

**In the High Court at Calcutta
Civil Appellate Jurisdiction
Appellate Side**

**The Hon'ble Mr. Justice Sabyasachi Bhattacharyya
And
The Hon'ble Mr. Justice Supratim Bhattacharya**

**FMAT No. 189 of 2024
IA No: CAN 2 of 2024
CAN 3 of 2024**

**Edible Products (India) Limited
-Versus-
Shalimar Chemical Works Private Limited**

For the appellant	:	Mr. Rudraman Bhattacharya, Sr. Adv., Mr. Suvasish Sengupta, Ms. Arunuima Lala, Mr. Arindam Chandra, Mr. Atish Ghosh, Ms. Antara Dey, Ms. Neha Gupta
For the respondent	:	Mr. Ranjan Bachawat, Sr. Adv., Mr. Abhrajit Mitra, Sr. Adv., Mr. Soumya Ray Chowdhury, Mr. Debayan Mondal, Mr. Subhankar Nag, Mr. Sanket Sarawagi, Mr. Sanjiv Kumar Trivedi Ms. Iram Hassan, Ms. Mahima Cholera, Mr. Himanshu Bhawsinghka, Ms. Susrea Mitra, Mr. Sagnik Bose
Heard on	:	13.11.2025, 20.11.2025 & 27.11.2025
Hearing concluded on	:	27.11.2025
Judgment on	:	03.12.2025

Sabyasachi Bhattacharyya, J.:-

1. The present appeal has been preferred by the defendant in a suit for infringement of trademark and/or passing off, against an order granting temporary injunction in terms of Prayer (b) of the injunction application filed in respect of the said suit and, simultaneously, dismissing a vacating application in respect of an *ad interim* order previously granted in similar tune by the learned Judge, Commercial Court at Alipore.
2. The plaintiff/respondent filed the suit for a decree of perpetual injunction restraining the defendant/appellant and its men and agents from using, manufacturing, offering for sale, advertising, marketing, promoting and selling in electronic media or interactive websites or otherwise dealing in goods bearing the impugned trademarks/trade dress either in isolation or in conjunction with any other mark which is identical and/or deceptively similar to the plaintiff's registered trademarks/trade dress or its distinctive get-up, colour combination, packaging in any manner whatsoever, and ancillary reliefs.
3. In the said suit, an injunction application was filed in similar terms. Initially, by an *ex parte* ad interim order dated August 16, 2023, the trial court granted injunction in terms of Prayer (b) of the injunction application, which is as follows:

“b) *An injunction restraining the respondent and/or its men, servants, agents, assigns, distributors, directors, dealers, licensees, subsidiaries and/or anyone claiming on its behalf from passing off its*

goods under the impugned trade mark/trade dress by manufacturing, offering for sale, advertising, marketing, promoting and selling through electronic media or interactive websites or otherwise dealing in goods bearing the impugned mark/trade dress either in isolation or in conjunction with other mark which is identical and/or deceptively similar to the petitioner's mark/trade dress or its distinctive getup, colour combination, packaging in any manner whatsoever;"

4. Subsequently, an application for vacating the said *ad interim* order was filed by the defendant/appellant, which was taken up for hearing with the temporary injunction application itself. By the impugned order dated May 15, 2024, the injunction application was allowed, thereby making absolute the *ad interim* order granted earlier and dismissing the vacating application.
5. Learned senior counsel appearing for the defendant/appellant argues that the primary case made out in the plaint is that of infringement of trade mark, from which the plaintiff/respondent is now seeking to deviate to a passing off action.
6. Learned senior counsel argues that an action for passing off has to pass the classic Trinity Test inasmuch as the claimant must show:
 - (i) Goodwill in the goods or services;
 - (ii) A misrepresentation by the defendant leading to confusion; and
 - (iii) Actual or likely damage to the claimant's goodwill.
7. Learned senior counsel places reliance on *Reckitt & Colman Ltd v Borden Inc*, reported at [1990] RPC 340 (popularly known as the "*Jif Lemon Case*") where the United Kingdom House of Lords placed reliance, *inter alia*, on the Trinity

Test laid down by Lord Diplock in *Erven Warnink B.V. v. J. V. Townend & Sons (Hull) Ltd.*, reported in [1980] R.P.C. 31.

8. Learned senior counsel argues that the said tests have not been satisfied in the present case. Although there is no doubt that ‘Shalimar’, by such name, has substantial goodwill since the 1940s, the shape and colour of the HDPE (plastic) bottles used for packaging the plaintiff’s products, which are now sought to be protected by the plaintiff, had not enjoyed such public recognition and/or long usage, since the HDPE technology was introduced much later.
9. It is further argued that the plaintiff uses a variety of shapes and colours of containers for selling their products and, as such, cannot be granted a monopoly in use of all such packages.
10. Moreover, it is contended that the shape of the bottles is not exclusive to the products of the plaintiff but is an established industrial practice. It is argued that the plaintiff admittedly does not have any registration over any shape of bottles but only in respect of its trade device.
11. It is argued that the high hurdles of proving and established business reputation (goodwill), a misrepresentation that causes confusion and resulting damage under common law have not been satisfied in the present case. Relying on the *Jif Lemon Case*¹, learned senior counsel argues that the plaintiff has failed to prove that the bottle’s shape has acquired secondary meaning to such an exceptional degree that it has overcome the consumers’ natural tendency to rely on the brand-name or label.

1. *Reckitt & Colman Ltd v Borden Inc*, reported at [1990] RPC 340

- 12.** In the *Jif Lemon Case*¹, it is argued, the shape of the bottle was that of a lemon, being directly relatable to the product being sold, which was lemon juice. Thus, an ordinary consumer might have been confused by use of the product of a different company in a similar package. However, the shapes of the bottles and containers over which the plaintiff claims superior right in the present case are of generic nature and are used by several other market competitors.
- 13.** Learned senior counsel next contends that the plaintiff is required to prove damages in a passing off action, showing a direct causal connection between the defendant's action and a quantifiable loss of sales, reputation or dilution of brand value, which has not been proved in the present case.
- 14.** Learned senior counsel for the appellant next argues that a comparison between the labels of the two products would show that those are distinct and different. Whereas the plaintiff uses the label 'Shalimar's Coconut Oil', predominantly using red colour with 'Coconut Oil' written in red border with white interior, the defendant clearly writes 'KMP Ayurvedic' and 'Coconut Hair Oil' in brown colours and the borders of the labels of the defendant are also brown.
- 15.** The logo just above 'Shalimar' in the plaintiff's label is also distinct and different from the label just above the word 'KMP' in the defendant's product.
- 16.** It is obvious that coconut oil will be depicted on the label of both parties, since both parties sell coconut oil, which is generic. While the plaintiff's coconut trees in the label are painted in red with the background of the Sun

in white, the defendant's coconut trees are in brown and pop up out of a half coconut, thereby distinguishing the two labels clearly.

17. The appellant, apart from placing reliance on *Jif Lemon Case*², cites *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, reported at *AIR 1965 SC 980*, where it was held by the Hon'ble Supreme Court that in a case of passing off, a defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff. Since the labels in the present case are completely different and the origin of the product of the defendant as 'hair oil' is clearly mentioned in the label, whereas the plaintiff's label does not indicate the origin 'edible oil', the labels of the defendant do not indicate that its goods emanate from the plaintiff.
18. Learned senior counsel next cites *M/s. Kemp & Company & another v. M/s. Prima Plastics Ltd.*, reported at *1998 SCC OnLine Bom 437*, wherein the Bombay High Court held that mere copying is not passing off. Monopoly in the property, it was held, is only preserved in favour of the registered design holder. The plaintiff, if it has to succeed on the ground of passing off, must show something more than mere similarity between the goods.
19. Learned senior counsel appearing for the appellant next cites *Dart Industries Inc. & Anr. v. Techno Plast & Ors.*, reported at *2016 SCC OnLine Del 4016*, where it was held that to obtain *prima facie* protection in an action of passing off in respect of trade dress, get-up or presentation of the product, there should be material disclosing that the general public associates the

2. *Reckitt & Colman Ltd v Borden Inc*, reported at *[1990] RPC 340*

shape-in-question only with the plaintiff. It is argued that such test has not been met in the present case.

- 20.** Learned senior counsel next cites *Kellogg Company v. Pravin Kumar Bhadabhai*, reported at 1996 (36) DRJ(DB), where a Division Bench of the Delhi High Court held on a comparison of the labels between two competing products that Kellogg's was prominently displayed on the label and held that though the labels are similar, the names were prominently displayed, and accordingly refused to grant interim protection.
- 21.** The appellant next cites *Britannia Industries Ltd. v. ITC Limited*, reported at 2017 SCC OnLine Del 7391, where a Division Bench of the Delhi High Court held that the connection between the get-ups must be such that it is recognized by the public as distinctive specially for the plaintiff's goods. A similar view, it is argued, was held in *Britannia Industries Ltd. v. ITC Ltd. and Others*, reported at 2021 SCC OnLine Del 1489.
- 22.** Learned senior counsel for the appellant, at the stage of rejoinder, also relies on *Skyline Education Institute (India) Private Limited v. S.L. Vaswani and another*, reported at (2010) 2 SCC 142, where the Hon'ble Supreme Court held that the words "Skyline" is a generic word and the plaintiff was not entitled to an injunction.
- 23.** Learned senior counsel relies on P. Narayanan's "Law of Trademarks and Passing Off" for the proposition that a defendant cannot avoid liability for unfair competition simply by segregating out the various aspects or elements of the plaintiff's product. However, the totality of the elements is the issue. In a trade dress case, the focus is on the entire look of the product or packaging of the plaintiffs and/or defendants.

- 24.** On the other hand, emphasis in a claim of trademark infringement is on deciding with a discrete symbol, such as a word, number or picture. To determine trademark infringement, if the plaintiff has defined the trade dress as the total image or overall impression of the plaintiff's product, package and advertising, then it is this composite image that is compared with the corresponding image or impression of the defendant's product. It is argued that applying such test, no case of passing off or infringement has been made out. Also, in the trademark sense, device includes pictorial representation of any object or thing, it is submitted.
- 25.** In reply, learned senior counsel appearing for the plaintiff/respondent contends that the disclaimer of a registered trademark does not affect the rights of a plaintiff in action for passing off and relies, in such context, on *Godfrey Phillips India Ltd. v. Girnar Food & Beverages (P) Ltd.*, reported at (1998) 9 SCC 531.
- 26.** Learned senior counsel next relies on *Sony Kabushiki Kaisha v. Mahaluxmi Textile Mills*, reported at (2009) 1 CHN 852 (FB), where a Full Bench of this Court had held that a common field of activity between the two competing products is not necessary in a passing off action. The mere argument that the two products are of different classes or categories of goods is not a good defence in a passing off action. Thus, it is contended that in the present case, the argument of the appellant that the defendant/appellant sells hair oil while the plaintiff/respondent markets edible oil in their respective containers, is not a good ground, if deception appears on the face of the get-up of the defendant's products.

- 27.** It is argued that there are overwhelming documents to indicate that almost 99 percent of the turnover of the defendant's business comes from sale of edible oil and thus, the portrayal of hair oil being the primary product of the defendant, for the purpose of distinguishing it from edible oil sold by the plaintiff, is a sham.
- 28.** Learned senior counsel next submits that in a passing off action, registration of trademark is not a necessary ingredient. Section 27(2) of the Trade Marks Act, 1999 (hereinafter referred to as "the 1999 Act") preserves common law right irrespective of an infringement action.
- 29.** Learned senior counsel also relies on the Trinity Test applied in *Jif Lemon Case*³ and contends that traditionally, passing off in common law is considered to a right for protection of goodwill in a business against misrepresentation caused in course of trade and for prevention of resultant damage on account of the said misrepresentation. The applicability of the said principle can be seen in ascertaining as to which proprietor has generated the goodwill by way of mark/name in the business. Furthermore, it is a recognized principle in common law jurisdiction that passing off right is a broader remedy than that of infringement.
- 30.** For such proposition, learned senior counsel relies on *S. Syed Mohideen v. P. Sulochana Bai*, reported at (2016) 2 SCC 683.
- 31.** Learned senior counsel next argues that even if *Jif Lemon Case*³, relief was granted where the trade names were different, but the get-up was similar, which constitutes the elements of a passing off action.

3. *Reckitt & Colman Ltd v Borden Inc*, reported at [1990] RPC 340

- 32.** In the case of *Gerbatschow Wodka KG v. John Distilleries Ltd.*, reported at (2011) 47 PTC 100, it was held that the shape of the bottle is recognized as a constituent element of trademark and protected as trade dress. It is the overall get-up/impression which matters in a passing off action.
- 33.** It is contended by the respondent that the HDPE bottles of the plaintiff have been in use since 2006, which is established by the advertisement materials and invoices produced by the plaintiff in the trial court. On the other hand, the defendant claims sale of its product in HDPE bottles only from 2017, whereas invoices have been produced from the year 2020. Thus, prior and superior use of the plaintiff for the previous several years constitutes, by itself, the goodwill of the product, being a superior right over that of the defendant, which is a much later entrant in the field. The plaintiff holds the superior right of user in respect of edible oil products bearing a unique trade dress.
- 34.** Learned counsel appearing for the plaintiff/respondent next argues that the total get-up, including colour combination, shape of HDPE bottles and appearance of the packaging are distinctive of its products. The plaintiff enjoys a major market share in edible oil sales, which runs into figures of more than Rs. 450 Crore annually, which is borne out by Paragraph 11 of the injunction application. The extensive advertisements by well-known public figures and publicity, in which the plaintiff has invested, gives a distinct edge in respect of goodwill and prior user to the plaintiff.
- 35.** As regards the insinuation of the appellant that the plaintiff has not sued other offenders in the field, learned senior counsel argues, by relying on a judgment of a learned Single Judge of this Court in *Assam Roofing Limited &*

Anr. v. JSB Cement LLP and Anr., reported at *AIR 2016 Cal 41*, that merely because the plaintiff has chosen to sue one infringer first and has not at the same time sued others for infringement, is no defence in an action for infringement and passing off and it is well-settled that it is the prerogative of the plaintiff as to whom to sue so as to protect its rights. It was further held that it is essential for the defendant to demonstrate substantial and continued use over period of time of the mark by others, failing which no defence of common to the trade/*publici juris* can be set up.

36. Learned senior counsel argues that the reliance of the appellant on *Kaviraj Pandit Durga Dutt Sharma (supra)*⁴ is irrelevant, since it was only held there that added matter “may” permit the defendant to escape liability. Thus, it is not a complete defence.
37. The dishonesty of the appellant is sought to be highlighted next by the plaintiff/respondent. Learned senior counsel argues that no explanation has been given by the defendant as to the deceptive similarity of the shape/colour scheme of the defendant’s container for an identical product. For such proposition, learned senior counsel cites *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*, reported at *(2004) 6 SCC 145*, where it was held that dishonesty is presumed if there is no explanation by the later user as to why the trademark/trade name was identical with that of the prior user.
38. The defendant, it is argued, seeks to copy in general the get-up, colour scheme/trade dress of other popular brands as well, such as Navaratna, Dabur, Parachute, etc. Thus, it is the common practice of the

4. *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, reported at *AIR 1965 SC 980*

defendant/appellant, it is alleged, to copy products of others to give a wrong impression in the minds of the consumers.

- 39.** Lastly, it is argued that the monopoly argument in respect of the shape of the bottle cannot be advanced by the defendant/appellant, since the defendant itself, on April 21, 2023, that is, long after receipt of a 'cease and desist' notice from the plaintiff on July 23, 2022, applied for registration of the shape of the bottle, thereby acknowledging its uniqueness. Thus, it is argued that the learned trial Judge was justified in passing the impugned order and the appeal ought to be dismissed.
- 40.** Heard learned counsel for the parties.
- 41.** In order to decide the present case, it is to be taken note of that the suit of the plaintiff, as framed, is for reliefs both in respect of infringement of trade mark as well as passing off.
- 42.** Since admittedly, several components of the plaintiff's products are registered, either as trademark or trade dress or device, there cannot be any doubt that both remedies are available to the plaintiff. Whereas sub-section (1) of Section 27 of the Trademarks Act, 1999 prohibits any person from instituting any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, the said bar does not apply to the plaintiff, as the plaintiff's products enjoys several registered trademarks; however, in such case, the remedy of the plaintiff would be limited to the registration of its trade mark/trade device/trade dress.
- 43.** On the other hand, sub-section (2) of Section 27 provides that nothing in the said Act shall be deemed to affect rights of action against any person for

passing off its goods or services as the goods of another person or as services provided by another person, or the remedy in respect thereof.

44. It is well-settled that a passing off action is an action in deceit, arising out of common law, and provides remedies in tort. Thus, the said action is, in a sense, wider in scope than an infringement action *simpliciter*.
45. In fact, the relief granted in the impugned order is on the premise of passing off, being in terms of prayer (b) of the temporary injunction application filed in the Trial Court.
46. Thus, the reliance on the Manual of Trade Marks by the appellant is, *per se*, not germane. Moreover, the said Manual is merely in the nature of a guidance, as evident from its general objective as laid down therein, and is a draft, to be finalized after receipt of comments of the stakeholders. Thus, much reliance cannot be placed on the same.
47. The classical Trinity Test, as laid down by Lord Diplock and reiterated in *Jif Lemon Case*⁵, is undoubtedly the guiding light in the field of passing off. Thus, the following have to be proved in a case of passing off by the plaintiff:
 - (i) That the trademark/device/dress, or the entire appearance of the plaintiff's product has acquired a goodwill or reputation in the marketplace that distinguishes such products from competitors;
 - (ii) The defendant misrepresents its goods or services, so that the public may have the impression that the offered goods or services are those of the plaintiff; and

5. *Reckitt & Colman Ltd v Borden Inc*, reported at [1990] RPC 340

- (iii) The plaintiff has suffered or may suffer damages because of such misrepresentation.

- 48.** Interestingly, in *Jif Lemon Case*⁵, the test of “the housewife searching for a product in the supermarket and being in a hurry, presented with a display of the products in close juxtaposition, being likely to pick up the offending product in the belief that what she was buying was the offended product”, was applied.
- 49.** The said test has been diluted in Indian jurisprudence to the extent that the perspective of a reasonable common person, uninformed in the specifics of the product, is to be applied. It has been underscored generally by Indian courts that the test is not that the two products would be juxtaposed and meticulously scrutinized to assess as to whether the two are alike. The appropriate yardstick is of how far a reasonably average person, having no particular information about the details of the products, looking at the offending product some time after seeing the offended product, would take the former to be the latter. A person of average recall is the parameter, and not a particularly good observer with vivid memory. In fact, the said test applies to most of the populace and is the reasonable test which should be applied.
- 50.** In *Jif Lemon Case*⁶, the packaging of the product was in a lemon-shaped container, whereas the product sold was lemon juice, thereby creating a direct causal link between the product and the packaging, which would be unmistakably identified with the prior seller. As rightly pointed out by learned senior counsel for the plaintiff/respondent, even in the *Jif Lemon*

6. *Reckitt & Colman Ltd v Borden Inc*, reported at [1990] RPC 340

*Case*⁶, the court restrained the defendant from using a deceptively similar get-up, although the respective trade names were wholly different.

- 51.** In the present case, the defendant/appellant argues that by mere user of the word “KMP”, as opposed to “Shalimar Coconut Oil”, a distinction has been drawn in the eye of the common person between the two products. However, a bare look at the entire packaging shows that the impression which is given to a common person having average recall is that there is striking resemblance and sufficient scope of confusing between the two.
- 52.** The appellant has laid much stress on the colour of the words in its trade device being brown, whereas that of the plaintiff/respondent being predominantly in red. However, the colour red acquires a crimson hue when depicted in the background of yellow, and there is also very little scope to distinguish between red and brown when the background colour is green. In the present case, the predominant colours used by the plaintiff in its packaging are yellow and green.
- 53.** Also, the packages of the products of both parties contain similar coconut trees. The mere fact that one has the Sun in the backdrop and the other a half coconut, both of round/semi-circular shape, does not create much of a difference when the two products are looked at after a certain point of time.
- 54.** We are to apply the test, not of a discerning person having specific taste for a unique product, but the test of an average market-goer, who would not have much time or recall value in respect of the products, particularly keeping in view the predominant target group of consumers of the product-in-question, that is, edible oil. The said product is used across all sub-strata

of society and, as such, the average recall value of an average uninformed common person is the yardstick which is to be applied.

55. Seen from such perspective, the combination of the coconut trees and the style of representation, coupled with the shape and colour of the bottles and the words used, seen as a whole, may reasonably give the impression that the defendant's product is that of the plaintiff.
56. It is the total impression and get-up which is to be considered in the context of passing off, and not individual components of the trade dress or appearance.
57. The appellant's reliance on *Skyline Education Institute (supra)*⁷ is neither here nor there, since the use of the words 'KMP', as distinguished from 'Shalimar Coconut Oil', loses significance in the larger backdrop of the entire device. If the appearances of the two products and packaging of the plaintiff and the defendant respectively are seen after some span of time by an average person, there is every possibility that the "trees (coconut?) will be missed for the woods", that is, the entire impression and appearance of the defendant's product will acquire predominance, making the individual words or letters used in such device pale into insignificance, if compared to the plaintiff's product.
58. Thus, the said argument of the defendant/appellant is not acceptable.
59. Again, the defendant/appellant has repeatedly reiterated that the plaintiff/respondent has failed to prove its market goodwill. Fact remains that sufficient advertising material and invoices have been produced by the plaintiff to indicate that the product of the plaintiff, in its present HDPE

7. *Skyline Education Institute (India) Private Limited v. S.L. Vaswani and another*, reported at (2010) 2 SCC 142

packaging of yellow and green background, has been used at least since the year 2006. The name 'Shalimar', the widespread acceptance of which has also been admitted by the appellant, has been in use at least since 1945 and has since become a household name. The two facts taken together unerringly indicate that at least from the year 2006, the brand name 'Shalimar' has been directly associated with the particular appearance of the HDPE containers of the products and the entire packaging of the plaintiff's product as inextricably connected with each other. Thus, the distinctive identity of the plaintiff's packaging and appearance is directly relatable to the goodwill enjoyed by 'Shalimar' from the year 1945, at least from the year 2006.

- 60.** On the other hand, the defendant/appellant claims that its product has been in use since 2017. Even going by such assertion, the defendant is late by at least over a decade in entering into the market of edible oil.
- 61.** The plaintiff has a point in arguing that the defendant's claim, that it sells hair oil as opposed to edible oil of the plaintiff, is somewhat belied by the fact that almost 99 per cent of the annual sales turnover of the defendant is derived from edible oil, as opposed to hair oil. The defendant/appellant has failed to bring before the court the packaging of any of its edible oil products, thereby necessarily compelling the court to draw the adverse inference that the defendant/appellant has deliberately and selectively brought before the court only its hair oil packaging, whereas the edible oil products are also sold in similar packages.
- 62.** Moreover, the generic product sold by both parties is coconut oil, which, it is common knowledge, has several uses, only two of which are as edible oil

and hair oil. Hence, the distinction between the nature of use of the products sold gets fudged and is rendered irrelevant.

- 63.** In fact, a Full Bench of this Court, in *Sony Kabushiki Kaisha (supra)*⁸, has categorically held that the class or category of goods or services to which a trademark is applied ought to be altogether ignored while testing a passing off action. The Full Bench, while so observing, relied on *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, reported at (2001) 5 SCC 73, where it was laid down that the similarity in the nature, character and performance of the goods of the rival traders would be one of the factors in adjudication in a passing off action. The key function of a trade mark, it was observed, is to indicate the source or origin of goods or services and the tort of passing off is committed if the offending trader applies an established trademark in such manner so as to cause confusion or deception in the mind of the consumers as regards the source or origin of the goods and the mind of purchasers are directed to the firm whose identity is already linked with the trademark in the marketplace. Even if the goods or services of the rival traders, it was held by the Full Bench, are different, this factor alone would not altogether eliminate the possibility of confusion or deception.
- 64.** Hence, the argument in that regard advanced by the defendants/appellant is not tenable in the eye of the law.
- 65.** In *S. Syed Mohideen (supra)*⁹, the Hon'ble Supreme Court laid down the test that traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in

8. *Sony Kabushiki Kaisha v. Mahaluxmi Textile Mills*, reported at (2009) 1 CHN 852 (FB)

9. *S. Syed Mohideen v. P. Sulochana Bai*, reported at (2016) 2 SCC 683

the course of trade and for prevention of resultant damage on account of the said representation.

- 66.** It was held to be a broader remedy than infringement.
- 67.** Hence, from the materials produced before the Trial Court and before us, it is evident that the plaintiff/respondent already has an established goodwill at least for a decade in respect of the trade dress sought to be protected and, if linked in the public mind with the name 'Shalimar', then a legacy of goodwill of more than eight decades in the market.
- 68.** Hence, the first limb of the classical Trinity Test is satisfied.
- 69.** The user of similar trade dress/appearance in the defendant's packaging of its product, in the absence of any explanation for such striking resemblance, definitely leads to the inference of misrepresentation and intended deceit. As held in *Satyam Infoway Ltd. (supra)*¹⁰, dishonesty is to be presumed if there is no explanation for adoption of a similar appearance/trade dress as the prior user despite knowledge of such user.
- 70.** The appellant also argues that other infringers in the market have not been sued. However, the said consideration is irrelevant in a passing off action, as held by a learned Single Judge of this Court, rightly, in *Assam Roofing Limited (supra)*¹¹.
- 71.** The defendant/appellant also argues that the shape of the bottles and the color combinations used by the plaintiff is too generic and is common in trade.
- 72.** However, such defence of *publici juris* cannot be set up in the instant case, since there is nothing on record, produced by the defendant, to demonstrate

^{10.} *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*, reported at (2004) 6 SCC 145

^{11.} *Assam Roofing Limited & Anr. v. JSB Cement LLP and Anr.*, reported at AIR 2016 Cal 41

substantial and continued use of the similar trade dress as the plaintiff by other users.

- 73.** Moreover, the 'generic' label sought to be attached to the shape of the plaintiff's bottle by the defendant is belied by the defendant's own application, after receipt of the 'cease and desist' notice issued by the plaintiff, for registration of the shape of the bottle. By the very act of making such application, the defendant/appellant has acknowledged the uniqueness and distinctiveness of the shape of the bottle and demolished its own case that it is generic in nature.
- 74.** Even otherwise, if scrutinized properly, the distinct ribbed texture of the bottle used by the plaintiff and the typical indentation/notch in the cap of the packaging of the plaintiff's product identifies the same with the plaintiff's product. A similar design of bottle is being used by the defendant, which is definitely deceptive, particularly in the absence of any explanation for such resemblance on the part of the defendant, and will definitely cause a misrepresentation and a confusion between the two products, considering the mindset of the average consumer having little recall. Hence, the deceit and misrepresentation factor, which is the second limb of the Trinity Test, is also satisfied.
- 75.** Thirdly, the damage likely to be caused to the plaintiff's goodwill by such mimicry of its trade dress and device is evident, since it is an admitted position that the plaintiff/respondent holds the lion's share in the market in the field of edible oil and has been in the market since 1945 and, with the HDPE packaging, at least since 2006.

- 76.** In support of such conclusion, we may also look at the averment made in the injunction application made before the Trial Court, which is not specifically controverted by the defendant, that the plaintiff has about Rs. 450 Crore sales turnover in the market. The undisputed dominance of the plaintiff itself is sufficient justification for the apprehension of damage to its goodwill and reputation if the defendant is permitted to market its products under a similar trade appearance/trade dress.
- 77.** Thus, since the cumulative appearance of the defendant's packaging remarkably resembles that of the plaintiff, particularly if seen at some interval between each other by a person of average intelligence and recall, the resultant damage to the plaintiff's goodwill is a given.
- 78.** In such view of the matter, we do not find any illegality in the impugned order.
- 79.** Rather, the learned trial Judge adverted to all the relevant facets of fact and law and came to its conclusions for passing the temporary injunction order upon rejecting the defendant/appellant's vacating application. It is well-settled that the appellate court, even otherwise, cannot substitute its own views for that of the trial court even if those are different from that of the trial Judge, merely because such other view is possible, in the absence of any error having been committed by the trial court. Since the trial court in the present case has definitely taken one of the plausible views, no interference is called for.
- 80.** Accordingly, FMAT No. 189 of 2024 is dismissed on contest, thereby affirming the impugned order dated May 15, 2024 passed by the learned Judge, Commercial Court at Alipore in Title Suit No. 23 of 2023.

- 81.** Consequentially, CAN 2 of 2024 and CAN 3 of 2024 are also disposed of.
- 82.** It is made clear that none of the observations made in this order and/or the order impugned herein shall be conclusive insofar as the adjudication of the main suit is concerned and the learned trial Judge shall decide the suit independently in accordance with law, on its own merits, without being unnecessarily influenced by any of the observations made in this order or the order impugned herein.
- 83.** There will be no order as to costs.
- 84.** Urgent certified copies, if applied for, be supplied to the parties upon compliance of all formalities.

(Sabyasachi Bhattacharyya, J.)

I agree.

(Supratim Bhattacharya, J.)