

Anglo-Dutch, Colour & Varnish Works ... vs India Trading House on 8 April, 1976

Equivalent citations: AIR1977DELHI41, ILR1976DELHI116, AIR 1977 DELHI 41, ILR (1976) 2 DELHI 116

Author: Yogeshwar Dayal

Bench: Yogeshwar Dayal

JUDGMENT

Yogeshwar Dayal, J.

(1) This is an application on behalf of the plaintiff for restraining the defendant-respondents, its servants, agents and representatives from manufacturing, selling, offering for sale or otherwise dealing in white zinc paint under the containers bearing the numeral 9001, having the get-up-layout, arrangement and the colour combination violet, grey and white as those of the applicant's containers bearing numeral 1001 and from passing off goods as those of the applicant in any manner.

(2) "THE application has been filed in a suit for permanent injunction on the basis of infringement of copyright, as well as passing off.

(3) The case of the plaintiff-applicant is that the plaintiff is one of the leading manufacturers and seller of superior white zinc paint well-known and highly demanded under trade mark 1001. The salient features of the plaintiff's trade mark are the numeral 1001 I appearing in bold type in grey lettering on a white circle along with the expression 'Superior White' on top and 'ZINC PAINT' on the bottom in the circle. The white circle with its grey lettering is superimposed on violet background with white parallelogram shapes on Top and base borders. On the white parallelograms, again, the numeral 1001 appears in grey lettering. The trading style of the plaintiff appears on one side on a white circle while on the other side it appears in grey lettering. It is further alleged that the get-up, layout, arrangement and violet, grey and white colour combination of the plaintiff's container are unique and distinctive represented in a special manner. It is the further case of the applicant that his superior white zinc paint in the containers described above has gained wide reputation so much so that the said goods bearing any such or similar mark are liable to be treated as those of the plaintiff or as connected with the plaintiff in some manner or the other. It is further alleged that the applicant's sale of goods under the mark described above from the commencement of the use of the afore-mentioned containers till date runs to the tune of rupees thirty lacs. It is also alleged that the applicant's artistic design on the containers is registered under number : A-13952/75 under Copyright Act, 1957, and is in use for the past nearly one year.

(4) It is also alleged in the application by the applicant that the respondent is trading under the name and style of M/S. India Trading House and the respondent has very recently adopted identical containers in respect of its white paint. The containers of the respondent, it is alleged, depicts numeral 9001 appearing in bold type in grey lettering on a white circle along with the expression 'SUPERIOR WHITE' on top and 'ZINC PAINT' on the bottom in the circle. The white circle with its grey lettering is super-imposed on violet back-ground with white triangular shapes on top and base borders. On the white triangles, again, the numeral 9001 appears in grey lettering the get-up, layout, arrangement and violet grey and white colour combination adopted by the respondent are in order to cause confusion and deception in the mind of the trade, and the public and in order to pass off white zinc paint as the genuine product of the applicant. It was averred that the respondent has deliberately imitated the mark belonging to the applicant. The similarity between the respondent's mark as compared to the applicant's mark is not a matter of chance but is with deliberate intention on the part of the defendant to deceive the ultimate purchasers and by said deception to earn profits to which the defendant-respondent is not entitled. The intention of the respondent is apparent from the close similarity of the containers as compared with that of the plaintiff-applicant and also from the fact that the respondent described itself as registered. The use of expression 'Regd.', it is alleged, is fraudulent as no such mark of the respondent is registered under the Trade and Merchandise Marks Act, 1958. It is further averred by the applicant that the item in dispute is purchased in large quantities by painters, 'mistress' and Karkhandars' who are unwary class of purchasers and who apart from the brand depend upon colour scheme, get-up and layout of the containers in order to identify and recognise the products which they purchase. Therefore, it is a clear case of passing off. The applicant is alleged to have been suffering loss in business as well as loss in reputation in trade. It was also pleaded that the product of the applicant under the mark described above is old and established and in comparison the infringing product is of recent origin.

(5) In the written-statement filed in the suit, the description of the plaintiff's mark was not denied. The get-up, layout and arrangement of colours was denied as unique or distinctive or that the mark is distinctive in a special manner. It was submitted that the containers with the description given by the plaintiff-applicant in its application has come in the market about a year back. The quantum of sales was denied for want of knowledge. It was further submitted that the sale of defendant's product in the present containers has been about 70 containers only during the last three months of their use. It was also pleaded that the size and colour shade of the defendant's container is different as compared to that of the plaintiff. It was pleaded that the defendant's containers has its lion brand and a monogram and trade style description entirely distinct and different and the plaintiff's container does not have any such brand or monogram or trade style description. It was submitted that the main thing in the plaintiff's mark was the number; 1001 whereas it is 9001 so far as defendant-respondent's product is concerned. It was also submitted that the artistic design has not been registered under the Copyright Act, 1957.

(6) The plaintiff has placed on record his own container as well as the container of the defendant and has also placed on record a photostat copy of the Copyright Certificate dated September 18, 1975.

(7) As stated earlier, the essential features of the plaintiff's trade mark, as mentioned in paragraph 2 of the plaint, have not even been denied by the defendant in the corresponding paragraph 2 of the written statement though the case of the defendant is that the get-up, layout, arrangement and colour-scheme is not distinctive. The , remains that the plaintiff's goods i.e. superior white zinc in the container as filed in court have been on sale for more than a year and it is only three months before the filing of the written statement that the defendant's goods in the impugned container have been brought in the market. The distinctive features of the container of the plain- tiff are :

(i) a large circle with the numeral 1001 appearing in grey on white background, (ii) this large circle is super-imposed on white background, (iii) the top and bottom figures in grey on white portions and (iv) on the back-side the tradings style in the white circle with grey lettering and a small monogram in the centre.

The container of the defendant, to the eye, is practically identical to that of the plaintiff except for the difference that instead of the numeral 1001, the defendant has adopted the numeral 9001. The other difference is that instead of there being parallelogram on the top and bottom there are triangles in the same colour-schemes. On the backside also, the monogram is different but the entire get-up is similar. Neither in the written-statement nor in the reply to the application for interim relief or at the Bar was any justification or explanation offered on behalf of the defendant as to how they hit upon the get-up and colour-scheme of the plaintiffs containers.

(8) Regarding the principles to be borne in mind in such a case, the question is practically settled in the two decisions of the Supreme Court : (1) *Corn Products Refining Co. v. Shaggrila Food Products E Ltd.* and (2) *Amritdhara Pharmacy v. Satya Deo Gupta* : . The tests laid down for comparing the two marks are : (i) The question whether the two marks are so similar as likely to cause confusion or deceive is one of first impression. It is for the Court to decide this question. (ii) The question has to be approached by applying the doctrine of fading memory i.e. From the point of view of a man of average intelligence having imperfect recollection. (iii) Whether the overall visual and phonetic similarity of the two marks is likely to deceive such a man or cause confusion that he may make mistake the goods of the defendant for those of the plaintiff. (iv) The other questions which arise are : (i) who are the persons who are likely to be deceived and (ii) what rules of comparison are to be adopted in judging whether such resemblance exists.

(9) Having noticed the principles which have to be borne in mind, the application thereof is not difficult in the present case. It is true that there is a phonetic difference between the numerals '1001' and '9001' but taking into account the entire get-up, the combination of colours it will be noted that the essential features of plaintiff's containers have been absolutely copied- The entire scheme of the containers is also the same. There is a common large circle, with the same colour-scheme and with the same background. There is the same description of Superior White on top and Zinc paint on the bottom in the circle. Again, the white circle with grey lettering is identically super-imposed on violet background. The only difference is that instead of white parallelogram shapes on top and base borders there are white triangles and on the white parallelograms instead of numeral 1001 in grey lettering, the numeral on the defendant's container is '9001' but the overall effect is just the same. The commodity is such that it is likely to be

purchased by customers from all strata of Society including the petty 'Karkhandars' and contractors.

(10) It was argued by Shri J. R. Goel on behalf of the defendant that there is nothing distinctive in the colour combination of the plaintiff's container and the plaintiff could not have a trade-mark in colour combination. I am afraid I cannot agree with this submission. The colour combination is not descriptive but is distinctive. The definition of the 'mark' as contained in clause (j) of Section 2 of the Trade and Merchandise Marks Act, 1958 is not exhaustive and the definition is such that there is practically no limit to the combination of various types of marks. A dealer can, therefore, have a trade-mark in combination of colours though not on an individual colour. In the present case, the combination of violet background and a large circle with white background and grey lettering is distinct combination of colours, and there is no legal bar to a person acquiring a trade-mark in such combination of colours for his containers.

(11) As to the extent and scope of the work "mark" as defined in Section 2(j) of the Trade and Merchandise Marks Act, 1958, the observations of Graham, J. in *Smith, Kline & French Laboratories Limited's Trade Mark* : (1974) R.P.C. 91(3) at page 95 may be seen : "THEupshot of all these cases is to my mind to establish that a scheme of coloring applied to goods may be a mark within the definition in Section 68. That definition, as was pointed out in contrast to other definitions in the Act, starts with the word "includes" showing that the definition is purposely not limited to the precise words which follow. The combination of colour giving a speckled effect in the present case is, in my judgment, no less a mark than the red lines in *Reddaway's hose case* or the "heading" in the cotton cases and in the *Winter-bottom tracing cloth case*. It is of course exactly parallel to the get-up in the *Hoffmann-La Roche*(4) *chlordiazepoxide case*."

(12) Again, in the later part of the judgment on page 96, learned Judge goes on to observe :

"THEtruth of the matter is I think as follows. In some cases the colour is an essential part of the article as an article whilst in others it is something which is not essential and ' has been added for some other reason. If it has been added so as to denote the origin of the goods, and the evidence shows that in practice it does so, it can properly be said that it is being used as a mark in the trade mark sense. The answer is no doubt one of degree and will depend on the evidence. It would be highly unlikely that colour in a lipstick could ever become distinctive of one manufacturer because in such a case colour is an essential element in and part of the article itself. It is for that reason that the customer buys it. Colour in a passenger motor car would normally be in a similar but not so conclusive a position, but I see no reason why a trader, as some do, should not paint his delivery vans or racing cars in specific distinct colours to indicate the origin of the car or of the goods it normally carries as emanating from him. With drugs, on the other hand, the position is the opposite of the lipstick. Colour is of no importance to the article as a drug and it may, if sufficiently distinctive, be an exceedingly effective indication of origin. It was so in the *Hoffmann-La Roche chlordiazepoxide case* (1972) R.P.C. 1(4). As has been said the less descriptive a trade mark is, the easier it is for it to be distinctive." Later on, at page 99 of the same judgment it was observed by *Grahami J.* as under: "I cannot see why other

manufacturers should want to adopt the applicants' colour arrangements here except for the improper motive of trying to benefit from the latter's established goodwill." In this judgment, Garham, J. relied on the observations of Harman Lord Justice in the Court of Appeal in the case of F. Hoffmann-La Roche & Company A. G. and Another v. D.D.S.A. Pharmaceuticals Limited : (1972) R.P.C. 1(4). It is worthwhile to quote the words of Harman Lord Justice at page 20 : "Goods of a particular get-up just as much proclaim their origin as if they had a particular name attached to them, and it is well known that when goods are sold with a particular get-up for long enough to be recognised by the public as goods of a particular manufacturer it does not matter whether you know who the manufacturer is."

(13) As stated earlier, instead of receiving any satisfactory answer, I received no answer from the defendants to the plain question as to why they wished to mark their goods in violet grey and white. The only answer which I could suggest to myself was that they have adopted the colour-scheme in order to attract to themselves some part of plaintiff's good-will and trade on their reputation and in fact to represent to public that their goods are the goods of the plaintiff. This is exactly a classic case of 'passing off'.

(14) I have seen the original Copyright Certificate of the plaintiff and this is again a gross case of infringement of plaintiff's right.

(15) The plaintiff has also claimed permanent injunction for restraining the infringement of his copy-right. The certified copies of the entries in the Copy-right Register bearing the seal of the Copyright Office are prima facie evidence of the particulars entered therein under Section 48 of the Copyright Act, 1957. Sub-section (1) of Section 14 gives the meaning of the copyright and under sub-section (2) any reference in sub-section (1) to the doing of any act in relation to a work includes a reference to the doing of that act in relation to a substantial part thereof. "Artistic work" itself is defined in Section 2(c)(iii) of the Copyright Act to include "any other work of artistic craftsmanship". Reading Section 2(c)(iii), 2(m)(i) and sub-sections (1), and (2) of Section 14 read with Section 51 of the Copyright Act, 1957 it becomes clear that the containers of the defendant are a clear infringement of the plaintiff's copyright. The only difference is that instead of numeral 1001, the defendant has used the numeral 9001. In all other respects, the container of the defendant is a substantial reproduction of the plaintiff's copyright and thus under Section 55 of the Act, the plaintiff is entitled prima facie to the relief of permanent injunction for the infringement of his copyright.

(16) The infringement of copyright being prima facie established, the plaintiff is entitled to interim relief for the infringement of the copyright as well.

(17) The principle which applies to the present case for the grant of interim relief is the same as laid down by Deshpande, J. in Wearwell Cycle Co. (India) Limited v. Wearwell Industries, Ludhiana and others : (1969) D.L.T. 469(5). No question of even balance of convenience arises. The defendant has used the plaintiff's trade-mark only for three months and the balance of convenience is in favor of the plaintiff that the defendant should be enjoined by temporary injunction till the disposal of the

suit from dealing in white zinc paint under the containers bearing numeral '9001' having the colour combination of violet, grey and white as those of the applicant's containers bearing numeral 1001' and from 'passing off' the goods as those of the applicants in any manner. It is ordered accordingly. Costs of the application will be costs in the suit.