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## Groundless threats of legal proceedings: Bombay High Court rules in favour of Hindustan Unilever in GLOW & HANDSOME case

India - [Nishith Desai Associates](#)

- Hindustan Unilever argued that Emami's statements in various online and print media constituted "groundless threats of legal proceedings"
- The court held that, on a *prima facie* basis, it appeared that Hindustan Unilever was the prior adopter of the mark GLOW & HANDSOME
- Emami's statements did *prima facie* amount to a threat against Hindustan Unilever

In *Hindustan Unilever Limited v Emami Limited*, the Bombay High Court has granted relief to plaintiff Hindustan Unilever Limited and passed an *ex parte* order against defendant Emami Limited. At issue in this case was the defendant's use of the trademark GLOW AND HANDSOME. The court held that the defendant had to provide the plaintiff with seven-day prior notice before initiating any legal proceedings against the plaintiff's use of the mark GLOW & HANDSOME.

### Background

The plaintiff, one of India's largest fast-moving consumer goods company, has been using several distinctive trademarks in relation to its various products. One such trademark is FAIR & LOVELY, which was adopted by the plaintiff in or about 1975 for use in relation to its face cream for women. To specifically target the men's segment of the population, in or around 2006 the plaintiff launched its 'Fair & Lovely, Men' product.

On 7 September 2018 the plaintiff independently and honestly coined and adopted the mark GLOW & HANDSOME in respect of its skincare products. To secure statutory rights in this mark, on 7 September 2018 the plaintiff filed multi-class trademark applications on a 'proposed to be used' basis.

In or about June 2020 the plaintiff filed another set of trademark applications seeking registrations of the mark on a 'proposed to be used' basis.

On 2 July 2020 the plaintiff made an official announcement that its Fair & Lovely skincare range was being rebranded as 'Glow & Lovely', and that its skincare range for men would be rebranded as 'Glow & Handsome'. The plaintiff was granted an FDA licence to manufacture its skincare products under the mark GLOW & HANDSOME on 3 July 2020. Thereafter, the plaintiff launched commercial advertisements in respect of its Glow & Handsome products, both on social media and in newspapers.

Immediately after the plaintiff made its announcement on 2 July 2020, the defendant issued statements in various newspapers, threatening to initiate legal action against the plaintiff for violating the defendant's alleged rights in its mark EMAMI GLOW AND HANDSOME.

### Plaintiff's arguments

The plaintiff, upon coming across the defendant's statements, conducted a search in the Register of Trademarks and learnt that:

- on 25 June 2020 the defendant had filed an application for the registration of the trademark GLOW AND HANDSOME on a 'proposed to be used' basis; and
- on 27 June 2020 the defendant had filed an application for the registration of the trademark EMAMI GLOW AND HANDSOME, claiming use from 26 June 2020.

The plaintiff submitted that:

- the defendant's statements, published in various online and print media, were unjustifiable and constituted "groundless threats of legal proceedings" under Section 142 of the Trademarks Act 1999;
- the defendant's claim of proprietorship of the marks GLOW AND HANDSOME/EMAMI GLOW AND HANDSOME was false and misconceived;
- the plaintiff was the prior adopter and user of the GLOW & HANDSOME mark; and
- the mark GLOW AND HANDSOME had not been used by the defendant and the latter was not entitled to disturb the plaintiff's honest and *bona fide* use of the earlier adopted trademark GLOW & HANDSOME.

The plaintiff further argued that, since its products bearing the mark were being commercially advertised across the country, the defendant was likely to wrongfully initiate proceedings in any court in India and try to obtain *ex parte ad interim* relief against the plaintiff.

### Decision

The Bombay High Court held that, on a *prima facie* basis, it appeared that the plaintiff was the prior adopter of the mark, having filed its trademark applications in September 2018 and June 2020. Further, based on the evidence submitted by the plaintiff, it appeared *prima facie* that the plaintiff had already launched commercial advertisements in respect of the mark. It was clear that the defendant had adopted the GLOW AND HANDSOME mark for the first time on 25 June 2020 and had not commercially used its mark. The court also held that the statements made by the defendant and published in various newspapers did *prima facie* amount to a threat against the plaintiff.

Based on the above reasoning, the court ruled in favour of the plaintiff and granted the relief sought, requiring the defendant to provide the plaintiff with seven-day prior notice before initiating any legal proceedings involving the plaintiff's mark.

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### TAGS

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