

* IN THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Reserved On: 12th October, 2011
Judgment Delivered On: 17th October, 2011

+ FAO(OS) 109/2011

BHOLE BABA MILK FOOD INDUSTRIES LTD....Appellant
Through: Mr.Mohan Vidhani, Mr.Rahul
Vidhani & Mr.Mihir Malhotra,
Advocates.

versus

PARUL FOOD SPECIALITIES PVT. LTD. Respondent
Through: Mr.Sandeep Sethi, Senior
Advocate with Mr.H.P.Singh,
Mr.Navroop Singh &
Mr.S.P.Kaushal, Advocates.

CORAM:
HON'BLE MR. JUSTICE PRADEEP NANDRAJOG
HON'BLE MR. JUSTICE SUNIL GAUR

1. Whether the Reporters of local papers may be allowed to see the judgment?
2. To be referred to Reporter or not?
3. Whether the judgment should be reported in the Digest?

PRADEEP NANDRAJOG, J.

1. Vide impugned order dated 19.1.2011, while restraining the defendant/respondent from selling 'Ghee' using the trademark 'KRISHNA' but permitting sale with the label having words "PARUL'S" and 'LORD' i.e. to read "PARUL'S LORD KRISHNA"; all 3 words having same font and prominence and not that the words "PARUL'S" and 'LORD' having a font so small that only the word 'KRISHNA' catches (the eye due to its prominence), application filed by the

appellant/plaintiff for interim injunction pending disposal of the suit has been disposed of by the learned Single Judge.

2. The appellant asserts that it has been in the business of manufacture and sale of ghee, milk and milk products since the year 1992 and sales have risen from ₹47.29 crores in the year 1997-1998 to ₹374.44 crores in the year 2008-2009. Appellant asserts that it has obtained registration of the label mark 'KRISHNA' having pictorial reflection of Lord Krishna standing on a lotus flower for dairy products falling in Class-29 of the Trade Mark Act. It is the further claim of the appellant that it is the registered proprietor of the word 'KRISHNA' written in a unique distinctive style where the serif of the letter 'K' extends beneath the letters 'RISHNA' in a curved manner and just after the letter 'A' takes a loop in the reverse above the word 'KRISHNA' and as the loop crosses the letter 'K' it curves down and ends at the letter 'K' i.e. the pictorial representation is the word 'KRISHNA' being encapsuled within a bean.

3. With reference to its sale figures, it is the case of the appellant that the word 'KRISHNA' has acquired a distinct secondary meaning in relation to the milk product sold by it and thus appellant alleges an infrangible proprietary interest in the word 'KRISHNA'.

4. The defendant/respondent asserted that the word 'KRISHNA' is a common word and is the name of a Hindu God who is associated with butter, milk and ghee and thus assert that the appellant cannot claim any exclusivity in the said word. That the word 'KRISHNA' has acquired secondary distinctiveness vis-à-vis the goods manufactured and sold by the plaintiff/appellant has been negated. Alternatively it is the case of the defendant that it is using the word

'KRISHNA' with 2 words prefixing the word 'KRISHNA' being the words 'PARUL'S' and 'LORD'.

5. For the purposes of an interim injunction pending trial, the learned Single Judge has posed 3 questions, for purposes of taking a prima facie view, being: (a) Whether the trademark of the plaintiff has achieved secondary distinctiveness of a kind which immediately brings to mind the appellant's product? (b) Whether the plaintiff could monopolise a name ascribed to deity 'KRISHNA'? And (c) Whether a registration of a trademark obtained by a person could be a subject matter of consideration in an action for infringement of the trademark pending application filed before the Registrar of Trademarks for cancellation thereof.

6. With regard of issue (c), the learned Single Judge has held in favour of the defendant/respondent and we do not discuss said issue as during arguments in the appeal said aspect was not touched upon by learned counsel for the appellant.

7. With regard to issue (a), the learned Single Judge noted that in order to arrive at a conclusion whether or not a mark has achieved secondary distinctiveness of a kind which immediately brings to mind the product of the proprietor of the mark, prima facie evidence has to be brought wherefrom a view could be taken that the mark in question reminds the consumer of the origin of the goods, which would encompass material to prima facie opine of the sufficiency of the distinctive secondary character acquired by the mark.

8. The learned Single Judge, in para 14.4 of the impugned order, has noted that several manufacturers of identical goods have been using the word 'KRISHNA' as a part of their

trademark and thus has opined that plaintiff's claim for distinctiveness and hence monopoly was prima facie not quite accurate.

9. The learned Single Judge has considered the decisions cited where a common word was held as acquiring secondary distinctiveness, and has rightly held that whether a common word had acquired secondary distinctiveness is primarily a question of fact.

10. With reference to the name of a deity, the learned Single Judge has held that law would lean against a deity's name being monopolized to the exclusion of the others.

11. Challenging the said opinion, prima facie found, learned counsel for the appellant urged that the rising sale figures of the plaintiff was determinative of the secondary distinctive meaning acquired by the trademark in question in relation to the goods in question.

12. We are in agreement with the view taken by the learned Single Judge not only for the reasons given by the learned Single Judge but the additional reason, as in the instant case, a deity may be associated with a particular kind of goods. It is common knowledge that Lord Krishna, as a child, was known for his love of milk and butter and thus Lord Krishna is closely linked with milk and butter and this would certainly dilute a proprietary claim projected by any person, in relation to Krishna with dairy products.

13. In a vast country like India where the population exceeds 120 crore citizens, a sales figure of ₹300 crores per annum would translate to less than ₹3/- per head per annum. Not to be misunderstood that we are laying down an empirical formula to be applied mathematically, with reference to said illustration, we only wish to highlight that

the volume of sale has to be considered with reference to the spectrum of consumers. For example, a product used by only a few would require issue of distinctiveness to be considered with reference to the sales keeping in view the market span. It is the span of the market which determines the secondary distinctive character acquired by a mark in the field in question.

14. Just as the word 'LOW ABSORB', an expression relating to the character of the product, i.e. edible oil was held not entitling the person to an exclusive use who first used the said words, in the decision reported as 174 (2010) DLT 279 Marico Ltd. vs. Agro Tech Ltd., the adoption of the name of a deity who is associated with a particular trait relating to goods, in the instant case Lord Krishna having a trait which has an association with milk and butter, would stand on the same low footing for protection as would be purely descriptive expressions pertaining to the subject product.

15. On the second question, the learned Single Judge has referred to various decisions guiding as to when words or part-words prefixing or suffixing a word in dispute would be relevant on the subject of a monopoly to a word of common origin.

16. The word 'KRISHNA' was being used by the defendant with the words 'PARUL'S LORD' preceding the word 'KRISHNA'.

17. The learned Single Judge has rightly noted that the small font of the words 'PARUL'S LORD' with prominence to the word 'KRISHNA' would disentitle the defendant to so sell its product and thus has rightly directed the defendant to print the words 'PARUL'S LORD' with the same prominence as the word 'KRISHNA'. It has been correctly opined that

dairy product sold under the mark 'KRISHNA' would not be confused qua the source if the same product is sold under the mark "PARUL'S LORD KRISHNA".

18. Since the stage is of forming a prima facie view, we refrain from delving deep into the matter as evidence has yet to be led, but would simply highlight that the registration obtained by the appellant is not per-se to the word 'KRISHNA' but is to the word 'KRISHNA' written in a distinctive form : akin to a label. The distinctiveness in which the word 'KRISHNA' is written by the appellant is as noted by us in para 2 above.

19. The distinctiveness to which the appellant can lay a claim is to what it has got registered as a whole and such registration cannot possibly give an exclusive statutory right to the appellant qua a particular word of common origin. The ratio of law in the decision reported as AIR 1955 SC 558 The Registrar of Trade Marks vs. Ashok Chandra Rakhit Ltd. is squarely attracted.

20. Before terminating our decision, we would note the law governing Appellate Jurisdiction pertaining to interlocutory orders where a learned Single Judge has exercised a discretionary power. In the decision reported as 1990 (2) ALR 399 Wander Ltd. & Anr. vs. Antox India Pvt. Ltd., the Supreme Court laid down the contours of Appellate Jurisdiction in the following words:-

“.....the appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion by the Court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised either arbitrarily, or capriciously or perversely or where the Court

has ignored the settled principles of law regulating grant or refusal of interlocutory injunction. An appeal against exercise of discretion is said to be an appeal on principle."
(emphasis supplied)

21. Since we are agreeing with the view taken by the learned Single Judge, we have reflected as above in a brief manner, lest parties are prejudiced at the trial and needless to state observations made by us herein above are tentative and limited to what we need to observe and note at the stage of interim relief. The final decision, post trial, would obviously be with reference to the evidence led.

22. However, one direction needs to be issued. Which we do.

23. The respondent would maintain an account of the sales affected by it and would file the same if required to be filed before the Court by the learned Single Judge.

24. Subject to the direction issued in para 22 above, the appeal is dismissed.

25. No costs.

(PRADEEP NANDRAJOG)
JUDGE

(SUNIL GAUR)
JUDGE

OCTOBER 17, 2011
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