



C.S.(Comm. Div.) No.713 of 2015

IN THE HIGH COURT OF JUDICATURE AT MADRAS

|               |            |
|---------------|------------|
| Reserved on   | 28.02.2023 |
| Pronounced on | 09.06.2023 |

CORAM

THE HONOURABLE **MR.JUSTICE C.SARAVANAN**

**C.S. (Comm. Div.) No.713 of 2015**

M/s.Veppolodai Chemicals,  
No.13-A/1 Pillayar Koil Street,  
Meenakshipuram West,  
Tuticorin – 628 002,  
Tamil Nadu,  
Represented by its Partner Mr.Michael Motha,  
residing at Flat No.17, 3<sup>rd</sup> Floor,  
R.M.Towers, No.107, 108,  
Chamiers Road,  
Nandanam,  
Chennai – 600 018.

... Plaintiff

Vs.

1. DS Spiceco Private Limited,  
Registered Office at 4828/24, Prahlad Lane,  
Ansari Road, Daryaganj,  
New Delhi – 110 002  
and also at  
B-6, 17, 18, 19, Sector – 3,  
Noida – 201 301,  
Uttar Pradesh.



C.S.(Comm. Div.) No.713 of 2015

2. D.S.Intellectual Properties Private Limited,  
4828/24, Pranolad Lane,  
Ansari Rod,  
Darya Ganj,  
New Delhi – 110 002.

... Defendants

Civil Suit (Commercial Division) filed under Order IV Rule 1 of the Original Side Rules and Order VII Rule 1 of C.P.C., to pass a Judgment and Decree against the defendant;

- a) granting a permanent injunction, restraining the Defendants, by themselves, their servants, agents, distributors, or anyone claiming through them from manufacturing, selling, offering and advertising for sale using the Trade Mark SPRINKLERS/SPRINKLE upon the goods or in relation to salt, spices and allied goods or in the course of any media and use the same in Invoices, letter heads and visiting cards or any other trade literature which is in any way visually, or deceptively similar to the Plaintiff Registered trademark SPRINKLE or in any manner infringing the Plaintiff Registered Trade Mark Nos.592204, 1398971, 1398972.
- b) granting a permanent injunction restraining the Defendants by itself, its agents or servants or anyone claiming through or under him any business marketing, selling advertising using in trade literature, invoices, name boards, website, internet advertisements the mark/name SPRINKLERS/SPRINKLE upon



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C.S.(Comm. Div.) No.713 of 2015

the goods or in relation to salt, spices and allied goods or with respect to or any other food preparation or on any other business the impugned trademark/name which is in any manner deceptively or phonetically confusingly similar to the Plaintiff's Trade Mark/name SPRINKLE or in any other manner pass off their business or goods as and for that of the Plaintiff.

- c) Directing the defendants to surrender to the Plaintiff's all types of goods containing/bearing the Trade Mark SPRINKLERS or other deceptively similar Trade literature.
- d) For a preliminary decree in favour of the Plaintiff, directing the Defendants to render an account of profits made by them by the use of the Trade mark SPRINKLERS on the good referred and for a final decree in favour of the Plaintiff for the amount of the profits found to have been made by the Defendants, after the Defendants have rendered accounts.
- e) Directing the defendants to pay to the Plaintiff the costs of the suit; and
- f) to pass such further or other orders as may be deemed fit and proper under the circumstances of the case and thus render justice.

For Plaintiff : M/s.Gladys Daniel

For Defendants : Mr.Edward James  
Mr.Aashish Dafaria  
Mr.Vedantha Sai



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C.S.(Comm. Div.) No.713 of 2015

## **J U D G M E N T**

The plaintiff has prayed for the following reliefs in this suit:-

*a) granting a permanent injunction, restraining the Defendants, by themselves, their servants, agents, distributors, or anyone claiming through them from manufacturing, selling, offering and advertising for sale using the Trade Mark SPRINKLERS/SPRINKLE upon the goods or in relation to salt, spices and allied goods or in the course of any media and use the same in Invoices, letter heads and visiting cards or any other trade literature which is in any way visually, or deceptively similar to the Plaintiff Registered trademark SPRINKLE or in any manner infringing the Plaintiff Registered Trade Mark Nos.592204, 1398971 and 1398972;*

*b) granting a permanent injunction restraining the defendants by itself, its agents or servants or anyone claiming through or under him any business marketing, selling advertising using in trade literature, invoices, name boards, websites, internet advertisements the mark/name SPRINKLERS/SPRINKLE upon the goods or in relation to sale, spices and allied goods or with respect to or any other food preparation or on any other business the impugned trademark/name which is in any manner deceptively or phonetically confusingly similar to the Plaintiff's Trade Mark/name SPRINKLE or in any other manner pass off their business or goods as and for that of the plaintiff;*



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C.S.(Comm. Div.) No.713 of 2015

*c) directing the defendants to surrender to the Plaintiff's all types of goods containing/bearing the Trade Mark SPRINKLERS or other deceptively similar Trade literature;*

*d) for a preliminary decree in favour of the plaintiff, directing the defendants to render an account of profits made by them by the use of the Trade Mark SPRINKLERS on the good referred and for a final decree in favour of the plaintiff for the amount of the profits found to have been made by the defendants, after the defendants have rendered accounts;*

*e) Directing the defendants to pay to the plaintiff the costs of the suit.*

2. Para 16 of the plaint which deals with cause of action reads as under:-

*“16. The cause of action for the suit arose on February 2015 when the Plaintiff came across the defendants goods bearing the Trade Mark SPRINKLERS along with the house name CATCH which is similar to the Plaintiff's registered Trademark SPRINKLE. The defendant is likely to increase its advertisements and expand its business activities. Therefore the plaintiff is constrained to file this suit for infringement of its Registered Trade Mark and passing off. This Hon'ble Court has got the jurisdiction to entertain and try the suit under Section 134 of the Trademarks Act, 1999 with respect to infringement of registered trademark since the plaintiff has its office at Chennai within the*



C.S.(Comm. Div.) No.713 of 2015

*jurisdiction of this Hon'ble Court. The defendant's product SPRINKLERS are being marketed widely within the jurisdiction of this Hon'ble Court through stockists and distributors. A few sample invoices are filed as proof of sale. Therefore the jurisdiction with respect to passing off also arises within the territorial limits of this Hon'ble Court. The plaintiff is filing an application for joinder of cause of action with respect to the relief of passing off since the defendants are carrying on business outside the jurisdiction of this Hon'ble Court.*

3. O.A.Nos.942 and 943 of 2015 were filed in the present suit by the plaintiff for interim injunction to restrain the defendants from using the trade marks SPRINKLERS/SPRINKLE towards the manufacturing, selling, advertising of its goods and towards business marketing, selling advertising in trade literature, invoices, websites, etc., respectively.

4. This Court vide its order dated April 21, 2016 was pleased to dismiss the said Applications filed by the plaintiff holding that “*this Court observing that the respondents are manufacturing and working products like salt and spices by using their trade mark “CATCH” and the respondents pleaded and proved that it was only to describe the nature of product inside, the word “SPRINKLERS” has been used, and the*



C.S.(Comm. Div.) No.713 of 2015

*words “SPRINKLERS” and “SPRINKLE” are commonly used words connected to goods, which are by nature capable of sprinkling over a surface or droplets over something. It is therefore essential a generic word and there is no merit in the contention that the word “SPRINKLERS” is a specific word and the applicant has a right to use that word to the exclusion of all others and the applicant is therefore not entitled to an injunction to restrain the defendants from using the word “SPRINKLERS”.*

5. Aggrieved by the above dismissal order, plaintiff filed an appeal bearing O.S.A.Nos.158 and 159 of 2016, before this Hon’ble Court. By judgement dated July 14, 2016, the Division Bench of this Hon’ble Court disposed the said appeals of the plaintiff, holding that “... the conclusion in the impugned order is liable to be sustained on account of the fact that the respondents are selling salt and spices under their trade mark “CATCH” and the expression “SPRINKLERS” is used as an adjective for the act of sprinkling”



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6. Thus, no order of injunction was operating against the defendants in the suit. Both plaintiff and defendants have been carrying on their respective business during the last 7 years since the above suit was instituted, without any prejudice to the rights of each other. After the pleading were completed, the Court vide framed the following issues in the present suit vide order dated July 29, 2022:-

- i. Whether the mark “sprinklers” is distinctive and entitled to protection under the Trade Marks Act, 1999?
- ii. Whether the plaintiff is the prior user of the trade mark “Sprinklers”?
- iii. Whether the defendants is using the word “Sprinklers” as a mark in relation to its goods?
- iv. Whether the plaintiff is entitled to relief in respect of alleged infringement?
- v. Whether the defendants is passing off its goods as those of the plaintiff by selling products by using the terms “Catch Sprinklers”?
- vi. Whether the defendants is passing off its goods as those of the plaintiff by selling products by using the terms “Catch Sprinklers”?
- vii. Whether the parties are entitled to any other reliefs?

7. After the above issues were framed on 29.07.2022, both the parties expressed their intention to not to adduce any oral evidence as is recorded vide order dated 29.07.2021. Since the Application No.4561 of



C.S.(Comm. Div.) No.713 of 2015

2021 was filed on 18.12.2021 and came to be allowed vide order dated 22.12.2021, the case was thereafter posted before the Additional Master for marking of documents.

8. Thus, the plaintiff examined P.W.1 and marked Exhibits P1-P8.

On behalf of the plaintiff, the following documents were marked:-

| Ex.Nos. | Date       | Nature of Documents                                                                         |
|---------|------------|---------------------------------------------------------------------------------------------|
| Ex.P1   | -          | Plaintiff's label                                                                           |
| Ex.P2   | -          | Defendant's label                                                                           |
| Ex.P3   | 11.02.2015 | Legal Use Certificate of the Plaintiff No.592204                                            |
| Ex.P4   | 11.02.2015 | Legal Use Certificate of the Plaintiff No.1398971                                           |
| Ex.P5   | 11.02.2015 | Legal Use Certificate of the Plaintiff No.1398972                                           |
| Ex.P6   | -          | Sample Sale Invoices of the Plaintiff's products                                            |
| Ex.P7   | -          | Sample Advertisements and Advertising invoices of Plaintiff's products                      |
| Ex.P8   | -          | Invoices showing sale of the impugned product within the jurisdiction of this Hon'ble Court |



C.S.(Comm. Div.) No.713 of 2015

9. The defendants also examined D.W.1 and marked Exhibits

D1-D11. On behalf of the defendants, the following documents were marked:-.

| Ex.Nos. | Date       | Document                                                                                                                                                                                           |
|---------|------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Ex.D1   | 18.11.2015 | Board Resolution of DS Spiceco Pvt.Ltd dated November 18,2015 evincing Mr.Saurabh Mishra's capacity and authority to sign the requisite documents on behalf of the defendants.                     |
| Ex.D2   | 10.12.2015 | Board Resolution of Dharmpal Satyapal Sons Pvt.Ltd dated December 10, 2015 evincing Mr.Saurabh Mishra's capacity and authority to sign the requisite documents on behalf of the defendants.        |
| Ex.D3   | 21.12.2021 | Board Resolution of DS Intellectual Properties Pvt.Ltd. dated December 21, 2021 evincing Ms.Samhita Chaudary's capacity and authority to sign the requisite documents on behalf of the defendants. |
| Ex.D4   | -          | Photographs of third party usage of the word SPRINKLERS on salt/spice packaging of salt/spic manufacturers & settlers worldwide and India                                                          |
| Ex.D5   | -          | Printouts from the online dictionaries like Collins, Merriam-Webster, Random House, Cambridge, Oxford, Macmillan bearing definitions of the words SPRINKLE and SPRINKLER                           |
| Ex.D6   | -          | Printouts of recipes of renowned chefs all over the world and India illustrating                                                                                                                   |



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C.S.(Comm. Div.) No.713 of 2015

|               |            |                                                                                                                                                                                                                                                      |
|---------------|------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|               |            | usage of word sprinkle for referring to addition of salt in the dish.                                                                                                                                                                                |
| Ex.D7         | -          | Printouts from the websites <a href="http://www.tradeindia.com">www.tradeindia.com</a> & <a href="http://www.panjiva.com">www.panjiva.com</a> listing out manufacturers and suppliers of salt sprinklers as a separate category                      |
| Ex.D8         | -          | Printouts from the Defendant's website <a href="http://www.dsgroup.com">www.dsgroup.com</a> showing generic use of the word SPRINKLERS                                                                                                               |
| Ex.D9         | -          | Document evincing that Superbrand had declared CATCH as a Superbrand in the year 2009-2010                                                                                                                                                           |
| Ex.D10        | -          | Printouts from Plaintiff's website <a href="http://www.sahayamathasalteems.com">www.sahayamathasalteems.com</a> evincing that the Plaintiff does not have a pan India presence and its products are available only in a few southern states of India |
| Ex.D11        | 08.03.1993 | Documents evidencing the fact that the Plaintiff's application for registration of trademark was filed on March 8, 1993 along with the examination report issued in respect thereof.                                                                 |
| Ex.C1 & Ex.C3 |            | Xerox copies of the Trademark Certificates obtained by the defendant in Class 30                                                                                                                                                                     |

10. These documents were marked as exhibits with objections as per the statement of objection as is required under the provisions of the Commercial Courts Act, 2015. The trial was thus completed on



C.S.(Comm. Div.) No.713 of 2015

03.08.2022.

WEB COPY 11. The plaintiff is the registered proprietor of the Trademark 'SPRINKLE' in various classes as detailed below:-

**Table-1**

| Sl.No | Mark                   | Regd.No. | Date of Application | Class | Renewal Valid |
|-------|------------------------|----------|---------------------|-------|---------------|
| 1.    | Sprinkle (Label)       | 592204   | 08.03.1992          | 30    | 08.03.2023    |
| 2.    | Sprinkle (Word Per Se) | 1398967  | 14.11.2005          | 1     | 14.11.2015    |
| 3.    | Sprinkle (Word Per Se) | 1398968  | 14.11.2005          | 13    | 14.11.2015    |
| 4.    | Sprinkle (Word Per Se) | 1398970  | 14.11.2005          | 23    | 14.11.2015    |
| 5.    | Sprinkle (Word Per Se) | 1398971  | 14.11.2005          | 30    | 14.11.2015    |
| 6.    | Sprinkle (Word Per Se) | 1398972  | 14.11.2005          | 30    | 14.11.2015    |
| 7.    | Sprinkle (Word Per Se) | 1398973  | 14.11.2005          | 42    | 14.11.2015    |

12. The mark has been registered both as a Word Mark and as a Device Mark. These Marks have been used for marketing iodized salt by the plaintiff. The plaintiff claims to be using the aforesaid mark since 1986-1987 and claims to have gained huge turnover and reputation. The



C.S.(Comm. Div.) No.713 of 2015

plaintiff claims to have also spent huge amounts in advertising and promoting the aforesaid Trademark for iodized salt.

13. In the plaint, the plaintiff has declared the following turnover from 1986-1987 upto 2013-2014:-

**Table – 2**

| Year      | Turnover          | Advertisement Expenses |
|-----------|-------------------|------------------------|
| 1986-1987 | Rs.3,37,962/-     | Rs.27,727/-            |
| 1987-1988 | Rs.13,92,044/-    | Rs.91,665/-            |
| 1988-1989 | Rs.70,04,099/-    | Rs.7,02,987/-          |
| 1989-1990 | Rs.5,09,268/-     | Rs.5,37,614/-          |
| 1990-1991 | Rs.83,55,353/-    | Rs.2,39,810/-          |
| 1991-1992 | Rs.1,17,43,812/-  | Rs.1,77,229/-          |
| 1992-1993 | Rs.1,32,34,489/-  | Rs.7,73,862/-          |
| 1993-1994 | Rs.1,71,46,613/-  | Rs.3,09,694/-          |
| 1994-1995 | Rs.2,36,31,269/-  | Rs.6,55,955/-          |
| 1995-1996 | Rs.3,66,83,407/-  | Rs.6,06,147/-          |
| 1996-1997 | Rs.3,93,72,087/-  | Rs.5,77,318/-          |
| 1997-1998 | Rs.4,56,54,826/-  | Rs.3,81,141/-          |
| 1998-1999 | Rs.5,55,39,134/-  | Rs.3,75,112/-          |
| 1999-2000 | Rs.6,38,50,206/-  | Rs.3,57,042/-          |
| 2000-2001 | Rs.6,94,89,622/-  | Rs.4,09,785/-          |
| 2001-2002 | Rs.8,28,26,135/-  | Rs.2,89,600/-          |
| 2002-2003 | Rs.9,11,92,465/-  | Rs.5,55,690/-          |
| 2003-2004 | Rs.9,50,85,151/-  | Rs.18,81,579/-         |
| 2004-2005 | Rs.10,00,35,725/- | Rs.6,81,388/-          |
| 2005-2006 | Rs.14,85,64,163/- | Rs.5,03,892/-          |



C.S.(Comm. Div.) No.713 of 2015

|           |                   |                |
|-----------|-------------------|----------------|
| 2006-2007 | Rs.15,09,55,073/- | Rs.3,92,434/-  |
| 2007-2008 | Rs.15,18,08,080/- | Rs.8,05,531/-  |
| 2008-2009 | Rs.26,26,64,870/- | Rs.8,43,886/-  |
| 2009-2010 | Rs.21,29,15,428/- | Rs.4,68,126/-  |
| 2010-2011 | Rs.19,04,53,670/- | Rs.35,76,663/- |
| 2011-2012 | Rs.24,88,67,865/- | Rs.7,77,507/-  |
| 2012-2013 | Rs.23,75,78,681/- | Rs.6,81,901/-  |
| 2013-2014 | Rs.24,81,33,246/- | Rs.8,28,256/-  |

14. The plaintiff is aggrieved by the use of the word “SPRINKLERS” by the defendant along with bearing registered Trademark CATCH for marketing their iodized table salt, chat masala, black pepper etc. The registered label of the plaintiff in TM.No.592204 and the defendants are as under:-

**Table -3**



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C.S.(Comm. Div.) No.713 of 2015

|                                                                       |  |
|-----------------------------------------------------------------------|--|
| Plaintiff's use<br>of the word<br>Sprinkle for<br>its Iodized<br>Salt |  |
|-----------------------------------------------------------------------|--|

**Table-4**



C.S.(Comm. Div.) No.713 of 2015

Defendant's use of the word Sprinklers for its products viz. Table Salt, Chat Masala and Black Pepper.



15. It is the specific case of the plaintiff that the use of the word



C.S.(Comm. Div.) No.713 of 2015

“SPRINKLERS” by the defendants for marketing iodized table salt, chat masala and black pepper etc. amounts to infringement of the registered Trademark of the plaintiff and an attempt to pass off their product as that of the plaintiff.

16. It is the case of the plaintiff that the defendants are using the word “SPRINKLERS” which is similar to the plaintiff’s registered Trademark “SPRINKLE” as above for the same product, same/similar class of good/goods and cater to same class of consumers.

17. It is therefore submitted that both the plaintiff and the defendants are marketing their products through the same trade channel and thus there is not only infringement but also passing off by the defendant.

18. The learned counsel for the plaintiff submitted that the plaintiff is engaged in the business of processing salt into refined salt and iodized



C.S.(Comm. Div.) No.713 of 2015

salt since 1986. In the course of the business, the plaintiff adopted the distinctive Trade Mark “SPRINKLE” when no other manufacturer or marketers had adopted the said trademark for their goods. As a result of the plaintiff’s efforts over these years and the quantity of the product sold, the plaintiff enjoys recognition, goodwill and reputation in the market.

19. It is submitted that the consumer associate the word SPRINKLE only with the plaintiff and thus the adoption of the word SPRINKLER by the defendants was nothing but an slavish imitation of the plaintiff’s well known trademark. Copies of sample sales invoices for the period 2009 to 2021 was marked as Ex.P6.

20. It is submitted that the Plaintiff has also spent considerable amount of money in spreading awareness about its product under the Trademark “SPRINKLE”. The copy of the sample advertisements and advertising invoices for the period 2002 to 2018 is also marked as Ex.P7.

21. It is stated that owing to the plaintiff’s hard earned goodwill and



C.S.(Comm. Div.) No.713 of 2015

reputation, the plaintiff acquired the Registration for the device mark of “SPRINKLE” (Exhibit P1) under No.592204 dated 08.03.1993 in class 30 with respect to Iodised salt. The legal use certificate of the said trademark is marked as Ex.P3.

22. The plaintiff secured registration for the trademark “SPRINKLE” (Word Per Se) in several classes including class 30 as under Nos.1398971 & 1398972 dated 14.11.2005. The legal use certificate of Trademark Nos.1398971 & 1398972 are also marked as Exs.P4 & P5.

23. It is submitted that in view of the above mentioned registrations, the plaintiff has an exclusive right over the Trademark “SPRINKLE” and thus, legally entitled to protection of its widely used and famous mark from any attempt of infringement and passing off by third parties including the defendants in the present suit.

24. It is stated that during February 2015, the plaintiff came across the defendant’s product bearing the Trademark “SPRINKLERS” along



C.S.(Comm. Div.) No.713 of 2015

with the house name Catch in respect of table salt, black pepper and chat masala as seen from Exhibit P2, which is both visually and phonetically similar to the plaintiff's registered Trade Mark "SPRINKLE".

25. It is thus submitted that use of the offending word "SPRINKLERS" amounts to infringement and passing off of the plaintiff's trademark. Hence, the subject suit was filed on 19.03.2015 and taken on file as C.S.No.713 of 2015.

26. The defendants have filed their Common Written Statement on 21.12.2015. The defendants in their Written Statement, the defendants have disputed the case made out by the plaintiff in the plaint. It is submitted that the first defendant has been in the business since 1956. The first defendant is the licensee and the second defendant is the registered proprietor of the Trademark.

27. In the Written Statement it has been further stated that the



C.S.(Comm. Div.) No.713 of 2015

defendants are the proprietors of leading brand “CATCH” for food and beverage articles and manufacture and sale of whole variety of products such as salt, pepper, spices, seasonings, packaged natural spring water, soda, tonic water, gold and silver wark, etc.

28. It is further stated in the Written Statement that the defendants were the first to introduce free flowing salt in an attractive and user friendly and attractive dispenser and brought the usage of salt directly to the dining table with their registered and well known Trademark “CATCH”.

29. It is further case of the defendants that the CATCH table top rotator dispenser is commonly called “Sprinklers” was a landmark innovation and gave the Indian consumer a new, convenient and world-class experience and soon numerous spice variants were introduced with the said packaging.

30. It is submitted that unrivaled products sold under the Trademark CATCH are complemented by excellent packaging making them a winning



C.S.(Comm. Div.) No.713 of 2015

product. Easy to use, convenient and high on hygiene, dispenser which is a Sprinkler became a perfect tabletop essential for every household.

31. According to the defendants, the word Sprinklers signifies the dispensers fitted with a rotating plastic cap that keeps out dampness keeping the spices and salt fresh and ensures dry free flowing of special salt. pepper or chat masala etc. packaged in it. as and when required.

32. It is submitted that the word Sprinklers is not used as a trade mark although it is part of their label. It is submitted that there is no scope for confusion between the plaintiff's Iodized Salt with their registered Trademark "SPRINKLE" with that of the dispenser used by the defendant with the word "SPRINKLERS.

33. The defendants on the other hand have also given a consolidated sales figure in the corresponding advertising expenses incurred by them from 2005-2006 to 2014-2016 in their Written Statement.



C.S.(Comm. Div.) No.713 of 2015

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34. As far as the complaint of the plaintiff that the use of the word “SPRINKLERS” either violating or infringing the plaintiff Trademark “SPRINKLE”. It is submitted that the case of the defendants that the word “SPRINKLERS” is a generic word used commonly in the salt trade.

35. It is submitted that the word “SPRINKLERS” is popularly and commonly used since ages to refer to and describe a dispenser, small container or bottle or pack made of plastic or glass or stainless steel with perforations or holes in the cap with a rotating lids to facilitate easy sprinkling i.e., free flow of grains of salt or spices over food.

36. It is submitted that there are a number of salt manufacturers and sellers in India as well as other countries who pack and sell their salt and spice products in such small containers/dispensers with perforations on the cap and call them “SPRINKLERS”. A few examples cited are as follows:-



C.S.(Comm. Div.) No.713 of 2015

- a. TATA
- b. EVEREST
- c. NANDOS
- d. SECRET CHEF
- e. BRAAI RUB
- f. CHEF'S CHOICE
- g. MALDON

37. It is submitted that the word “SPRINKLER” is derived from the English word “SPRINKLE” and commonly means a device perforated with small holes on the cap, which is used to scatter water or particles over something. Various English dictionaries of the word such as Collins, Merriam Webster, Random House, Cambridge, Oxford, Macmillan, commonly define the words SPRINKLE and SPRINKLER as follows:-

a. Collins

*Sprinkle- to scatter (liquid, powder, etc. in tiny particles or droplets over something), to drizzle lightly.*

*Sprinkler – a device perforated with small perforations that is attached to a garden hose..., a person or thing that sprinkles.*



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C.S.(Comm. Div.) No.713 of 2015

*b. Macmillian*

*Sprinkle- to shake small amounts of a liquid or a substance such as sugar over the surface of something.*

*Sprinkler – A piece of equipment used for automatically sprinkling water on plants or grass in a garden.*

*c. Cambridge*

*Sprinkle – to drop a few pieces or drops of something over a surface*

*Sprinkler – a device with a lot of small holes that you put on the end of a hose in order to water plants*

*d. Oxford*

*Sprinkle – cover an object or surface with small drops or particles of a substance*

*Sprinkler – a device that sprays water*

*e. Merriam Webster*

*Sprinkle – to drop or spread small pieces or amounts of something over something.*

38. It is further submitted that the word SPRINKLE is very closely connected with the salt product (and spices) since one of the ways to add salt or spices to the food is to **sprinkle** and it is can be described as an act of sprinkling salt. It is reiterated that salt can only be **sprinkled** on the



C.S.(Comm. Div.) No.713 of 2015

food as the word “**sprinkled**” does not have any synonym, which can appropriately describe such an act. While the words such as scatter, smatter or disperse may come close to mean such an act, it is the word “**sprinkle**” which by custom and usage has come to be associated and is solely associated with and used to describe the act of adding grains of salt to food.

39. It is further submitted that the word “SPRINKLERS” has a generic connotation, *inter alia*, in the salt trade is lucidly illustrated by the fact that various online trade directories like Trade India, Panjiva have a separate listing for manufacturers and suppliers of salt sprinklers.

40. It is further submitted that the word “SPRINKLER” is so closely connected and associated with the salt product as explained above and therefore it would be unjust and unfair to allow a single trader to monopolize the said word to the exclusion of others in respect of any salt related product. It would be further unjust and unfair to allow a single



C.S.(Comm. Div.) No.713 of 2015

trader to register and obtain exclusive rights in the word SPRINKLE in respect of salt product so that he can prevent honest traders from using its derivatives such as “SPRINKLERS” in respect of small bottles or containers with perforations on the cap commonly and widely used to dispense and add salt to food.

41. It is further stated that the respondents/defendants are merely using generic word “SPRINKLERS” to refer to a small dispenser/container of salt manufactured and marketed under its well known and famous brand name and trademark CATCH. The said fact is apparent exclusive rights in the word “SPRINKLE” in respect of salt product so that he can prevent honest traders from using its derivatives such as “SPRINKLERS” in respect of small bottles or containers with perforations on the cap commonly and widely used to dispense and add salt to food.

42. It is further stated that the defendants are merely making generic use of the word “SPRINKLERS” to refer to its small containers of salt manufactured and marketed under its well known and famous brand name and Trademark CATCH. The said fact is apparent not only from the use of the mark on its packaging but also from the references made to the word



C.S.(Comm. Div.) No.713 of 2015

“SPRINKLERS” on its website and promotional material. Sprinklers has been mentioned as a product category in its spice range along with straight spices, blended spices, straight premium spices and Hin (asafoetida).

43. It is further stated that the plaintiff has been making generic use of the word “SPRINKLE” in advertising its salt product. The advertisements filed as documents clearly show that the plaintiff is promoting its salt product as “Iodised and prepared for sprinkling”. It also claims that its salt is without any lumps and “For sprinkling easily”.

44. It is submitted that The said advertisement clearly shows the plaintiff’s double standards that while on the one hand it makes generic use of the word “SPRINKLE” in its advertisement and on the other it has obtained registration of the said word and is preventing other traders from making the legitimate use of the same or its derivatives such as “SPRINKLERS” as a descriptor or generic word in the trade.



C.S.(Comm. Div.) No.713 of 2015

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45. It is submitted that, in fact the plaintiff is estopped from exercising any monopoly rights, it may have in view of the fact that it has itself used the word “SPRINKLE” in a generic sense in its advertisements.

46. The plaintiff also filed its Reply Statement on 24.02.2016, when it was stated that some facts stated in the defendants Written Statement had to be dealt by way of a Reply Statement but the same was returned for certain compliance. Owing to the delay in representation of the Reply Statement, an Application No.875 of 2021 in the subject suit was filed by the plaintiff on 15.11.2017 to condone the delay in representation of the Reply Statement.

47. The said application was allowed by an order dated 29.06.2021 in spite of objections raised by the defendants through their counter affidavit dated 25.06.2021, thereby condoning the delay in representing the Reply Statement.



C.S.(Comm. Div.) No.713 of 2015

48. The Plaintiff also filed an Application No.4561 of 2021 in the subject suit on 18.12.2021 to receive additional documents; 'Sample Sales Invoices (2009-2021)' & 'Sample Advertisement and Advertising invoices (2002-2018)'. On being satisfied with the relevancy, proof and admissibility of the above documents, this Court also allowed the said application in Application No.4561 of 2021, vide order dated 22.12.2021, and as a result, these documents were marked as Exhibits P6 & P7, respectively.

49. It is further stated that the defendants have failed to make out a case to dismiss the suit. The plaintiff has filed necessary documents and established the contentions in the plaint and are seeking a decree as prayed for.

50. In support of his contention, the learned counsel for the plaintiff has placed reliance on the following case laws:-

- i. ***Ruston & Hornsby limited vs. The Zamindara Engineering Company,***  
***MANUC/SC/0304/1969;***
- ii. ***Kaviraj Pandit Durge Dutt Sharma vs. Navaratna Pharmaceutical Laboratories,***  
***MANU/SC/0197/1964;***



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C.S.(Comm. Div.) No.713 of 2015

- iii. ***Corn Products Refining Company vs. Shangrila Food Products Limited, MANU/SC/0115/1959;***
- iv. ***Kores (India) Limited vs. Doms Industries Private Limited, MANU/DE/0729/2022.***

51. The learned counsel for the defendants in their Written Statement have stated that the defendant No.2 is the registered proprietor and licensor of the Trademark “CATCH” and the defendant No.1, is a licensee thereof. The defendants are part of a vast multi-diversified conglomerate Dharmapal Satyapal Group (“DS Group”) having a turnover of over 6500 crores. The DS Group is one of the leading FMCG conglomerates in India and was founded in the year 1929.

52. In support of their contentions the learned counsel for the defendants have relied on the following case laws:-

- i. ***Standard Electricals Limited vs. Rocket Electricals and Others, (2004) 72 Del 794;***
- ii. ***Free Elective Network Private Limited vs. Matrimony.com Limited, C.S.No.122 of 2021;***
- iii. ***ITC Limited vs. Nestle India Limited, 2020 SCC Online Mad 1158;***
- iv. ***Three-N-Products Private Limited vs. Kairali***



C.S.(Comm. Div.) No.713 of 2015

***Exports and Others, 246 (2018) DLT 691;***

- v. ***Asian Paints Limited vs. Home Solutions Retail (India) Limited, 2007 (35) PTC 697;***
- vi. ***ITC Limited vs. Nestle India Limited, (DB) (OSA.No.170 of 2020);***
- vii. ***ITC Limited vs. Nestle India Limited, S.L.P.No.5651 of 2021;***
- viii. ***S.Syed Mohideen vs. P.Sulochana Bai, 2016 (66) PTC 1 SC.***

53. It is stated that the defendants are the proprietors of the country's leading Food and Beverage brand CATCH and manufacture and sell a whole variety of products under the Trademark CATCH including salt, pepper, spices, seasonings, packaged natural spring water, soda, tonic, water, gold and silver vark, etc. Salt and spices sold under the Trademark CATCH are known for their matchless product quality, original aroma and wholesome flavor of authentic spices. The defendants' CATCH branded products are of the highest standards and are identified as such by the trade and public.

54. It is stated that a large variety of CATCH spices are sold in different packaging of small boxes, sachets and sprinklers. The defendants



C.S.(Comm. Div.) No.713 of 2015

use sprinkler packs primarily for Table salt, Chat masala, Black pepper, Black salt, Dahi masala and Sendha namak, whereas kitchen range of blends, pure spices and whole spices are sold in boxes and sachets.

55. The defendants submit that the word “SPRINKLERS” is not distinctive and the plaintiff is not entitled to protection under the Trade Mark Act, 1999; and the defendants are not using the word “SPRINKLERS” as a mark in relation to its goods.

56. On behalf of the defendants, at the outset, it is respectfully submitted that the plaintiff has filed the present suit on baseless grounds which have no merit in law merely with an intent to cause harassment to the defendants and secure a monopoly over generic and descriptive term in the trade “SPRINKLER” and is presenting an inaccurate and distorted picture regarding use of the word “SPRINKLERS” by the defendants.

57. It is a settled position that descriptive and generic common words are not entitled to protection under the Act. They are hit by Section 9(1) of the Act. In so far as the word “SPRINKLE/SPRINKLER” is



C.S.(Comm. Div.) No.713 of 2015

concerned, it is submitted that the same is both a generic and common word as used in the trade of salt and spice manufacturing and marketing, it is also generally used to refer to an describe a small container or bottle with perforations or holes in the cap to facilitate sprinkling, i.e., the free flow of grains or salt or spices over food.

58. It is stated that in the case of **Standard Electricals Limited** vs. **Rocket Electricals and Ors.**, (2004) 72 Del 794, the Hon'ble Delhi High Court has held that, "The word STANDARD is a common English language word and is highly laudatory and is incapable of being appropriated by any single person/company."

59. It is submitted that in the case of **Asian Paints Limited** vs. **Home Solutions Retail (India) Limited**, 2007 (35) PTC 697, the Bombay High Court held that, "The expression "Home Solutions" was inherently incapable of becoming distinctive of any single person with respect of any single product or service. It is generic and *publici juris*. It describes the nature of services offered. Thus understood, at this stage of the proceedings, it was held that it was not possible to accept the plaintiff's



C.S.(Comm. Div.) No.713 of 2015

claim that it has unique enviable reputation and exclusive goodwill to the mark “HOME SOLUTIONS”.”

60. Further, it was submitted by the Supreme Court, in the case of **Skyline Education Institute Private Limited vs. S.L.Vaswani and Others**, (2010) 2 SCC 142, held that “the word ‘Skyline’ was a generic word because the same is being used by thousands of persons and institutions as part of their trading name or business activities”. It was therefore submitted that a generic descriptive word was inherently incapable of gaining distinction in favour of any single person with respect to any product and exclusionary rights cannot be afforded to the holder of such a generic/descriptive mark, the plaintiff herein.

61. Contrary to the plaintiff’s submissions in the Reply Statement, it is respectfully submitted that the defendants are not attributing the meaning of SHAKER to SPRINKLERS. It is blatantly incorrect to state that word SPRINKLER is ‘only’ attached to a garden hose and in relation to liquids. It is submitted that the word SPRINKLER as an extension of



C.S.(Comm. Div.) No.713 of 2015

SPRINKLE, is used specifically in the salt trade and culinary field, to mean a device perforated with small holes on its cap, to sprinkle salt, pepper, spices etc., on food or dishes.

62. It is stated that the defendants being in the food and spices industry and selling salt, chat masala etc., description of their product would be SPRINKLER and not SHAKER. Thus, the appropriate term as being used by the defendants and commonly used across the industry, would be SPRINKLERS, which is derived from SPRINKLE, and a generic/descriptive word for the act of SPRINKLING or to SPRINKLE salt, pepper, spices, on to food or dishes.

63. It is stated that the plaintiff in the plaint state that they filed a number of suits to protect their trade mark and have secured favorable orders before this Hon'ble Court. It is submitted that the plaintiff have failed to file in the present suit, any of the orders and decrees as obtained in the said suits to establish the protection of the mark "SPRINKLE" and the relevance to the instant case.



C.S.(Comm. Div.) No.713 of 2015

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64. It is further stated that the plaintiff has themselves been making generic use of the word “SPRINKLE” in its advertising documents marking as Exhibit P7, which clearly shows that the plaintiff is promoting its salt product as “Iodized and prepared for sprinkling” and that it is without any lumps and ‘For sprinkling easily’.

65. It is further stated that it is highly unfortunate that the plaintiff is blatantly using the word SPRINKLE and its verb usage SPRINKLING in the generic/descriptive sense on one hand and hypocritically on the other hand, seeking exclusive rights over the word to prevent other traders from legitimate use of the same or its derivatives such as the alleged mark “SPRINKLERS” used as a descriptor in the trade.

66. It is further pertinent to note that presently the logo of the SPRINKLE brand as seen on the plaintiff’s website [www.sprinklesalt.com](http://www.sprinklesalt.com) is indicative of the descriptive use of the term SPRINKLE/SPRINKLER.



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C.S.(Comm. Div.) No.713 of 2015



67. It is submitted that the letter “I” of “SPRINKLE” as seen above is being shown as a sprinkler. Thus, the generic use of the word by the plaintiff itself ought to stop any rights as sought in this Suit restraining the defendants and other traders from using the same generic word, SPRINKLE/SPRINKLERS.

68. It is further stated that this Hon’ble Court in the case of **Nestle’s Products (India) Limited vs. P.Thankaraja and another** (AIR 1978 Mad 336) while discussing on the registration of the trade mark “INSTEAL” held that, “INSTEAL” has the tendency to monopolise all



C.S.(Comm. Div.) No.713 of 2015

manufactured tea which goes by the generic description of ‘instant tea’ or ‘instantaneous tea’. To grant registration to this word-mark, would therefore make Alvitone as its owner a monopolist of a part of the ordinary vocabulary in which traders transact business with themselves and their customers.” Similarly, the plaintiff herein, is attempting to act as a monopolist over the ordinary vocabulary term “SPRINKLER” which is widely used in the transaction of business in the channels of packaging and marketing, between the traders and their customers in the salt/spice industry.

69. It is also stated that the Bombay High Court in the case of **Pidilite Industries Limited and Others vs. Vilas Nemichand Jain and Others**, 2015 (64) PTC 185 (Bom) has held that, “Therefore, mere evidence of extent of use invoices, financial figures of sales and so on might perhaps show use or even increased use. But something more is necessary to show that the use is such that the mark has become distinctive. As the commentary says, use itself does not equal distinctiveness”. In the context of a descriptive mark even extensive use is insufficient and what is required, as is borne out by the extract from the



C.S.(Comm. Div.) No.713 of 2015

commentary in Narayanan on Trade Marks, is that the secondary meaning acquired must be shown to have displaced entirely the primary descriptive meaning of the mark. To succeed in such a action what a plaintiff must show is that the goods bearing the mark have come to be identified with his goods exclusively and in the case of a descriptive mark, evidence is necessary of members of the public as well, not just people who are specially placed to attest to its uniqueness.”

70. Accordingly, the mere invoices with specially placed persons (Vendors) as submitted by the plaintiff and marked as Exhibits P6, would not be sufficient to achieve the requirement of ‘use’ and ‘distinctiveness’. Thus, the plaintiff is not entitled to any protection over the words SPRINKLE/SPRINKLER.

71. It is further stated that with respect to the mark being registered and the plaintiff in effect seeking exclusive/monopoly over SPRINKLE/SPRINKLER, it is submitted that, Section 17(2) of the Act makes clear that even in so far as registered marks are concerned, if the



C.S.(Comm. Div.) No.713 of 2015

same contains any matter which is common to the trade or is otherwise, of a non-distinctive character, the registration thereof, shall not confer any exclusive right. Further, in a recent decision of this Hon'ble Court in **ITC Limited vs. Nestle India Limited**, 2020 SCC Online Mad 1158, while discussing the terms 'Magic Masala', this Hon'ble Court was pleased to hold that, "Both the words" "Magic" and its derivative "Magical" are common to the trade.

72. Therefore, neither the plaintiff nor the defendant can claim any monopoly over the expression "Magic" or "Masala" for they are common words in Indian Culinary and Indian food industry". The above order has also been affirmed by the Hon'ble Supreme Court. It is thus submitted that, SPRINKLE/SPRINKLER being words of the trade in the specific food/salt and spice trade industry, no single party shall be afforded any such monopoly/exclusionary rights over the same.

73. It is further stated that the Delhi High Court in the case of **Cadilla Healthcare Limited vs. Gujarat Co-operative Milk Marketing**



C.S.(Comm. Div.) No.713 of 2015

**Federation Limited and Others**, 2009 (41) PTC 336 (Del.) (DB) held that, "... the use of the term "Sugar Free" by the respondent is not in the trademark sense but as a common descriptive adjective." Accordingly, it is humbly submitted the use of the term "SPRINKLER" by the defendants is per se not as a mark in relation to its goods, but as a common descriptive adjective.

74. In the light of Section 30(2)(a) and Section 35 of the Act, even a registered proprietor of a Trademark cannot interfere with the use of the registered trade mark or any similar mark by any member of trade, if the same is used to indicate character, quality or kind of the product.

75. Further, the above is consistent with the findings of this Hon'ble Court in the applications and appeals filed by the plaintiff in the O.A.Nos.942 and 943 of 2015 and O.S.A.Nos.158 and 159 of 2016 dated April 21, 2016 and July 14, 2016 respectively, wherein this Hon'ble Court



C.S.(Comm. Div.) No.713 of 2015

has categorically held that the word “SPRINKLERS” is a common and generic word and is used as an adjective for the act of sprinkling.

76. It is thus respectfully submitted that the plaintiff's mark “SPRINKLE” is not distinctive and accordingly not entitled for protection under the Act. Further, the word “SPRINKLERS” is used by the defendants' as a purely generic and descriptive term to describe the nature of the pack/dispenser in which its salt and spices are sold.

77. It is further submitted that the plaintiff is not the prior user of the Trademark “SPRINKLE”

78. It is submitted that the defendants use the word “SPRINKLERS” on the packaging of its products. As seen from the defendants' Label marked as Exhibit P2, the brand name as intended for the products to be marketed under is “CATCH” the registered trademark of the defendants.



C.S.(Comm. Div.) No.713 of 2015

“SPRINKLERS” is sandwiched between the brand name CATCH and the product name such as TABLE SALT, and it merely serves the only purpose of being descriptive of the product and its intended use and product category. Therefore, the use was purely generic and descriptive use of the common word “SPRINKLERS” cannot be said to be a use of the word as a trade mark by the defendants and therefore, constituting an infringement.

79. It is submitted that the usage of “SPRINKLERS” by the defendants, is purely an descriptive and protected under Section 30(2)(a) of the Act which provides that “A registered trade mark is not infringed where the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services”. Accordingly, it is submitted there is no such infringement on the part of the defendants.

80. Further, the **Delhi High Court in the case of Peps Industries Private Limited vs. Kurlon Limited**, CS (Comm) 174/2019 has recently



C.S.(Comm. Div.) No.713 of 2015

passed an order dated March 16, 2020 and held that, “As regards the second issue i.e. whether the mark “No Turn” is used by the defendant as a trademark or as a descriptive mark with the trademark to describe the quality of the mattresses, it may be noted that the manner in which “No Turn” is used on the mattresses and from the brochure of the defendant it is evident that the mark “No Turn” is not used as a trademark/brand but to describe the quality of the mattress and thus the mattresses which do not require to be “turned around” are labeled “No Turn”. Accordingly, it is submitted that the use of the mark “SPRINKLERS” is not used by the defendants as a trade mark/brand, but only as a description of its products. Thus, the plaintiff’s attempt to prevent such bona fide, fair use, which is simply descriptive of the container is illegal and unjustified.

81. It is further submitted that the defendants has made a bona fide use of a generic word, “SPRINKLERS”, which is also commonly used in the salt trade to describe the particular type of product packaging bearing perforations on the cap. Thus defendants’ use of a generic word in the descriptive sense cannot make it liable for infringement or violation of a



C.S.(Comm. Div.) No.713 of 2015

trade mark.

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82. It is further submitted that the defendants are not passing off their product as that of the plaintiff while selling their products using the words “Catch Sprinklers”

83. It is submitted that the contention of the plaintiff that its goods with the mark “SPRINKLE” are advertised extensively and sold all over India and anyone who sees the defendant’s product with the Trademark “SPRINKLERS” will get the impression that the defendants are carrying on business under the aegis of the plaintiff or are operating with the express or implied consent of the plaintiff cannot be countenanced. It is submitted that the plaintiff have failed to produce any substantial evidence in relation to substantiate the above assertion.

84. It is submitted that the container is a dispenser fitted with a rotating lid which allows sprinkling of content in it and with the help of the rotating plastic cap it can close the perforations/holes/pores to keeps out dampness and thereby keeping the contents of spices such as salt, chat



C.S.(Comm. Div.) No.713 of 2015

masala and black pepper etc., fresh and dry and ensure free-flowing.

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85. It is submitted that ever since its launch of CATCH table top rotator dispenser within the sprinkler dispenser has made the defendants market leader in the said segment. It is submitted that the Trademark “CATCH” is prominently displayed on all packaging in a unique script and form and enjoys extensive goodwill and reputation and is exclusively associated with the defendants.

86. It is further submitted that Trademark ‘CATCH’ is a well-known trade mark on its own right and the products sold with it enjoy a enviable market reputation and share. The phenomenal sales figures of CATCH spices bear testimony to the goodwill and reputation that the said products enjoy in the market. Defendants promote their CATCH branded products by way of consistent and innovative advertising and promotional campaigns enlisting celebrities through every possible media including print, television, cinema halls/multiplexes, Live Media, hoardings at prominent locations, Delhi Metro, etc. On account of such extensive advertising/publicity, along with widespread use of trademark CATCH,



C.S.(Comm. Div.) No.713 of 2015

defendants and their products have gained exceptional visibility and recognition worldwide and in India.

87. Accordingly, on account of the aforesaid sales and promotional efforts made by the defendants consistently over the years, trademark CATCH has gained the status of being a 'Superbrand'. The Superbrands organization which is an independent arbiter on branding and pays tribute to the world's leading brands which are chosen by experts and consumers declared CATCH as a Superbrand in the year 2009-2010. In this connection Exhibit D9 shows that Superbrand had declared CATCH of the defendants as a Superbrand in the year 2009-2010.

88. It is submitted as per the settled law with respect to passing off is the trinity test as laid down by the House of Lords in **Reckitt & Colman Limited vs. Borden Inc** [1990] 1 ALL E.R. 873 and has been applied by the Indian Courts consistently as reaffirmed by the Hon'ble Supreme Court in **S.Syed Mohideen vs. P.Sulochana Bai**, 2016 (66) PTC 1 (SC), wherein the three constituents as required to be established are goodwill, misrepresentation and damage. In this regard, it is submitted



C.S.(Comm. Div.) No.713 of 2015

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- i. *the plaintiff has failed to prove its goodwill in the market and that the general consumers can identify the product or service they provide. It is respectfully submitted, the brand CATCH of the defendants has far higher sales and brand recognition in the country;*
- ii. *there is no such misrepresentation to deceive the customers on the part of the defendants. The brand/trademark/logo of the defendants is clear and unmissable as 'CATCH', and below it, 'SPRINKLER' is merely used as a descriptor. The same is also being done by several big brands/companies in the trade/industry and no individual brand/company can claim exclusively over the term SPRINKLER; and*
- iii. *the plaintiff has critically failed to establish the consequent loss based on the alleged infringement/passing off.*

89. It is therefore respectfully submitted that there is no merit in the averments and allegations of passing off made in the instant suit against the Defendants.



C.S.(Comm. Div.) No.713 of 2015

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90. It is therefore submitted that the plaintiff is not entitled to the reliefs as prayed for in the above said suit. In light of all the aforesaid submissions, it was submitted that the plaintiff has failed to make out a case for grant of the permanent injunctions, costs of the suit and other reliefs as prayed in the suit, as the defendants have not infringed or passed off the plaintiff's registered mark, and used the mark "SPRINKLERS" as a descriptive adjective and further, the very words SPRINKLE/SPRINKLERS is a generic and descriptive word and widely used in the industry by multiple brands, others in the industry such as Chefs etc., and therefore no monopoly rights can be granted to the plaintiff concerning SPRINKLE/SPRINKLERS.

91. I have heard the learned counsel for the plaintiff and the learned counsel for the defendants. I have perused the Plaint, Written Statement, proof affidavits filed on behalf of the plaintiff and the defendant and Exhibits marked on behalf of the plaintiff and the exhibits marked on



C.S.(Comm. Div.) No.713 of 2015

behalf of the defendants. I have also considered the case laws submitted on behalf of the plaintiff and the defendants.

92. The present suit was instituted on 16.03.2015. The written statement was filed on 17.12.2015. The plaint was later amended in the year 2022 pursuant to an order passed on 24.07.2022 in A.NO.2341 of 2021. The defendant also filed a reply statement on 24.02.2016.

93. The registration of Trade Mark No. 592204 in Ex.P3 Legal Use Proceeding Certificate is for goods in Class 30. It is for a Device Mark with the word “SPRINKLE” few other features. The Trade Mark Application No. 592204 was filed as a device mark on 08.03.1993 by a partnership concern M/s.Jothna Motha trading as M/s.Veppolodai Chemicals claiming user of the mark from 1986. The aforesaid device mark of “SPRINKLE” was registered on 31.05.2005 vide Trade Mak No. 592204. The registration of Trade Mak No. 592204 in Ex.P3 Legal Use Proceeding Certificate is valid and subsisting as on date.

94. Ex.D-11 print out of the various communication prior to



C.S.(Comm. Div.) No.713 of 2015

registration of device mark “SPRINKLE” reveals that Trade Mark

Application No.592204 for registration of the device mark “SPRINKLE”

was filed on March 8, 1993 in Class 30 for ‘**Iodised Free Flow Salt**’. The

description claimed in Ex. P3 Legal User Certificate for Trade Mark

No.592204 also confirms the same.

95. Prior to registration of Ex.P3, The Registrar of Trade Marks vide Ex.P11 Examination Report had raised objection to registrar of the device mark of ‘Sprinkle’ on the ground of distinctiveness under Section 9 of the Trade and Merchandise Marks Act, 1958. It was stated that “the word ‘Sprinkle’ was descriptive of goods”.

96. Ex.D11 Examination Report of the Trade Mark Registry also shows that there was a prior pending application for registration of the word “SPRINKLES” as a Trade Mark vide Trade Mark Application No.540647 in the name of Indus Diet Specialite Private Limited,



C.S.(Comm. Div.) No.713 of 2015

Chandigarh.

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97. The Trade Mark Registry had raised an objection that the word was not distinctive and had raised an objection that the word was not distinctive. On the other hand, it was stated to be descriptive vide in his examined report marked as Ex.P.11.

98. The application was ordered to be advertised in Trade Mark Journal. Since there was no opposition to registration of the mark was filed, the learned Registrar of Trademarks directed the registration of the trademark and had raised an objection that the word was not distinctive. On the other hand, it was stated to be descriptive vide in his examined marked as Ex.P.11.

99. Thus, Trade Mark Application.No.540647 was cited during examination. It indicates that the plaintiff was not the first person to have adopted “SPRINKLES” as a Trademark and filed the Trade Mark Application for registration as a device mark viz. “SPRINKLE” much later



C.S.(Comm. Div.) No.713 of 2015

on 08.03.1983.

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100. Prior to institution of the present suit on 16.03.2015, the plaintiff had also filed two other Trade Mark Applications for registration of the word SPRINKLE as a trade mark vide Trade Mark Application Nos.1398971 and 1398972 for registration of the word “SPRINKLE” on 14.11.2005. These applications were registered on 14.03.2008 vide Certificate.Nos.694703 and 694955 as is evident from Ex. P4 and Ex.P5 Legal Use Certificates filed by the plaintiff.

101. Trade Mark.No.1398971 in Class 30 has been registered **“iodized salt and salt of all kinds”** while T.M.No.592204 in Class 30 filed on 08.03.1993 was confined to **“iodised free flow salt”**. Trade Mark.No.1398972 in Class 30 is altogether for different description of the goods with which this case is not concerned with.

102. The word “SPRINKLE” is a verb. It describes an action. To “SPRINKLE” means to fling about a small drop or particle over a surface.



C.S.(Comm. Div.) No.713 of 2015

Anything that “sprinkles” is a sprinkler. Any device which “sprinkles” is sprinkler. The word “SPRINKLER” is a common noun. The defendants have adopted the word “SPRINKLERS” by adding a suffix “S” to the common noun “SPRINKLER” to describe their attractive dispenser used for packaging “Iodized Salt, Chat Masala and Pepper Powder” etc.

103. The word “SPRINKLERS” used by the defendants in association with their Trade Mark Catch was not intended to be used as a Trademark. It however forms part of “CATCH” Label used by the defendants as a Trademark for marketing its “Iodized Salt, Chat Masala and Pepper Powder” etc. in the dispenser.

104. Although, the word “SPRINKLERS” is used along with the their Trade mark “Catch” with a stylized and colorful font and is intended to describe the dispenser in which “Iodized Salt, Chat Masala and Pepper Powder” are sold with a rotating lid with pores by the defendants, the presence of the word “SPRINKLERS” along with Catch in the Label



C.S.(Comm. Div.) No.713 of 2015

renders it to form part of the trade mark adopted by the defendant. It becomes a Trade mark within the meaning of Section 2(zb) of the Trade Marks Act, 1999.

105. The dispenser of the defendants is in cylindrical shape on which the above device mark has been imprinted with the word “SPRINKLERS”. The dispenser has a circular lid with perforation along with rotating lid to allow the spices, salt or chat masala, etc., contained therein to be sprinkled on the food items. These are meant to be kept on the dining table for ready access to a person to sprinkle salt on the food to enhance the taste. On the other hand, the packaged salt of the plaintiff have to be stored in a container after the package is opened for salt absorbs water from atmosphere.

106. When the application was filed in TMA.No.592204 by the plaintiff for registration of the label/device of “SPRINKLE” as a Trade mark, it was “proposed to be used”. The plaintiff, therefore is certainly not a prior adopter of the word “SPRNKLE”for iodized salt.



C.S.(Comm. Div.) No.713 of 2015

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107. The plaintiff has also not disputed that the defendants commenced business in 1987. The plaintiff has failed to establish that the plaintiff was the first one to adopt or is the prior user of the mark SPRINKLE in respect of the salt products.

108. Both the words SPRINKLE/SPRINKLERS are both descriptive and common words and incapable of being monopolized registered of a trademark, let alone entitled to protection under the Act in their favor although the word SPRINKLE has been registered.

109. In **Abercrombie & Fitch Company vs. Hunting World Incorporated**, 537 F.2d 4 (2d Cir. 1976) (Abercrombie), the Court held as under:-



C.S.(Comm. Div.) No.713 of 2015

*“The cases, and in some instances the Lanham Act, identify your different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright...”*

110. In the case of **Free Elective Network Private Limited** vs. **Matrimony.Com Limited**, C.S.No.122 of 2021, the Court observed as under:-

*“17. Since a generic term describes either the product/service category or the product/service, no person is permitted to monopolize or appropriate such term and claim exclusive use thereof. For example, trademark protection and exclusivity cannot be claimed over the term “car” when used for a motor car or “radio” or “television” when used in relation to the said products. In contrast to generic or common descriptive terms, a descriptive term describes a characteristic or ingredient or quality or intended purpose of a product or service. Such terms may be entitled to protection provided they acquire distinctiveness and secondary meaning. In **Zatarains, Inc. v. Oak Grove Smokehouse**, 698 F.2d 786 (**Zatarains**), the US Court of Appeals for the Fifth Circuit formulated four tests to discern if a mark is descriptive: whether the mark has a dictionary meaning; whether imagination is*



C.S.(Comm. Div.) No.713 of 2015

*required to connect the product or service to the mark and, if so, how much; whether competitors are likely to need the terms used in the mark to describe their product or service; and the extent of use of the term by others to market a similar product or service. If the above tests were to be applied to the sub-element “Jodi” in its application to a website or app that facilitates subscribers to find a long-term partner or spouse, the sub-element “Jodi” in the mark is a dictionary word in the Tamil and Hindi languages meaning a pair or couple. The term directly refers to the intended purpose of the service and it is not necessary to exercise one's imagination to make the connection. While the use of the term as a trademark by other providers of similar services is not necessary, the term may be required to be used at least descriptively by other service providers in the same field. Finally, the evidence on record discloses that a number of other service providers use the element “Jodi” as part of their website or app. It should also be noticed that “Jodi” is clearly indicative of the intended purpose of the service, but it does not describe the service. Because it clearly refers to and does not merely suggest the intended purpose, it falls within the descriptive and not the suggestive category. As a descriptive mark, it certainly does not have inherent distinctiveness. This leads to the question whether the mark has acquired distinctiveness.”*

111. In **ITC Limited vs. Nestle India Limited**, C.S.No.231 of

2013, the Court observed as follows:-

*“137. The purpose of a trademark/service mark is to establish a trade connection between the goods or*



*the service offered by the proprietor of such a trademark/service mark. An average consumer decides to pay for such goods or service by referring to the mark associated with them.*

*149. A mark, which conveys character or quality of the goods, is a descriptive mark. It is an inherently weak mark and is almost incapable of being protected and/or registered unless it has acquired distinctiveness due to its long and continuous use over a period of time to the exclusion of others.*

*150. Proprietor who chooses words or artistic work which are not distinctive and are inherently weak or is incapable of protection, run the risk of such mark trampled or used by others. Law will not come to their rescue and they are often left without any remedy. Descriptive marks may attain distinctiveness on account of its long use and if nobody else had used it prior in time. If the marks are invented or coined as a new word, it affords a higher degree of protection under law.*

*151. Therefore, before conceiving a mark to establish a trade connection, proprietors are expected to choose marks wisely which are either arbitrary, fanciful and/or at best suggestive of their product/goods/services to market.*

*152. If the mark is suggestive, it would require to pass the test of imagination for being protected. The more imagination is required on the customer's part to get the direct description of the product from the term, the more likely the term is suggestive and not descriptive.*



153. *In Stix Products Inc. Vs. United Merchants & Mfrs Inc.*, 295 F.Supp 479,160 USPQ7777 (SCNY1968), Judge Weinfeld's formulation of the imagination test is often quoted in applied:-

*"A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. The term is descriptive if it walked with conveys an immediate idea of the ingredients, qualifies or characteristics of the goods".*

154. *For instance, Rexona, Vivel, Liril, Margo, etc. for soap, Bata, Reebok for footwear, etc. prima facie appear to be invented or coined words. They may command a higher decree of protection if there is a contest. Similarly, Apple for apple computers, Ipad, Iphone or Maggi for various food products manufactured and marketed by the defendant or Sunfeast Yipee! by the plaintiff, Hushpuppies, Pavers, Nike, Puma etc. for foot wear appear to be fanci & arbitrary words and therefore command a higher decree of protection.*

155. *Composite label used by both the plaintiff and the defendant in Exhibits P19 and 21 qualify as trademarks. However, same cannot be said about the expression "Magic Masala" or "Magical Masala" used in the respective labels.*

156. *Under the Trade Marks Act, 1999, proprietors are entitled to apply for registration. If the mark is registered, such proprietor can take proceedings for infringement of their mark. However, if the mark is not registered, common law protection of passing-off*



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C.S.(Comm. Div.) No.713 of 2015

*is available to such proprietors.*

*157. In Godfrey Philips India Ltd. Vs. Girnar Food & Beverages (P) Ltd., (2004) 5 SCC 257, the Division Bench of the High Court had held that phrase “SUPER CUP” which was used as a trademark was descriptive and laudatory of the goods of the appellant and, therefore, the appellant was not entitled to any order of injunction.*

*158. The Hon’ble Supreme Court however while remanding the case to the Division Bench of the High Court held that, “A descriptive trade mark may be entitled to protection, if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source”.*

*159. Thus, a “descriptive term” which directly and clearly conveys information about the ingredients, qualities and characteristics of the product or services is not protectable at the first instance but may qualify for protection if it has assumed a secondary meaning and identifies a particular product or as being from a particular source.*

*160. On the other hand, a “suggestive term” used as a mark which indirectly suggest the qualities and characteristics of the product may be registrable and protected.*

*161. Before an expression attains a secondary meaning in the eyes of the consumers, it has to go through a long and an arduous uninterrupted use.*



C.S.(Comm. Div.) No.713 of 2015

*Such use are at the risk of being run-over or trampled and used by others. Before such words or expression achieve a secondary meaning, they are at the risk of being used by others in which case they loose their claim for protection under law.*

*162. If such a proprietor initiates an action for an injunction to exclude a subsequent user in their journey to distinguish such words as their marks, the Courts rarely rescue such proprietors. Such proprietors promote such words or expression as their marks at their peril.*

*163. Thus, the thumb rule under the law is that words or the expression which and are not distinctive are inherently weak and are therefore incapable of being registered or protected.*

*164. However, such words may become distinctive on account of their long and uninterrupted use over a period time as a result of which they may get a secondary meaning and the consumer may begin to associate them with the goods of such proprietor.”*

112. During the pendency of the present suit the defendants have also filed application for registration of the device “Catch Sprinklers” in TM.No.2535739 on 22.05.2013 in Class 30. The registration was also granted to the defendants by the Trademark Registry vide Certificate.No.1556942 on 22.05.2017.



C.S.(Comm. Div.) No.713 of 2015

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113. Similarly, the defendants had also filed another application for registration of the device mark in TM.No.2535740 in Class 30 on 22.05.2013. The said device mark has been registered by the Trademark Registry on 22.05.2017 vide Certificate.No.1557658.The Catch Sprinklers (DEVICE) which have been registered in favour of the defendants are as under:-



114. The above device mark which has been registered for spices of all kinds included in Class 30. The word “SPRINKLERS” has been used



C.S.(Comm. Div.) No.713 of 2015

by the defendants on a dispenser along with the word catch on the container for selling table salt, chat masala and pepper.

115. On the other hand, the three registered Trademarks in Class 30 which have been referred to supra of the plaintiff are the salt package of the wrapper. Though the applications for registration of the device of “Catch Sprinklers” were filed by the defendants on 22.03.2013, the registrations have been secured during the pendency of the Suit on 22.05.2017 vide Certificate Nos.1556942 and 1557658, were not marked.

116. There are no records to show that these registration was opposed by the plaintiff or any steps were taken to rectify the registration secured by the plaintiff.

117. The defendants ought to have taken steps for marking these certificates as Exhibits before this Court. The Written Statement filed by the defendants is also silent regarding the applications filed for registration of the Device Marks vide TM.Nos.2535739 and 2535750 on 22.05.2013. However, the fact remains that these marks have been now registered. The



C.S.(Comm. Div.) No.713 of 2015

copies of which were produced during the hearing.

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118. The copies of the respective Trademark certificates obtained by the defendants in Class 30 are captured for the purpose of record:- They are marked as Exhibit C1 & C2.

Form TM-1  
Form No. 1

GOVERNMENT OF INDIA  
Ministry of Commerce  
Trade Marks Registry  
New Delhi-110002  
Trade Marks Act, 1999  
Section 44 of the said Act  
Certificate of Registration of Trade Mark (Class 30) (No. 20/2015-2016)

THE TRADE MARK (REGISTRATION) ACT, 1999 (No. 44 of 1999) (Section 44)

IN pursuance of the provisions of the said Act, the following Trade Mark is hereby registered in Class 30 of the International Classification of Trade Marks (NICE Classification) under the said Act.

Trade Mark as a word

TAMIL MALAR

Registered under the said Act on 20 May 2015.

Registrar of Trademarks



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C.S.(Comm. Div.) No.713 of 2015

119. The registration of the above marks have been allowed uncontested. As mentioned above no steps have been taken by the plaintiff either to rectify the registration of the device registered in favour of the defendants vide above two TM.Nos.2535739 and 2535750. The plaintiff has also not filed any application to oppose the registration.



120. Section (2) to Section 137 of the Trade Marks Act, 1999 reads

as under:-

*“137. Evidence of entries in register, etc., and things done by the Registrar.-*

*(1) A copy of any entry in the register or of any document referred to in sub-section (1) of section 148 purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.*

*(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be prima facie evidence of the entry having been made, and of the contents thereof, or of the matter or things having been done or not done.*

121. Section 137 of the Trade Marks Act, 1999 has been replicated in the Trade Marks Act, 1999 after it replaced the Trade and Merchandise Marks Act, 1958. Section 115 of the Trade and Merchandise Marks Act, 1958 dealt with issue of such legal use certificate. Section 115 of the Trade and Merchandise Marks Act, 1958 and Section 137 of the Trade Marks Act, 1999 is compared and reproduced below:-



C.S.(Comm. Div.) No.713 of 2015

| <b>Section 115 of the Trade and Merchandise Marks Act, 1958</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                             | <b>Section 137 of the Trade Marks Act, 1999</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>115. Evidence of entries in register, etc., and things done by the Registrar:-</p> <p>(1) A copy of any entry in the register or of any document referred to in sub- section (1) of section 125, purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry, shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.</p> <p>(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be prima facie evidence of the entry having been made, and of the contents thereof, or of the matter or thing having been done or not done.</p> | <p>137. Evidence of entries in register, etc., and things done by the Registrar”-</p> <p>(1) A copy of any entry in the register or of any document referred to in sub-section (1) of section 148 purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.</p> <p>(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be prima facie evidence of the entry having been made, and of the contents thereof, or of the matter or things having been done or not done.</p> |

122. The requirement of a legal use proceeding certificate that was contemplated in the 1958 Act and under the 1940 Act is redundant in the



C.S.(Comm. Div.) No.713 of 2015

light of the modernization of the dissemination of information through internet.

123. These information are readily available to public with the click of the button by accessing the portal maintained by the Office of the Controller General of Patents, Designs & Trade Marks, Department of Industrial Policy & Promotion, Ministry of Commerce & Industry.

124. The defendants have also furnished copies of the Trademark Certificates vide above two TM.Nos.2535739 and 2535750 which are available in the due course of hearing.

125. Under Section 5 of the Indian Evidence Act, 1872 the Court can take judicial notice of certain facts. Under Section 57(6) of the Indian Evidence Act, 1872 the Court can take cognizance of all seals which any person is authorized to use by the Constitution or an Act of the Parliament.

126. Thus, Court can take judicial notice of these facts although the defendants have been negligent in not bringing it on record by properly



C.S.(Comm. Div.) No.713 of 2015

marketing them as the document, even though the Court had permitted the respective parties to hand the documents before the learned Master by an order dated 29.07.2022.

127. Further as per Section 74 (i) and (ii) of the Indian Evidence Act, 1872 the certificate issued by the Trade Mark Registry is to be construed as public document viz., official bodies and tribunals. The Tribunal has been defined in Trademarks Act, 1999 in Section 2 (ze) as follows:-

*“2(ze) ‘tribunal’ means the Registrar or, as the case may be, the Appellate Board, before which the proceeding concerned is pending”*

128. However, there is a *lacuna* on the part of the defendants in as much as the defendants have not produced certified copy as is required under Section 77 of the Indian Evidence Act, 1872. However, considering the fact that the information is available on the web portal maintained by the Office of the Controller General of Patents, Designs & Trade Marks, Department of Industrial Policy & Promotion, Ministry of Commerce & Industry.



C.S.(Comm. Div.) No.713 of 2015

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129. The Court is inclined to take cognizance of these two documents and that the content of which has been reproduced in this Judgement. Therefore, these documents are to be considered as necessary for a fair disposal of the case.

130. In the light of the above, the issue therefore to be considered is whether the plaintiff is entitled to succeed, even though the defendants have failed to mark these documents as exhibits.

131. In this connection Section 28 of the Trade Marks Act, 1999 is relevant. Section 28 of the Trade Marks Act, 1999, confers right on a registered proprietor of the Trademark to obtain relief in respect of infringement of a Trademark in the manner provided in the Act. Section 28 of the Trademarks Act, 1999 reads as under:-

***“28. Rights conferred by registration:-***

*1. Subject to the other provisions of this Act, the*



C.S.(Comm. Div.) No.713 of 2015

*registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.*

*2. The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.*

*3. Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.”*

132. Sub-section 3 to Section 28 of the Trade Marks Act, 1999 has an exception. It deals with the situation where two or more persons are



C.S.(Comm. Div.) No.713 of 2015

registered proprietors of Trademarks, which are identical with or nearly resemble each other, the exclusive right to the use of the trademark will not give a right of action against them merely on account of registration of the Trademark. However, such right can be enforced against any other persons not being the registered proprietor and/or registered users other than by way of permitted use. The registration of the marks vide T.M.No.2535739 and T.M.No.2535740 in Class 30 date back to the date of the application on 22.05.2013, i.e, two years prior to institution of the present suit on 16.03.2015.

133. As on date there are no rival proceedings to registrations of T.M.No.2535739 and T.M.No.2535740 in Class 30. In the light of the above it has to be construed that there is no infringement of the registered Trademark of the plaintiff by the defendants. Infringement can arise only if a mark is used by a person not being the registered proprietor of the Trademark. Therefore, there is no case made out for infringement of the Trademark.

134. In **ITC Limited** vs. **Nestle India Limited**, C.S.No.231 of



2013, the Court has discussed the scope of “passing-off” as follows:-

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*169. The expression “passing-off” means and suggest to pass-off one’s goods as that of another person whose product has a reputation in the market and to dilute such person’s goodwill. It is to trade on the good-will of another person and thereby not only to deceive the buyers (consumers) but also is intended to cause injury to the proprietor of the trademark. This is the essence of passing off.*

*170. Passing- off action is a common law remedy recognised under the above Act. An action for passing-off is a broader remedy than an action for infringement of a trademark under Section 134 the said Act. It is to restrain or stop by an order of a Court an unfair trade practice by a competitor who misleads the consumer by making them believe that they are indeed purchasing the goods of his competitor.*

*171. An action for passing-off is not merely confined to protect an unregistered trademark of a proprietor. It is also intended to protect overall colour scheme, get-up, layout and trade dress etc. adopted by a proprietor which his competitor unfairly copies and causes deception on the consumer and thereby inflicts a loss on the proprietor.*

*172. Loss to the consumer is the actual loss for the consumer is cheated by the competitor. Though a consumer suffers, rarely a consumer take action*



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C.S.(Comm. Div.) No.713 of 2015

*against the perpetrator unless the consumer approaches the Consumer Forum.*

*173. Loss to the proprietor in the case of passing-off is a direct reduction in sale, growth, dilution of the intrinsic value of the mark and risk of being exposed to unnecessary civil action and the expenses incurred in connection of burden of vigilant.*

*174. The purpose of passing-off action is not only to protect commercial goodwill but is also to ensure that the purchasers are not exploited and dishonesty intruding is prevented. For that the plaintiff must establish that his business or goods have acquired reputation. [Sir Shadi Lal Enterprise Ltd.Vs. Kesar Enterprise Ltd., 1998 PTC(18)].*

*175. On passing-off, eminent jurist Salmond in Law of Torts, 17 th Edn. p. 401 has stated as follows: -*

*"The gist of the conception of passing-off is that the goods are in effect telling a falsehood about themselves, are saying something about themselves, which is calculated to mislead. The law on this matter is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices the benefit of the reputation already achieved by rival traders."*

*176. In an action for passing-off, the plaintiff is required to show colourable imitation so calculated to cause deception that the goods traded by him are to be taken to by the ordinary purchaser as that of*



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C.S.(Comm. Div.) No.713 of 2015

*the plaintiff.*

*177. While testing whether there is actual confusion or not by such copying, the court adopts the test of an ordinary person with an average intelligence and imperfect recollection. [See Corn Products Refining Co. Vs. Skangrila Food Products Ltd., (1960) (1) SCR 968 and Amritdhara Pharmacy Vs. Satya Deo Gupta, (1963) 2 SCR 484: AIR 1963 SC 449]. In Amritdhara Pharmacy Vs. Satya Deo Gupta, (1963) 2 SCR 484 : AIR 1963 SC 449, on facts it was held that “To such a man the overall structural and phonetic similarity-of the two names “Amritdhara” and “Lakshmandhara” is, in our opinion, likely to deceive or cause confusion”.*

*178. In Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73, the Hon’ble Supreme Court observed as under:*

*Broadly stated, in an action for passing-off on the basis*

*of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:*

*(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.*

*(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.*



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C.S.(Comm. Div.) No.713 of 2015

*(c) The nature of the goods in respect of which they are used as trade marks.*

*(d) The similarity in the nature, character and performance of the goods of the rival traders.*

*(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*

*(f) The mode of purchasing the goods or placing orders for the goods.*

*(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.*

*179. In Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries, (2018) 2 SCC 1, it was held that an action for passing-off is premised on the right of the prior user generating a goodwill and is unaffected by any registration of the mark under the Act. To prove and establish an action of passing-off, three ingredients are required to be proved by the plaintiff ie. Goodwill, misrepresentation and damages. Actual deception is not required [Century Traders Vs. Roshan Lal Duggar & Co., AIR (1978) 250(DEL)].*

*180. In Eastman Photography Materials Company, Limited Vs. The Comptroller-General of Patents,*



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C.S.(Comm. Div.) No.713 of 2015

*Designs, And Trade-Marks Respondent, [1898] A.C. 571, it was observed as follows:-*

*“We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the register, though differently spelt and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were it ought, of course, to be rejected.”*

*181. Lord Halsbury further observed as under:-*

*“Of course also words which are merely mis-spelt, but which are nevertheless, in sound, ordinary English words, and the use of which may tend to deceive, ought not to be permitted.”*

*182. In Ruston Vs. Zamindara, AIR 1970 SC 1649, the Hon'ble Supreme Court held that the test in the case of passing-off is whether the defendant selling goods so marked is to be designed or is calculated to lead purchasers to believe that they are the plaintiff's goods?”*

*183. In Oertli Vs. Bowman, 1957 RPC 388 (CA) (at p. 397), the gist of passing-off action was explained by stating that it was essential to the success of any*



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C.S.(Comm. Div.) No.713 of 2015

*claim to passing-off based on the use of given mark or get-up that the plaintiff should be able to show that the disputed mark or get-up has become by user in the country distinctive of the plaintiff's goods so that the use in relation to any goods of the kind dealt in by the plaintiff of that mark or get-up will be understood by the trade and the public in that country as that of the goods of the plaintiff's goods. It is in the nature of acquisition of a quasi-proprietary right to the exclusive use of the mark or get-up in relation to goods of that kind because of the plaintiff having used or made it known that the mark or get-up has relation to his goods. Such right is invaded by anyone using the same or some deceptively similar mark, get-up or name in relation to goods not of plaintiff. The three elements of passing-off action are the reputation of goods, possibility of deception and likelihood of damages to the plaintiff. In our opinion, the same principle, which applies to trade mark, is applicable to trade name.*

*184. In Satyam Infoway Ltd. Vs. Sifynet Solutions (P) Ltd., (2004) 6 SCC 145, the Hon'ble Supreme Court was concerned with an invented / coined word "Sify" and held that in "An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing-off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a*



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C.S.(Comm. Div.) No.713 of 2015

*distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.*

*185. That apart, the Court has to view whether there is likelihood of confusion with the possible injury to the public and consequential loss to the appellant. Similarity in the name may lead an unwary user of internet of average intelligence and imperfect recollection to assume the business connection between the two. Thus, to maintain a suit for passing-off, the plaintiff has to be established that the mark is distinctive.*

*186. In order to show what amounts to sufficient business to amount to goodwill, the claimant should show that it has sufficient goodwill in the form of customer base.*

*187. In Laxmikant V. Patel Vs. Chetanbhai Shah, (2002) 3 SCC 65, the Hon'ble Supreme Court observed as under:-*

*13. In an action for passing-off it is usual, rather essential, to seek an injunction, temporary or ad interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff*



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C.S.(Comm. Div.) No.713 of 2015

*must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly (ibid, para 16.16) passing-off cases are often cases of deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in Law of Passing-Off (1995 Edn., at p. 3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing-off. Likelihood of damage is sufficient. The same learned author states that the defendant's state of mind is wholly irrelevant to the existence of the cause of action for passingoff (ibid, paras 4.20 and 7.15). As to how the injunction granted by the court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiff's distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name (Kerly, ibid, para 16.97).*

188. In *JK Oil Industries Vs. Adani WilmarLtd.*, 2010 (42) PTC 639 (Del.), the Delhi High Court has observed as follows:

*“In order to bring home a tort of passing off, the plaintiff will have to establish and prove the following: (i) the defendant has made a false representation or employed deception. Mere confusion will not suffice; (ii) because of such false representation an unwary consumer is deceived,*



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C.S.(Comm. Div.) No.713 of 2015

*though there is no necessity to prove intent; and (iii) lastly, the false representation has injured the plaintiff's goodwill and not just its reputation.*

*11.1 In sum and substance passing off is really a tort of false representation whether intentional or unintentional whereby, one person attempts to sell his goods or service as those manufactured or rendered by another, which is, "calculated" to damage the goodwill of the other person. (See Erven Warnink BV vs Townend & Sons (Hull) Ltd 1980 RPC 31 at page93). Therefore, for the plaintiff to succeed, it will have to prove all three ingredients referred to hereinabove. (See Island Trading vs Anchor Brewery 1989 RPC 287 at page 295).*

*189. In Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceuticals Laboratories, (1965) 1 SCR 737:AIR 1965 SC 980, the Court recognised that 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 that of another. In the same decision, the Court held as follows:-*

*“30. The mark of the respondent which he claimed was infringed by the appellant was the mark ‘Navaratna Pharmaceutical Laboratories’, and the mark of the appellant which the respondent claimed was a colourable imitation of that mark is ‘Navaratna Pharmacy’. Mr Agarwala here again stressed the fact that the ‘Navaratna’ which constituted an essential part or feature of the Registered Trade Mark was a descriptive word in common use and that if the use of this word in the appellant's mark were disregarded there would not*



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C.S.(Comm. Div.) No.713 of 2015

*be enough material left for holding that the appellant had used a trade mark which was deceptively similar to that of the respondent. But this proceeds, in our opinion, on ignoring that the appellant is not, as we have explained earlier, entitled to insist on a disclaimer in regard to that word by the respondent. In these circumstances, the trade mark to be compared with that used by the appellant is the entire registered mark including the word 'Navaratna'. Even otherwise, as stated in a slightly different context: [Kerly on Trade Marks 8th Edn. 407]*

*“Where common marks are included in the trade marks to be compared or in one of them, the proper course is to look at the marks as wholes and not to disregard the parts which are common”.*”

*190. In Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd., (1955) 2 SCR 252 : AIR 1955 SC 558, in para 14, it has been held as follows:-*

*14. It is true that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. As said by Lord Esher in Pinto v. Badman [8 RPC 181 at p 191] :*

*“The truth is that the label does not consist of each particular part of it, but consists of the combination of them all”.*

*Observations to the same effect will be found also in*



C.S.(Comm. Div.) No.713 of 2015

*In re Apollinaris Company's Trade Marks [LR (1891) 2 Ch 186] , In re Smokeless Powder Co., In re Clement and Cie [LR (1900) 1 Ch 114] and In re Albert Baker & Company and finally in the Tudor case referred to above which was decided by Sargant, J. This circumstance, however, does not necessarily mean that in such a case disclaimer will always be unnecessary. It is significant that one of the facts which give rise to the jurisdiction of the tribunal to impose disclaimer is that the trade mark contains parts which are not separately registered. It is, therefore, clear that the section itself contemplates that there may be a disclaimer in respect of parts contained in a trade mark registered as a whole although the registration of the mark as a whole does not confer any statutory right with respect to that part.*

*191. In F. Hoffmann-La Roche & Co. Ltd. Vs. Geoffrey Manner & Co. (P) Ltd., (1969) 2 SCC 716 at page 720, it was held as follows:-*

*“It is also important that the marks must be compared as wholes. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient, similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. Thus, in Lavroma case [Tokalon Ltd. v. Davidson & Co., 32 RPC at 133 at 136] Lord Johnston said: “...*



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C.S.(Comm. Div.) No.713 of 2015

*we are not bound to scan the words as we would in a question of comparatioliterarum. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop.”*

*192. In Amritdhara Pharmacy Vs. Satya Deo Gupta, (1963) 2 SCR 484 : AIR 1963 SC 449, in para 8, it was been held as follows:*

*“8. We agree that the use of the word “dhara” which literally means “current or stream” is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, “fools or idiots”, may be deceived. A critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing-the whole word has to be considered. In the case of the application to register “Erectiks” (opposed by the proprietors of the trade mark “Erector”) Farwell, J., said in William Bailey (Birmingham) Ltd. Application [(1935) 52 RPC 137] :*

*“I do not think it is right to take a part of the word*



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C.S.(Comm. Div.) No.713 of 2015

*and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole.... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word.”””*

135. There is also no scope for interring any confusion although the plaintiff has attempted to make out a possible case for confusion to establish there is passing off. There is no confusion as the marks are entirely different although they are used in the same industry. The plaintiff ought to have adopted a mark which is distinctive.

136. The plaintiff ought to have noted that the word “Sprinkle” is not distinctive word. Having adopted a word as a mark which is so common to the trade, the plaintiff cannot claim monopoly to the exclusion of the defendants. The word “sprinkle” is common to the food industry especially in the context of salts and spices.

137. In the light of the above discussions the issues framed are



C.S.(Comm. Div.) No.713 of 2015

consolidated as under:-

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138. **Issue No.1:-** Whether the mark “SPRINKLERS” is distinctive and entitled to protection under the Trade Marks Act, 1999?

**Answer:-** It is irrelevant whether the word “Sprinkler” is distinctive and entitle to protection under the Trade Marks Act, 1999. Both plaintiff and the defendants are entitled to protection subject to the limitations of the registration. However, such registration will not give an exclusive monopoly or right against each other.

139. **Issue No.2:-** Whether the plaintiff is the prior user of the Trademark “Sprinklers”?

**Answer:-** Although plaintiff has claimed to be using the mark since 1986, the application that was filed by the plaintiff in 1993 claims to be user since 1986. This is evident from the fact that the application that



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C.S.(Comm. Div.) No.713 of 2015

was originally filed on 08.03.1993 was amended as the label which was subject matter of TM.No.592204 wrapper indicating date of manufacture on 10/2001 as below:-

**Iodised Salt**  
**SPRINKLE**

Net Wt. 500 GMS

592204  
8 MAR 1993

CONSUMES IODINE & HELPS HEALTHY GROWTH  
NUTRIENT FOR YOUR AND YOUR CHILDREN

Manufactured by: **VEPPALGOAI CHEMICALS**  
Plot No. 100, South Cotton Road, Tuticorin - 620 001

Max. Retail Price: Rs. 3.00 (Inclusive of all taxes)

REGD. CHD. 592204 ✓  
F-248

1. Name of the Applicant : Jotham Motha,  
H. Sell Motha,  
Smt. Grace Palidano,  
Smt. Rohini Motha,  
Smt. D. Manamagethai,  
Smt. Indira Motha,  
M.V. Vaidyan,  
Smt. V. Sankila,  
Smt. B. Poojamma &  
Michael Motha  
Trading as:  
VEPPALGOAI CHEMICALS.

2. Address : No.100, South Cotton Road,  
Tuticorin - 620 001,  
Chidambaram District  
South India.

3. Goods : Iodised free flow salt.

4. Class : 30

5. User : Since 1986.

6. Descriptions : Manufacturers & Merchants.

SIGNATURE FOR THE APPLICANT.



C.S.(Comm. Div.) No.713 of 2015

[illegible]

Therefore, although the issue is answered as above it is of no significance as the plaintiff has no right against the defendant.



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C.S.(Comm. Div.) No.713 of 2015

140. **Issue No.3:-** Whether the defendants is using the word “Sprinklers” as a mark in relation to its goods?

**Answer:** There is no dispute that the defendants are using the word “Sprinklers” in relation to not only iodised salt but also chat masala and pepper in Class 30. Therefore, Issue No.3 is answered accordingly.

141. **Issue No.4:-** Whether the plaintiff is entitled to relief in respect of alleged infringement?

**Answer:-** In the light of the above Issue No.4 is answered against the plaintiff.

142. **Issue Nos.5 and 6:-** Whether the defendants is passing off its goods as those of the plaintiff by selling products by using the terms “Catch Sprinklers”? and Whether the defendants is passing off its goods



C.S.(Comm. Div.) No.713 of 2015

as those of the plaintiff by selling products by using the terms “Catch  
Sprinklers”?

**Answer:-** Both the plaintiff and the defendants are engaged in similar trade. The Question of passing off by the defendants cannot be countenanced as the products are packaged differently. The plaintiff's product is sold in a polythene cover, whereas the defendants products are sold in a cylindrical container wherein the word SPRINKLERS is used along with the registered Trademark CATCH in a stylized font. The overall Trade Dress get-up, color scheme and the layout of the labels of the plaintiff and the defendants are materially different. There is hardly any scope for any confusion.

That apart, the word “SPRINKLERS” and “SPRINKLE” are very common to the food industry. Salt is sprinkled on the food to enhance test and therefore, the application that was originally filed by the plaintiff itself was objected by the Trademark registry stating that the mark was descriptive. Although the plaintiff has used the expression “Sprinkle” as a noun, the word “Sprinkle” is a verb signifying an action. The word “Sprinkler” is also a verb.



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C.S.(Comm. Div.) No.713 of 2015

143. **Issue No.7:**Whether the parties are entitled to any other reliefs?

**Answer:** In view of the above, the issue No.7 is also answered against the plaintiff.

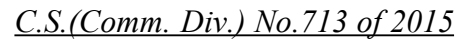
144. The Registrar of Trade Mark did not find the mark to be distinctive and had raised objection.

145. Although the defendant has been negligent and inconvenienced the Court, the plaintiff cannot succeed merely because defendant has failed to produce the information that was available in a proper manner. Court can order cost to be paid by the defendant for the negligence.

146. Therefore, this Court is inclined to order cost payable by the defendants to a sum of Rs.50,000/- (Rupees Fifty Thousand Only) to the credit of the Adayar Cancer Institute.

147. With these observations and directions, the suit stands dismissed.

**.06.2023**



Index: Yes/ No

rgm

| <b>Ex.Nos.</b> | <b>Date</b> | <b>Nature of Documents</b>                                                                  |
|----------------|-------------|---------------------------------------------------------------------------------------------|
| Ex.P1          | -           | Plaintiff's label                                                                           |
| Ex.P2          | -           | Defendant's label                                                                           |
| Ex.P3          | 11.02.2015  | Legal Use Certificate of the Plaintiff No.592204                                            |
| Ex.P4          | 11.02.2015  | Legal Use Certificate of the Plaintiff No.1398971                                           |
| Ex.P5          | 11.02.2015  | Legal Use Certificate of the Plaintiff No.1398972                                           |
| Ex.P6          | -           | Sample Sale Invoices of the Plaintiff's products                                            |
| Ex.P7          | -           | Sample Advertisements and Advertising invoices of Plaintiff's products                      |
| Ex.P8          | -           | Invoices showing sale of the impugned product within the jurisdiction of this Hon'ble Court |

| Ex.Nos. | Date       | Document                                                                                                                                                                       |
|---------|------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Ex.D1   | 18.11.2015 | Board Resolution of DS Spiceco Pvt.Ltd dated November 18,2015 evincing Mr.Saurabh Mishra's capacity and authority to sign the requisite documents on behalf of the defendants. |
| Ex.D2   | 10.12.2015 | Board Resolution of Dharmपाल Satyapal Sons Pvt.Ltd dated December 10, 2015 evincing Mr.Saurabh Mishra's capacity                                                               |



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C.S.(Comm. Div.) No.713 of 2015

|        |            |                                                                                                                                                                                                                                 |
|--------|------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|        |            | and authority to sign the requisite documents on behalf of the defendants.                                                                                                                                                      |
| Ex.D3  | 21.12.2021 | Board Resolution of DS Intellectual Properties Pvt.Ltd. dated December 21, 2021 evincing Ms.Samhita Chaudary's capacity and authority to sign the requisite documents on behalf of the defendants.                              |
| Ex.D4  | -          | Photographs of third party usage of the word SPRINKLERS on salt/spice packaging of salt/spice manufacturers & settlers worldwide and India                                                                                      |
| Ex.D5  | -          | Printouts from the online dictionaries like Collins, Merriam-Webster, Random House, Cambridge, Oxford, Macmillan bearing definitions of the words SPRINKLE and SPRINKLER                                                        |
| Ex.D6  | -          | Printouts of recipes of renowned chefs all over the world and India illustrating usage of word sprinkle for referring to addition of salt in the dish.                                                                          |
| Ex.D7  | -          | Printouts from the websites <a href="http://www.tradeindia.com">www.tradeindia.com</a> & <a href="http://www.panjiva.com">www.panjiva.com</a> listing out manufacturers and suppliers of salt sprinklers as a separate category |
| Ex.D8  | -          | Printouts from the Defendant's website <a href="http://www.dsgroup.com">www.dsgroup.com</a> showing generic use of the word SPRINKLERS                                                                                          |
| Ex.D9  | -          | Document evincing that Superbrand had declared CATCH as a Superbrand in the year 2009-2010                                                                                                                                      |
| Ex.D10 | -          | Printouts from Plaintiff's website <a href="http://www.sahayamathasalts.com">www.sahayamathasalts.com</a> evincing that the Plaintiff does not have a pan                                                                       |



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C.S.(Comm. Div.) No.713 of 2015

|                     |            |                                                                                                                                                                                      |
|---------------------|------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|                     |            | India presence and its products are available only in a few southern states of India                                                                                                 |
| Ex.D11              | 08.03.1993 | Documents evidencing the fact that the Plaintiff's application for registration of trademark was filed on March 8, 1993 along with the examination report issued in respect thereof. |
| Ex.C1<br>&<br>Ex.C2 |            | Xerox copies of the Trademark Certificates obtained by the defendant in Class 30                                                                                                     |

**C. S. N. J.,**

**09 .06.2023**



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C.S.(Comm. Div.) No.713 of 2015

**C.SARAVANAN, J.**

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C.S. (Comm. Div.) No.713 of 2015

09.06.2023