



O.A.Nos. 551 to 555 of 2023

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Reserved on : 23.08.2023

Delivered on : 10.10.2023

CORAM

THE HONOURABLE Ms. JUSTICE P.T. ASHA

O.A.Nos. 551 to 555 of 2023

in

C.S.(Comm Div). No. 153 of 2023

Britannia Industries Ltd.,
Mr. Ravichandran Rajagopal
5/1A, Hungerford Street,
Kolkata – 700017
West Bengal, India

...applicant

Vs

ITC Limited
Virginia House,
37, J.L. Nehru Road,
Kolkata – 700071
and also at
69 Pasumpon Muthuramalinga Thevar Road,
(Chamiers Road), Austin Nagar,
Nandanam, Chennai – 600 035



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and also at
ITC Limited
Education & Stationary Products Business
ITC Centre, 4th and 5th Floor,
760 Anna Salai,
Chennai – 600002.

...respondents

Prayer: Judges summons is filed for the following reliefs:

(a) Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from manufacturing, exporting, marketing, offering for sale (physical or online platforms), selling (physical or online platforms), advertising (physical or online platforms) or in any manner dealing in any Biscuits/Cookies including but not limited to Butter Cookies and/or such allied and cognate goods which is identical or deceptively similar to the Applicant's registered trademark/ Trade Dress/packaging/ colour scheme/get up/layout of BRITANNIA GOOD DAY BUTTER COOKIES amounting to infringement of Applicant's registered trademark/trade dress/packaging/ colour scheme under Registration



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Numbers 4182344, 5186937, 5186938, 5186939 and 5186940 in
Class 30, pending disposal of suit.

(b)Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its Officers, servants and agents or anyone acting for and on their behalf from manufacturing, exporting, marketing, offering for sale (physical or online platforms), selling (physical or online platforms), advertising (physical or online platforms) or in any manner dealing in any Biscuits and/or such allied and cognate goods under the Impugned Trade Dress of Respondent in the present Complaint or any other trade dress deceptively similar to applicant's Trade Dress/packaging/ colour scheme/get up/layout of BRITANNIA GOOD DAY BUTTER COOKIES or any trade dress/packaging/ colour scheme as used or had been used by Applicant for its product BRITANNIA GOOD DAY BUTTER COOKIES amounting to passing off , pending disposal of suit.



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(c) Ad-interim injunction restraining all the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from manufacturing, exporting, marketing, offering for sale (physical or online platforms), selling (physical or online platforms), advertising (physical or online platforms) or in any manner dealing in any Biscuits including but not limited to 'Sunfeast MOM'S MAGIC BUTTER' Cookies and/or such allied and cognate goods under the Trade Dress/packaging/ colour scheme/get up/layout of Applicant's BRITANNIA GOOD DAY BUTTER COOKIES or any other trade dress/ colour scheme of the Applicant which is a reproduction and/or substantial reproduction of BRITANNIA GOOD DAY BUTTER COOKIES so as to infringe the Applicant's Copyright in the original artistic works by reproducing the same in any material form or using the same or any colourable imitation thereof or otherwise howsoever, pending disposal of suit.



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(d) Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from launching, selling (physical or online platforms), manufacturing, marketing (physical or online platforms), offering for sale (physical or online platforms) or in any manner dealing in any Biscuits/Cookies including but not limited to 'Sunfeast MOM'S MAGIC BUTTER' Cookies under the trade dress which is identical or deceptively similar to Applicant's Trade Dress/packaging/ colour scheme/get up/layout used for BRITANNIA GOOD DAY BUTTER COOKIES or any other trade dress/ colour scheme which is identical or deceptively similar to the Applicant's trade dress/ colour scheme amounting to dilution of the goodwill and reputation of the applicant's trade dress / colour scheme or doing any other thing which will lead to dilution of the applicant's, intellectual property



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(e) Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from launching, selling (physical or online platforms), manufacturing, marketing (physical or online platforms), offering for sale (physical or online platforms) or in any manner dealing in any Biscuits/Cookies including but not limited to 'Sunfeast MOM'S MAGIC BUTTER' Cookies under the trade dress which is identical or deceptively similar to Applicant's Trade Dress/packaging/ colour scheme/get up/layout used for BRITANNIA GOOD DAY BUTTER COOKIES or any other trade dress/ colour scheme which is identical or deceptively similar to the Applicant's trade dress/ colour scheme amounting to unfair competition or doing any other act amounting to unfair competition, pending disposal of suit.



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For applicant : Mr. P.S.Raman
for Mr. M.S. Bharath

For respondent : Mr. Vijay Narayanan
Senior Counsel
Mr. S.R. Rajagopal
Senior Counsel
Mr. Srinath Sridevan
Senior Counsel
for Mr. Arun C.Mohan.

JUDGMENT

Aggrieved by the colour scheme suddenly adopted by the defendant / respondent for their Butter Cookies “Sunfeast Mom's Magic Butter Cookies” which is visually identical to the colour scheme and label of the plaintiff / applicant's Butter Cookies “Good Day”, the applicant has approached this court seeking relief to restrain the respondent from adopting the same and marketing / selling their products in the market.



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2. The applicant would contend that they are a well known company which was initially set up to manufacture biscuits way back in the year 1892. They had started their business in a small house in Calcutta (as it was then known). The applicant has taken its present name, namely, Britannia Industries Limited, in the year 1979. The applicant manufactures various varieties of biscuits, breads, cakes, rusk and dairy products which includes butter, cheese, yogurt, milk etc., One of the most popular brands of the applicant is their “Good Day” brand, which in turn has several flavours.

3. The above suit is with reference to one such flavour / variant called “Good Day Butter Cookies”. The applicant has a pan India presence and the products are available throughout the country. It is the contention of the applicant that they have developed a huge market base through their wide spread advertisement and the turnover for the brand Good Day is also sizable.



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4. The applicant would contend that under the umbrella Good Day apart from Butter Cookies, there are various other variants / flavours, namely, Cashew Cookies, Choco Chip, Pista Badam Cookies, Choco Nut cookies, Choco Almond cookies, mixed fruit etc,. It is the applicant's contention that the name Britannia Good Day was adopted by them in the year 1986 and since then, they have been continuously and extensively using the same. From the year 1997, the applicant has started selling the Butter Cookies in a distinctive wrapper having blue as a primary colour and yellow as its secondary colour. Though the elements / design imposed on the wrapper had undergone changes over the years, from the year 2021 the trade dress of the applicant's brand Good Day Butter Cookies is in the same fashion as depicted in this suit. The colour continues to be primarily blue with yellow as a secondary colour, with the name Britannia in white lettering inside a red band above the words Good Day. The name Good Day in white is artistically depicted with a word “day”



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being drawn below the word “good” and “y” being drawn to depict a smile.

5. That apart, the wrapper has the picture of a single biscuit with butter shavings at the base of the biscuit. The applicant would submit that the smily device “day” has also been registered. It is the applicant's case that the over all get up and the colour blue and yellow has become associated with the applicant's biscuits in the minds of the public.

6. The applicant has further stated that the other manufacturers of Butter Cookies have adopted other colours for the wrappers and those who have adopted the colour blue with the attendant images of the cookies and butter shavings which resembles the trade dress of the applicant have been visited with legal proceedings initiated by the applicant. The applicant would submit that in and around June 2023, the applicant had come across the respondent's product Sunfeast



Mom's Magic Butter Cookies wrapped in the same trade dress. The wrapper is identical to that of the applicant's. The applicant would submit that the respondent had started marketing Butter Cookies only in the year 2015. From 2015 to 2023, the biscuit was being sold in a red coloured wrapper. It is only with effect from June 2023 that the respondent had suddenly switched to the colour blue for its wrapper.

7. It is the applicant's contention that with the introduction of the colour blue except for the name, in all other respects the respondent's products are identical to that of the applicant's. According to the applicant, this is a dishonest adoption by the respondent with an intent to eat into applicant's well established market. It is primarily the contention of the applicant that the entire get up with the colour would lead to confusion amongst the general public and the respondent could easily pass off their product as that of the applicant's product.



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8. The applicant on the other hand has been doing business in this segment since the year 1997 and over 2 decades and 6 years they have carved a niche for themselves in respect of this variant in the market. The respondent who is a late entrant had adopted the colour red initially and it is only in the month of June of this year, i.e., 2023 that the respondent had decided to adopt the colour blue. Along with the suit, the applicant has also filed the following interim applications:

(a) Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from manufacturing, exporting, marketing, offering for sale (physical or online platforms), selling (physical or online platforms), advertising (physical or online platforms) or in any manner dealing in any Biscuits/Cookies including but



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not limited to Butter Cookies and/or such allied and cognate goods which is identical or deceptively similar to the Applicant's registered trademark/ Trade Dress/packaging/ colour scheme/get up/layout of BRITANNIA GOOD DAY BUTTER COOKIES amounting to infringement of Applicant's registered trademark/trade dress/packaging/ colour scheme under Registration Numbers 4182344, 5186937, 5186938, 5186939 and 5186940 in Class 30, pending disposal of suit.

(b)Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its Officers, servants and agents or anyone acting for and on their behalf from manufacturing, exporting, marketing, offering for sale (physical or online platforms), selling (physical or online platforms),



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advertising (physical or online platforms) or in any manner dealing in any Biscuits and/or such allied and cognate goods under the Impugned Trade Dress of Respondent in the present Complaint or any other trade dress deceptively similar to applicant's Trade Dress/packaging/ colour scheme/get up/layout of BRITANNIA GOOD DAY BUTTER COOKIES or any trade dress/packaging/ colour scheme as used or had been used by Applicant for its product BRITANNIA GOOD DAY BUTTER COOKIES amounting to passing off, pending disposal of suit.

(c)Ad-interim injunction restraining all the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from manufacturing, exporting, marketing, offering for sale (physical or online



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platforms), selling (physical or online platforms), advertising (physical or online platforms) or in any manner dealing in any Biscuits including but not limited to 'Sunfeast MOM'S MAGIC BUTTER' Cookies and/or such allied and cognate goods under the Trade Dress/packaging/ colour scheme/get up/layout of Applicant's BRITANNIA GOOD DAY BUTTER COOKIES or any other trade dress/ colour scheme of the Applicant which is a reproduction and/or substantial reproduction of BRITANNIA GOOD DAY BUTTER COOKIES so as to infringe the Applicant's Copyright in the original artistic works by reproducing the same in any material form or using the same or any colourable imitation thereof or otherwise howsoever, pending disposal of suit.

(d) Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies,



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Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from launching, selling (physical or online platforms), manufacturing, marketing (physical or online platforms), offering for sale (physical or online platforms) or in any manner dealing in any Biscuits/Cookies including but not limited to 'Sunfeast MOM'S MAGIC BUTTER' Cookies under the trade dress which is identical or deceptively similar to Applicant's Trade Dress/packaging/ colour scheme/get up/layout used for BRITANNIA GOOD DAY BUTTER COOKIES or any other trade dress/ colour scheme which is identical or deceptively similar to the Applicant's trade dress/ colour scheme amounting to dilution of the goodwill and reputation of the applicant's trade dress / colour scheme or doing any other thing which will lead to dilution of the applicant's, intellectual



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property

(e)Ad-interim injunction restraining the Respondent, their partners, proprietors, Companies, Sister Concerns, directors, executives, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from launching, selling (physical or online platforms), manufacturing, marketing (physical or online platforms), offering for sale (physical or online platforms) or in any manner dealing in any Biscuits/Cookies including but not limited to 'Sunfeast MOM'S MAGIC BUTTER' Cookies under the trade dress which is identical or deceptively similar to Applicant's Trade Dress/packaging/ colour scheme/get up/layout used for BRITANNIA GOOD DAY BUTTER COOKIES or any other trade dress/ colour scheme which is identical or deceptively similar to the Applicant's trade dress/ colour scheme amounting to



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unfair competition or doing any other act amounting to

unfair competition, pending disposal of suit.

9. The respondent has filed their counter admitting that they are a late entrant in the market with their Sunfeast range of biscuits. As in the case of applicant's Good Day brand, the respondent's Sunfeast brand consists of variants like Butter Cookies, Cashew cookies, Fruit and Milk, Choco chip, Butter fills, Cashew fills, etc., The respondent would submit that the colour blue is commonly associated with butter and dairy derivative products and therefore the adoption of colour blue by the respondent.

10. The respondent would submit that they have simply replaced the colour of the wrapper from Red to Blue. Therefore, the applicant's primary objection is to the colour blue and not the overlying elements. The respondent would submit that the applicant cannot have monopoly over the colour which is nothing but an



attempt to suppress trade competition. The Red band which is now existing on the wrapper is only a temporary feature to show promotional offers in tune with the trade practice. The respondent would further submit that the applicant has been adopting different colours for different variants under the brand Good Day. It is the contention of the respondent that their label is visually, phonetically and structurally different from that of the applicant and there is no confusion in choosing the product. They would also contend that there are several brands having the colour blue on their wrappers which would only go to show that the applicant does not hold a monopoly to the colour blue. It is also their contention that an average consumer does not purchase biscuits by colour. Therefore, it is their contention that the applicant cannot sustain the suit or the applications.

11. Elaborate oral submissions have been made by Mr.P.S.Raman, learned senior on behalf of Mr. M.S.Bharath, learned



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counsel for the applicant and Mr.Vijay Narayanan, Mr.S.R.Rajagopal, and Mr. Srinath Sridevan, learned senior counsels all making submissions on behalf of Mr. Arun C.Mohan, learned counsel for the respondent.

12. The submissions on either side are herein below set out in a point form.

13. Submissions of the Applicant:

(a) The mark Good Day has been adopted registered and in continuous use since the year 1986. It is a well known and recognised so by the Judgement of the Delhi High Court in ***Britannia Industries Ltd., Vs. Rakesh Kumar Jain and others*** and ***Sh. Gian Chand Garg Vs. Britannia Industries Ltd.***, - 2023 SCC Online 910.



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(b) There are several variants under the umbrella Good Day and the suit is in respect of the variant “Butter Cookies” which from the year 1997 has a distinctive wrapper with blue as the primary colour and yellow as the secondary colour. The elements over this colour combination has undergone changes over a period of time but from 2015 the applicant has continued with the present trade dress.

(c) By long usage (2 decades and 6 years) this packaging / trade dress and colour scheme have come to be associated with the applicant's “Good Day” butter cookies by the consumers.

(d) The volume of sales in respect of these variant has been on a steady rise and the market share of Good Day butter cookies is alone 32.7 % out of the total 61.4% that the entire Good Day brand has cornered.



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(e)The respondent has started to manufacture and market biscuits only in the year 2003 and in 2014 has started the variant butter cookies.

(f)From 2014 the respondent's butter cookies have been sold in a red wrapper and only in June 2023 the respondent has adopted the blue colour.

(g)The biscuits of the applicant and the respondent which is the subject matter of the instant case weighs 50 grams and is priced at Rs.10/-, each. The products are sold side by side and therefore considering this display from the perspective of ordinary person with an average memory and recall there is every likelihood of confusion between the applicant's trade dress and the respondent's.

(h)The recent adoption of the colour blue by the respondent is a dishonest intent particularly when they are to date continuing to sell



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the butter cookies in the red wrapper. The respondent has not explained the reason for the sudden change.

(i)The respondent has not established that the colour blue is associated only with butter and therefore cannot claim defense under Section 30 (2) of the Trade Marks Act since the applicant's case is not about the colour blue alone but a combination of both colour as well as the elements.

14. The learned senior counsel for the applicant has relied upon the following Judgements:

(i)***William Grant & Sons Limited Vs. McDowell and Company Limited*** – 1995 SCC Online Del 398.

(ii)***National Bell Co & Another Vs. Metal Goods Mfg Co. Pvt Ltd & Another*** – (1970) 3 SCC 665.



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(iii)***P.M.Palani Mudaliar & Co., Vs. Jansons Exports and***

others - AIR 2017 Mad 105.

(iv)***Deere & Company & another Vs. Mr. Malkit Singh*** – 2018

SCC Online 8527.

(v)***The Andhra Perfumery Works Joint Family Concerns Vs.***

Karupakula Suryanarayaniah and others – 1967 SCC Online Mad 177.

(vi)***N.Ranga Rao Sons Vs. Anil Garg & others*** – 2005 SCC

Online Del 1293.

(vii)***Cadbury India Limited and Others Vs. Neeraj Food***

Products – 2007 SCC Online Del 841.

(viii)***ITC Limited Vs. Ganesh Flour Mills*** - C.S.NO. 285 of

2013.

(ix)***Intercontinental Great Brands Vs. Parle Products Private***

Limited – C.S. (Comm). No.64 of 2021.

(x)***Corn Products Refining Co. Vs. Shangrila Food Products***

Ltd., - AIR 1960 SC 142.



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(xi) ***Cadila Health Care Ltd., Vs. Cadila Pharmaceuticals Ltd***

—(2001) 5 SCC 73.

(xii) ***Rhizome Distilleries Pvt, Ltd., Vs. Union of India – 2012***

SCC Online Mad 651.

(xiii) ***M/s.South India Beverages Pvt. Ltd., Vs. General Mills***

Marketing Inc. and another – 2014 SCC Online Del 1953.

(xiv) ***Parle Products (p) Ltd., Vs. JP and Co. Mysore – (1972)***

1 SCC 618.

(xv) ***Girnar Food & Beverages Pvt., Ltd., Vs. Godfrey Phillips***

India Ltd., - 2001 SCC Online Del 294.

(xvi) ***Pidilite Industries Ltd., Vs. SM Associates and others –***

2003 SCC Online Bom 143.

(xvii) ***Stamford Foundry Co. Vs. Thatcher Furnace Co. - 200***

F. 324 (1912).

(xviii) ***De Cordova and others Vs. Vick Chemical Coy – (1951)***

68 RPC 103.



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(xix) *Colgate Palmolive Co. Vs. Anchor Health and Beauty*

WEB.COM *Care* – 2003 SCC Online Del 1005.

15. Submissions of the Respondent:

(a) The primary defense is that the applicant cannot claim monopoly over colour and the depiction of the respondent's trademark “Mom's Magic” is in no way similar to that of the applicant's trademark “Good Day”.

(b) The applicant's product and the respondent's product (butter cookies) can be easily distinguished.

(c) When the colour is removed from the applicant's and the respondent's trade dress their products are strikingly dissimilar.

(d) The colour blue is common for the butter and dairy products.



(e)The applicant has not demonstrated as to how the respondent's label for Sunfeast Mom's Magic butter cookies is identical to the applicant's registered trademark label.

(f)The learned senior counsels would highlight the distinguishing features in both the products as set out herein below:

<i>Applicant's Britannia Good Day Butter Cookies</i>	<i>Respondent's Sunfeast Mom's Magic Butter Cookies</i>
If the pack is divided vertically into two halves, the left side as well as the right side halves would remain predominantly blue.	If the pack is divided vertically into two halves, the left side half is predominantly blue and the right side half is pictorial depiction of butter, in its natural colour, “yellow”.
The applicant's alleged well known mark GOOD DAY is written on the left side	The respondent's registered trademark Mom's Magic is written in a distinctive font towards the left side but closer to the centre of the pack
A device of smiley is placed beneath the words good day.	A distinctive device of golden heart is placed on the left side encircling the words mom's



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<i>Applicant's Britannia Good Day Butter Cookies</i>	<i>Respondent's Sunfeast Mom's Magic Butter Cookies</i>
	magic.
Applicant's house mark BRITANNIA is written in white colour within a red oblong device right above the words GOOD DAY	Respondent's umbrella brand SUNFEAST is written in gold colour at the left top corner of the golden heart device.
The packaging includes an image of a single biscuit placed at the middle of the packaging in a straight position. The biscuit design contains the image of a smiley on its lower half and has three butter shavings/ dollops placed below /beside the single biscuit	The packaging contains a distinctive device of a biscuit placed on the right bottom corner in an angular position leaning against the swoosh of butter. The biscuit design contains an image of heart towards the left side of the biscuit in the middle portion.
The device of single biscuit has two radiating circles in two different shades of blue containing the statement “Many smiles make a good day”	The device of biscuit with a heart shape is leaning on a swoosh of butter flowing and forming a butter shaving at the bottom of the golden heart device.



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16. Each of the elements on the wrapper in both the products are totally different and the marks have to be compared as a whole. To support this contention, the respondent rely upon the Judgement reported in **2001 (5) SCC 73 – Cadila Healthcare Limited Vs. Cadila Pharmaceuticals Limited**, (paragraph no.15).

17. As per Section 17 of the Trademarks Act, the applicant can seek infringement of their mark as a whole and cannot dissect the elements more particularly the colour combination. In this regard, they would rely upon the Judgement reported as **Godfrey Phillips India Ltd., Vs. P.T.I. Private Limited and others – 2018 (73) PTC 178 (Del)**.

18. The applicant has stated that they have no objection to the respondent selling their butter cookies in red wrapper which only goes to show that the dispute is with reference to colour. When the



colour is removed and the elements retained there is no resemblance between the two marks. The colour combination for which the monopoly is sought to be asserted is nothing but a colour denoting the characteristics of the product, yellow denotes butter and the colour blue is associated with dairy products. They would rely upon the Judgement reported in **2005 (31) PTC 583 – Colgate Palmolive Company Limited Vs. Patel and Another**, **2008 (36) PTC 166 Del - Cipla Limited Vs. M.K.Pharmaceuticals** and **2023 Scc Online Del 265 - Surya Food and Agro Limited Vs. Om Traders and others**.

19. In the food industry, the colour denotes a particular food variant and therefore the colour which is commonly used by all parties thereby loses its distinctiveness in relation to trademark. In support of this contention, the learned counsel relied upon the Judgement reported in **1970 (3) SCC 665 – National Bell Co. Vs. Metal Goods Mfg. Co.,**



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20. With regard to passing off, the applicant has not proved that the colour combination blue and yellow depicted in their trademark has attained good will and reputation, as a result of which the consumers has started associating this colour combination to the applicant's product. They would rely upon the following judgements to support this contention:

(i) ***Reckitt & Coleman Products Ltd., Vs. Borden Inc.*** - (1990 RPC 341).

(ii) ***Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories*** – AIR 1965 SC 980.

21. The names of both the parties are predominantly displayed on the wrapper and there is no question of confusion. An average consumer does not purchase the product on the basis of the colour but would only refer to the name of the product.



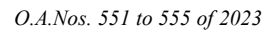
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22. Lastly, there has been no misrepresentation on the part of the respondent.

Discussion:

23. This Court is called upon to prima facie consider if the respondent has infringed the trademark / trade dress / packaging / colour scheme / get up / layout of the applicant and is guilty of passing off their product, namely, Sunfeast Mom's Magic Butter Cookies as that of the applicant's Britannia Good Day Butter Cookies by adopting packaging, particularly the colour combination of the applicant.

24. Before proceeding to discuss the facts and the various citations that have been put forward by the counsels on the either side as also certain other case laws, it is necessary to briefly compare the earlier act, namely, the Trade and Merchandise Marks Act, 1958 with



herein below made in a tabulated statement:

33/67



<i>Trade and Merchandise Marks Act, 1958</i>	<i>Trade Marks Act, 1999</i>
mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark; and (ii) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to	services of one person from those of others and may include shape of goods, their packaging and combination of colours; and (i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and (ii) in relation to other provisions



<i>Trade and Merchandise Marks Act, 1958</i>	<i>Trade Marks Act, 1999</i>
use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII;	of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;



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25. A reading of the above comparative table would indicate that after the amendment of Trade and Merchandise Marks Act, 1958 and the enactment of the Trade Marks Act, 1999, the legislature has recognised the fact that the colour could also be registered as a mark. In fact a reading of the objects and reasons to the new act, namely, the Trade Marks Act, 1999 with reference to Section 2 would explain that the definition of mark has been enlarged to include shape of goods, packaging and combination of colours. This could possibly be on account of the fact that the colour photography had come into existence long back and the manufacturers were attracting consumers both through visual media as well as print media , whereby, the colour of a mark was also given importance.

26. The instant case before this court also revolves around a colour in as much as the applicant's case is that by adopting the colour blue to their wrapper the respondent was attempting to pass off their product as that of the applicant. Before proceeding to discuss the case



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laws which have been submitted extensively on both sides, it is necessary to reiterate certain facts.

27. The applicant's contention is that their Butter Cookies, namely, Good Day Butter Cookies weighing 50 grams and priced at Rs.10/- was being wrapped in a wrapper which had a colour combination of both blue and yellow with the brand name Britannia inside the red oblong device since 1997 with variations. Though the elements on the wrapper had changed, however the colour blue and yellow remains static. The respondent had entered into the market of selling biscuits only in the year 2003 and have been marketing butter cookies from 2015. The respondent's wrapper was red in colour from 2015 till June 2023. In June 2023, the colour of the wrapper was changed to blue and yellow. The applicant's contention is that once the wrapper of the respondent had been changed to the blue colour then at a glance the product of the respondent appears to be deceptively similar to that of the applicant's. The applicant's



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contention / grievance is that by adopting this colour and passing off their product as that of the applicant's their ultimate customers who had associated the colour blue and yellow with the applicant's Butter Cookies would be confused and this confusion could work to the detriment of the applicant.

28. The defense to this plea is that since the applicant is only aggrieved by the introduction of the colour blue and as no person can claim monopoly over colour, the suit has to be ultimately dismissed and consequently the applicant is not entitled to an ad interim injunction. Therefore, at the first instance it has to be considered as to whether visually the respondent's product (Sunfeast Mom's Magic Butter Cookies) in the blue wrapper is similar to the applicant's Good Day Butter Cookies. It has to be borne in mind that when a consumer buys a product they either go by the brand name in case of the literate consumer and by the general getup of the packaging by a semi-literate



or illiterate consumers. The consumer does not do a “spot the 6 differences” when purchasing the product.

29. In the Judgement of the Hon'ble Supreme Court in **(1972) 1 SCC 618 – Parle Products (p) Ltd., Vs. J.P. And Co., Mysore**, their lordship has held as follows:

“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.....



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..... *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."*

30. Therefore, the Court has to sit in the armchair of a person of an average intellect, imperfect recollect to see whether such a person would be able to distinguish at the glance the differences in the trade dress of the applicant as well as the respondent. At the first glance what strikes us is the getup of the packaging; blue colour, single biscuit and butter shavings in yellow colour which is the most predominant feature in both the products. It is an admitted fact that



the applicant has been marketing the product since 1997 in a wrapper of blue and yellow combination. The respondent who had started marketing with red and yellow wrapper for over 9 years has all of a sudden converted the wrapper to the blue and yellow combination and there is absolutely no explanation as to why the respondent has all of a sudden adopted the blue colour. When a question was put by this Court to the counsel for the respondent the answer was that that blue is the colour which denotes butter and dairy products. If that be so, there is no explanation as to why the respondent has not adopted this colour when they had launched the product, namely, Butter Cookies.

31. Another fact which has been brought to the notice of this court is that even today, the respondent is marketing the Butter Cookies in red wrapper and the blue wrapper has been introduced only in South India, whereas, in North India Butter Cookies are still been sold in red wrapper. A Google search also reveals that this particular range of Butter Cookies of the respondent is continuing to



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be sold only in a red wrapper. The respondents have not denied this contention put forward by the applicant. The applicant has produced the extracts from the online portals dated 05.07.2023, which shows that the respondent is continuing to market their 50 grams butter cookies, Sunfeast Mom's Magic in a red wrapper.

32. Be that as it may, this Court has to consider whether the respondent is guilty of passing off their product as that of the applicant. With the enactment of the Trade Marks Act, 1999, colour has also been recognised to be a mark capable of registration as is evident from the definition of mark and also Section 10 which stipulates that a trademark can be limited wholly or in part to a combination of colours which has to be taken in to consideration for distinctive character of trademark.

33. To support their argument that no person can claim monopoly over colour the respondents have relied upon the



Judgement of the Delhi High Court in the case of **Colgate Palmolive**

Co. Vs. Patel and others – 2005 (31) PTC 583. The respondent would rely upon paragraph no.50 of the said Judgement, which reads as follows:

“The above texts and the colour diagrammes also indicate that the exclusivity and monopoly of a colour and a colour scheme is not favored. Not only is the red colour one of the seven primary colours but it along with white and black colours has in fact been described as one of the three basic colours in nature. Furthermore, even though the colour combination of the registered mark indicates red and white, in essence the carton of the plaintiffs for which registration has been granted is entirely in red except the logo in the form of the word 'COLGATE' and other small ancillary words such as the price, quality etc. which are printed in white. It is this placement of small print in white containing the word



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'COLGATE' in a small area placed on the back ground in red which contributes to the commercial impact of the plaintiff's carton in the market place and indeed gives exclusivity and distinctiveness to the plaintiff's mark. Thus, the mark COLGATE in white on a red background highlights the plaintiff's product and gives a distinct identity to the combination, and such a combine is certainly entitled to protection from not only passing off, but infringement too. However, I am also of the view that the red and white colour combination per se without the word/mark 'COLGATE' is not entitled to protection from infringement."

34. In the very same Judgement, the learned Judge has observed that the toothpaste markets have purchasers from all strata of society and having various levels of education and awareness and they may



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not notice the difference in the brand name and are likely to get influenced by the overall packaging and get up of the two cartons.

35. The learned Judge had relied upon the Judgement reported in *AIR 1979 Delhi 114 – Vicco Laboratories, Bombay Vs., Hindustan Rimmer, Delhi*, wherein it was observed that for the purpose of granting temporary injunction three facts are essential, namely, to Prove prima facie case, the balance of convenience between the parties and the irreparable injury likely to be caused in case the injunction is not granted.

36. The learned Judge, therefore, relying upon the Judgement in *Vicco Labs Supra* has stated as follows:

“In my view, the plaintiffs' product being a prior product as a cumulative result of the features summarized above would have been entitled to protection against the defendants' product from passing off.”



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However, the learned judge had denied the relief of infringement.

37. In the Judgement reported in ***Cipla Limited Vs. M.K.Pharmaceuticals – 2008 (36) PTC 166 (Del)***, the applicant's claim with reference to shape and colour was denied on the ground that in the case of medicines, the customers do not buy medicines on the basis of shape and colour, but only by its name and therefore the adoption of the shape and colour will not result in any confusion in the minds of the people.

38. The respondents have also relied upon the judgement in ***Surya Foods and Agro Limited Vs. Om Traders and Another – Manu/De/1425/2019***. However, this Judgement has been overruled by the Division Bench in the Judgement reported in ***2023 SCC Online Delhi 265*** - ***Surya Foods and Agro Limited Vs. Om Traders and Another***, wherein, the Division Bench had set aside the findings



of the single Judge that the colour scheme of plaintiff's packaging was not unique or distinctive as there were large numbers of biscuits available in the market which were sold with the same colour scheme.

39. The Delhi High Court in the Judgement reported in **2005 SCC Online Del 1293 – N.Ranga Rao and Sons Vs. Anil Garg and others**, which has also been relied upon by the respondent, was considering a dispute relating to the getup and colour scheme of the lia range of agarbathies, which the applicant therein claimed to be distinctive and the packaging cartons were of different colour schemes depending upon the fragrance of the agarbathies contained therein. The defendant has adopted the name “LIA” and was marketing their product which was also agarbathies in similar cartons and colours. Therefore, the plaintiff had come forward with a suit for infringement and passing off. The learned Judge had discussed the category of customers who would be the purchasers of agarbathies and the learned Judge had held as follows:



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“The very nature of product is such that it is bought not only by a sophisticate and discerning customer, but people from all walks of life. The use of such fragrance sticks is largely for the purposes of pooja, but it is also used for other purposes of fragrance in the rooms, etc. The average customer is not one who will make a detailed scrutiny colour by colour, mark by mark to find out whether the product is of the plaintiff or the defendants. The profile of the customer will vary from the rich to the poor. It has also to be kept in mind that, in fact, the more discerning and rich customer may not even go to buy such a product himself, but would possibly dispatch the house-help to obtain the same. Thus, the factors which weighed in Kellogg Company's case (supra) would hardly apply to the present case.”



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40. Ultimately, the learned Judge has held as follows:

“The overall visual impression from the colour scheme, the arrangement of the mark, the style of writing of the mark, the general get-up and trade dress leads to the conclusion that there is a clear attempt on the part of the defendants to pass off their goods as that of the plaintiff and, thus, the test laid in Parle Products (P) Ltd.'s case (supra) is clearly satisfied. The ingredients of a passing off action have been very succinctly set out in Yves St Laurent Parfums's case (supra), which sets out that a misrepresentation need not to be crass, but may involve a complex mechanism of misrepresentation. Thus, the representation may operate in a number of ways, no single one of which may be compelling but a combination of which is effective. This is the position in the present case. One only needs to look at two products side by side to see



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the striking similarity in various combination of factors.

It is the overall impression that a customer gets to the source and origin of the goods from visual impression of colour combination, packaging and the get-up, which is of relevance and if an unwary and gullible customer gets confused, it amounts to a passing off as set out in Colgate Palmolive Co. Ltd.'s case (supra). No doubt, there is no monopoly in colour combinations, but what is relevant in the present case is that there is substantial reproduction of the colour combination in a similar pattern in each packet and there are similar six series of packets. The defendants being the second comers owed a duty to name and dress their product in such a manner as to avoid all likelihood of consumers confusing it with the product of the first comer [Harold F. Ritchie, Inc.'s case (supra)]”



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The learned Judge went on to hold that the respondent's packaging was identical and deceptively similar to that of the plaintiff.

41. In the instant case also the category of customers for this variant of biscuits would be that class of purchasers who are not familiar with the English language and who would be entirely influenced by the get up of the product. The blue and yellow combination for nearly over 2 decades and 6 years has been associated with the product of the applicant and therefore when the respondents product is kept side by side to that of the applicant, there is an element of confusion in the minds of the customers which could work to the detriment of the applicant.

42. It is also to be borne in mind that while purchasing products customers do not shop with an intent of picking out differences in the packaging of the two products but would be predominantly propelled



by their overall recollection of the product. In the judgement reported

in 2001 (5) SCC 73 – **Cadila Health Care Ltd., Vs. Cadila Pharmaceuticals Ltd.**, the Hon'ble Supreme Court had held as follows:

“Trade mark is essentially adopted to advertise ones product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the original owner of the mark. That is why it is said that in a passing off action, the plaintiffs right is against the conduct of the defendant which leads to or is intended or calculated to lead to deception. Passing off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation



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which other has established for himself in a particular trade or business. The action is regarded as an action for deceit”

43. The learned Judges have further discussed the fact that the Indian population is wholly illiterate and the English language is known only to fraction of population. The learned Judge had observed as follows:

“The decisions of English Courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard



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to Indian conditions? We think not. In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiffs goods seems to over look the ground realities in India. While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a



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nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be at par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any



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confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health.”

44. They have ultimately set out certain factors which has to be considered while dealing with actions of passing off in paragraph no.35 therein which read as follows:

“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.

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.



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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 and

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

45. Compared on this scale, the possibility of confusion in the minds of the consumers is definitely high. The Hon'ble Supreme Court of the United States of America in the case of ***Qualitex Co. Vs. Jacobson Products Co., Inc***, has held that colour sometimes would amount to the legal requirements for the use as the trademark and had also stated that the trademarks law does not prohibit the use of colour



alone as trademark particularly when the colour has attained the secondary meaning by reason of the fact that a brand is identified and distinguished by a particular colour.

46. The Division Bench of this Court in the Judgement in **2004 (3) Mad LJ 543 – SVS Oil Mills Vs. SVN Agro Refineries and another**, was considering adoption of a similar label and colour scheme of the plaintiff. The learned judges had observed that no doubt the plaintiff cannot seek monopoly over colour, however, they had gone to state that while the brand name of the manufacturers is relevant factor, the colour scheme and getup of the container or packages are also equally important. In the marketing of goods the customers would associate colour scheme and getup with the product of their choice. The learned Judges had gone on to observe as follows:



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“We are of the view that the impression regarding the colour scheme and the getup in the labels or container would get imprinted in the minds of the customers and that would carry in their mind in choosing the product by their appearance in the departmental shops or in the super market or in any other shop. The Supreme Court has repeatedly held that what has to be seen in the case of a passing off action is the mind of an unwary purchaser with average intelligence and imperfect recollection. When such a person goes to the market for the purchase of an article, the entire layout including the brand name, colour scheme and getup of the container would be the guiding factor in the purchase of the article. We are prima facie of the view that the domestic articles are purchased not only by their brand names, but also by the colour scheme and getup of the container in which the goods



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are marketed. In our view, it would be totally unrealistic to focus one's attention to the brand name of an article ignoring the colour scheme and getup in the case of passing off action. In our view, even in the case of articles of daily use, like toothbrush, the same colour scheme and getup found in two articles with slight variation in brand name of the article would cause confusion in the mind of the user. It is true that a customer may select the oil on the basis of the brand name. However, if the articles of the same kind are displayed in a shop with slight variation in the trade name with the same colour scheme and getup, there is likelihood of deception to be caused in the mind of an unwary purchaser in the purchase of the article. The oil is not sold on medical prescription, but it is openly available and openly sold in the shops and departmental stores. We are of the view that if same



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colour scheme and getup of the labels of the plaintiff are used by the defendants with the trademark phonetically similar to the plaintiff with reference to the same kind of articles it would create confusion in the minds of unwary purchasers while purchasing the articles of one manufacturer as that of the other manufacturer. We are unable to accept the wide proposition submitted by the learned counsel for the respondents that since the plaintiff's articles are sold only by the trademark SVS on inverted triangle which are prominently displayed on the label, the colour scheme and getup are not important."

47. Ultimately, the Bench had observed as follows and held in favour of the plaintiff:

"Applying the above tests laid down by the Supreme Court, we find that the plaintiff has been using



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its trading style and trademark for quite a long period and continuously whereas the defendants have entered into the said field only recently. Secondly, the goods of the plaintiff have acquired distinctiveness and are associated in the minds of the general public as goods of the plaintiff. Thirdly, the nature of activity of the plaintiff and that of the defendants are the same or similar. Fourthly, the goods of the parties with which the trade mark of the plaintiff is associated are the same or similar. Fifthly, the user of similar colour scheme and getup by the defendants as that of the plaintiff is likely to deceive and cause confusion in the mind of the public and injury to the business reputation of the plaintiff. Sixthly, the sphere of activity and the market of consumption of goods of the parties are similar. Lastly, the customers of the plaintiff inter alia include uneducated, illiterate and unwary customers who are



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capable of being deceived, confused or misled.”

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48. In the instant case, the applicant has been marketing butter cookies in the colour combination in which it is sold since 1997, whereas, the respondent has adopted the colour blue only as recently as in June 2023. Further, the respondent is still marketing its butter cookies in the red wrapper and has not introduced the colour blue in Northern states of India would clearly go to show that the applicant is simply testing waters and there appears to be an element of dishonesty.

49. Therefore, the plaintiff has proved prima facie case and balance of convenience has been proved by the applicant in the following manner:

(i) The applicant has been using the trade dress with element and the colour combination since 1997 for its butter cookies and has built a considerable consumer



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base considering statistics that had been provided with reference to the market share of Good Day butter cookies.

(ii) The argument that there cannot be monopoly for colour, though at first blush appears correct however considering the fact that the product has been sold in this colour combination for over 2 decades and 6 years, the consumers have associated the same to the applicant's product the applicant is entitled to protect its trademark.

(iii) The respondent has started selling butter cookies in the year 2014 and upto June 2023 they have been selling it in a red wrapper. There is no explanation as to why they have suddenly adopted the colour blue and the adoption appears to be dishonest in



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as much as the market share of applicant's biscuit has hit all time high for the period 2022 – 2023. There appears to be an intent to infringe upon the mark of the applicant and pass off their product as that of the applicant's by adopting a trade dress which at a glance is similar to the trade dress of the applicant.

(iv) The respondent continues to market the product in a red wrapper and the blue colour has been introduced only in Southern India and not in North India.

(v) The argument that the blue is adopted for dairy products has not been proved by the respondent and the applicant has shown popular brands which are selling butter cookies in a different colour.



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50. Therefore, this Court which is only considering a prima facie case is of the opinion that the applicant has proved that there is a case of passing off and infringement on the part of the respondent and they should be injuncted from marketing their product “*Sunfeast Mom's Magic Butter Cookies*” in a blue wrapper. Accordingly, O.A.Nos. 551 to 555 of 2023 are allowed.

10.10.2023

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P.T. ASHA. J,

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Pre-delivery Order in
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