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

Reserved on : 12th March, 2018

Date of Decision: 20th April, 2018

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RFA 17/2009

MARICO LTD

..... Appellant

Through: Ms. Anuradha Salhotra & Mr. Achal
Shekhar, Advs. (M-9602338663).

versus

MRS. JAGIT KAUR

..... Respondent

Through: None.

CORAM:

JUSTICE PRATHIBA M. SINGH

JUDGMENT

Prathiba M. Singh, J.

1. Before the Copyright Board, an application was preferred under Section 50 of the Copyright Act, 1957 by Hindustan Unilever Limited, the predecessor of Marico Ltd., Appellant herein, (*hereinafter* 'Appellant') against one M/s. J.K. Enterprises (proprietary concern of Mrs. Jagjit Kaur) (*hereinafter*, 'Respondent'). The Appellant sought rectification of the impugned entry in the Register of Copyrights bearing no. A-64850/2003 dated 25th July, 2003, which is an artistic work for the label "NIHAL UTTAM". The Appellant claims to be the successor-in-interest of Tata Oil Mill Company Ltd. (*hereinafter*, 'TOMCO') which had coined the brand name 'TATA NIHAR'. In 1994, the brand was amended to 'NIHAR' and was used in respect of hair oil, coconut oil, cosmetics, perfumes, etc. The earliest trade mark registration of the word "NIHAR" dated back to 24th October, 1994 and has since been registered in India and in several other countries

including Qatar, Kuwait, Malaysia, Bangladesh, Nepal, UAE, Saudi Arabia, Yemen, Mauritius and others.

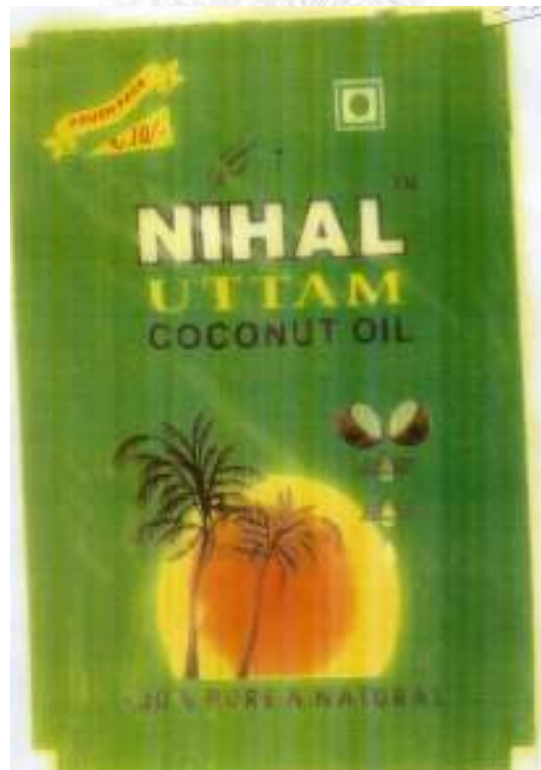
2. It is the case of the Appellant that the trade mark NIHAR has been in use for several years in respect of coconut oil and the label that has been used, has the primary colour scheme of green, yellow and white with the representation of two coconut trees. Over the years though, the labels themselves have been amended, the fundamental get up and colour scheme continued to remain the same. The Appellant came across the Respondent's copyright registration bearing No A-64850/2003. The Appellant's contention was that the Respondent registered the impugned copyright as an '*artistic work*' under Section 2(c) of the Copyright Act, in the year 2003. The registration issued to the Respondent dated 25th July, 2003 claimed the first publication to be of 2002. Accordingly, a Rectification Petition came to be filed before the Copyright Board, seeking rectification/removal of the Respondent's registration from the Register of Copyrights. Before the Board, the Appellant was substituted as Petitioner in the petition after assignment of relevant rights from Hindustan Unilever Ltd. Accordingly, the Appellant herein would be deemed to include the present Appellant or its predecessor. The Rectification petition was dismissed on 21st September 2008 and the present appeal assails the said order. On the last date, counsel appearing for the Respondent had sought discharge after giving notice to the Respondents. Counsel was accordingly discharged and the matter was adjourned. None appears for the Respondent and is therefore proceeded ex parte. Submissions on behalf of the Appellant have been heard.

3. A perusal of the Respondent's impugned copyright registration and the Appellant's labels show that there are several similarities between the

same. The comparison of the works of the Appellant and the Respondent are set out below:



(APPELLANT'S LABEL)



(RESPONDENT'S LABEL)

4. A perusal of the labels which are extracted above clearly shows that

the Respondent's artistic work "NIHAL UTTAM" is clearly not an original work but an imitation of the Appellant's label. The Respondent's label is a substantial reproduction and a colourable imitation of the Appellant's "NIHAR COCONUT OIL". The Appellant is thus a person aggrieved and is entitled to maintain the petition under Section 50 of the Copyright Act 1957. The said provision reads as under:

"50. Rectification of Register by Appellate Board.- The Appellate Board on application of the registrar of Copyrights or of any person aggrieved, shall order the rectification of the Register of Copyrights by-
(a) the making of any wrongly omitted to the register,
or
(b) the expunging of any entry wrongly made in, or remaining on, the register, or
(c) the correction of any error or defect in the register."

5. The question that arises in this case is as to whether the Respondent's impugned copyright registration is an "entry wrongly made in or remaining on the Copyright Register". Any entry made of a work which is not an original work would be an entry wrongly made in the Register. A perusal of the Respondent's registration shows that the Respondent claims the "NIHAR UTTAM" label extracted above to be an 'artistic work' published for the first time in 2002. Copyright registration can only be granted to original artistic works. Registration of copyright cannot be granted to works which are a reproduction or imitation of other original works. If any person has obtained registration of copyright of a work which is not an original work under Section 13 of the Copyright Act, such a registration or entry made in the register would be an entry wrongly made.

6. A perusal of the labels extracted hereinabove shows that the comparative features of the two labels are so similar that “NIHAL UTTAM” label can safely be termed as colourful imitation or substantive reproduction. Colour scheme between the two labels is the same. The manner in which the coconut tree is arranged is the same, the arrangement of two broken coconuts is similar. Due to the long user in the market, the Appellant’s label was quite extensively used and hence the Respondent had access to the Appellant’s label. It is the settled position in law that when two labels or artistic works are compared, the broad features are to be compared and not by putting the two labels side by side. The Supreme Court in ***Parle Products P. Ltd v. J. P. & Co., Mysore (1972) 1 SCC 618*** observed as under:

“9. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one, to accept the other if offered to him. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The

word "Glucose Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary, to refer to the decisions referred to at the Bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it."

Though the above observation has been rendered in the context of comparison of label marks in a passing off action, the tests for comparison of labels which are artistic works, would be the same.

7. The Copyright Board has primarily rejected the Appellant's contentions on the ground that 'NIHAR' is a word of Sanskrit origin. 'NIHAL', on the other hand, owes its origin to Persian. The Copyright Board has further held that the Appellant's allegations in the copying are in a very generalized form and no specifics of the attributes of copying have been explained. Hence, the Copyright Board held that there is no shred of evidence to explain the copying. The Copyright Board has, thereafter, observed as under:

"Copy of the labels annexed to the registration

certificate granted to the respondent under question submitted by the petitioner as Annexure L indicates works NIHAL UTTAM superscripted with the word 'NIHAL' in Aerial Black fonts and the word 'UTTAM' written down below 'NIHAL' in Elephant fonts. There is in left margin in the circle mentioned in semi circle '100% PURE&NATURAL' and within the larger circle in a small circle superscribed J.K. in Edwardian Script ITC fonts with two coconut trees down below that. Petitioner had been using all along 'NIHAR' with its various variations with three successive owners. These words owe their roots to different languages having distinct meanings. Whereas 'NIHAR' is a word of Sanskrit origin 'NIHAL' owes its origin to Persian. Petitioner has alleged about the copying in a very generalised form and no specifics of the attributes of copying have been explained. There is not a shred of evidence of buttress as to the features of copying. Arguments in the nature of class of goods and nature of business of the Petitioner and Respondent being similar and so there being degree of confusion and deception have a prominent role in determining a matter relating to the rights of a trade mark. In matter of copyright, lackness of the originality of the work is the touchstone."

8. A perusal of the above findings of the Copyright Board reveals that the Copyright Board has made fundamental errors in analysing the two artistic works. Arguments in the nature of class of goods and nature of business of the petitioner and respondent not being similar and so there being no chances of confusion and deception do not have a bearing in a matter involving rectification of copyright. In matters of rectification of copyright, a lack of originality in the work is the touchstone. The Board is concerned with artistic features in the label and not with the trademark. The

artistic features and their comparison clearly shows that the Respondent's label has been clearly inspired by the Appellant's label and the features, colour combination, get up, etc., are also substantially similar. The Respondent's publication and the creation of the work are also subsequent to that of the Appellant. Under such circumstances, the rejection of the rectification application on the ground that the word "NIHAR" comes from Sanskrit and "NIHAL" owes its origin to Persian is completely contrary to law.

9. The Copyright Board has observed that the Division Bench of High Court of Calcutta has vacated the stay earlier granted by the Single Judge of the said High Court. The present appeal is independent of the said proceedings pending in the Calcutta High Court, inasmuch as the Court in this case is concerned with the originality of the label of the Respondent. The exact status of the said litigation in the Calcutta High Court has not been brought before this Court. This Court is only concerned with the reasoning of the Copyright Board in dismissing the rectification petition filed by the Appellant.

10. Though trademarks and copyright operate under different statutes, since rights in an original artistic work could overlap with label marks registrable under the Trade Marks Act, the legislature in its wisdom added a proviso to Section 45 in the Copyright Act which reads as under:

"45. Entries in Register of Copyrights.- (1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights:

[Provided that in respect of an artistic work which is used or is capable of being used in [relation to any goods or services], the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in [Section 3 of the Trade Marks Act, 1999 (47 of 1999)], to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by any person other than the applicant.]
(2) On receipt of an application in respect of any work under sub-section (1), the Registrar of Copyrights may, after holding such inquiry as he may deem fit, enter the particulars of the work in the Register of Copyrights.”

11. Thus, before any application for copyright registration can be allowed, the applicant has to seek a no objection from the Registrar of Trademarks. The Registrar has to see as to whether any trademark identical or deceptively similar to such artistic work exists on the Trade Marks Register and then issue a No-Objection letter. In the present case admittedly, the Trademark for the word “NIHAR” was applied for and registered since 1994 for an identical class of products i.e. oil. It is unclear as to whether the Appellant itself or its predecessor had registered any label as “NIHAR” for coconut oil. Thus, it cannot be said that the no objection certificate issued in favour of the Respondent was wrongly issued by the Registrar of Trademarks. However, the other evidence which was presented by the Appellant in the form of the following documents ought to have been considered by the Copyright Board.

- 1) Copies of packaging of TATA NIHAR since 1995
- 2) Economic Times dated 27th April, 2002 about the market share

of TATA NIHAR.

- 3) Deed of assignment dated 10th September, 1997 between Ajit Upasham, and the predecessor of the Appellant assigning the copyright to the Appellant's predecessor.
- 4) Second deed of assignment dated 25th August, 2001 for several variations of NIHAR label.

12. The above documents were sufficient to show that the Appellant's work/label was available earlier in the market. It is the settled position in law that copyright exists independent of registration. Thus, the Appellant's labels are original artistic works. Owing to the similarity between Appellant's and Respondent's label, it can be safely concluded that the Respondent's label, subject matter of the impugned Copyright registration, is not an original artistic work.

13. A perusal of the Trademark Registrar's website shows that the Respondent has attempted registration of various trademarks bearing nos.1105118 for NIHAL UTTAM, 1452054 for NIHAL ACTIVE WASHING POWDER, 1452057 FOR NIHAL ACTIVE (LABEL), 1584396 for NIHAL ACTVIE FRESH, DEVICE OF WASHING MACHINE & BUBBLES (LABEL) and 1584398 for NIHAL GOLD, JK (MONO), DEVICE OF COCONUT, COCONUT TREE & DROPS (LABEL). All of the above trademarks have been refused, withdrawn or opposed. Thus, the Respondent appears to be making a special attempt to imitate the Appellant and copy various marks and labels of the Appellant. The conduct of the Respondent is clearly dishonest and thus, the dictum of Justice Kekewich in ***Munday v Carey (1905) R.P.C 273 at 276*** clearly applies wherein the Court held as under:

“Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity”

14. Under the Copyright Act, all that the Board needs to look at is the comparison of the artistic works. The Board is not examining all the factors that are relevant to a passing off action. The artistic works being so similar that one is almost an imitation of the other, there is no justification to reject the rectification application. The Appellant's products were openly advertised and have substantial sale in the market. Clearly, the Respondent had access to the Appellant's works and was copying the same. The Appellant being a person aggrieved, the registration is an entry which wrongly remains in the Register. The reasoning of the Copyright Board is contrary to law.

15. Moreover, it appears that the Respondent has also now gone out of business and the Respondent's address is also not traceable. Under these circumstances, the Copyright Board's judgment is set aside. The Copyright registration for the artistic work bearing No. A-64850/2003, described as 'NIHAL UTTAM' is cancelled/ rectified. The same is directed to be removed from the Register of Copyrights. Needful to be done within 8 weeks. A copy of this order be sent to the Registrar of Copyright Board, Baudhik Sampada Bhavan, Plot No.32, Sector-14, Dwarka, New Delhi for compliance.

16. Appeal is allowed in the above terms.

PRATHIBA M. SINGH
Judge

APRIL 20, 2018/Rahul