

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

Reserved on : 13.09 2010

% Date of decision : 20.09.2010

+ **RFA (OS) No. 37 / 2010**

RICH PRODUCTS CORPORATION & ANR.

... ..APPELLANTS

Through : Mr. Peeyosh Kalra, Ms. V. Mohini &
Mr. Vikram Grover, Advocates.

- V E R S U S -

INDO-NIPPON FOODS LIMITED

... ..RESPONDENT

Through : Mr. S.K. Bansal & Md. Sazid Rayeen,
Advocates.

CORAM :

HON'BLE MR. JUSTICE SANJAY KISHAN KAUL

HON'BLE MR. JUSTICE VALMIKI J. MEHTA

1. Whether the Reporters of local papers
may be allowed to see the judgment? No
2. To be referred to Reporter or not? No
3. Whether the judgment should be
reported in the Digest? No

SANJAY KISHAN KAUL, J.

1. The claim of exclusive right to use the word mark 'WHIP
TOPPING' resulted in filing of a suit by the appellants.
The appellants claimed that the said word mark is part of
its registered trademark 'RICH'S WHIP TOPPING' and the
use of the word mark 'WHIP TOPPING' by the respondent

as part of its trademark / label 'BELLS Whip Topping' was deceptively similar. The appellants also claim that the respondent seeks to pass off its goods for that of the appellants on account of the trade-dress, packaging and instructions, which are alleged to be identical. The appellants, thus, sought appropriate reliefs in the suit both of perpetual injunction and consequential reliefs for accounts, etc.

2. The appellants along with the suit filed an application for interim relief under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908, but failed in that endeavour in terms of an Order dated 03.07.2007 of the learned Single Judge. In the appeal filed by the appellants against the interlocutory order, the trial in the suit was reduced by consent to filing of affidavits of evidence by both the parties with the documents to be read in evidence without the need of the cross-examination and the suit to be decided accordingly. Learned Single Judge, thus, framed the following issues on 10.11.2008 :-

“(i) Whether the plaintiff is the proprietor of the Trademark “RICH’S WHIP TOPPING” in relation to its goods as mentioned in the plaint both under the statutory as well as under the common law? OPP

(ii) Whether the plaintiff No. 1 has acquired distinctive goodwill and reputation and secondary meaning in respect of the trademark “RICH’S WHIP

TOPPING” by virtue of its prior, long and continuous user as alleged? OPP

(iii) Whether the trademark “RICH’S WHIP TOPPING” is a trademark possessing trans-border reputation? OPP

(iv) Whether the registered trademark of the plaintiff “RICH’S WHIP TOPPING” is deceptively similar to the trademark of the defendants, “BELLS WHIP TOPPING” and amounts to infringement and passing off the plaintiffs’ impugned product? OPP

(v) Whether the defendant’s packaging is confusingly similar to the trade-dressing of the plaintiffs’ packaging? OPP

(vi) Whether the plaintiff is entitled to damages against the defendants and if so, in what sum? OPP

(vii) Whether the trademark of the plaintiff is not a coined word? OPD

(viii) Whether the trademark of the plaintiff is a descriptive trademark? OPD

(ix) Whether the trademark of the plaintiff is a common dictionary word and that the same is common in use? OPD

(x) Whether the trademark of the plaintiff is generic in nature? OPD

(xi) Whether the plaintiff is guilty of concealment of the fact that its registered trademark is subject to a disclaimer and the effect thereof? OPD

(xii) Whether the suit instituted by the plaintiff is barred on account of delay and laches and acquiescence on the part of the plaintiff? OPD

(xiii) Relief.”

3. The parties filed their respective affidavits of evidence. The suit was taken up for final disposal and in terms of the impugned judgment and decree dated 19.02.2010, the suit has been dismissed. Issue No. 1 was answered in favour of the appellants insofar as the proprietary rights in the trademark ‘RICH’S WHIP TOPPING’ were concerned, but it was held that the same did not extend to a part of the trademark ‘WHIP TOPPING’. Issues No. 2, 3, 4 and 5 were answered against the appellants, while Issues No. 7 to 10 were answered in favour of the respondent and against the appellants. The sequitor was that Issue No. 6 was also answered against the appellants. Issues No. 11 and 12 were, however, answered in favour of the appellants.
4. The sum and substance of the case of the appellants is that ‘RICH’S WHIP TOPPING’ is a non-dairy topping and is one of the various non-dairy products manufactured and sold by the appellants. The object of all these products is that the food products remain soft while frozen and can be served straight from the freezer. The appellants claim large sales running into billions of US \$. The trademark is originally of appellant No. 1 and appellant No. 2 was a joint-venture initiated by appellant No. 1 for

manufacturing the products under the concerned trademark for which royalty was being paid by appellant No. 2 to appellant No. 1. It is undisputed that in India “RICH’S WHIP TOPPING” is a trademark, which was registered w.e.f. 13.11.1991 in Class 30 for non-dairy topping, icing, filling and generally for other goods in that Class. The registration is subject to a disclaimer with respect to the letter ‘S’ and the word “TOPPING”. The appellants claim that ‘RICH’S WHIP TOPPING’ and ‘WHIP TOPPING’ are registered in several countries across the globe.

5. In order to support their case, the appellants filed the affidavits of Mr. Jill K. Bond, PW – 1 in support of the worldwide reputation and the deceptively similar mark and packaging of the respondent. The international sales figures are sought to be proved through Ms. Betty Fye, PW – 2. The facts pertaining to appellant No. 2 have been deposed by Mr. Priyakant Himatlal Shah, PW – 3. In total, eight (8) witnesses have been examined by the appellants.
6. The case is resisted by the respondent claiming the use of the expression ‘BELLS Whip Topping’ in the trade since 1995. The appellants’ mark is stated to be generic in nature with no trademark significance. It is the case of the respondent that the appellants cannot segregate a part of the trademark to claim exclusive right in that

segregated part, especially as 'WHIP TOPPING' is a descriptive expression referring to the character and quality of the product, which has not acquired any secondary meaning. The expression 'WHIP TOPPING' is stated to be common to use in the trade world over. A number of illustrations for the same are given, which have been referred to in para 14.1 of the impugned judgment as under :-

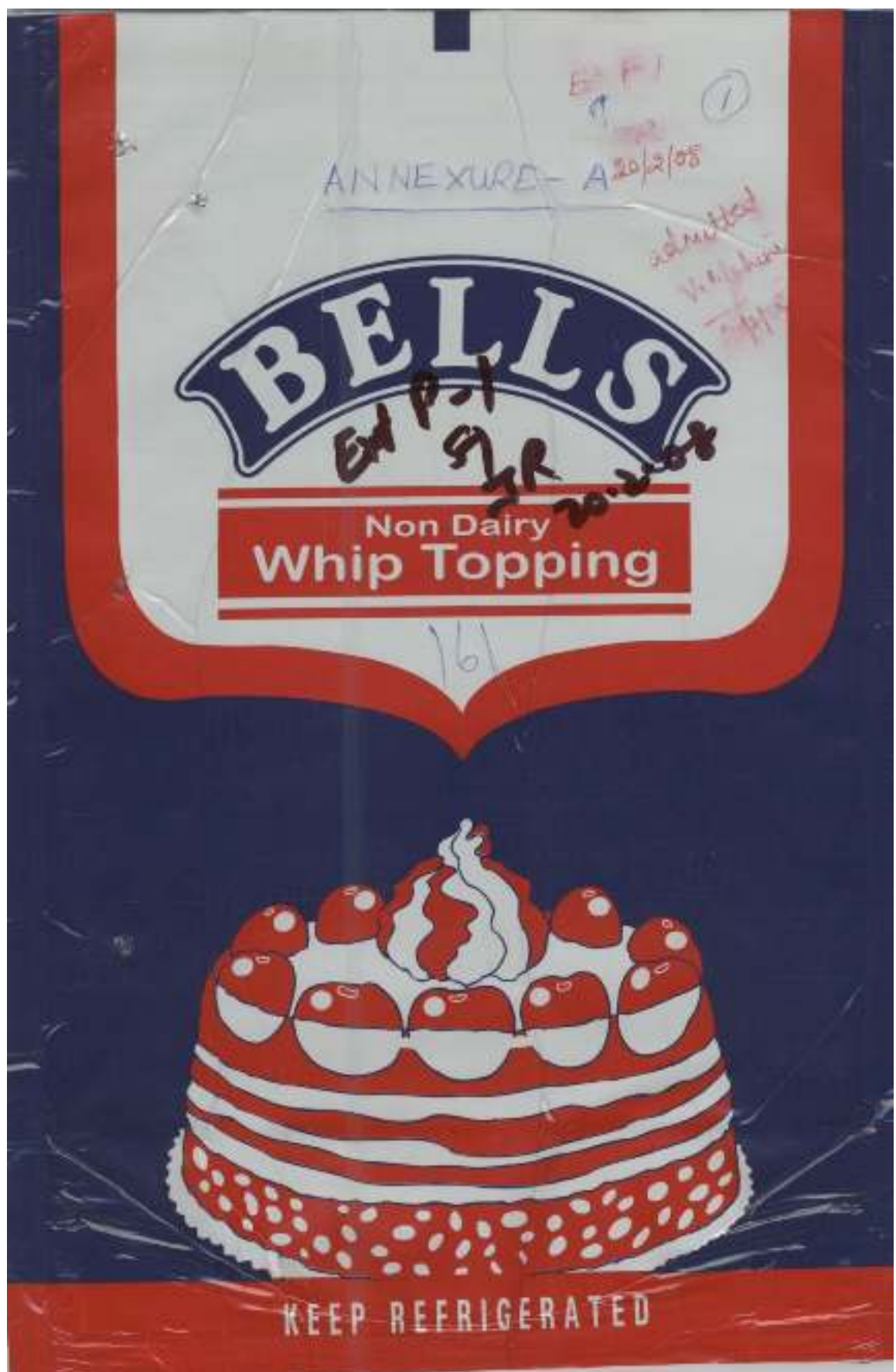
"14.1 In defence of its right to use the mark "BELLS WHIP TOPPING" the defendant has stated that the plaintiffs' mark is generic in nature and has no trademark significance. It is further averred that, in any event, the plaintiffs' trademark, which is registered as one composite whole, is "RICH'S WHIP TOPPING" with a disclaimer in so far as letter 'S' and the word 'Topping' is concerned; therefore, there can be no infringement much less a commission of tort of passing off by the defendant in using the trademark "BELLS WHIP TOPPING". This, according to the defendant, is more so in view of the fact that "WHIP TOPPING" is a descriptive expression which alludes to the character and quality of the product itself and hence, cannot be protected till it can be demonstrated that it has acquired a "secondary meaning". The defendant has further averred that the product in issue is "WHIP TOPPING" and it cannot be described in any other manner except by using that expression and especially when it is a manufacturer of the said product. It is the defendant's stand that the said word/expression „WHIP TOPPING" is commonly used in the trade world over. According to the defendant "WHIP TOPPING" is an imitation dairy product which is commonly used in making desserts, baked and frozen products by various manufacturers all over the world, and hence is "*publici juris*". In this regard, example of other manufacturers, which have used the word mark "whip topping" in respect of their products, have been referred to in the written statement. For the sake of convenience they are extracted here-in-below:

S.No.	Name of the Company	Product
1.	Lego Foods Co. Ltd.	Lego non-dairy Whip Topping
2.	Kraft Foods	Cool Whip Whipped Topping
3.	Flavor Right Foods, Columbus, Ohio 43216, USA	Flavor Right Premium ready to whip Topping
4.	Elgin Dairy Foods, Inc., Chicago, Illinois, USA	1) Elgin NP Whip Topping 2) Elgin's Indenum Whip Topping 3) Elgin's ready-to-whip D-lux Whip Topping
5.	Morningstar Foods Inc., USA	1) Frozen Whipped Toppings 2) Dairy Fresh Aerosol Whipped Toppings
6.	Hanan Products Co. Inc.	Hanan's Whip Topping

7. The analysis of the impugned judgment shows that the learned Single Judge has rightly found that the registration of the appellants' mark is for 'RICH'S WHIP TOPPING' and not 'WHIP TOPPING' and such a position is present even in certain foreign jurisdictions such as USA and New Zealand. This is apart from the disclaimer of the letter 'S' and the word 'TOPPING'. There is no registration in favour of the appellants with respect to the trade-dress, which is based on use of inter-play of red, blue and white colours. The appellants can claim right to the part of the trademark 'WHIP TOPPING' only if the appellants are able to establish that the said expression has acquired a secondary meaning. We are in agreement with the conclusion of the learned Single Judge that on analysis of the evidence on record, there is

no material to suggest that by mere use of the word mark 'WHIP TOPPING', the product of the appellants comes to the mind of a consumer. The testimony of PW – 8, which refers to the 'eye-catching' aspect of the appellants' packaging, does not deal with the aspect of distinctiveness of the word mark 'WHIP TOPPING'. The respondent uses its trademark 'BELLS Whip Topping' with prominent use of the word 'BELLS', leaving no manner of doubt about the distinctiveness of the description of the product of the respondent.

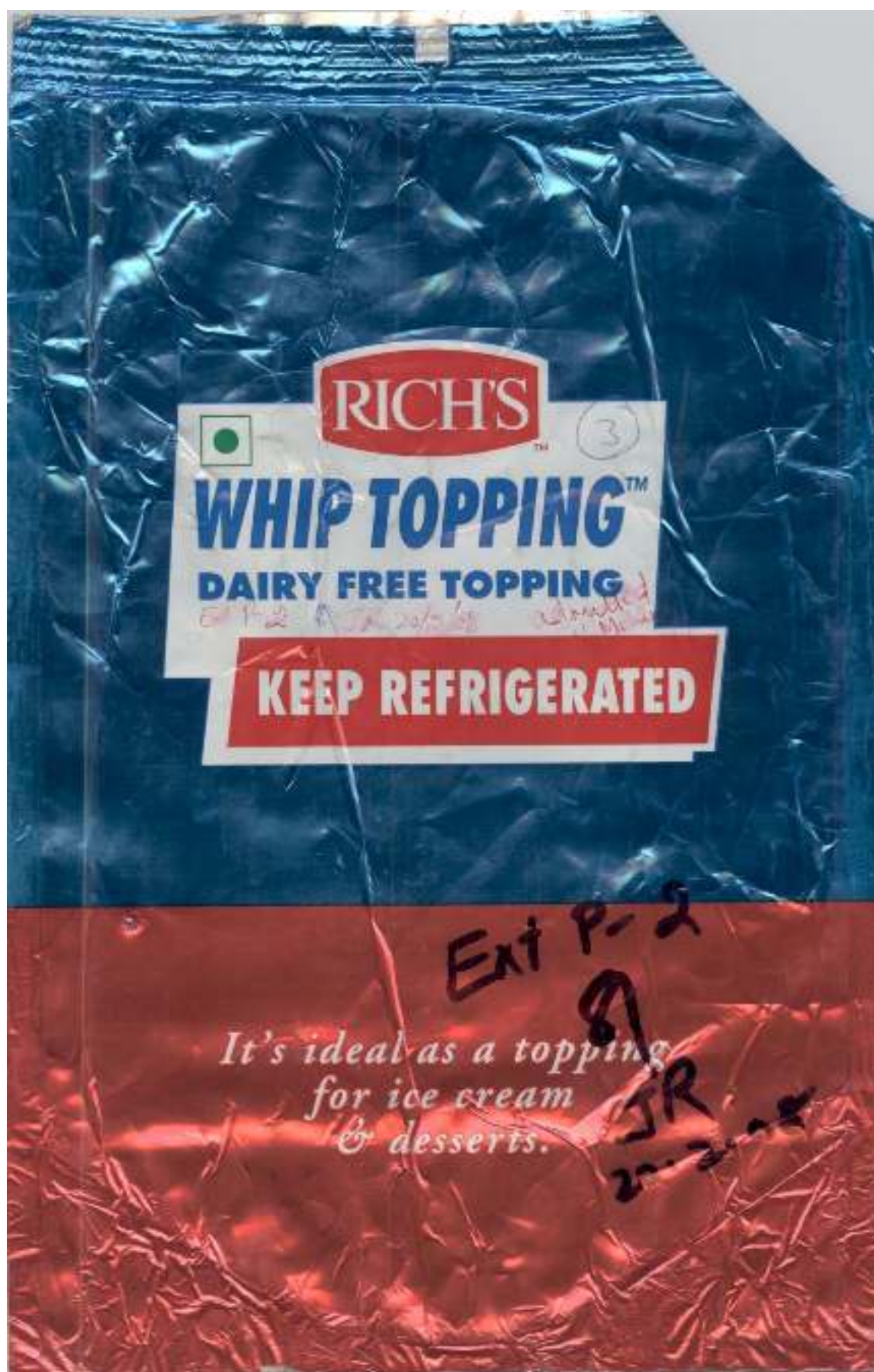
8. Learned Single Judge has considered the dictionary meaning of the expression 'WHIP TOPPING' – the word '*whip*' in the context of its use in the present case imply '*a light fluffy dessert made with whipped cream or beaten eggs*', while the word '*topping*' would mean '*a top layer or garnish put on food*'. The conclusion drawn is that 'WHIP TOPPING' would be '*representative of toppings or garnish for food items, which have a cream-like quality*' and, thus, is both '*generic*' and '*descriptive*' of the product. The expression has acquired no secondary distinctive meaning by its exclusive use and / or publicity.
9. In order to appreciate the visual impact of the two cartons, we consider it appropriate to reproduce Exhibit P – 1 (of the respondent) and Exhibit P – 2 (of the appellants) as under :-



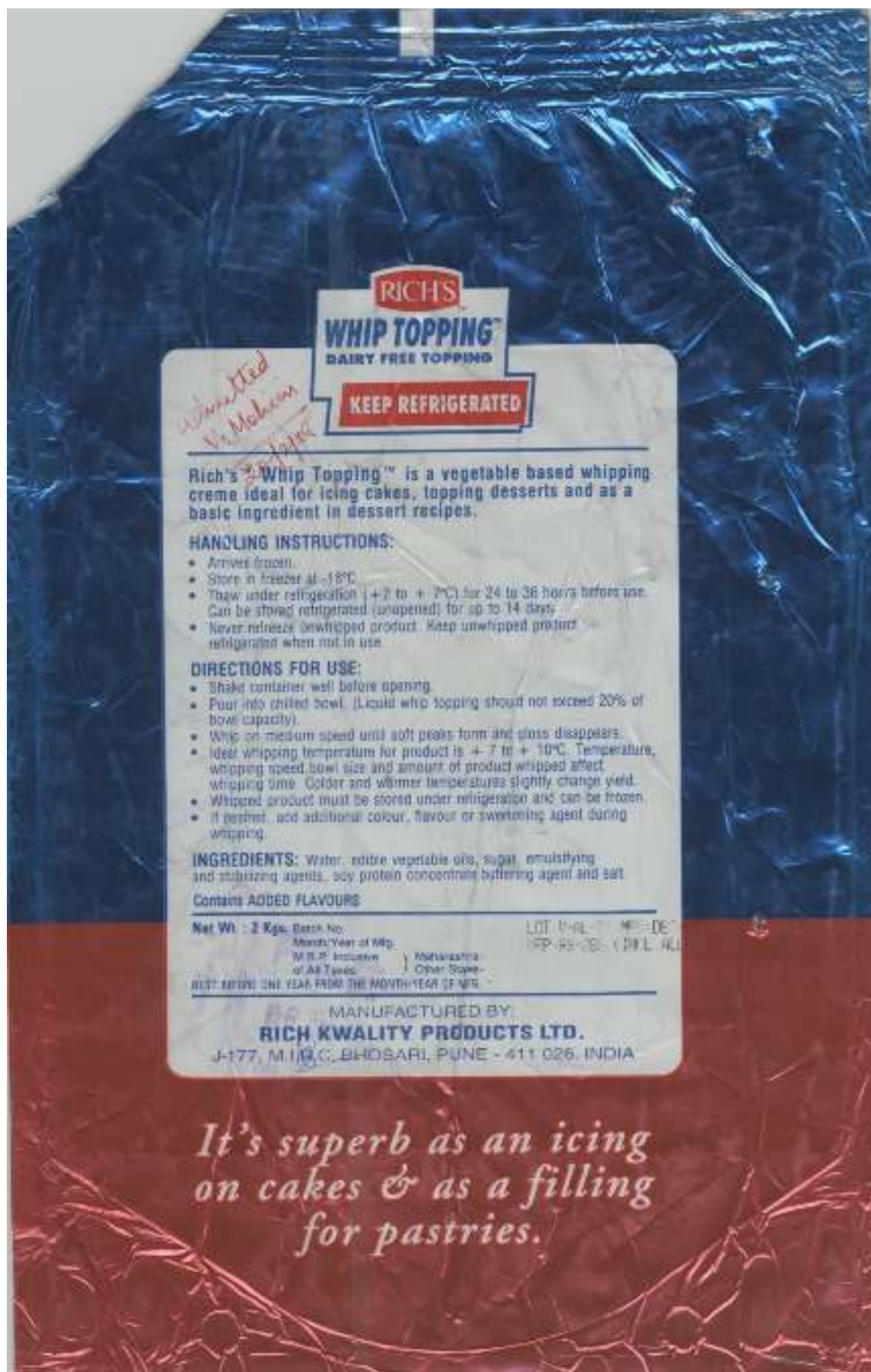
Front Side of Exhibit P – 1 (of the respondent)



Back Side of Exhibit P – 1 (of the respondent)



Front Side of Exhibit P – 2 (of the appellant)



Back Side of Exhibit P – 2 (of the appellant)

If the aforesaid two packagings are analysed, it would be seen that there is no similarity in the colour scheme except that both have different hues of combination of blue, red and white colours. The packaging of the appellants, in fact, uses more pinkish colour in half of its packaging, while the packaging of the respondent uses red colour throughout with a dark blue colour. The word 'BELLS' is very prominent as also the distinctive large cake reproduced on the packaging.

10. We have also compared the instructions at the back on which a lot of emphasis was laid by learned counsel for the appellants. It cannot be lost sight of that there are a limited nature of directions for use, which can be given in respect of such non-dairy whip topping and, thus, the directions cannot be different. They are certainly not copied verbatim nor is the presentation identical. In fact, if one examines the plea of learned counsel for the appellants in the context that all these aspects should be taken together to show the dishonest intention of the respondent, the conclusion actually reached is quite the contrary.
11. We are, thus, in complete agreement with the view of the learned Single Judge contained in paras 39.1 and 40 that there is not even the slightest attempt to deceive by the respondent and that the appellants have, in fact, failed to

show any copyright in the handling instructions / directions for use.

12. Once a conclusion is reached that there is no exclusive right of the appellants in the word mark 'WHIP TOPPING', but only in 'RICH'S WHIP TOPPING' and the use by the respondent of 'BELLS Whip Topping' is distinctive enough, the natural corollary is that Issue No. 1 has to be answered against the appellants. There is nothing to show that the word mark 'WHIP TOPPING' separately has acquired any secondary distinctive meaning and has trans-border reputation. In fact, the learned Single Judge has rightly noticed that the appellants themselves have accepted the limitation both in USA and New Zealand with respect to the exclusive right to use the word 'TOPPING' and 'WHIP TOPPING' which form a part of the registered trademark 'RICH'S WHIP TOPPING'. In India, the appellants have even accepted the disclaimer in respect of the letter 'S' and the word "TOPPING". There is no deception arising from any similarity of the packaging and / or trade-dress and instructions. The word, 'WHIP TOPPING' is both '*generic*' and '*descriptive*' and cannot be exclusively appropriated as a trademark.
13. We find that the judgment of the learned Single Judge is well-reasoned and unexceptionable both on the legal pleas discussed as well as the analysis of the evidence.

14. The appeal being meritless is dismissed with costs.

SANJAY KISHAN KAUL, J.

September 20, 2010
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VALMIKI J. MEHTA, J.