

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

% *Judgment reserved on: 11th September, 2014*
Judgment pronounced on: 31st October, 2014

+ **CS(OS) No.1829/2014**

RECKITT BENCKISER (INDIA) LTD & ANR. ...Plaintiffs
Through Mr. C.M.Lall, Adv. with Ms.
Nancy Roy, Adv

versus

DABUR INDIA LTD. ...Defendant
Through Mr. Sudhir Kumar Makkar &
Ms.Meenakshi Singh, Advs.

CORAM:
HON'BLE MR.JUSTICE MANMOHAN SINGH

MANMOHAN SINGH, J.

1. By this order I propose to decide the application filed by the plaintiffs bearing I.A. No.11442/2014 under Order 39 Rules 1 and 2 CPC in a suit for permanent injunction and damages for trademark and copyright infringement, passing off and unfair trade practices.

2. Brief facts as per the plaint are that the plaintiffs are members of the Reckitt Benckiser Group PLC which is stated to be an internationally renowned corporation that operates in many countries around the world through its subsidiaries. The plaintiffs are into the business of various consumer and healthcare products including antiseptic liquid, toilet care products, surface

care products, pharmaceuticals, insecticides and food products which bear famous trademarks including Strepsils, Gaviscon, Clearasil, Mortein, Dettol, Harpic, Vanish, Durex and Cherry Blossom.

3. It is stated that Reckitt Benckiser is the owner and manufacturer of the globally acclaimed and well known non-prescription drug for heartburn and gastro-oesophageal reflux disease in many countries, traded under the brand GAVISCON. The history of GAVISCON dates back to the year 1960 and in a span of over four decades, as per the plaintiffs, GAVISCON became a household name and the most preferred medicine for patients suffering from heartburn and gastro-oesophageal reflux diseases, this being the medicine of its first kind available in various countries to treat the said medical condition. The plaintiffs marketed and sold GAVISCON in the global markets including United Kingdom, Ireland, Benelux, France, Germany, Spain, Italy, Poland, Austria, Switzerland, etc.

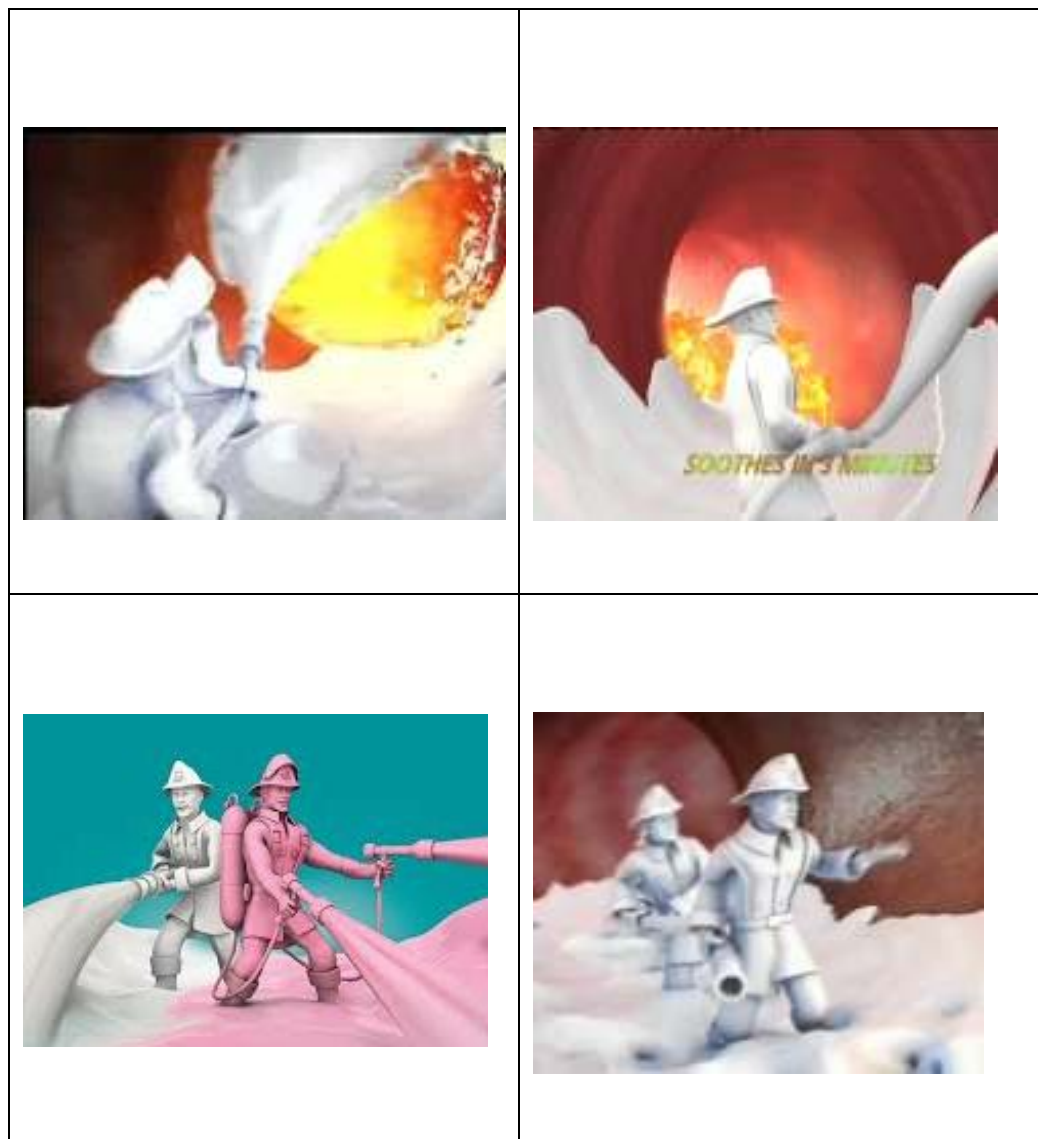
4. It has been stated that the antacid and anti-reflux action of GAVISCON inspired the plaintiffs' Group to conceptualize the unique and original script based on fire-fighting for the advertisement and marketing. In the year 2006 the plaintiffs devised, adopted and commenced the use of FIREMAN DEVICE in the advertisement to market their said product GAVISCON. It is averred that owing to its popularity and distinctiveness, the

plaintiffs are extensively using the FIREMAN DEVICE which has now become synonymous with GAVISCON.

5. The original fire-fighting script and FIREMAN DEVICE which are primarily and prominently the base theme of each and every advertisement or commercial relating to the plaintiffs' product GAVISCON, are the integral part of the GAVISCON trade dress and advertisement, promotional and marketing strategies relating to plaintiffs' highly preferred medicine. Plaintiffs are the owner of the copyright in the said advertisement.

6. It is stated that the plaintiffs use the unique fire-fighting concept and the fireman device uniformly and extensively across global markets. Also, the terms "fire-fighting" and "fireman" are suggestive of the plaintiffs' product GAVISCON. The FIREMAN DEVICE is depicted and is used in the course of trade, marketing, promotion and advertisement by the plaintiffs in various manners including inter alia the following:





7. The storyboard of plaintiffs' conceptualized script is that the fire-fighters, which are replicas of the FIREMAN DEVICE, are treating the heartburn and other gastro-oesophageal reflux diseases by sprinkling GAVISCON on the oesophagus and the stomach walls. This script was conceptualized to depict the effect and working of GAVISCON once it is consumed by the consumer.

8. The plaintiffs also advertise and promote its product GAVISCON on its websites such as www.gaviscon.com, www.gaviscon.co.uk, www.gaviscon.co.au, www.gaviscon.ca etc. that are active and accessible throughout the world including India. It has been stated that a general online image search on Google for the terms “GAVISCON” and “FIREMAN” reveals various images of the plaintiffs’ conceptual advertisement and the FIREMAN DEVICE.

9. The plaintiffs have procured/applied for registration of the FIREMAN DEVICE as a trademark in various jurisdictions. The said FIREMAN DEVICE was registered in India in favour of the plaintiffs on 22nd October, 2007 in Class 5 bearing registration No. 1613551.

10. The defendant who is manufacturing various Ayurvedic and non-prescription medicines which includes inter alia Pudín Hara, Honitus, Hajmola, Glucose-D etc. is alleged to be infringing the advertisement of the plaintiffs with its advertisement relating to Pudín Hara.

11. It is the case of the plaintiffs that in the second week of May, 2014, plaintiffs learnt about the defendant’s new product, Pudín Hara Fizz from a TV commercial. On enquiry it was revealed that the defendant launched the said product to enter the growing antacid market. The plaintiffs noticed that the defendant has ad-verbatim copied the plaintiffs’ original script and used virtually identical FIREMAN elements in their impugned advertisement. In

fact the defendants are using the term FIRE BRIGADE in their impugned advertisement.

12. It is contended that defendant with sheer dishonest intentions copied the original plot, script and concept of the plaintiffs' and reproduced the same with slavish and misleading changes.

- (i) The actor in both the advertisement scripts is shown to have discomfort and pain in the upper abdomen region, hinting to heartburn.
- (ii) The double action i.e. antacid and anti-reflux action of plaintiffs' product GAVISCON which is depicted by different coloured FIREMAN DEVICE is replaced by lemon slices and peppermint leaves in defendant's advertisement.
- (iii) Both the advertisements show fire burning inside the oesophagus and the consumed dose of the product is traversing through the oesophagus. The firemen are shown to emerge out of the consumed dose of the product with the fire nozzle and are shown sprinkling the product on the oesophageal walls.

13. It is the case for the plaintiffs that owing to long, extensive and continuous use of fire-fighting script by the plaintiffs for over 8 years, the consumers relate the fire-fighting action with antacid and anti-reflux effect of GAVISCON. The impugned advertisement is a slavish imitation of the plaintiffs' original fire-fighting script whereby the defendant is illegally riding upon the plaintiffs' immense reputation and goodwill.

14. Upon service, the defendant has filed the written statement, however no reply to the application I.A. No.11442/2014 has been filed. It has been submitted that the written statement be read as reply to the said application.

15. The case of the defendant as per the written statement is that the plaintiffs have not approached this Court with clean hands and have suppressed material facts, which if disclosed, would have completely non-suited the plaintiffs. The plaintiffs have deliberately not disclosed to this Court that the product of the defendant namely PUDIN HARA LEMON FIZZ is being marketed across India since March, 2010 whereas the product of the plaintiffs was introduced in the Indian market only in November, 2011. Furthermore, the plaintiffs falsely contended that the defendant has launched its product only in the second week of May, 2014, which is absolutely false and incorrect. The defendant has been selling its product Pudín Hara in Pearl and Liquid Syrup form, for over decades and the product in question namely Pudín Hara Lemon Fizz is being sold in Indian market since April, 2010. The defendant has an annual turnover of more than Rs.4 Crores in respect of the said product and the defendant has been spending considerable amount towards advertisement and promotion of the said product. It is thus inconceivable that the plaintiffs being a competitor were not aware of the existence of the product.

16. It is averred that the plaintiffs falsely contended that advertisement of the defendant is slavish imitation of the

advertisement of the plaintiffs by making oblique reference only to use of "fireman device" in the advertisement of the defendant's product. Firstly there is no similarity whatsoever in the two television commercials and thus there is no violation of the copyright of the plaintiffs in any manner. Secondly the plaintiffs cannot in law claim any exclusivity or copyright on the idea of a fireman. It is not unusual for the advertisement of an antacid to contain a reference to heartburn/ burning sensation in the stomach or a reference or depiction of oesophagus and the plaintiffs ought not to be allowed to claim any exclusivity in conveying such message.

17. It has been also averred that the plaintiffs deliberately have not disclosed anywhere in the plaint the date of introduction of its product in the Indian market, its annual turnover, its expenditure on the promotion of the said products etc. The plaintiffs have deliberately not disclosed that its product was launched for the first time in November 2011 only in Southern market and the said product was introduced in the remaining market in India in December, 2013.

18. It has been further averred that the plaintiffs have deliberately not disclosed its revenue figures by stating that they shall produced the same when they are required to be produced before the Court. Similar is the situation with regard to the details of marketing, advertisement, promotion expenditure. Had the plaintiffs disclosed these details, the same would have obviously indicated that the plaintiffs are a new entrant in the Indian market

and as a matter of fact the market share of the plaintiffs for the product in question is 0.21%. As such there is no conceivable reason for the defendant or anybody else to copy the advertisement concept of the plaintiffs, as is sought to be alleged.

19. It has been stated that the product Pudín Hara Lemon Fizz is a variant of Pudín Hara, which has been manufactured by defendant for the last many decades. Pudín Hara is the most trusted brand in India in the space of stomach care and is ranked 16th in the top 20 OTC brands in India by Economics Times Brand equity survey for many years while Gaviscon is nowhere in the in the list. Pudín Hara enjoys more than 80% of brand recall whereas Gaviscon is fairly new brand launched in India. Pudín Hara is the 4th largest player in India in the space of stomach care/acidity as per the data made available by M/s AC Nielsen.

20. Further, there is no similarity between the advertisement campaign of the plaintiffs' product and the product of the defendant. Showing discomfort in upper abdomen hinting heart burn is common to advertisement of antacid products across the industry and the said concept has been used by defendant as well as various other competitors many time over in the print and TV commercial. In fact the script of Pudín Hara Lemon Fizz is nowhere similar to Gaviscon as it is communicating cooling relief, which is the core theme of the brand's communication. Pudín Hara Lemon Fizz Commercial has used "Pet Ka Fire Brigade" as a device and not the fireman. The TV commercial of the defendant uses fire spitting as a strong device to highlight problem and fire

brigade to show the cooling relief provided by the product. The goodness of natural ingredients like lemon and mint is a natural fit with the mother brand, namely Pudín Hara. Also to convey the ingredient story lime, mint and other ingredients are changing into Pudín Hara Man inside the stomach unlike Gaviscon where fireman is entering from mouth. Furthermore, there is no similarity in the firemen used by the defendant with the device of fireman used by the plaintiffs and the defendant has used the brand colour which is green and very much synonymous to Pudín Hara.

21. The suit of the plaintiffs is tainted with malafides and only the purpose of filing the suit and application is to scuttle and truncate fair competition. The product of the defendant already has its market presence and the plaintiffs deliberately feigned ignorance about the same whereas the product of the plaintiffs has recently been introduced in the Indian market which fact the plaintiffs have conveniently omitted to mention. The suit merits dismissal on this ground alone.

22. There is no similarity whatsoever in the Fireman device used by the plaintiffs and the firemen depicted by the defendant in the impugned advertisement. Further there is no similarity between the story board/ script of the advertisement of the plaintiffs' product and the defendant's product. The story board for the advertisement of the product of the defendant is quite distinctive and any perceived similarity between the story boards of the two commercials is absolutely misconceived.

23. The suit of the plaintiffs does not disclose any valid cause of action and there is no infringement of the trademark and copyright of the plaintiffs nor is any cause of action existent in favour of the plaintiffs for the case of passing off. In so far as the infringement of trademark of the plaintiffs is concerned there is no infringement whatsoever. It is not the case of the plaintiffs that the defendant has used the trademark of the plaintiffs on its product. In so far as the depiction of fireman in the advertisement is concerned, there is no similarity of the fireman depicted in the advertisement of the defendant to the registered device mark of the plaintiffs. Even otherwise the appearance of the firemen is only a fleeting glance and a miniscule part of the entire advertisement. The plaintiffs have tried to project a cause of action on the basis of some perceived similarity, where none exists. The plaintiffs have no lawful right to claim any exclusivity on the very concept of fireman. In so far as the claim of passing off is concerned, no case is made out that any person of ordinary prudence, is likely to perceive after watching the impugned television commercial that the product of the defendant has any relation to or nexus with the plaintiffs or its product. Nor can it be argued by stretch of imagination that the impugned commercial is likely to cause any deception qua the product of the plaintiffs.

24. The plaintiffs have falsely contended in the plaint that the defendant has copied the original plot, script and concept of the plaintiffs and reproduced the same with misleading changes. A perusal of the two advertisements would clearly demonstrate the

falsity of in the contention raised by the plaintiffs as there is no similarity in the two advertisements and the plaintiffs is indulging in hair splitting to legitimize its otherwise contention which is bereft of any merit or substance.

25. When the matter came up for hearing before this Court, Mr. Chander Lall, learned counsel appeared on behalf of the plaintiffs and Mr. Sudhir Makkar, learned counsel appeared on behalf of the defendant. Both the counsel made various submissions.

26. Mr. Lall, learned counsel for the plaintiffs has made his submissions in support of the application which can be outlined in the following manner:

- a) Firstly, Mr. Lall argued that the product namely Gaviscon is immensely popular in the course of the trade and enjoys high level of the distinctiveness with the products of the plaintiffs. It has been argued that the plaintiffs conceived the script of the advertisement wherein the FIREMANS device is being used which sprinkles the medicine all across the heartburn which has been identically copied by the defendant. It has been argued that the with the popularity of the Gaviscon trade mark which as per Mr. Lall is one of the popular medicines for gastro-oesophageal reflux, the distinctive character of the device of the fireman has also grown manifold. It has been argued that the said device of Fireman as depicted in the plaint performs the function of the trade mark under the provisions of Section 2 (1) (m) of the Trade Marks Act (hereinafter referred to as “the Act”) and as such is required

to be protected thereunder. In order to demonstrate the distinctiveness of the Fireman's device, Mr. Lall has relied upon the documents filed with the plaint along with certain Google hits wherein search of FIREMAN along with GAVISCON produces desired results. It has been argued that the device of fireman is also registered with the plaintiffs in many countries including in India bearing registration No. 1613551. Thus, the use of the distinctive registered trade mark which is FIREMAN's device deceptively similar to that of the plaintiffs' by the defendant amounts to infringement of the plaintiffs' registered trade mark comprised in the fireman's device.

- b) Secondly, it has been argued by Mr. Lall that the use of the device of fireman along with the defendant's product, Pudina Hara Lemon Fizz, which is also a medicine meant for gastric disorders, the defendant is encashing the goodwill and reputation of the plaintiffs and thus causing confusion and deception in the market leading to passing off.
- c) Thirdly, Mr. Lall, argued that the device of the defendant in the instant case is deceptively similar to the device of FIREMAN of the plaintiffs'. It is argued by Mr. Lall, the marks can be deceptively similar to each other if they are likely to cause confusion and deception in the course of trade and amongst the public. It is thus argued that the defendant's plea that the representation of the device of the defendant is different from the plaintiffs' is no answer in law and is

untenable defence till the time, the mark conveys the same idea. Mr. Lall, in order to support the plea of the mark conveying the same idea relied upon the judgment passed in the case of ***National Sewing Thread Co. Ltd v. James Chadwick and Bros Ltd*** AIR 1953 SC 357 to state that till the time mark conveys the same idea, the representation of the mark is inconsequential if it good enough to confuse the public.

- d) Fourthly, Mr. Lall, argued that the defendant by using the advertisement which is similar to that of the plaintiffs' containing the device of FIREMAN sprinkling the medicine on heartburn to convey the extinguishing of fire arising out of heartburn is infringing the plaintiffs' copyright in the said advertisement which as per the learned counsel for the plaintiffs is the original expression of the idea and as such required to be protected under the laws of the copyright. As per Mr. Lall, the defendant's are therefore liable for the colourable imitation of the plaintiffs' work in the form of the copyright infringement.

27. In view of the aforementioned submissions advanced by the learned counsel for the plaintiffs, it has been prayed that this Court should proceed to allow IA No.11442/2014 in terms of the prayers made therein.

28. Per contra, Mr. Makkar, learned counsel for the defendant has made his submissions denying all allegations made in the plaint and relied upon the averments made in the written

statement. He argued that the plaintiffs have failed to make out any case of infringement of trademark, copyright or passing off. He submitted that the device used by the defendant is common in trade, it is a non distinctive character, generic device which has a direct reference to the character and quality of goods involved in the present. The said device is neither being used by the defendant on its products and packaging material nor the defendant has any such intention, it is being used in the television advertisement only. There is no deception under these circumstances.

29. I have gone through the plaint, written statement and the documents filed by the respective parties. I have also considered the submissions advanced by the learned counsel for the parties at the bar. I shall now proceed to discuss the various aspects which fall for consideration in view of the submissions advanced by the learned counsel for the parties and the facts in hand.

Infringement of the Device Mark

30. Firstly, it is noteworthy to clarify that the plaintiffs assert the registration of the representation of fireman standing in a posture which is represented below as registration No.1613551 in India to state that the said representation is of the FIREMAN, which is a character or caricature used by the plaintiffs in their advertisement campaign and in some cases along with the product and thus the use of deceptively similar fireman by the defendant leads to infringement of the plaintiffs' registered trade mark. In order to minutely understand the cause of action relating to infringement, it

is deemed expedient to first have a look at the registration of the mark in favour of the plaintiffs as granted and represented in the certificate. The said registration bearing No.1613551 is represented as under:



31. From the bare perusal of the representation of the device mark registered in the favour of the plaintiffs, it can be seen that the registration of the mark is confined to the device of a man represented in white/ grey colour standing in the posture wearing hat. The plaintiffs by placing reliance on the said registration allege that the defendant by using the following representation as one of the part of the advertisement campaign infringes the plaintiffs' registration No.1613551. The defendant's fire extinguishing man's devices which are used by them in the advertisement are represented as :



32. It needs no reiteration as a principle of law that the infringement is the remedy provided out of the rights granted by the registration under the provisions of Section 28 of the Act. Thus, for the purposes of the infringement of the registered trade mark, one has to compare the mark which is forming the subject matter of registration vis-a-vis the mark used by the plaintiffs which is found to be objectionable by the plaintiffs. This distinction is essential in as much as the plaintiffs in the present case have sought to argue that there exists similarity between the plaintiffs' FIREMAN and defendant's fireman by showing the advertisements of the two competing parties and in addition relied upon the registration to contend the infringement. I think therefore, it is first essential to understand the scope of the infringement of

trade marks in the present case which is the comparison between the device of the man standing in posture wearing hat in grey or white colour as registered and granted to the plaintiffs with that of the clipping in advertisement where two/three firemen with different colours are extinguishing fire as reproduced above. By doing the comparison between the two, one has to really pose the question, whether the representation of the device in the manner done by the defendant in its advertisement amounts to an infringement of the registration No.1613551. If the answer comes in affirmative, then infringement is established and otherwise not. It may be altogether different matter that the plaintiffs have distinct case of passing off relating to overall comparison of the advertisement and the representations of the FIREMEN of the plaintiffs advertisement with that of the defendant's advertisement and leading some sort of the misrepresentation, which shall be tested in the latter part of this judgment. However, at the moment, the Court is concerned with the aspect of the infringement as sought to be asserted and argued by the plaintiffs on the strength of the registration No.1613551 and thus it would be improper to confuse between the comparison of the registered mark with that of offending misuse as against the comparison between the two advertisements of the parties and mix up the two in order to form any view on the aspect of the infringement.

33. The plea of the plaintiffs that the said devices are deceptively similar to the registered trade mark does not support the case of the plaintiffs so far as the allegation of the

infringement is concerned. This is due to the reason that even though this Court is of the view that the two devices from the bare perusal of them are apparently different wherein one is represented in standing posture with a particular dressing and another one which is of the defendant is used as character in the defendant's advertisement performing certain activity of fire extinguishing, still if the Court assumes that the marks are deceptively similar for the sake of the enquiry of the infringement, then Court has to measure the likelihood of the confusion and deception in the course of the trade or to the public on the basis of tests for the rule of comparison between the two marks as applicable in law of passing off as per the well settled law.

34. It has been observed by the Supreme court in the case reported as 1969 (2) SCC 727 ***Ruston & Hornsby Ltd. Vs. The Zamindara Engineering Co.*** that different questions arise for consideration in an action for infringement of a trademark and an action for passing off but the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions. In para 7 thereof, it was observed that **in an action for infringement where the defendant's trademark is identical with the plaintiff's mark, the Court will not inquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the register, but something similar to it, the test of infringement**

is the same as in an action for passing off.

(Emphasis Supplied).

35. From the reading of the aforementioned proposition of law laid down in the case of ***Rustom*** (supra) by the Supreme Court it is clear that in the cases where the mark of the plaintiffs' and defendant's are identical, the Court will not enquire anything further. However, in the cases where the marks are alleged to be deceptively similar to each other, the tests for enquiry as to confusion and deception in the cases of infringement are same as that of the passing off.

36. For understanding the difference in the considerations which fall in the cases of infringement and passing off respectively, the observations of the Supreme Court in the case of ***Kaviraj Pandit Durga Dutt Sharma Vs. Navratna Pharmaceutical Laboratories*** AIR 1965 SC 980 are instructive wherein the Supreme Court has observed thus:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in

favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. **While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement.** No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two

ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

(Emphasis supplied)

37. From the reading of the illuminating observations of the Supreme Court in the case of ***Pandit Durga Dutt*** (supra), it can be said that the Supreme Court has taken the consistent view that where the marks in the cases of infringement are identical or case of imitation, the Court will not go any further question and difference in the get up, representation is inconsequential which may otherwise be relevant in the enquiry as to confusion and deception in passing off action.

38. The combined effect of the reading of the observations made by the Supreme Court in ***Durga Dutt*** (supra) and ***Rustom***

(Supra), is that in the cases like the present one, where the mark is alleged to be similar to that of the plaintiff's registered mark, one has to really proceed with the tests for enquiring confusion and deception as applicable to the law of passing off which shall be afortiori be applicable to infringement. Thus, the overall comparison between the two marks, difference in the colour scheme, representation, get up and overall features which might have no role to play in the case of identical marks may be relevant for the inference to be drawn as to confusion and deception in the infringement. This principle of coinciding the test of infringement and passing off cases relating to confusion and deception enquiry by the combined effect of **Durga Dutt's** case and **Rustom's** case has been approved by the Courts from time to time in India including the case of **Allied Blenders and Distillers P. Ltd. Vs. Paul P. John and Ors.**, 2008 (38) PTC 568 (Del) decided by the Division Bench of this Court.

39. Let me now evaluate by comparing the two representations as a whole in order to find out whether there can exists any likelihood of confusion and deception.

40. It is to be again noted that the comparison is between the mark which is posture of standing man wearing hat with that of the clipping in the advertisement of the defendant. The marks under comparison shall remain the same which has been done above as the inquiry is still of an infringement only but only certain considerations like difference in get up, colour scheme and added

on matter would become relevant in order to see whether there exists likelihood of confusion and deception.

41. Even if one compares the representation of the registered mark vis-a-vis the defendant's representation, prima facie, I find that there exists less of similarities between the two marks and more of the differences which outweigh the similarities. There is only man standing in posture forming subject matter of the registration, where as the defendant's representation depicts two/three men standing opposite to each other sprinkling liquid at the opposite side. The colour of the representation of the man in the plaintiffs' case is of white colour where as the defendant's two/three men are represented in the green colour and are shown in the form of shadow. The posture of the FIREMAN of the plaintiffs' is also different from that of the posture of the defendants advertisement. In the defendant's representation, the two/three men are performing the acts of the extinguishing fire wherein the plaintiffs' fireman under the registration is standing in stationary form. The colour scheme and background of the orange colour representing fire in the defendant's case make the representation of the entire scene different from that of the plaintiffs' device. This all can be seen from prima facie view of the two representation and the prima facie view can be formed on that basis. Thus, even if one has to proceed on the premises of the passing off for the purposes of the comparing the two marks one being forming the subject matter of the registration and another being misused by the defendant, still I prima facie find that there

exists no likelihood of confusion and deception between the plaintiffs' registered mark which is a representation of the man standing in posture wearing hat with that of the defendant's representation of the firemen in the clippings of the advertisement as the add-on matters on the representation of the defendant's clipping are good enough to infer the same.

42. On fair comparison, the device of the man represented in the posture with a hat device vis-a-vis the device of the two firemen performing the activity of the extinguishing fire which is the clipping from the advertisement of the defendant, it is difficult to prima facie state that there exists any kind of similarity between the two devices even conceptually and structurally. This is due to the reason as what forms the subject matter of the registration is the representation of the device of man simpliciter standing in posture wearing hat and not the firemen performing some extinguishing activities. Thus, the corresponding clipping if used on television advertisement where even the representation of the two/three men is not even visible but the said men or characters are performing fire extinguishing activity are prima facie apparently distinctively represented if one merely compares them with the representation forming subject matter of the registration. Thus, it is difficult to hold at this stage that it amounts to infringement if it is used on television advertisement.

43. The above discussion answers the aspect of infringement so far as it is provided under the provisions of Section 29 (1) to Section 29 (3) of the Act. In the instant case, as I have prima facie

found that the marks are apparently different in representation in view of my discussion, therefore, the question of the taking advantage over the registered device's goodwill does not arise and nor the same would be an infringement by way of the advertisement as provided in Section 29 (4), Section 29(7) and Section 29 (8) respectively. This is due to the reason that the device mark which is registered is distinctly represented than what has been shown in the advertisement by the defendant. More detailed enquiry is done under the next head of passing off which evaluates as to whether the defendant could be said to be taking advantage over the goodwill of the plaintiffs' or not which is the similar question to be answered in terms of Section 29 (4), (7) and (8) of the Act though according to me, the bounds of infringement in present case are confined due to difference in the representation but one can consider the aspect of the goodwill and reputation of the plaintiffs being overlapping with that of the claim of passing off and refer the same for better comprehension.

Passing off

44. The plaintiffs have claimed the rights in common law relating to fireman device which as per the plaintiffs have been conceived in the year 2006. It has been further contended in the plaint that the plaintiffs have also prepared the advertisement for its medicine based on the fire fighting of the heartburn which represents the fireman device extinguishing fire by sprinkling GAVISCON on the oesophagus and the stomach walls. The

fireman's device as contained in the advertisement of the plaintiffs in different postures is represented as under :





45. In addition, the plaintiffs have asserted the distinctiveness in the fireman's device and argued that the plaintiffs' advertisement containing the script represents the said fireman's device which acts as a trade mark and extinguishes the fire in the form of heartburn in the advertisement. The plaintiffs have alleged that the defendant has also prepared the advertisement for its product PUDIN HARA LEMON FIZZ containing the similar firemen extinguishing the fire and as per the plaintiffs', the defendants are copying the advertisement verbatim and causing misrepresentation and taking advantage of the goodwill and reputation attached to the plaintiffs' advertisement as well as on the distinctiveness attached to the FIREMAN'S device owned by the plaintiffs.

46. The plaintiffs have compared its advertisement with that of the defendant by putting the clippings side by side in the following manner:

Plaintiffs' advertisement	Defendant's advertisement
	
	
	

47. By citing the clippings, it has been contended that the defendants are riding over the goodwill and reputation attached to the device of FIREMAN. It has been argued that the defendant has also copied the fire fighting script of the advertisement and as such attempting to gain market share on the strength of the popularity of the GAVISCON medicine and advertisement campaign of fire fighting of the heartburn and thus causing passing off by taking advantage of the goodwill and reputation of the plaintiffs' and causing the damage to the plaintiffs.

48. It is again clarified at this stage that the passing off claim in the present case is broader as it is not confined to any particular registration representing the mark but is based on the overall comparison of the different postures of the fireman's device and the competing advertisements prepared by the plaintiffs and defendant and resultant damage to the goodwill and reputation as claimed by the plaintiffs.

49. I have considered the case of the plaintiffs from both the angles either by comparing the fireman's device with that of the representation of the two/three men extinguishing fire in the defendant's advertisement and/or the comparison of the two advertisements and I am still of the view that prima facie it is difficult to conceive a case of passing off to be made out in the circumstances like the present one in view of my discussion hereinafter.

50. It would be relevant to indicate that the modern tort of passing off, as per Lord Diplock in ***Erven Warnink BV v. J. Townend & Sons (HULL) Ltd.*** (1979) 2 All ER 927 and as approved in ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Limited*** 2001 (5) SCC 73 and reiterated in ***Heinz Italia and Another v. Dabur India Limited*** 2007 (6) SCC 1, has five elements, i.e., (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trade (in the sense that this is a reasonably foreseeable consequence), and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

51. The said five factors laid down by Lord Diplock in the case of ***Erven Warnink*** (supra) is the extension of three main ingredients under the law of passing off in the traditional form which are :

- a) Existence of the goodwill
- b) Misrepresentation.
- c) Damage or likely to cause damage.

The said three ingredients are popularly known as the ***classical trinity*** in UK law and the 5 factors in ***Erven Warnink*** are known as passing off in the modern form. Be that as it may, the relevance of these factors in the present case is that the

satisfaction of all of them is essential in order to establish the tort of passing off.

Goodwill is one of the essence of the gist of the passing off action. The said goodwill in the present case can be evaluated by looking at the assertions made in the plaint relating to the distinctiveness attached to the FIREMAN'S device and the fire fighting campaign adopted by the plaintiffs alongside the documents filed therewith. This is essential as the plaintiffs' claim in the plaint that the said plot or theme is exclusive proprietary of the plaintiffs and the device of the FIREMAN is highly distinctive of the plaintiffs. The plaintiffs do not provide in the plaint the exact date as to when this advertisement related to fire fighting campaign was launched by it and in which country for the first time. Though the plaintiffs have stated in the plaint the fireman's device has been adopted in the year 2006.

52. The plaintiffs in order to support their claim for distinctiveness relies upon the fact that the advertisements of the plaintiffs have been put on internet and youtube which as per the plaintiffs is assessable in India. The plaintiffs though state that the said advertisements are available on youtube but the documents filed on record do not suggest any indication of Indians having accessibility to the theme or plot or for that matter fire fighting device at the relevant time. The plaintiffs further rely upon its popularity through its website namely www.gaviscon.com, www.gaviscon.co.uk and www.gaviscon.co.au and

www.gaviscon.ca. The plaintiffs also rely upon some Google hits to contend that while searching for the fire fighting along with GAVISCON or FIREMAN, the plaintiffs' product is depicted. The print outs of these websites are filed alongwith the plaint to suggest that there exists a trans-border reputation of the FIREMAN's device including in India. The plaintiffs rely upon a list of the advertisements wherein fire fighting device as per the plaintiffs have been used published in different jurisdictions in order to support its claim of the trans border reputation extending to India. The plaintiffs also rely upon the worldwide registration of the firemen device in order to claim distinctiveness. On the strength of the said documents, the plaintiffs' claim the exclusivity to the device of the FIREMAN and also the theme and plot of the firemen extinguishing the heartburn.

53. On the contrary, the defendant claims to be selling its popular medicine with the name PUDIN HARA LEMON FIZZ since the year 2010. It has been stated by the defendant that the plaintiffs have deliberately not disclosed the expenditure as to promotion of the advertisement of FIREMEN device in India. The plaintiffs have also not provided the details of the marketing, advertisement, promotional expenditure incurred in India. The defendant has thus in effect disputed the distinctiveness of the plaintiffs' FIREMEN device in India and also their promotional activities attributing knowledge to the public including the defendant giving reason to copy the plaintiffs' advertisement. It is

stated in the written statement that the plaintiffs are the new entrant in the market having launched their product in the year 2011 in South India and 2013 in rest of India and there is no reason for the defendant to copy the advertisement concept of the plaintiffs. The defendant also claimed its own goodwill by calling itself as 4th largest player in India in the space of stomach care product as the survey report of AC Nielson quoted by the defendant. The defendant claimed the turnover of Rs.4 crores in respect of the said product and thus claimed independent goodwill of its product.

54. After considering the material available on record, it can be seen that there exists fewer evidence on record at this stage to make out a strong prima facie case that the defendant in all probability was aware of the plaintiffs' fire fighting campaign along with the device of FIREMAN. Whatever material exists like webprints or list containing the advertisements published in various jurisdictions may make out a doubtful case as to spill over reputation of the plaintiffs' advertisement campaign in India. It is noteworthy to mention that none of the advertisement provided in the list filed by the plaintiffs was published in India. The case of spill over reputation as per the case of **Whirlpool v. N.R. Dongre**, AIR 1995 Delhi 300 has to be based on incontrovertible evidence which should establish a strong prima facie case of spill over reputation in India. Like in the whirlpool's case, there were journals and magazines like TIMES Magazine, Fortune Magazine,

Reader's digest having wide scale circulation in India. In the present case, even if it assumed that some kind of spill over reputation is there, it is yet to be determined as it is a disputed question of fact as to whether the distinctiveness of the fireman's device and the advertisement of the plaintiffs was of such a level so as to persuade the defendant to adopt the said device along with the advertisement in order to gain a commercial boost in the manner contended by the plaintiffs. This is essential due to the reason that the defendant claims to have launched the product namely PUDIN HARA LEMON FIZZ in the year 2010 prior to the entry of the plaintiffs in India and enjoys the annual turn over of its product of Rs. 4 crores. There is no replication on record traversing these pleas of the defendants as false as a matter of fact. Thus, the question of the distinctiveness or existence of the extent of the reputation of the plaintiffs is postponed and is required to be conclusively determined in trial after completely appreciating the evidence to be adduced by the parties. At this stage, the prima facie doubts can be raised on the aspect of the degree of distinctiveness of the FIREMAN's device and advertisement campaign spilling over to India and consequential reputation which enabled the defendant to take advantage thereof as a commercial boost.

Misrepresentation :

55. The misrepresentation as an ingredient of passing off is inextricably connected to that of goodwill or reputation in order to form a classical trinity or the passing off in the modern form. The

presence of the goodwill which has been misused by the defendant in the course of the trade in order to form misrepresentation results in damage to the proprietor leading to passing off. As I have already expressed doubts as to existence of goodwill and trans-border reputation in the absence of the irrefutable material indicating that in all probability, the defendants were aware of the plaintiffs advertisement's campaign as well as the device of firemen without plaintiffs being present in India. Even if it is assumed for the sake of the argument that there existed enough reputation to believe that the defendant was aware for all good reasons about the plaintiffs' right in the Fireman's device and/or the advertisement in the manner published by the plaintiffs, still, the element of misrepresentation which is somehow connected with good yet independent in nature is missing in the present case.

56. As I have already analyzed above under the head of the infringement that the device of the plaintiffs relating to fireman is a man standing in a posture with a hat on his head and the clipping of the advertisement of the defendant makes altogether different representation of the persons extinguishing the fire in the form of shadow. The difference in the colours scheme, get up, features in advertisement as well as in the clipping which is stated to be offending the plaintiffs' concept are all add on matters which are relevant for the passing off enquiry in order to draw inference against likelihood of the confusion and deception.

57. The plaintiffs claim distinctiveness on two aspects in order to claim misrepresentation, first being that the plaintiffs have distinctive fireman device and secondly the plot of the fire extinguishing is copied by the defendant along with the other features in advertisement. The defendant on the contrary seeks to justify the advertisement by stating that the depiction of discomfort in upper abdomen hinting heartburn is common to the advertisement of antacid product across the industry and likewise is the concept of extinguishing of the said fire. I find that the said justification expressed by the defendant at this prima facie stage seems to be plausible. My reasons for accepting the said justification is that it is not unusual in the course of the trade of antacid medicines to show heartburns or abdomen pain. We have already seen the advertisements of several antacid medicines like ENO, Dygenie wherein heartburns are shown by pain in the stomach after person eats something or is going to eat something and the 5 min or 10 min effect of such soluble medicines is also shown to have lowered down the effect of the burns or quench the fire flames. I find that the heartburns or what we call in Hindi "Jalan" or "Dil Ki Jalan" is not an alien term amongst Indians in the branch of Gastroenterology. Thus, the depiction of the quenching of the flames by sprinkling of water or for that matter medicine cannot be said to be phenomena or theme which cannot be conceived by anyone but for the plaintiffs as stated to be invented by them. Therefore, if there are heartburns or fire kind of situation in the abdomen, the representation of lowering down of the same

can conceivably be extinguishment of the fire. Accordingly, prima facie by mere commonality of the depiction of the pain in the stomach after or prior to eating and also showing the effect of medicine by extinguishing the fire inside would not lead to inference as to misrepresentation unless there exists a case of imitation. In the present case, prima facie look of the defendant's representation fire extinguishing devices show that they are far remote from that of plaintiffs' device. The common feature as alleged by the plaintiffs relating to the person having pain in the stomach is not the essential feature or characteristic in the advertisement, which usually the antacids medicines depict in the start of the advertisements and no inference of imitation can be drawn by the said fact.

58. Accordingly, the differences in the colours, backgrounds of the advertisements, overall set up of the advertisements, the features of the firemen, overall features of the advertisement, coupled with the use of slogan "Pet ka Fire Brigade", the use of the name PUDIN HARA LEMON FIZZ which is a popular medicine in its own right and the name of defendant "Dabur" shown in advertisement, conceivable nature of phenomena of fire extinguishment in the heartburns cases and doubtful case of distinctiveness of the plaintiffs' advertisement campaign and firemen devices in India further provide strength to this prima facie view that there exists a possibility that the defendant could have conceived this concept of the fire extinguishment in the

advertisement on its own without having knowledge about the plaintiffs though it is yet to be determined conclusively in trial wherein the possibility of imitation by the defendant can altogether be ruled out or not after the parties adduce the evidences including the evidence as to the distinctiveness of the firemen devices, surveys and public opinions as to knowledge of the firemen devices and the related evidence as to possibility of the confusion and connection in the course of trade. At this stage, I take the prima facie view that the element of the misrepresentation is also not present in view of the reasoning contained under this head.

59. The prima facie view which has been taken relating to lack of misrepresentation under this head has been formed on the basis of the overall comparison of the features of the plaintiffs' firemen device and advertisement with that of the advertisement of the defendant and considering the similarities/dissimilarities and add on matters on the representations in the advertisement. Moreover, the misuse complained of by the plaintiffs in the present case is not the **use as a trade mark sense as traditionally understood as a part of the brand name or trade name which is more strikingly visible to the customer but the use of the device or character as a part of the theme in the advertisement conveying some sort of connection with the plaintiffs' concept**, such kind of use though would be covered in relation to the goods in the trade mark sense but the mode of

assessment of imitation or deceptive resemblance of course has to be examined and tested with greater vigil especially after seeing whether there exists the high level of distinctiveness attached to the device which immediately connects the mind of the public with the source of the goods or brand name attached to the same and other host of the factors operating alongside the use of the said device as a part of the advertisement campaign. All these factors and reasoning collectively are weighed by this Court to form this prima facie opinion. In that sense, the present case is peculiar in its own facts as it relates to use of the device as a part of the advertisement campaign and that too not in an identical form but something similar to it and the Court is called upon to answer whether the said use causes misrepresentation or not at the ad interim stage.

60. Mr. Lall, learned counsel for the plaintiffs laid great stress upon the judgment passed in the case of ***National Sewing Thread Co. Ltd*** (supra) wherein the Supreme Court was concerned with the competing marks comprising the device of EAGLE with outspread wings in respect of threads along with the expression EAGLE brand and the similar device used by the other side with the expression “Vulture brand” when earlier the other side adopted the mark EAGLE brand but later on changed it to vulture. In that context, the Supreme Court observed that it is immaterial whether the appellant’s used the word Vulture or not as the device conveys the same idea and the appellants are

camouflaging vulture with eagle when two years down the line, the appellants were using it 'eagle' and later on amended to 'vulture'. The Court on facts found that the depiction of the device of eagle or a bird which looks like an eagle though named as vulture conveys the same idea as that of the Eagle and thus confusive in nature. Mr. Lall wants this Court to follow the said judgment of ***National Sewing Thread*** (supra) to the facts of the present case. I find that the facts of the present case are altogether different from that case and thus the said judgment is not applicable to the present case due to the following reasons :

- a) In ***National Sewing Thread*** (supra), the infringing party or appellants therein were earlier using the mark EAGLE along with the device of eagle but later on upon objecting amended the description of the mark to be called as Vulture though the representation of the device remained of the eagle. In that context, the Court has held that the mark of the appellants conveyed same idea as that of the respondent and the difference in the description is immaterial. Such facts are not present in the instant case in as much as the defendant in the present case has been using the clippings originally from the beginning in the same manner and there is no past history of the defendant's infringing the plaintiffs mark and thus no prior inference of dishonesty which can be formed in the present case in order to state that the defendants are camouflaging

the plaintiffs' fireman device in their advertisement in such sense.

- b) In ***National Sewing Thread*** (supra), the manner of use of the mark was as a part of the trade mark and device in logo form and the use complained of was also use as a part of the trade mark only whereas in the instant case the trade mark of the plaintiffs is GAVISCON though the device of man with a hat on is used along side the mark in certain places, the said man performs fire extinguishing activities only in advertisement; likewise the defendant's mark is "Pudin Hara Lemon Fizz" but the user complained of is the use of the device or character trade mark as a part of the advertisement campaign similar to that of the plaintiffs. The said manner of use in the present case is thus not the one relating use of the mark in traditional trade mark or brand name sense but the use as a part of the advertisement campaign and thus the factually the case of ***National Sewing Thread*** (supra) is distinguishable.
- c) In ***National Sewing Thread*** (supra), the observation of the marks conveying the same idea has been made when the device of EAGLE has no connection with that of the threads and the Court found that the appellant's use of the device of EAGLE in respect of the threads is unjustifiable as it conveys some connection with that of the respondent by conveying similar idea. In the present case, I have in my analysis found that the grounds on which similarity is sought to be ascribed

include a person having pain in his stomach due to acidity as a first story board of the advertisement, which I have found is not unusual or peculiar to the plaintiffs as every advertisement relating to antacid medicine or medicine attempting to cure acidity would invariably start with such depictions, likewise the fire kind of situation or quenching of flames or watering down of the same or extinguishing of the same was also found as prima facie not the one which is inconceivable by any one knowing the symptoms of heartburn. Thus, in such a case, where the idea or theme has some connection with the good or service for which it has been used as a characteristic or trait of the said product, in that case, it is not readily inferred that whole theme or plot of fire extinguishing belongs to the plaintiffs. The said fact is again a distinguishable one from **National Sewing Thread's** case and the said case is thus not applicable to facts of the present case.

61. In view of the same, I do not accept the submission of Mr. Lall that the present case is similar to that of **National Sewing Threads** (supra) and the same is clearly distinguishable on facts and thus the proposition of law emerging therefrom cannot be applied to different set of facts in the present case.

62. I would say that the facts of the present case are someway similar if not identical to one of the leading cases decided by the Privy Council of Australia in the case of **Cadbury Schweppes**

Pty. Ltd. v. Pub Squash Co. Pty. Ltd. reported in [1981] R.P.C. 429 which has been relied upon by Indian courts from time to time including this Court for the legal proposition discussed therein by the Court. Let me first discuss some facts in the case of ***Cadbury Schweppes's*** case (supra), which are as under:

- a) In 1973, the plaintiffs therein, in a drive to increase their share of the Australian soft drinks market, developed a lemon squash which they decided to present as an adult drink, the consumers of which would be shown to be ruggedly masculine and adventurous. It was decided that the advertising would also invoke feelings of nostalgia by the use of the slogan “a great old squash like the pubs used to make”. They named it “Solo” and in line with the adult image of the proposed new product, a medallion-type label was designed bearing a device similar to that used on beer labels in Australia; it was mainly to be sold in greenish-yellow cans. At the same time television and radio advertisements were created and broadcast, both taking as their theme a rugged, lone male canoeist shooting rapids in a kayak and the fact that the product resembled the lemon squashes that pubs used to make.
- b) In 1975 the defendants therein launched a lemon squash drink called “Pub Squash”; they also chose as the theme of their television advertising campaign a man engaged in vigorous physical endeavour and likewise invoked a theme of

nostalgia. The label was again of a medallion type bearing the words “Pub Squash” and the cans in which it was sold were the same size and shade of yellow as those of the plaintiffs. On 6th May, 1975 the defendants registered “Pub Squash” as a trade mark in Part B of the Register. Later, in 1975, the name of the defendants' product was changed to “Pub Soda Squash”. The plaintiffs brought proceedings against the defendants for passing off, unfair trading and expungement of the defendants' trade mark.

c) The plaintiffs' case before the Trial Court and also before the Privy Council was that:

(i) by the end of April, 1975, in consequence, in particular, of the intensive television and radio advertising campaign mounted by the plaintiffs or some one or more of them, the product “Solo” had become associated in the minds of the buying public with one or more of the following, both alone and in combination:

- a. a lightly aerated lemon squash style of soft drink;
- b. which soft drink was sold in cans having a capacity of 250 and 370 ml., the predominant colour of which was lemon or yellow, and in bottles having a capacity of 1.25 l., the predominant colour of the labels upon which was lemon or yellow;
- c. the advertising slogan or slogans “those great lemon squashes that pubs used to make”, “those great lemon

squashes a few country pubs still make”, “those lemon squashes the pubs used to make”, “the kind of lemon squash pubs used to make” and other similar slogans and themes;

(ii) whether deliberately or not (although it was submitted that the defendant's actions were deliberate) the defendant appropriated for its product “Pub Squash” the reputation and goodwill of and market for “Solo”, that appropriation being effected by one or more of the following, both alone and in combination:

- a. making “Pub Squash” a soft drink similar in style to “Solo”;
- b. marketing “Pub Squash” in cans of similar size and colour, and in bottles of similar size, with labels of similar colour, to those in which “Solo” was marketed;
- c. adopting the name “Pub Squash” (later “Pub Soda Squash”)
- d. using as part of the mark for “Pub Squash” golden yellow bar doors similar to those used in old-style hotels;
- e. utilising in the advertising (particularly in its television advertising) for “Pub Squash” themes and slogans similar to those used in advertising for “Solo”, as for example “when the heat is on, and your throat is asking for the local, rip into a Pub Soda Squash;

drown that thirst with the biting taste of lemon in Pub Soda Squash”;

(iii) even if, contrary to what was submitted in (i) and (ii), it were held that the necessary elements of the traditional tort of passing off had not been established, nonetheless the plaintiffs, or some one or more of them, was or were entitled to rely, in the present case, upon the tort of unfair competition since, so it was submitted, the defendant had, with fraudulent intent, set out to compete unfairly with the plaintiffs by “pirating” the formula for “Solo”, “pirating” the colour of the containers in which “Solo” was marketed, and “pirating” the theme upon which the advertising for “Solo” was based.

d) The defendant’s case before the Court was that :

- (i) neither the colour of the containers in which or of the labels upon the containers in which “Solo” was sold, nor the theme or slogans used in the advertising for “Solo” was capable, in the circumstances of becoming distinctive of “Solo”;
- (ii) even if it be otherwise, neither the colour of the containers or labels, nor the themes or slogans, in fact, ever became distinctive of “Solo”;
- (iii) even if it be otherwise, “Pub Squash” was sufficiently differentiated from “Solo” as to prevent passing off;

- (iv) even if it be held that passing off had occurred, it was innocent, so that the plaintiffs should not be granted any relief;
 - (v) further, the plaintiffs having been aware, from the “launch” of “Pub Squash” of the matters of which they now complained, and having taken no action for over two years, were disentitled, by reason of laches acquiescence and delay, to any relief in the proceedings;
 - (vi) further still, Cadbury-Schweppes had disentitled itself to any relief in the present proceedings by reason of its conduct in seeking to register in South Australia, in which State “Pub Squash” was also marketed, the business name “Pub Squash Company”.
- e) The Trial Court dismissed the suit after appreciating the evidence by observing that the plaintiffs are not entitled to injunction and the matter came up before the Privy Council which is the Supreme Court of New South Wales wherein the Court evaluated the evidence of the parties and competing submissions advanced by the parties and laid down some significant propositions of law which are as follows:

At page 456:

“While customers purchasing soft drinks may take more care in making their selections, the evidence would seem to suggest that those who purchase soft drinks in mixed businesses and milk-bars are often less careful in making their selections. But whatever be the location where a purchase is made, it is, in the light of current

marketing methods, hard to avoid the conclusion that mistakes in selection are not uncommon.

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It is trite law that it is an actionable wrong for a person in trade or business to represent, whether deliberately or not (although fraud seems to have been a necessary ingredient in the old common law action for damages), that his goods are those, or that his business is that, of another; and that, whether the representation of which complaint is made is effected by direct statements, or by some indirect means such as the use of names or “badges” commonly associated with the goods or business of that other, or any names or “badges” colourably resembling those commonly associated with the goods or business of that other, in connection with goods or a business of the same or a similar kind, in such a way as to be calculated to cause the ordinary purchasers of that other's goods, or the ordinary customers of that other's business, to take the goods to be those, or the business to be that, of that other (see, for example, Kerly's Law of Trade Marks and Trade Names 10 Ed. 362, paragraph 362).”

At page 457:

“But what is the nature of the goodwill or reputation which must be established? Must it be established that the name or “badge” is universally and exclusively associated with the plaintiff's goods or business? And what is the relevant time for establishing that goodwill or reputation? Although some of the authorities (see, for example, *Leahy, Kelly & Leahy v. Glover* (1893) 10 R.P.C. 141 at 155 ; *S. Chivers & Sons v. S. Chivers & Co. Ltd.* (1900) 17 R.P.C. 420 at 428–430) seem to suggest that universal and exclusive association is the test which must be met, it seems to me that, while meeting that test may be the only way, in any particular case, to establish that a surname, or a descriptive

phrase, has become distinctive of the plaintiff's goods or business, the true test is, whether the name or "badge" has become, among those commonly concerned to buy goods of the type in question, or to deal with businesses of the type in question, distinctive of the plaintiff's goods or business—so much, so it seems to me, is suggested by the judgment of *Lindley L.J. in Powell v. The Birmingham Vinegar Brewery Co. Ltd.* (1896) 13 R.P.C. 235 at 254, lines 42–57 ; see to the like effect, the views of A.L. Smith L.J. *ibid.* at 262, lines 37–49. If it be established that the name or "badge" has, in fact, become distinctive in the relevant sense it matters not that purchasers or customers do not know the identity of the manufacturer of the goods or of the proprietor of the business...."

At page 461:

"The question then is, did it do so? There is no doubt that if the two cans (or two bottles) are placed side by side, it can readily be seen that they are different. This, however, is not necessarily enough, for one must take into account the nature of the market-place and the habits of ordinary purchasers: *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at 174–175; *Tavener Rutledge Ltd. v. Specters Ltd.* [1959] R.P.C. 83 at 88–89 . As I have pointed out earlier, it is not uncommon, albeit that it is not the universal practice, both in supermarkets, and in mixed businesses and milk-bars which have self-selection display refrigerators for products such as "Solo" and "Pub Squash" to be displayed alongside each other; and in those cases in which they are not, they are, nonetheless displayed in close proximity to each other. Further, as I have pointed out, the purchase of a soft drink is often a casual transaction. These two features of the market seem to explain most, if not all, of the cases of incorrect selection of which evidence has been given. But when accepting,

as I do, that by reason of the nature of the market-place and of the habits of purchasers, mistakes are likely to, and do, in fact, occur, the evidence would seem to demonstrate that in most, although not all, cases in which there has initially been a wrong selection by a customer, or the wrong product has been offered by the shopkeeper, the error has been recognised before the purchase has been completed. This being so, it seems to me that the defendant has sufficiently differentiated its product from that of the plaintiffs': *Goya Limited v. Gala of London Limited*, [1952] 69 R.P.C. 188 ; Kerly's Law of Trade Marks and Trade Names 10 Ed. 373, paragraph 16–15).”

At page 488:

“It is unnecessary to explore the law in any depth, because it is now accepted by both sides that the issue in the case is whether in promoting its product the respondent so confused or deceived the market that it passed its product off as the product of the appellants. Nevertheless the case presents one feature which is not found in the earlier case law. The passing off which the appellants complain depends to a large extent on the deliberate adoption by the respondent of an advertising campaign based on themes and slogans closely related to those which the appellants had developed and made familiar on the market in the radio and television advertising of their product. Does confusion or deception, if it be shown to arise from such an advertising campaign, amount to a passing off ? To answer the question it is necessary to consider the modern character of the tort.” (Emphasis Supplied)

At page 490:

“The width of the principle now authoritatively recognised by the High Court of Australia and the

House of Lords is, therefore, such that the tort is no longer anchored, as in its early nineteenth century formulation, to the name or trade mark of a product or business. It is wide enough to encompass other descriptive material, such as slogans or visual images, which radio, television or newspaper advertising campaigns can lead the market to associate with a plaintiff's product, provided always that such descriptive material has become part of the goodwill of the product. And the test is whether the product has derived from the advertising a distinctive character which the market recognises." (Emphasis Supplied)

"But competition must remain free; and competition is safeguarded by the necessity for the plaintiff to prove that he has built up an 'intangible property right' in the advertised descriptions of his product, or, in other words, that he has succeeded by such methods in giving his product a distinctive character accepted by the market. A defendant, however, does no wrong by entering a market created by another and there competing with its creator. The line may be difficult to draw; but, unless it is drawn, competition will be stifled. The test applied by Powell J. in the instant case was to inquire whether the consuming public was confused or misled by the get-up, the formula or the advertising of the respondent's product into thinking that it was the appellants' dissimilar product. And he held on the facts that the public was not deceived. Their Lordships do not think that his approach in law (save in one respect, as will later appear) to the central problem of the case can be faulted. The real question in the appeal is, therefore, one of fact, whether the judge erred in the inferences he drew from the admitted primary facts." (Emphasis Supplied)

63. From the reading of the aforementioned propositions of law laid down by the Privy Council in ***Cadbury Schweppes*** (supra) especially the underlined propositions, it can be seen that the proposition before the Privy Council was also of the similar nature as before this Court which is that whether promotion of the product of the respondent in the advertisement campaign based on themes and slogan closely related to those which the appellant had developed amount to confusion and deception in the course of trade. The Court in ***Cadbury Schweppes*** (supra) analyzed the legal position relating to modern tort of passing off in the case of ***Erven Warnink*** (Supra) laid down by the Lord Diplock and agreed with the appellants/ plaintiffs that the modern law of tort encompass the slogan, visual images which television advertisements can lead the market to associate with the plaintiffs' product provided the said material become part of the goodwill of the product. However, on facts of the case, the Court found that there was no misrepresentation and the Court affirmed the decision of the Trial Judge. The Privy Council had to say the following in relation the passing off relating to advertisement :

"If my view of the state of the law be correct then the plaintiffs have failed to make out a case for relief on this aspect of the case as well; for the facts, as I have found them above, reveal no relevant misrepresentation on the part of the defendant as to its goods. (Emphasis Supplied)

However, as the plaintiffs have submitted not only that there is a tort of unfair competition independent of passing

off in the traditional sense, but, also, that that tort is far more extensive in ambit than I have held it (if it exists) to be, it is, I feel, incumbent upon me to take all such findings of fact as are relevant to the more extensive case argued for by the plaintiffs. I take that view since, if the plaintiffs are minded to appeal, and if my view of the law be held to be wrong, the Court of Appeal will have available to it all the facts necessary for the determination of the issue, and the parties will thus be spared the additional time and, perhaps, expense which would be involved if the matter needed to be remitted to me for further findings of fact before any appeal could be finally disposed of.

It is to be recalled that the plaintiff's case, on this aspect of the matter, was that the defendant had deliberately set out to compete unfairly with the plaintiffs by "pirating" the formula for "Solo", "pirating" the colour of the containers in which "Solo" was marketed, and "pirating" the theme upon which the advertising for "Solo" was based. The defendant's conduct was, so Mr. Horton submitted, "a most audacious and unblushing fraud".

"But the question which arises is, whether the evidence tendered on behalf of the defendant ought to be accepted, or whether I ought, as the plaintiffs submitted, to reject it and to find, instead, that the defendant, by its officers, upon becoming aware of "Solo", deliberately set out to take advantage of the plaintiff's efforts in creating a market for a soft drink of a lemon squash type.

Despite the fact that the answers to the Interrogatories to which I have referred above (which answers, I am satisfied, were drafted by Mr. Brooks, or by Mr. Brooks in conjunction with his advisers - see transcript page 198; see also in answer to Interrogatory 17(a) the use of the phrase "our product") suggested that as early as October 1974 the defendant's officers were aware of and from time to time discussed, "Solo" and the advertising for "Solo", each of the witnesses who was an officer of the defendant

at the time displayed a singular reluctance to admit that he knew of or had been a party to any discussion of “Solo” or the advertising for “Solo”, this reluctance, tended, at times, to lead to quite tortuous attempts by witnesses to explain away their unawareness of “Solo” or of the advertising campaign for “Solo”, some of which attempts produced completely irreconcilable conflicts in the evidence.

Mr. Brooks provides a perfect example of the matters to which I have just referred. Thus, he said that he did not see the “Solo” advertisement until February 1975; that he was a party to a discussion about the advertisement in or about December 1974, a date which he fixes “because I don't think their advertising started until December”; that “it was sometime towards the end of 1974 and 1975 that we started to hear a bit about ‘Solo’, that it had been launched towards the end of 1974”; that towards the end of December 1974 or January 1975 he had discussions with the advertising agency concerning the advertising for “Solo”; that “You see I don't believe there was any advertising in October, so it is not possible to have discussions on advertising”; that in about October 1974 he discussed “Solo” with Mr. Harris, and showed Mr. Harris a can of “Solo” which he had in his possession.....

Not only am I not satisfied by the evidence that the officers of the defendant remained in ignorance of the existence of “Solo” and of the advertising for “Solo” until the defendant was committed to marketing “Pub Squash” by that name, but I am not satisfied that they remained in ignorance until October 1974. Rather, I am persuaded that, by no later than August 1974, and, in all probability by an earlier date, officers of the defendant (such officers including Mr. Brooks), were aware of the “launch” of “Solo” into Victoria and Southern New South Wales and of the advertising associated with the “launch”.

Finally the court concluded that in relation to the advertisement campaign that the common features which

are alleged by the plaintiffs therein/ appellants therein are actually the ones which could not have been avoided by any commercials relating to soft drink. In the words of the court speaking through Powel J, it was observed thus:

"I have earlier described the form and extent of the television commercials screened on behalf of the defendant, and, in doing so, have pointed to the features, or intended features, of "The Million Dollar Man", "Furnace" and "Kneeboard" relied upon by the plaintiffs in support of their submission that the defendant attempted to copy their (the plaintiffs') form of advertising.

After much consideration **I have come to the conclusion that this charge is not made out against the defendant. So far as the evidence goes, the concept of, and the scripts for the various advertisements, were the product of the efforts of Mr. Harris and his staff, none of the officers of the defendant being involved beyond the giving of instructions. Although I did not find Mr. Harris to be an entirely satisfactory witness nonetheless I am disposed to accept that he did not, nor did his staff, consciously set out to copy the "Solo" advertisements. The suggested similarities with the "Solo" advertisements, as for example, "ripping off" the top of a can of "Pub Squash", "the spurt of mist" (both in "The Million Dollar Man") and the reference to "the local" (in "Furnace") are, in my view, naturally suggested by, and would be hard to avoid, in a commercial for a canned soft drink named "Pub Squash"; while the proposed incident in "Kneeboard" was, in my view, not unnatural and was different, in its context, from the incident of the canoeist, in the "Solo" advertisements, spilling "Solo" down his chin.**

(Emphasis Supplied)

"From what I have written above it will appear that it is my view that, as from a time being no later than the later part

of August 1974, the defendant, having by means of one or more of its officers become aware of the successful launch of “Solo” in Victoria and of the sale of “Solo” in Southern New South Wales, and, thus, appreciating that in all probability the Victorian “launch” would be followed by a large scale “launch” of “Solo” upon the New South Wales market, set out in a deliberate and calculated fashion to take advantage of the plaintiffs' past efforts in developing “Solo” and of the plaintiffs' past and anticipated future efforts in developing a market for a product such as “Solo”, and that, in particular the defendant, by its officers, sought to copy or to approximate the formula for “Solo”, and chose a product name and package for the defendant's proposed product derived from and intended to gain the benefit of the plaintiffs' past and anticipated advertising campaign, and the plaintiffs' package for their product.

Notwithstanding these findings, it is my view, as I have earlier indicated, that, as the facts, as I have earlier found them, do not reveal any relevant misrepresentation on the part of the defendant as to its goods, the plaintiffs have not made out a case for relief based upon the extended concept of passing off or upon unfair trading.

The learned judge then considered the various discretionary defences raised by the defendants.” (Emphasis Supplied)

64. In the result, the appeal was dismissed by the Supreme Court in ***Cadburys Schweppes*** case by affirming the findings on facts by Trial Court relating to lack of misrepresentation. Lord Scarman wrote a separate opinion which also affirmed the finding of the Trial Court on the lack of misrepresentation. Some of the legal propositions quoted above are from the analysis of Lord Scarman’s concurring opinion rendered separately.

65. The discussion of the **Cadbury Schweppes** case was necessary in order to see as to how the Courts approach in assessing the passing off claim relating to use of the devices or themes as a part of the advertisement campaign and the mode of evaluation of the evidence in such cases. As seen above, it was established on facts, that the defendant's officials were made aware of plaintiffs' drink in the case by the year 1974 prior to the launch of the defendant's drink about the same and the name Solo. Still, the Court proceeded to hold that the relevant misrepresentation on evidence is missing as the features claimed in the advertisement in order to allege misrepresentation are hard to avoid in any television commercial relating to Soft drink. This was the case which was decided after appreciating the complete evidence lead by both the parties on aspect of the distinctiveness of the features like yellow coloured cans, medallions, word SOLO and theme or formula of the drink. In sharp contradistinction to the same, I am here concerned with the ad interim stage where the parties are yet to lead their evidence on the aspect of the distinctiveness. In such a case, I have already expressed my two prima facie findings; first being that I express my doubts as to the degree and the extent of the spill over reputation in India relating to the Fireman's device in the minds of the public at the relevant time in absence of any irrefutable material available on record and thus the question of the distinctiveness has to be determined properly after the evidence is led in trial; secondly even if it is assumed that there exists some kind of spill over reputation, still

prima facie the element of the misrepresentation is missing due to the collective operation of the host of the factors analysed. If the prima facie findings arrived by me are seen in the light of ***Cadburys Schweppes*** (supra) case, I am of the opinion that the same are in consonance with the approach adopted in the said case except in that case the Court agreed on the first limb of establishment of the distinctiveness after trial as against in the present case, I am doubtful about the same at this ad interim stage in view of the fewer material available on record to suggest such degree of the distinctiveness in the minds of Indian public leading to strong prima facie case.

Damage and prima facie view as to passing off.

66. In view of my above discussion, I find that prima facie the element of the distinctiveness and misrepresentation is missing from the classical trinity or passing off in the extended form laid down by Lord Diplock in ***Erven Warninck's*** case (supra) and thus the question of the resultant damage does not arise. Accordingly, the plaintiffs have prima facie failed to make out a case of passing off and are not entitled to the relief of the temporary injunction on that count in relation to television advertisement.

Copyright Infringement

67. The plaintiffs have alleged that the defendant's by copying the original script of the advertisement of the plaintiff along with fire fighting device is infringing the plaintiffs; copyright in the said

advertisement which is original work of the plaintiffs and also in the original artistic work contained in the device of the fireman.

68. On the other hand, the defendant argued that the plaintiffs cannot claim any monopoly over the idea of fire extinguishment by the fireman and the devices and representation used by the defendant are altogether different from that of the plaintiffs. It has been further argued that there are substantial differences in the works of the plaintiffs' vis-a-vis the work of the defendant in the advertisement as depicted in the plaint.

69. I have considered the rival submissions of the parties on the aspect of the copyright infringement. I have already done extensive analysis in order to form a prima facie view that the device of fireman is not apparently closer to that of the plaintiffs. It cannot be said that the said device or representation used by the defendant is the colourable imitation of the plaintiffs' work. Prima facie, it appears that there exists several differences in colours, background, representation of the caricatures in the form of shadows etc coupled with other changes in advertisement which makes the advertisement as a composite work as a whole distinct from that of the plaintiffs' advertisement. Likewise, the depiction of the person extinguishing fire is also a concept or theme in the advertisement which cannot be monopolised under the guise of the copyright as per the well settled law that ideas are not protected in the copyright but only the manner of expression are protected under the law of copyright. (**R.G. Anand v. Delux Films**, 1979 SCR (1) 218).

70. As discussed earlier, it is apparent on comparison that prima facie there is no similarity between story board/ script of the advertisement of the plaintiffs' product and the defendant's product. The script of the defendant's advertisement of the product Pudín Hara Lemon Fizz has used "Pet Ka Fire Brigade" as a device and not the fireman like plaintiffs' advertisement. The TV commercial of the defendant uses fire spitting as a strong device to highlight problem and fire brigade to show the cooling relief provided by the product. To convey the ingredient story lime, mint and other ingredients are changing into Pudín Hara Man inside the stomach unlike plaintiffs' Gaviscon where fireman is entering from mouth. The screenshots of the defendant's advertisement showing the said advertisement in detail are as under:













71. Prima facie, I find that there exists differences in the manner of the expression of the plaintiffs' works with that of the

defendants in the television advertisements in many respects besides the similarities as alleged by the plaintiffs. The inference as to copying cannot be inferred by way of commonality in the plot as always some similarities are bound to occur at places like in an advertisement of antacid or drug curing acidity, there is bound to be a representation of person having stomach ache or acidity problem prior to eating or after eating. Likewise, the extinguishment of heartburn or fire is an idea, the plaintiffs may have their way of presenting the idea and the defendant has modified its way of presenting the same by making changes in the colours, presentation, backgrounds with the additions made in the advertisement. Thus, I am of the view that prima facie, it is not possible to hold that there exists a copyright infringement in the theme or script of the plaintiff's advertisement nor any infringement can be inferred on the aspect of the infringement of the copyright in the device.

72. The resultant effect of the discussion which has been conducted under the distinct heads is that the plaintiffs have failed to make out any prima facie case for the grant of the temporary injunction either on the count of infringement of trade mark, copyright or passing off if the said device is used in two advertisements. The balance of convenience is in favour of the defendant against the plaintiffs as in the absence of any prima facie entitlement as to injunction, the defendant would be more inconvenienced with the grant of injunction and so as the irreparable damage which would cause to defendant if the

injunction is granted in favour of the plaintiffs and against the defendant in the absence of any prima facie case on infringement of trademark, copyright and passing off as far as the said television advertisement.

73. Consequently, the plaintiffs are not entitled to the relief of temporary injunction in respect of the television advertisement and IA No.11442/2014 is disposed of with the direction that during the pendency of the suit, there would be no interim order against the defendant if the impugned television advertisement is used in the manner it is already being used. In case of any modification in the said television advertisement, the defendant shall take necessary permission from the Court. The said request of the defendant for modification shall be considered by the Court after hearing both the parties. However, in order to avoid confusion from any quarter, the defendant is not allowed to use the device of Fireman along with their physical product or its packaging including advertisement in the newspapers which is also agreed by the defendant.

74. No costs.

(MANMOHAN SINGH)
JUDGE

OCTOBER 31, 2014