana's products under the mark LAVERA have become extremely popular and widely available/sold all over the world and the customers in India are also well aware of the quality and reputation of the LAVERA products as these are easily available for purchase through online shopping websites. To substantiate its case Laverana made actual purchase of products through websites in India.
- Laverana argued spill over of global reputation of the LAVERA mark in India relying upon Indo-German diplomatic and cultural ties that span over 60 years. It also relied upon large expatriate Indian population living in the UK, Europe, Australia, etc, where Laverana's products are freely available.
- Laverana argued that it became aware of the Mac Personals mark LAVERA in September, 2010, when the same was published in the Trademarks Journal for opposition. Further

enquiries revealed that Mac Personal is using the mark Mac's LAVERA in relation to cosmetic and skin care products. Use of an identical mark for identical goods is clearly in bad faith.

**Mac Personal in support of its case contended:**

- Laverana is guilty of delay, latches and acquiescence as they were aware of Mac Personal's use of the LAVERA mark since the year 2005. The lawsuit was filed in the year 2012.
- Laverana has miserably failed to make out any case of trans-border reputation. There is no use of the mark in India.
- Mac Personal is entitled to use the said trademark/label LAVERA and MAC'S LAVERA on the basis of the law of honest adoption and concurrent user.
- Mac Personal's predecessor-in-interest had coined and adopted the trademarks LAVERA and Mac's LAVERA in respect of the products namely, bleaching preparations, other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices, etc, on 1<sup>st</sup> August, 2005.
- Mac Personal took LOAVERA from ALOEVERA and coined a new mark/word LAVERA.

**After hearing the parties and reviewing the documents in detail, the Court ruled in favour of Laverana and made the following observations:**

- a) From the material placed on record, it is evident that Laverana is the first adopter of the LAVERA mark which is being used by them globally prior to Mac Personal.
- b) The court also cited several recent decisions where it was held that the existence of a merchant on web pages which are of foreign origin and social media are sufficient to show the trans-border nature of reputation without having any activity in India at the relevant time. The Court has also considered Laverana's extensive use, global registrations and availability of the LAVERA branded products on online shopping websites to conclude that Laverana has succeeded in establishing its trans-border reputation.
- c) With regard to delay, the Court has held that delay cannot be a ground for refusing injunction as Laverana has made out a strong case for passing off.
- d) Laverana's mark LAVERA is an arbitrary and uncommon mark in relation to cosmetics. Further, Mac Personal is not the proprietor of the LAVERA mark and they have also failed to give any valid justification for adoption of the same.

The court confirmed the injunction granted earlier in favour of Laverana and restrained Mac Personal from using the trademark LAVERA in respect of all kinds of cosmetic goods and body products included in Class 3 till the disposal of the case.

*RNA, IP Attorneys represented Laverana in this case on instructions from RWZH Rechtsanwälte, Germany*

Vatika Towers  
10th Floor Block-B  
Sector-54  
Gurgaon-122002  
National Capital Region (Haryana)  
India

Tel. +91 124 4655999  
Fax. +91 124 4045047  
Email [info@rnaip.com](mailto:info@rnaip.com)

Copyright © RNA, IP Attorneys