

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

% **Date of decision: 26th March, 2019**

+ **CS(COMM) 10/2019 & IA No.259/2019 (u/O XXXIX R-1&2 CPC)**

SURYA FOOD AND AGRO LIMITED **Plaintiff**

Through: Mr. N. Mahabir and Mr. P.C. Arya,
Advs.

Versus

OM TRADERS & ANR. **Defendants**

Through: Mr. Hemant Sharma, Adv. for D-2.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

1. The plaintiff has instituted this suit against the two defendants namely (i) Om Traders; and, (ii) Raja Udyog Private Limited (RUPL), for permanent injunction restraining selling, offering for sale any goods, advertising or promoting any product under the packaging, get up, trade dress of the defendants' product 'BUTTER KRUNCH' or any packaging, get up, trade dress which is similar to that of plaintiff's product 'BUTTER DELITE' and likely to cause passing off and for ancillary reliefs.

2. The suit came up first before this Court on 10th January, 2019, when though not finding any case of passing off to have been made out but observing that the suit could not be dismissed at that stage, summons of the suit and notice of the application for interim relief issued and the application for issuance of commission dismissed.

3. The defendant No.1 has failed to appear despite service on 17th February, 2019 and none has appeared for the defendant No.1. The

defendant No.1 is proceeded against *ex-parte*. The defendant No.2 has filed written statement and to which a replication has been filed by the plaintiff.

4. The counsel for the parties have been heard yesterday as well as today, clarifying that unless in the hearing any factor requiring evidence to be led is found, the suit will be disposed of on the basis of pleadings and admitted documents.

5. The plaintiff has instituted the suit, pleading (i) that the plaintiff is well-known in the market since the year 1994 for its 'PRIYAGOLD' Biscuits; (ii) that 'BUTTER DELITE' brand of the plaintiff's biscuits with a distinctive packaging has huge sells in India since December, 2015; (iii) that the plaintiff is owner of several other brand names like Butter Bite, Italiano, Classic Creme, Bourbon Creme, CNC, Snacks Zig Zag, Puff Crème etc.; (iv) that the goodwill associated with the mark 'PRIYAGOLD' rubs on to the plaintiff's other trade marks which plaintiff uses on various products and get associated with substantial recall and attention; (v) that the plaintiff has exclusive common law and proprietary interest in the packaging, get up and trade dress of the products sold under the mark 'BUTTER DELITE'; (vi) that the product with distinctive packaging sold under the mark 'BUTTER DELITE' has been advertised by the plaintiff in various print media and the packaging, get up and trade dress of the products sold under the mark 'BUTTER DELITE' is exclusively identified with the plaintiff; (vii) that adoption of packaging with similar get up and trade dress as that of 'BUTTER DELITE' especially in relation to biscuits, will create confusion and deception; (viii) that the packaging of the plaintiff's product 'BUTTER DELITE' is also an artistic work under the Copyright Act, 1957 and was

created/authored by Mr. Sachin More, Designer at Oberoi IBC India Pvt. Ltd. in August, 2015 under instructions from the plaintiff and he has assigned all rights in the artwork to the plaintiff; the plaintiff thus is the owner of copyright; (ix) that the plaintiff has also applied for registration of the trade mark 'BUTTER DELITE' in Class 30 of the 4th Schedule to the Trade Mark Rules, 2002; however in the application for registration, it has been inadvertently stated "proposed to be used as the mark has been in use since December, 2015"; (x) that in December, 2018, the plaintiffs came across the defendants' product under the trade mark 'BUTTER KRUNCH' with substantially similar packaging as that of plaintiff's 'BUTTER DELITE'; (xi) that the defendants, in their product 'BUTTER KRUNCH' has copied the artwork, printed and written contents of the packaging of 'BUTTER DELITE' and copied every feature, placement of different elements on the product and packaging of 'BUTTER DELITE'; and, (xii) that the plaintiff in the plaint has set out a comparison chart of the plaintiff and the defendants' product packaging as under:

PLAINTIFF	DEFENDANT
	
BUTTER DELITE is written on left side.	BUTTER KRUNCH is written on left side.
Company name is placed on left top corner in a box.	Company name is place on left top corner in a box.
Namkeen Butter Biscuits is	Namkeen Butter Biscuits is

mentioned at the front bottom.	mentioned at the front bottom.
A distinct line runs through the butter and biscuits and the two layered colour scheme/pattern	A distinct line runs through the butter and biscuits and the two layered colour scheme/pattern.
The distinct line is golden in colour.	The distinct line is golden in colour.
One curly slice of butter is presented on right top corner.	One curly slice of butter is presented on right top corner.
PLAINTIFF	DEFENDANT
ANOTHER SIDE VIEW	ANOTHER SIDE VIEW
	
BUTTER DELITE is written on right side.	BUTTER KRUNCH is written on right side.
Company name is placed on left side.	Company name is placed on left side.
PLAINTIFF	DEFENDANT
FRONT VIEW	FRONT VIEW
	

Background colour is a two layered colour scheme/pattern.	Background colour is the same two layered colour scheme/pattern.
BUTTER DELITE is written on left side.	BUTTER KRUNCH is written on left side.
Company name is placed on left top corner in a box.	Company name is placed on left top corner in a box.
Namkeen Butter Biscuits is mentioned at the front bottom.	Namkeen Butter Biscuits is mentioned at the front bottom.
Biscuits are shown to be dipped in butter.	Biscuits are shown to be dipped in butter.
A distinct line runs through the butter and biscuits and the two layered colour scheme/pattern.	A distinct line runs through the butter and biscuits and the two layered colour scheme/pattern.
The distinct line is golden in colour.	The distinct line is golden in colour.
One curly slice of butter is presented on right top corner.	One curly slice of butter is presented on right top corner.
PLAINTIFF	DEFENDANT
SIDE VIEW	SIDE VIEW
Left corner in a box.	Left corner in a box.
One curly slice of butter is presented on right top corner.	One curly slice of butter is presented on right top corner.

and, (xiii) that the defendants have deliberately copied the packaging of the plaintiff to deceive the consumers into buying the defendants' product believing it to be the original 'BUTTER DELITE' product of the plaintiff.

6. The defendant No.2 RUPL in its written statement, has pleaded (a) that the defendant No.2 RUPL previously known as 'Raja Biscuits Industries Private Limited', in the year 2003 commenced business of manufacturing and marketing of biscuits and other bakery products under the trade mark "RAJA" which forms the key part of the corporate name of the defendant No.2 RUPL; (b) that the trade mark 'RAJA' was adopted to distinguish the product of the defendant No.2 RUPL from those of the others in the trade; (c) that on 29th September, 2008, the name of 'Raja Biscuits Industries Private Limited' was changed to the present name of 'Raja Udyog Pvt. Ltd.'; (d) that the trade mark 'RAJA' was registered in favour of the defendant No.2 RUPL on 22nd July, 2008; (e) that the defendant No.2 RUPL in association with its house mark / principal trade mark 'RAJA' has registered as many as 75 trade marks used in association with the trade mark 'RAJA'; (f) that the turnover of the defendant No.2 RUPL has multiplied from Rs.27,70,299.18 paise in the year 2002-2003 to Rs.4,95,83,25,024/- in the year 2017-2018; (g) that the advertising budget of the defendant No.2 RUPL also has grown from Rs.9,89,076/- in the year 2002-2003 to Rs.6,48,81,126/- in the year 2017-2018; (h) that in or about 2016, the defendant No.2 RUPL introduced the trade mark comprising of the expression 'BUTTER KRUNCH' in association with the registered house mark 'RAJA' and has been using it since then; (i) that the trade mark 'BUTTER KRUNCH' is prominently written in an artistic manner on the packaging and/or trade dress used by the defendant No.2 RUPL along with the distinctive trade mark 'RAJA' on the top to indicate the source thereof; (j) that the sale of the biscuits under the mark 'RAJA BUTTER KRUNCH' in the year 2016-2017 was of Rs.7,55,53,975.50 paise and in the year 2017-2018 grown to Rs.13,49,57,983.30 paise; (k) that the packaging and/or trade dress of 'RAJA BUTTER KRUNCH' is completely different from that of 'BUTTER

DELITE'; and, (l) that the trade dress or get up used by the defendant No.2 RUPL in respect of its product 'BUTTER KRUNCH' is an original artistic artwork within the meaning of Copyright Act, 1957.

7. The plaintiff has filed a replication to the written statement aforesaid of the defendant No.2 RUPL denying the contents thereof and reiterating the contents of the plaint.

8. At this stage, it is deemed appropriate to set out hereinbelow the packaging of the plaintiff as under:



and the packaging of the defendant No.2 RUPL as under:



9. The counsel for the plaintiff has argued, (I) that it is not the case of the plaintiff in this suit that there is any similarity between the trade marks

‘BUTTER DELITE’ and ‘BUTTER KRUNCH’ and no relief also in that respect has been sought; (II) that the claim of the plaintiff in this suit is of the defendant No.2 RUPL having copied the packaging and trade dress of the plaintiff; (III) that the two packagings, though not of the same size are about the same size; (IV) that both have the trade mark i.e. ‘BUTTER DELITE’ and ‘BUTTER KRUNCH’ written in white letters on a red brown background; (V) that both have a golden line running through the length of the packaging; (VI) that both depict a platter with the biscuits and butter; (VII) that both use the words ‘Namkeen Butter Biscuits with sugar sprinkled Taste’; (VIII) that the product ‘BUTTER DELITE’ of the plaintiff alone has annual sales of Rs.120 crores; (IX) that while the plaintiff has pleaded the name of the author of its artwork, the defendant No.2 RUPL though has pleaded its packaging to be original artistic work, has not pleaded the name of the author; (X) that the plaintiff has been granted *ex-parte* injunctions in CS(COMM) 1277/2018 and on parity should be granted injunction in the present case also; (XI) that the subject product costs Rs.5/- and is purchased mostly by children who are unable to distinguish between the two goods; and, (XII) that the trade channels of the plaintiff as well as the defendant No.2 and of the products of both are the same.

10. The counsel for the defendant No.2 RUPL, inspite of opportunity has not made any submissions and the documents filed by the defendant No.2 RUPL along with its written statement are found to have been returned under objection and are reported to have been taken back by the counsel for the defendant No.2 RUPL.

11. I had on 10th January, 2019, when the suit had first come up before this Court, not granted *ex-parte* injunction sought reasoning, (A) that not only were the trade marks 'BUTTER DELITE' and 'BUTTER KRUNCH' different but the product could also easily be distinguished by the mark 'PRIYAGOLD' and 'RAJA' used in conjunction with 'BUTTER DELITE' and 'BUTTER KRUNCH' respectively; (B) that the paper used in the packaging of the plaintiff was without any gloss and that used in the packaging of the defendant No.2 RUPL was glossy, again distinguishing the two; (C) that the shade of the colour of the two packaging were also different; and, (D) that the mark 'PRIYAGOLD' on the packaging of the plaintiff was engrossed on a white background and the mark 'RAJA' on the packaging of the defendant No.2 RUPL was engrossed on a yellow background.

12. On the pleadings of the parties, there is a dispute as to who was first in the market, with the plaintiff claiming use since December, 2015, though in the trade mark application filed in 2016 claimed registration of 'BUTTER DELITE' on proposed to be used basis, and the defendant No.2 RUPL in its written statement has pleaded use since 2016.

13. Though there is no document on record in support of the plea of the defendant No.2 RUPL, of its sales and expenditure of advertising but all that can be said is that it is not as if, while the plaintiff is established, having a big market, the defendant No.2 RUPL is fly by night-operator.

14. However, the suit can be disposed of at this stage, irrespective of the aforesaid issues requiring trial, if on a bare perusal of the two packaging, no case of passing off were to be found. It has been held in ***Mahendra &***

Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd. (2002) 2 SCC 147 followed in ***Larsen & Tuobro Ltd. Vs. Lachmi Narain Traders*** (2008) 149 DLT 46 (DB) that in suits relating to infringement and passing off, examination of self-serving witnesses by the parties is of no avail and it is ultimately the Court which has to take a call on similarity / deceptive similarity, keeping in mind the perspective of a consumer with an ordinary intellect and a non-discerning eye. Reference in this regard can also be made to ***Staar Surgical Company Vs. Polymer Technologies International*** 2016 SCC OnLine Del 4813, ***Kanungo Media (P) Ltd. Vs. RGV Film Factory*** 2017 SCC OnLine Del 8768, ***Jaideep Mohan Vs. Hub International Industries*** (2018) 249 DLT 572, ***The Financial Times Ltd. Vs. The Times Publishing House Ltd.*** (2016) 234 DLT 305 and ***Mallcom (India) Limited Vs. Rakesh Kumar*** 2019 SCC OnLine Del 7646.

15. The counsel for the plaintiff in this context has referred to:

- (I) ***Parle Products (P) Ltd. Vs. J.P. & Co.*** (1972) 1 SCC 618 and ***Allied Blenders & Distillers Private Limited Vs. Shree Nath Heritage Liquor Private Limited*** 2014 SCC OnLine Del 3412 to contend that comparison must be made from the eye of an unwary consumer with imperfect recollection and similarity is to be assessed from an overall comparison and not microscopic comparison;
- (II) ***Cadila Healthcare Ltd. Vs. Cadila Pharmaceuticals Ltd.*** (2001) 5 SCC 73 to contend that the question is whether similarity is likely to confuse and emphasis in the enquiry has to be on similarities rather than dissimilarities;

(III) *Parmial Mandir Vs. Bharat Vasi Sugandhit Dhoop* 2014 SCC OnLine Del 800 to contend that the two packaging need not be an exact imitation but could involve complex mechanism of misrepresentation;

(IV) *Colgate Palmolive Company Vs. Anchor Health and Beauty Care Pvt. Ltd.* (2003) 108 DLT 51, *Gurnam Singh Vs. G.I. Cosmetics* 2018 SCC OnLine Del 12386 and *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. Vs. Anchor Health & Beauty Care Pvt. Ltd.* (2014) 211 DLT 466 (DB) to contend that passing off action based on copying of trade dress may succeed, even when the trade marks are different; and,

(V) *Anglo-Dutch Paint Color and Varnish Works Pvt. Ltd. Vs. India Trading House* AIR 1977 Delhi 41, *Cadbury India Ltd. Vs. Neeraj Food Products* 142 (2007) DLT 724, *Seven Towns Ltd. Vs. Kiddiland* 2016 SCC OnLine Del 5168 and *Midas Hygiene Industries P. Ltd. Vs. Sudhir Bhatia* (2004) 3 SCC 90 to contend that if the defendant is unable to give justification for adoption of packaging/copyright, it shows dishonesty and intention to copy.

16. The counsel for the plaintiff has also referred to and handed over:

(A) Article titled “The Role of Packaging in Brand Communication” by Arun Kumar Agariya, Ankur Johari, Hitesh K. Sharma, Udit N.S. Chandraul and Deepali Singh published in International Journal of Scientific & Engineering Research, Volume 3, Issue 2, February-2012 authoring (i) that packaging is recognized as an integral part of modern marketing operation and is an important part of the branding

process as it plays a role in communicating the image and identity of a company; (ii) that the role of packaging is changing from that of ‘protector’ to ‘information provider’ and ‘persuader’; and, (iii) that research suggests that there is an increase in companies developing their own private brands that exhibit packaging attributes, such as the shape, sizing, colouring, lettering, or even, the logo;

(B) Article titled “Packaging and Purchase Decisions: An exploratory study on the impact of involvement level and time pressure” by Pinya Silayoi and Mark Speece published in British Food Journal, Volume 106 Number 8 2004 pp. 607-628 authoring (i) that packaging seems to be one of the most important factors in purchase decisions made at the point of sale; (ii) that packaged food products are moving into ever larger supermarkets and hypermarkets, and there is a proliferation of products, offering consumers vast choice; (iii) that the competitive context is ever more intense, both in the retail store and household; and, (iv) that with the move to self-service retail formats, packaging increases its key characteristic as the “salesman on the shelf” at the point of sale;

(C) Article titled “The art of packaging: An investigation into the role of color in packaging, marketing, and branding” by Behzad Mohebbi published in International Journal of Organizational Leadership 3(2014) 92-102 authoring (i) that color is an excellent source of information as much as it is estimated that 62-90 per cent of person’s assessment and evaluation is based on colors alone; (ii) that colors have dramatic and profound effect on consumers’ thoughts,

feelings, and behaviors; (iii) that there is a consensus among marketing scientists and managers that product form or design and product aesthetics are indispensable tools to gain competitive advantage in competitive market; (iv) that one means of capturing discerning consumers is through the strategic use of visual cues; and, (v) that graphics and color are decisive factors in affecting consumers purchase decision; and,

(D) Article titled “The Power of Sensation Transference: Chocolate Packages & Impulse Purchases” by Suraj Kushe Shekhar and Raveendran P.T., published in IMJ, Volume 5, April-December 2013 authoring (i) that in today's world product package is often considered the fifth ‘P’ of the marketing mix; (ii) that although advertising is a major sales promotion tool, packaging is even more critical—this is because, for other promotional tools, there is always the need for communication to persuade and attract the consumer; however, when packaging is properly done, the products can sell by themselves; (iii) that proper packaging is an easier, cheaper means of advertising and hence huge amount of money spent on advertisement and promotional techniques can be redirected by ensuring that things are done properly during the product packaging stage; (iv) that shape of a package is normally the first element that the consumer notices in stores; (v) that in today's world, children have growing spending power in terms of being customers in their own right; they are also major influencers within the family decision making unit; (vi) that a layman who wishes to buy a chocolate from the market would always choose one that has

an eye catching package; chocolate packaging, thus, has a hypnotic effect on the customers mind.

17. I have considered the arguments aforesaid but am not persuaded and my reasons therefor are recorded below:

(I) As far as the opinions of Academicians referred to by the counsel for the plaintiff are concerned, they emphasis the importance of packaging in affecting the sale and of which there can be no doubt. However, it is worth noticing that most of the research of the functioning of the human mind referred to and relied upon in the said Articles / Publications, though authored by Indians, is by foreigners and with respect to foreign consumers and not in the context of the Indian consumers. Though I had as far back as in *Allied Blenders & Distilleries Pvt. Ltd. Vs. Shree Nath Heritage Liquor Pvt. Ltd.* 2014 SCC OnLine Del 3412 and *Gillette Co. LLC Vs. Tigaksha Metalics Pvt. Ltd.* (2018) 251 DLT 530 lamented that inspite of advancement in study of the decision making by the human brain having been done, it is unfortunate that the said scientific studies are not being applied by the practitioners of the law relating to trade marks to demonstrate possibilities of deception and confusion. Though the counsel for the plaintiff has made an effort in this regard but only to show the importance of packaging and colour but not to show the possibility of deception and confusion between the packaging of the plaintiff and the defendant No.2 RUPL and which is the question for adjudication in the subject proceedings.

(II) As far as the aspect of deception / confusion is concerned, though undoubtedly the test to be applied is of similarities and not of dissimilarities but in my opinion the similarities to be seen are the similarities distinctive and peculiar of the packaging of the plaintiff and not similarities which are found generally on packaging of all makers of the same product. To illustrate, a maker of talcum powder, packaging whereof is generally in cylindrical form, cannot, while alleging passing off by another, count the cylindrical form, which is common to the trade, as a similarity. The argument of the counsel for the plaintiff, in my opinion, suffers from this fallacy. The plaintiff, while listing the similarities in the packaging of the defendant No.2 RUPL with that of the plaintiff, is also counting elements which are common to packaging of all marketeers / producers of biscuits.

(III) None of the entries in the comparative table pleaded by the plaintiff and reproduced by me above, in my opinion, are distinctive to the packaging of the plaintiff and are generally to be found in the same product of nearly all marketeers / producers of biscuits / cookies.

(IV) The packaging of a product depends on and takes the form of the size and shape of the product, with packaging of very few products being disproportionate to the size and shape of the product and which unnecessarily adds to the cost of the product. The biscuits available in the market are either rectangular or in round shape, with indistinguishable variation in the size. The packaging thereof has to thus take the shape of the biscuits and if the shape and size of the

biscuits of two manufacturers is the same, the size of the packages in which they are sold will also be the same.

(V) The Court of Appeals for the Second Circuit of United States in *The Paddington Corporation Vs. Attiki Importers & Distributors, Inc.* MANU/FESC/0210/1993 held that where it is the custom of an industry to package products in a particular manner, a trade dress in that style would be generic and therefore not inherently distinctive. The same Court again, in *Gemmy Industries Corp. Vs. Fundamental Too, Ltd.* MANU/FESC/0286/1997 held that trade dress protection has limits; a trade dress that consists of the shape of a product that conforms to a well-established industry custom is generic and hence unprotected.

(VI) Much emphasis has been laid by the counsel for the plaintiff on the colour scheme. However, the colour scheme of the packaging of the plaintiff again is not something which is unique or distinctive of the product of the plaintiff and there are a large number of other biscuits available in the market with the same colour scheme. Moreover, the choice of colours for use in packaging is limited and merely because the colour of the packaging of the defendant No.2 RUPL is the same as of the product of the plaintiff, cannot, in my view, be taken into account, while judging deception / confusion. The plaintiff itself pleads and claims that the product of both are targeted to children. Generally, all products / goods targeted at children are of colour red which mostly attracts children. Mention can be made of

biscuits under the mark Britannia Tiger Biscuits and Britannia Vita Marie Gold which also in my memory are packaged in red colour.

(VII) I have already in order dated 10th January, 2019 observed that while the packaging foil used by the plaintiff is without any gloss, the packaging foil used by the defendant No.2 RUPL is glossy and which difference is evident. I also noticed that the shade of the colour of the packaging of the plaintiff as well as of the defendant No.2 RUPL, though both red, are different shades of red and the said difference also is evident immediately.

(VIII) The United States District Court for the Northern District of Illinois, Eastern Division, in ***Keebler Company Vs. Nabisco Brands, Inc.***, 1992 U.S. Dist. LEXIS 6826 held that it is common in the cookie and cracker market to find similar product types in similar package colours and that virtually every colour is in use by the cookie manufacturers, making it almost impossible to select new colours without using a colour already in use; the primary colours red, yellow and blue are widely used and that since consumers, when selecting cookie and cracker products in stores are often confronted with a wide array of similarly coloured cookie and cracker products, it is probable that such consumers are less likely to be confused or misled merely by similarities in the colour of packaging. It was further held that to establish a cause of action for trade dress infringement, the plaintiff must prove that its trade dress is protectible i.e. it is inherently distinctive or has acquired secondary meaning and that there is a likelihood of confusion. It was yet further observed on a cursory

glance at almost every single package of cookies introduced into evidence in that case established that photograph of the cookie products on the front and on the side of the packaging was extremely common, almost universal, as was the use of descriptive phrases to describe the qualities of the product.

(IX) This Court in *Colgate Palmolive Company Limited Vs. Patel* (2005) 31 PTC 583 was concerned with a suit for permanent injunction restraining passing off by the defendant of its toothpaste 'AJANTA' as that of the plaintiff under the mark 'COLGATE', by use by the defendant of the red carton with the word 'AJANTA' inscribed on the said red carton in white colour and other print also on the carton in white colour, as on the carton of the plaintiff's toothpaste under the mark 'COLGATE'. Citing a host of case law developed in the US Courts, it was held that colour *per se* cannot be claimed as a trade mark and that colour must combine with other things to acquire a distinctive design which may afford protection. It was further held that red, yellow and blue are primary colours and on mixture whereof, all other hues of the colour can be created and that exclusivity and monopoly of a colour and colour scheme is not favoured. It was also held that not only is the colour red one of the seven primary colours but along with white and black colours has in fact been described as one of the three basic colours in nature. The earlier judgment in *Colgate Palmolive Co. Vs. Anchor Health & Beauty Care* supra on which the counsel for the plaintiff has placed reliance was noticed as also holding that though no party can have monopoly over a particular

colour but if there is substantial reproduction of colour combination in the similar order which over a period has been imprinted upon the minds of customers, it certainly is liable to cause not only confusion but also dilution of distinctiveness of colour combination.

(X) I may in this regard notice that the plaintiff herein claims use of the packaging, of which passing off is alleged, only since the year 2015 though in the application for registration of trade mark 'BUTTER DELITE', filed in the year 2016, had claimed that the same was proposed to be used. The defendant also claims use of the impugned packaging since the year 2016. The plaintiff has not specifically pleaded the date from which the defendant is using the impugned packaging. For this reason also, the length of time for which the plaintiff has been using the packaging of which passing off is alleged, if at all from before use the impugned packaging by the defendant, was for a short span of time only, not qualifying as long, so as to be imprinted on the minds of the customers.

(XI) Recently in ***Luxembourg Brands S.A. R.L. Vs. G.M. Pens International Pvt. Ltd.*** (2018) 254 DLT 603, relying on ***Colgate Palmolive Co. Ltd Vs. Patel*** supra, it was held to be well settled that no person can claim monopoly on the use of the basic colours.

(XII) Reference may also be made to the judgment of the Supreme Court of the United States in ***Wal-Mart Stores, Inc. Vs. Samara Brothers, Inc.*** MANU/USSC/0027/2000, also reiterating with respect to colour category of marks, that no colour mark can ever be

inherently distinctive. It was held that colour is unlike a fanciful, arbitrary or suggestive mark since it does not automatically tell a customer that it refers to a brand and does not immediately signal a brand or a product source. It was further reasoned that in case of colour, the consumer predisposition to equate the feature with the source does not exist. Reliance was placed on the earlier judgment in *Qualitex Co. Vs. Jacobson Products Co.* MANU/USSC/0028/1995 and which is also found to have reasoned that a colour serves a significant non-trade mark function— whether to distinguish a heart pill from a digestive medicine or to satisfy the noble instinct for giving the right touch of beauty to common and necessary things, but the Courts while allowing colour as a trade mark and exclusive use thereof will keep in mind that it should not interfere with legitimate competition, by excluding other competitors from use of an important product ingredient and it should not discourage competitors from creating aesthetically pleasing mark designs which they are entitled to do.

(XIII) The High Court of Justice, Chancery Division also in *Imperial Group Plc. Vs. Philip Morris Limited* [1984] R.P.C. 293, concerned with the question, whether adoption by the manufacturers of cigarettes under the mark “Raffles”, of a black pack with gold embellishments resembling the packaging of the “John Player Special” or “JPS” cigarettes of the plaintiff constituted a colourable imitation of the get-up of the cigarette pack of the plaintiff, held that nobody seeing or buying a pack of “Raffles” could for one moment imagine that they were seeing or buying a pack of “John Player Special” or “JPS”. It

was held that the test to be applied is, whether the defendants' goods are calculated to be mistaken for the plaintiffs' and applying the said test, it was found that the features in which the two resembled each other were common to the trade and black alone or black with gold embellishments in the field of packs of cigarettes could not deceive anyone into buying the cigarettes of the defendant, thinking the same to be the cigarettes of the plaintiff. It was further held that the name "John Player Special" or "JPS" on the one hand on the pack of cigarettes of the plaintiff and the name "Raffles" on the pack of cigarettes of the defendant on the other hand was proper and sufficient distinction to prevent any such deception.

(XIV) The counsel for the plaintiff has also laid much emphasis on, butter on both the packaging being depicted in curly shape. To appreciate the same, I may highlight that the plaintiff has not raised any objection to the trade mark 'BUTTER KRUNCH' of the defendant No.2 RUPL. It is not the case of the plaintiff that use by the defendant No.2 RUPL of 'BUTTER KRUNCH' amounts to passing off the same as 'BUTTER DELITE' of the plaintiff. Similarly, though objection is taken to the placement of the words 'Namkeen Butter Biscuits' in both the packaging but not to use of the words 'Namkeen' or 'Butter' or 'Biscuits'. Butter, if required to be depicted, cannot be depicted in the shape in which it is generally found in homes and shops i.e. in a brick or slab form and in which form if depicted on advertisements and packaging would be not identified as butter and to be recognized as butter in all advertisements, is shown in curly shape

as in packaging of both. It is so shown also in the packaging of Britannia Good Day Rich Butter Cookies, McVitie's Butter Cookies, Parle 20-20 Butter Cookies and Unibic Butter Cookies. Thus, the curly shape in which butter is shown on the packaging of both plaintiff and defendant, is also found to be generic.

(XV) In my opinion, when judging such generic similarities, the dissimilarities which stand out and which prevail over the similarities also count. I have already in order dated 10th January, 2019 observed that the use of the mark 'PRIYAGOLD' engrossed on a white background on the packaging of the plaintiff and 'RAJA' engrossed on a yellow background on the packaging of the defendant No.2 RUPL alone is enough to prevent the biscuits of the defendant No.2 RUPL being confused with the biscuits/cookies of the plaintiff.

(XVI) Besides to *Imperial Group Plc.* Supra in which "Raffles" prominently displayed on the cigarette pack of the defendant was held to be sufficient to distinguish from the cigarette pack "John Player Special" or "JPS" of the plaintiff in spite of the packaging being of identical colour black with gold embellishments, reference in the Indian context may be made to *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories* AIR 1965 SC 980 holding, that while in the case of infringement of trade mark, if the essential features of the 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, but 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. Applying the said principle in ***Kellogg Company Vs. Pravin Kumar Bhadabhai*** 1996 (36) DRJ, a Division Bench of this Court declined an injunction inspite of close resemblance in the cartons of the plaintiff and the defendant, owing to the name “AIMS” written prominently on the defendant’s carton which was held to defeat the claim, of intention of the defendant to misrepresent his goods for that of the plaintiff. It was held that the question, in cases of passing off is, whether the thing taken in its entirety, looking at the whole thing, is such that in the ordinary course of things a person with reasonable apprehension and with proper eyesight would be deceived. It was held to be impermissible to say that “the square on the left side top had a small red and green border and or there was a red band horizontally and defendant's carton if examined from close quarters, showed these feature”. It was further held that since viewed as a whole, one can see the words “Kellogg's”, and “AIMS” prominently displayed on each carton there could be no confusion.

(XVII) Mention may also be made of:

- (i) ***S.M. Dyechem Ltd. Vs. Cadbury (India) Ltd.*** (2000) 5 SCC 573, holding that the occurrence of the name “CADBURY” on the defendant’s wrapper was a factor to be considered while deciding the question of passing off and that

the presence of the defendant's name on its goods was an indication that there was no passing off, even if the trade dress was similar.

(ii) ***Star Bazaar Pvt. Ltd. Vs. Trent Ltd.*** 2010 (43) PTC 154 (Del) where the Division Bench of this Court held that one of the primary requirements for the grant of injunction in case of passing off is that customers of the plaintiff might be led to believe or might be confused between the goods of the plaintiff and the goods of the defendant. Finding the defendant in that case ready to add the words "TATA Enterprise" above the words "Star Bazaar" in respect of the same services, it was held that it was unlikely that there would be any confusion in the mind of any customer that the retail departmental store of the defendant was the same as the retail departmental store of the plaintiff.

(iii) ***Intex Technologies (India) Ltd. Vs. AZ Tech (India)*** (2017) 239 DLT 99 (DB) holding that the added matter in the form of the word mark "INTEX" to the word "AQUA" common to the plaintiff as well as the defendant was prominent and distinct as to dispel any chance of even an initial confusion.

(iv) ***Kuber Khaini Pvt. Ltd. Vs. Prabhooolal Ramratan Das Pvt. Ltd.*** 2002 (24) PTC 135 (Cal), the plaintiff wherein was carrying on business of manufacture and marketing of khaini, chewing tobacco, pan masalas, gutkhas etc. in pouches of a

distinct design, colour scheme and get-up, in the name of “KUBER”. The claim of the plaintiff was that the defendant was also selling the same goods in pouches and sachets having design, get-up, colour scheme and dimensions deceptively similar to that of the plaintiff and under the mark "CHAKOR". It was further the case of the plaintiff that the purchaser would not be able to read the name "CHAKOR" on the pouch and will be guided by the get-up of the same and be deceived into buying the goods of the defendant, treating the same to be of the plaintiff. It was held that, (i) dissimilarities appearing on the face of the pouches/wrappers left no scope for purchaser being misled; (ii) different name was a piece of evidence that the buyer will go by the name as well and again there was no question of being deceived; and, (iii) marks, names and get-up must always be considered as a whole thing to judge whether the totality of the impression given was likely to cause mistake, deception or confusion.

(XVIII) As far as the other elements listed by the plaintiff in its comparative table reproduced above, of placement of different ingredients of packaging is concerned, again considering the similar size of the product and the resultant similar size of the packaging, the placement of various ingredients has to be such that while picking up the product the various ingredients of packaging are not covered and remain visible to the naked eye. On a small packaging, the contents necessarily have to be on one side thereof and cannot be equally

distributed and some of which will then get covered, while handling the product.

(XIX) Mention may also be made of *King & Co. Ltd. Vs. Gillard* [1905] 22 R.P.C. 327 where the claimant was trading in preparations for soup in packets with printing, put in steel boxes of a certain kind with the letters “EDWARDS” displayed thereon. The defendant started selling similar products in a series of similar boxes under the name “GILLARDS” appearing at the place where “EDWARDS” appeared on the plaintiff’s goods. It was concluded that the words “EDWARDS” and “GILLARDS” were displayed prominently on the respective cartons, obviating any scope for confusion despite unmistakable similarity in the appearance of packets and boxes.

(XX) In *J&P Coats Ltd. Vs. Chadha & Co. (India)* (1967) 3 DLT 595, though colour of rival boxes of thread were similar, the Court held that even the illiterate users may well be expected to distinguish between the opposite marks “DOG” and “ANCHOR”.

(XXI) In my opinion, the element of brand loyalty if any of the goods of the plaintiff will not let the consumers thereof eschew the all-important trade mark on the goods that he intends to buy.

(XXII) Rodney D. Ryder, Advocate and Author in his textbook “Brands, Trademarks and Advertising” 2002 Edition, dealing with the psychological basis of brand imitation has authored on the basis of surveys, research and experiments done, that (i) consumer buying

behaviour is a complex process and much of it is conducted subconsciously; (ii) the first step in the decision making process is perception of the stimulus or object; (iii) in order to perceive an object or stimulus, the consumer must pay attention to it; (iv) intensity is the time spent actually looking at the object; the longer the consumer looks at the object, the greater the chance that it will be perceived; (v) direction refers to the object being in focus; (vi) obviously, to perceive an object the consumer must focus on the object and spend time looking at it; (vii) in directing the attention of the consumer, visual as opposed to semantic information has a significant impact; thus the size and colour of the object can affect its ability to attract attention; (viii) when a consumer first perceives a stimulus, that is within the first 200 milliseconds, he / she views it holistically to determine where to focus his / her attention in order to find the information that he / she is searching for; (ix) an individual's processing capacity is limited and so the individual is looking for the easiest way to achieve his / her goal with least effort; (x) by means of selective attention, the individual determines where to focus his / her attention to find the information that he / she is searching for, for example brand name, price, weight etc.; (xi) having perceived an object and stimulus, these perceptions are then interpreted by the individual subconsciously, based on the individual's previous experience and in the light of what he / she expects to see; (xii) the principles underlying perceptual organization are sometimes referred to as "Gestalt Psychology"; the basic premise

of “Gestalt Psychology” is that people do not experience the numerous stimuli they select from the environment as discrete sensations but rather they tend to organize them into groups and see them as a whole; (xiii) the organization of stimuli into groups helps to memorise and recall them; and, (xiv) consumers therefore tend to remember the overall look of a product rather than individual details of the packaging such as font, colour, text etc.

(XXIII) Applying the aforesaid psychological basis also, I am of the view that the consumer is likely to remember and recall the goods of the plaintiff with ‘PRIYAGOLD’ and / or ‘BUTTER DELITE’ and it is not even the case of the plaintiff that there is any similarity thereof with ‘RAJA’ and / or with ‘BUTTER KRUNCH’.

18. Once it is so, even if on trial, it is found that the plaintiff is the prior adopter of the subject packaging, the plaintiff would not be entitled to any relief and it is thus not deemed necessary to put the suit to trial. Order XV-A of CPC as applicable to commercial suits, as the present suit is, permits decision thereof issue-wise and if a finding on an issue defeats the claim even if the finding on other issues, after trial, were to be in favour of the plaintiff, permits dismissal of the suit, so as to not consume the time of the Court.

19. The plaintiff is thus not found entitled to the reliefs claimed in the suit.

20. The suit is dismissed.

21. The counsel for the defendants having not contributed to the hearing and having contested the suit in a lackadaisical manner, no costs.

Decree sheet be drawn up.

RAJIV SAHAI ENDLAW, J.

MARCH 26, 2019

‘bs/pp/gsr’

(corrected & released on 25th April, 2019)

