

Sentini Bio Products Pvt. Ltd. vs M/S. Allied Blender & Distillers Pvt. ... on 6 July, 2015

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Bench: Pradeep Nandrajog, Pratibha Rani

* IN THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Reserved on : May 26, 2015
Judgment Delivered on : July 06, 2015

+ FAO (OS) 368/2014
SHREE NATH HERITAGE LIQUOR PVT. LTD.Appellant
Represented by: Mr.Jayant Tripathi, Advocate with
Mr.Sumit Rajput, Advocate

versus

M/S. ALLIED BLENDER & DISTILLERS
PVT. LTD.Respondent
Represented by: Mr.Pravin Anand, Advocate with
Mr.Shrawan Chopra, Advocate,
Ms.Abhilasha Nautiyal, Advocate
and Mr.Vibhav Mithal, Advocate
FAO (OS) 493/2014
SENTINI BIO PRODUCTS PVT. LTD.Appellant
Represented by: Mr.Gopal Subramaniam,
Sr.Advocate instructed by
Mr.Gagan Gupta, Advocate

versus

M/S. ALLIED BLENDER & DISTILLERS
PVT. LTD.Respondent
Represented by: Mr.Pravin Anand, Advocate with
Mr.Shrawan Chopra, Advocate,
Ms.Abhilasha Nautiyal, Advocate
and Mr.Vibhav Mithal, Advocate

CORAM:

HON'BLE MR. JUSTICE PRADEEP NANDRAJOG
HON'BLE MS. JUSTICE PRATIBHA RANI

PRADEEP NANDRAJOG, J.

1. Shree Nath Heritage Liquor Pvt. Ltd. (the appellant of FAO (OS) No.368/2014) impugns the order dated July 01, 2014 passed by the learned Single Judge disposing of IA No.20759/2013 filed by M/s.Allied Blenders and Distillers Pvt. Ltd. (the plaintiff) confirming the ex-parte ad-interim injunction granted on December 19, 2013 restraining Shree Nath Heritage from using the mark „Collector s Choice for its product (whisky) during the pendency of the suit. M/s.Sentini Bio Products Pvt. Ltd. (the appellant of FAO (OS) No.493/2014) impugns the order dated July 01, 2014

allowing IA No.1685/2009 filed by M/s.Allied Blenders and Distillers Pvt. Ltd. (the plaintiff) confirming the ex-parte ad-interim order restraining M/s.Sentini Bio Products Pvt. Ltd. from using the mark „Officer s Special for its alcoholic beverages and in particular Indian made foreign liquor during the pendency of the suit.

2. The two appeals thus pertain to marks used for whisky, „Officer s Choice of the respondent and „Collector s Choice and „Officer s Special of the two appellants.

3. Briefly stated, the facts relevant and giving rise to the two appeals are as follows:

a. The respondent is a company incorporated under the Indian Companies Act and is in the business of manufacturing and marketing alcoholic beverages, including Indian Made Foreign Liquor. The respondent s alcoholic beverages are sold under various trademarks and labels, out of which one is „Officer s Choice . It is the respondent s case that „Officer s Choice is one of its most popular trademarks and was adopted in the year 1988. The respondent further claims that its whisky under the mark „Officer s Choice is one of the highest selling whiskies in the world. The respondent is also the registered proprietor of the trademark „Officer s Choice in various classes such as classes 32, 33, 34 etc. b. The appellant of FAO (OS) No.368/2014 is also incorporated under the Indian Companies Act and is engaged in the business of manufacturing, blending and bottling of Indian Made Foreign Liquor. It is the appellant s case that its mark and label „Collector s Choice was adopted in the year 2013. The parties however dispute the exact month of the appellant s adoption. The appellant of FAO (OS) No.493/2014 is also incorporated as a company under the Indian Companies Act and sells Indian made foreign liquor under the mark and label „Officer s Special and the product was launched in December, 2008 after obtaining approval of the label „Officer s Special from the excise authorities in the State of Andhra Pradesh in March, 2008 and in the State of Chattisgarh in May, 2008. c. The respondent filed CS (OS) No.2589/2013 on the original side of this Court against the appellant of FAO (OS) No.368/2014 claiming violation of its trademark „Officer s Choice , CS (OS) No.247/2009 against the appellant of FAO (OS) No.493/2014 claiming violation of its trademark „Officer s Choice , and against the appellant of FAO (OS) No.493/2014 additionally claiming violation of the copyright in its label. d. It is the respondent s case that, being the prior owner and registered proprietor of the trademark „Officer s Choice , it has exclusive rights in the said trademark. The appellant s trademark „Collector s Choice and „Officer s Special conveys the same idea as that of the respondent s trademark „Officer s Choice , i.e. Choice of a person holding an office of authority and is deceptively similar to the respondent s said mark. Hence, it is highly likely that consumers will confuse the appellant s „Collector s Choice and „Officer s Special as that of the respondents. e. According to the appellant of FAO (OS) No.368/2014, the mark „Collector s Choice was used by it to emphasize upon the unique characteristics of its product and stature of the customers of its product since the word „Collector in common parlance refers to someone who collects specified articles as per their own

choice. Thus, in this regard it refers to someone who appreciates finer things like the appellant's whisky. f. The said appellant has further claimed that in the respondent's trademark registration for „Officer's Choice the word „Choice has been disclaimed and hence the respondent has no right in the said word. The appellant also laid emphasis on the fact that its product under the mark „Collector's Choice has a distinctive packaging when compared with the respondent's packaging.

g. The appellant of FAO (OS) No.493/2014 claims that the respondent's trademark „Officer's Choice consists of two general words in which trademark rights cannot be claimed and that while obtaining registration of its trademark „Officer's Choice the respondent has disclaimed the word „Choice. As regards respondent's claim for copyright infringement the said appellant claims that its label is original and artistic and is registered under the Copyright Act. It is the further claim by the said appellant that since the respondent does not have separate registration for the words „Officer and „Choice its rights if any are limited to the combination of the two words. It is the further case of this appellant that the respondent is not entitled to any equitable relief because it has concealed from this Court the accurate status of the proceedings between the parties before the Excise Commissioner in the State of Andhra Pradesh and Chattisgarh when said appellant's impugned label was granted approval despite objection by the respondent. h. The appellant of FAO (OS) No.368/2014 has challenged the Court's jurisdiction to entertain the respondent's passing off claim. General Principles:

4. It would be profitable to quickly summarize the general principles applicable in trademark cases, and we could do no better than distillate them from McCarthy on Trademarks and Unfair Competition, Ed. IV :

i. Likelihood of confusion (i.e. confusion is probable and not simply possible) is the standard for both trademark infringement and passing off.

ii. Priority of use needs to be considered.

iii. To establish trademark infringement and/or passing off in most cases

(we discuss one statutory exception where confusion is presumed by court below) it needs to be shown that an appreciable number of buyers and not the majority of buyers are likely to be confused. Even 1% of India's population will be an appreciable number of buyers.

iv. Likelihood of confusion may be proved in many ways, such as:

Through survey evidence;

By showing actual confusion;

Through arguments based on a clear inference arising from a

comparison of the marks in question and the context in which the marks are used;

Under Section 29 of the Trademarks Act, 1999, confusion is presumed if the marks are identical and are used for identical goods/ services.

5. Confusion can be of the following categories:

Point of sale confusion -this refers to confusion that takes place at the time of purchase.

Post sale confusion - this includes confusion of those other than the purchaser.

Initial interest confusion - this refers to confusion that may be caused initially, i.e. prior to purchase, but at the time of purchase of the alleged infringer/ tortfeasor's product or using its service, the consumer is not confused.

Reverse confusion - this occurs when consumers purchase the goods or use services of the senior user thinking them to originate from the junior user.

6. When a person knows that the mark in question does not originate from the senior user but the senior user is called to mind, then it is a step before confusion. If on the other hand, the consumer is in a state of wonderment if there is a connection, this is confusion. Further, if this consumer then purchases the junior user's product, this is then deception. Factors considered by courts to determine likelihood of confusion in trademark infringement and passing off:

7. As per the law in the United States of America, while examining whether a mark resembling another can be registered, the Courts have interpreted Section 2(d) of the Lanham Act and in particular the expression „likelihood of confusion“ (For example, Du Pont factors laid down by the CCPA).

8. While examining whether a mark infringes another under Section 32 of the Lanham Act, the Courts in America in various circuits have also examined the expression „likelihood of confusion“ (For example, Polaroid factors of the 2nd Circuit and Sleekcraft factors of the 9th Circuit).

9. In the above cases, the courts have laid down a series of factors that need to be looked at, which could be summarized as:-

Du Pont factors laid down by the erstwhile United States Court of Customs and Patent Appeal [177 USPQ 563 (CCPA 1973)] i. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. ii. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

iii. The similarity or dissimilarity of established, likely-to-continue trade channels.

iv. The conditions under which and buyers to whom sales are made, i.e. impulse vs. careful, sophisticated purchasing. v. The fame of the prior mark (sales, advertising, length of use). vi. The number and nature of similar marks in use on similar goods. vii. The nature and extent of any actual confusion. viii. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. ix. The variety of goods on which a mark is or is not used (house mark, „family mark, product mark).

x. The market interface between applicant and the owner of a prior mark:

- a. mere „consent to register or use.
- b. agreement provisions designed to preclude confusion i.e. limitations on continued use of the marks by each party.
- c. assignment of mark, application, registration and good will of the related business.
- d. laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- xi. The extent to which applicant has a right to exclude others from use of its mark on its goods.
- xii. The extent of potential confusion, i. e., whether de minimis or substantial.

xiii. Any other established fact probative of the effect of use. Polaroid factors laid down by the Federal Court of Appeals for the 2nd Circuit in 128 USPQ 411 (2d Cir. 1961) Polaroid Corp. v. Polarad Electronics Corp.

While these factors were developed for cases where the products or services of the two parties were different, they have been used in cases of identical goods and services as well.

- i. The strength of the mark.
 - ii. The degree of similarity between the two marks.
 - iii. The proximity of the products.
 - iv. The likelihood that the prior owner will bridge the gap.
 - v. Actual confusion.
 - vi. The reciprocal of defendant's good faith in adopting its own mark (Bad faith).
 - vii. The quality of defendant's product.
 - viii. The sophistication of the buyers.
- Sleekcraft factors laid down by the Federal Court of Appeals for the 9th Circuit [204 USPQ 808 (9th Cir. 1979)]
- i. The strength of the plaintiff s mark.
 - ii. Proximity of the goods.
 - iii. Similarity of the marks.
 - iv. Evidence of actual confusion.
 - v. Marketing channels used.
 - vi. Type of goods and the degree of care likely to be exercised by the

purchaser.

vii. Defendant's intent in selecting the mark.

viii. Likelihood of expansion of the product lines. Weightage to be given to each of the above factors should depend upon the facts of each case.

10. The aforesaid factors have been explained in subsequent cases to include the following considerations, namely (See McCarthy on Trademarks and Unfair Competition, Ed. IV):

Similarity of marks:

- i. Marks can be similar/ identical in their sound, sight or meaning.
- ii. The „Anti-dissection and „comparing dominant parts rules are applied harmoniously.

iii. It is important to see similarity of context in which the marks appear.

Class of consumers:

- i. Courts have held that if the buyer market consists of both

discriminating and casual purchasers, the court must give consideration to likely confusion of both kinds of buyers.

Defendant's intention:

- i. Courts have held that if the defendant intended confusion, this tends to show confusion of customers.
- ii. Some Courts have even held that proof of defendant's bad faith in

adopting the impugned mark shifts the burden to the defendant to disprove infringement.

iii. Intent may be inferred when the defendant is aware of the plaintiff's trademark.

Proof of actual confusion:

- i. While the test for trademark infringement and passing off is the

likelihood of confusion, instances of actual confusion are obviously relevant to the determination of the question on confusion.

ii. Having said that, absence of evidence of actual confusion should not be held against the prior owner of a trademark if there is a likelihood of confusion arising from a comparison of the conflicting marks and the context of their use.

11. The factors laid down in India by the Supreme Court in the decision reported as (2001) 5 SCC 73 Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd. that are to be considered while deciding the question of likelihood of confusion in passing off are as follows:

- i. Nature of the marks, that is, whether the marks are word marks or label marks or composite marks, i.e. both words and label works.
- ii. Degree of resemblance between

the marks, phonetically similar and hence similar in idea.

iii. Nature of goods in respect of which they are used as trademarks. iv. Similarity in nature, character and performance of goods of rival traders.

v. Class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and degree of care they are likely to exercise in purchasing and/ or using the goods. vi. Mode of purchasing the goods or placing orders for the goods. vii. Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks. The Supreme Court has cautioned that weightage to be given to each of the above factors should depend upon the facts of each case and same weightage cannot be given to each factor in every case. The above Cadila factors for passing off have not been specifically applied to trademark infringement cases.

12. While applying the above factors while deciding the question of trademark infringement, the following must be borne in mind:

i. Trademark infringement is governed by Section 29 of the Trademarks Act, 1999. This provision presumes confusion on the part of the public if the marks and goods/ services in question are identical. ii. The view of the Supreme Court on the defence of „added matter“ in trademark infringement is that if the essential features of the trademark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from the of the registered proprietor of the mark would be immaterial. The relevant extract from the decision reported as AIR 1965 SC 980 Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories is reproduced below. It reads as under:-

"In an action for infringement, the plaintiff must, no doubt, make out that the use of the plaintiff's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trademark of the respondent have been adopted by the appellant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from the of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

13. Instructed by the law as above we proceed by applying the factors for assessing likelihood of confusion for trademark infringement and passing off in the two appeals and firstly we discuss the

appeal filed by Shree Nath Heritage Liquor Pvt. Ltd. Our prima-facie observations and findings in the succeeding paragraphs 14 to 78 relate to FAO (OS) No.368/2014. Our prima-facie observations and findings in paragraphs 79 onwards relate to FAO (OS) No.493/2014.

Nature of the mark:

14. The respondent has registrations for its „Officer s Choice composite word mark and „Officer s Choice label dating back to the year 1988 and 1990 respectively. The respondent has been using the trademark „Officer s Choice since 1988 and is an arbitrary mark for whisky. Therefore, the respondent has vast reputation and goodwill in the said mark. The appellant is using a composite word mark „Collector s Choice and a label.

Degree of resemblance between the marks:

15. We first need to discuss the effect of the disclaimer on the word „Choice in two of the respondent s trademark registrations. In the decision reported as AIR 1955 SC 558 Registrar of Trademarks Vs. Ashok Chandra Rakhit, regarding passing off, the Supreme Court held that statutory disclaimer will have no bearing if the respondent s trademark has acquired secondary meaning. In the facts of the present case, our prima facie view is in favour of the secondary meaning of the respondent s mark „Officer s Choice in light of the respondent s long use and sales under the said trademark. Hence, the question of disclaimer is not relevant to the question of passing off in the present case.

16. Turning to the effect of disclaimer with respect to trademark infringement, it is pertinent to note at this point that only two registrations of the respondent, i.e. registrations no. 489582 and 538927, have the word „Choice disclaimed. The respondent has several trademark registrations, albeit some of which are labels, for alcoholic beverages and a host of other goods, for „Officer s Choice without any disclaimer.

17. A disclaimer in a trademark does not travel to the market place. Hence, for the purpose of comparison of two marks, the disclaimed portion can also be considered. Therefore, the marks in the two registrations of the respondent with a disclaimer can be considered as a whole even for infringement.

18. Concerning the rules of anti-dissection and comparing dominant part, it is possible for both parts of a composite trademark to be dominant. In the instant case, while the first part of the respondent s trademark (Officer s) is dominant, we need not decide the nature of the second part of the respondent s mark (Choice) since the second part is identical in the appellant s mark. Furthermore, even in the label registrations of the respondent, at least the word mark „Officer s Choice is an essential feature of the labels as consumers would refer to the respondent s product by the word mark. Hence, we proceed with comparing the first part of the two trademarks in question.

19. The words „Officer and „Collector are phonetically different. However, Courts have applied the test of similarity in the idea, i.e. semantic similarity, of two marks in deciding the question of deceptive similarity between them. In the decision reported as AIR 1960 SC 142 Corn Products v. Shangrila Foods the Supreme Court held that „Gluvita was likely to cause confusion with the mark „Glucovita as both conveyed the same idea of glucose and life giving properties of vitamins.

20. The Canadian Law of Trademarks and Unfair Competition by Harold G. Fox notes that "trademarks may differ in their various component elements and yet the idea or impression left on the mind may be such that they amount to confusing marks."

21. Similarly, P. Narayanan in the Law of Trade Marks and Passing off states that "regarding word marks it is necessary to take into account the meanings conveyed by the words or the ideas suggested by them, for words are remembered not only by their sound and appearance but also by the ideas suggested by them."

22. Sun, for soaps, because Surian is nothing more than the Tamil translation of the English word Sun, and would thus be considered deceptively similar to the previously existing mark.

23. That takes us to the heart of the debate. How can similarity in an idea be created?

24. It is pertinent here to refer to a study which can be found in the International Journal of Research in Marketing [22 (2005) 27-44] in an article titled Distinctive Brand Cues and Memory for Product Consumption Experiences. Researching on consumer experiential learning from a memory perspective, and referring to „brand image and the role of brand names as cues that retrieve or signal product attributes, benefits, effect, or overall quality, the conclusion of this study demonstrated that the conceptual background behind the brand name is what triggers the recollection of memory in a consumer, and not the brand name in itself. The study revealed that, when five brands of the same type of product : „Orange Juice , were named on the basis of a shared conceptual background (all five being named after different islands in the Caribbean : „Bahamas , „Bermuda , „Aruba , „Dominica and „Barbuda), the consumers ability to distinguish the various brand names was found to be poorer due to this shared conceptual background. Further, when the various brand names did not share the same conceptual background, the rate of recollection of the correct brand names by a consumer was higher. In other words, if the consumer is asked which brand he preferred, if all brands share the same conceptual background, then he would first remember that the product he liked was named after some Caribbean island, and would then need to exercise his brain to recall which island his favourite brand was named after.

25. Since this discussion pertains to similarity between Word Marks, a semantic understanding of how commonness of idea is conveyed through the use of words is relevant here. As discussed in The Application of Semantic Field Theory to English Vocabulary Learning by Chunming Gao and Bin Xu, Theory and Practice in Language Studies, Vol. 3, No. 11, pp. 2030-2035, Nov. 2013, words in the semantic field can be said to create a sense relation, and in semantics, there are broadly three sense relations:

„Hypernyms , „Synonyms and „Antonyms .

26. Whereas hypernyms create the relation of inclusion, synonyms that of equivalence, antonyms that of opposite relations. Since antonyms by definition, convey the opposite sense relation of the word, it falls outside the purview of this discussion.

27. We thus need to expand the concepts of hyponymy and synonymy.

(i) Hypernyms The Oxford English dictionary defines a Hypernym to mean "A word with a broad meaning constituting a category into which words with more specific meanings fall; a subordinate.

For example, colour is a hypernym of red"

It further defines a hyponym as:

"A word of more specific meaning than a general or superordinate term applicable to it For example, Spoon is a hyponym of cutlery. Contrasted with hypernym."

(ii) Synonyms The Oxford English dictionary defines a synonym to mean:

"A word or phrase that means exactly or nearly the same as another word or phrase in the same language.

For example, shut is a synonym of close; the east was a synonym for the Soviet Empire;

and a person or thing so closely associated with a particular quality or idea that the mention of their name calls it to the mind: For example the Victorian age is a synonym for sexual puritanism.

28. When it comes to giving a clear, precise and correct definition of synonymy, many difficulties arise. There are numerous approaches with numerous definitions of synonyms and types of synonyms, because there are different ways in which synonyms may differ. It would be imprecise to define synonymy as identity of meaning since there are no two terms with completely identical meaning. However, the general understanding of synonymy can be stated to be the phenomenon of two or more different linguistic forms with the same meaning.

29. Synonymy could be classified into absolute synonymy and relative synonymy. Absolute synonyms refer to words with the exact same meaning in all context, and thus are considered by several academicians to be a logical impossibility, given that words cannot be interchangeable in all possible contexts (since that, itself, would entail infinite possibilities), and given further, that two words being absolute synonyms would normally result in the language rendering one of them obsolete over the passage of time.

30. Relative synonyms, on the other hand refer to words or phrases which are relatively similar, in that they are similar in certain contexts, while not in others. Such synonymy could be further classified into such categories as following:

i. Synonymy with different degrees Words that constitute this type of semantic field have same extended meanings, yet different in degrees. For example, anger, rage and fury are all about the emotional excitement induced by intense displeasure, while anger is used normally without definite degree of intensity; rage focuses on a loss of self-control; and fury empathises a rage so violent that it may approach madness ii. Synonymy with different emotions This type of synonymy is mainly formed by words with basically same meaning yet with different emotions. For example, a philanthropist and do-gooder can be mean both charity and sympathy, while philanthropist usually means charitable persons who aid people in sufferings and donate for the poor yet do-gooders refer to those unrealistic humanists who dream of doing good recklessly and vainly. Another example, Statesman and politician both mean people who take part in social politics, while Statesman refers to those who could do well in controlling and governing the state yet politician mainly means people who play political tricks for their own interests. In both of the examples, the formers are all commendatory; and the latter s derogatory.

iii. Synonymy with Different Styles This type of semantic field mainly consists of the words with relatively same meaning yet with different styles. American linguist Martin Joos (1962) lists five different styles of words in his book Five Clocks as frozen, formal, consultative, casual and intimate. According to these five styles, we can label the word Horse with five different tags, charger is frozen, steed is formal, horse is consultative, nag is casual and plug is intimate.

iv. Synonymy with different collocations This type of synonymous semantic field is formed by words with relatively same meaning yet different collocations. For example, the words that could indicate the meaning of accuse are charge, rebuke, reproach and accuse itself, while the propositions that collocate with them are different. That is to say, accuse collocates with „of , charge collocates with „with , rebuke collocates with „for and reproach with „for or „with .

31. In the market research study referred to above, Island A and Island B, both in the Caribbean, are simply hyponyms of the broader hypernym (Islands in the Caribbean). So a consumer with imperfect recollection would recall the correct name of his preferred brand, if they do not share the same conceptual background or hyponym. This is because sharing a hyponym in the form of a conceptual background as the basis of naming various brands, would create the same idea in the mind of the consumer impairing his ability to recall his preferred brand name. Similarly, when various brand names are synonyms of each other, for example, men s perfumes being called Macho, Tough, Stud and Rugged while each of these words may not mean the same in every context, in the context of men s perfumes, they convey the same idea as that of masculinity. As per the findings of the study referred to above, the similar brand name recollection impairment could be observed in such a case as well. Thus, from the findings of the study provided above, coupled with the legal position on ascertaining similarity of marks based on the ideas conveyed by them, we may arrive at the conclusion that marks containing words with the same sense relation (or falling in the same semantic field, or conveying the same or similar idea in the mind) as that of previously existing

marks are likely to be considered so similar as to be refused registration or deemed to constitute infringement of the previously existing trademark.

32. However, it is important to create a parameter within which marks conveying similar ideas should be accorded protection under trademark law. This is because if protection is accorded to the sense relation of a word, it raises a slippery slope as to what extent such monopoly over the sense relations be extended under trademark law. For example, in contrast with five brands of Orange juice named after islands of the Caribbean would naming a brand of orange juice after any other island X (which is not in the Caribbean) would also be prohibited in stating that island X is a hyponym of the broader hypernym „Island ? Similarly, would trademark protection of synonyms extend to all synonyms of the word, such that men's perfumes cannot be named after any word which is synonymous to the word „Tough (such as dangerous or risky)?

33. Thus, a restrictive application needs to be made for protecting words which share the sense relation, in that, protection should be accorded only to those sense relations of the word where the context in which they are applied to the brand name, is the same, which causes similar ideas to be conveyed in the minds of the consumers. In this regard, one may also briefly discuss the concept of contextual correlation of semantic similarity, articulated by authors George A Miller (Dept. of Psychology, Princeton University, Princeton, New Jersey) and Walter G Charles (Dept. of Psychology, Oregon State University, Corvallis, Oregon) and in the book Language and Cognitive Processes, [1991, 6(1) 1-28], under the chapter titled „Contextual correlates of semantic similarity, where they observe an inverse linear relationship between the similarity of word meanings and the difference in contexts in which they are used and conclude:

„... on an average, for words of the same language drawn from the same syntactic and semantic categories, the more often two words can be substituted into the same context the more similar in meaning they are judged to be

34. In the aforementioned two examples one observes that the similarity in idea conveyed by the word marks, through hyponymy or synonymy, can only be said to occur when the hyponymy or synonymy exists in a given context. Thus, when brands of orange juice are named after various islands of the Caribbean they convey a similar idea, which is likely to be only in the context of enjoying a glass of orange juice on a beach at one such tropical island. Similarly, when Men's perfumes are named after synonyms of the word Tough, the commonness of idea is created only when the words are synonymous in the context of masculinity, and not when any word which is synonymous to Tough, in a different context (such as dangerous, or risky) is used.

Application of the above stated principles to the given case:

35. In the facts of the instant case, it prima-facie emerges clear that COLLECTOR and OFFICER, may be considered hyponyms of the hypernym „persons holding office or the word COLLECTOR may be considered a hyponym of the word OFFICER or both COLLECTOR and OFFICER may be synonymous to each other : „persons holding office . What needs to be ascertained, thus, whether these two words exist in hyponymy or synonymy with each other in the same context, such that the

same idea is conveyed by the marks „Officer s Choice and „Collectors Choice , causing the likelihood of confusion or deception in the minds of a consumer of average intelligence and imperfect collection.

The semantic relationship between the words 'Officer' and 'Collector':

36. The Oxford Dictionary defines the words „Officer and „Collector as follows:

„Officer - A person holding a position of authority...In India, the chief administrative official of a Zillah or district, whose special duty is to collect revenue, but who also (except in Bengal) holds certain magisterial powers.

„Collector - includes:...an officer employed to collect or receive money due, as taxes, customs etc.

37. The Essential Commodities Act, 1955 defines a Collector as including an Additional Collector and such other officer, not below the rank of Sub- Divisional Officer, as may be authorized by the Collector to perform the functions and exercise the powers of the Collector under this Act.

38. While the word „Collector may have more than one meaning, as claimed by the appellant, it cannot be ignored that this word is commonly understood by consumers in India as an officer employed to collect or receive money due, as taxes, customs etc. as is evident from at least the above definitions. It is this meaning of the word „Collector that is relevant to the present case for the following additional reasons:

i. According to information on the 2011 census on the website of the Ministry of Human Resource and Development, at least 27 percent of India s population is illiterate and a substantial population is not well versed in English. Therefore, this segment of the population is likely to be unaware of the English meaning of the word „Collector that the appellant refers to and would understand „Collector to be an „Officer . It is highly likely that even a part of this segment falls in the overlap of consumers of the products in question.

ii. A large segment of the literate population in India would understand both Hindi and English. Even for this segment of the population, it cannot be ruled that the primary meaning of the word „Collector for these consumers is an „Officer .

39. As discussed above, words may be associated with one another by way of sense relations. Sense relationships may be classified as synonyms, hyponyms and antonyms.

40. Thus we need to explore the sense relationship between „Officer and „Collector :

i. The word „Collector can be seen a hyponym of the word „Officer - phrase „Person holding an office of authority a. As discussed above, hyponymy contains all

objects that belong to the same category. Hyponymy can be seen as the relationship between a genus and its species.

b. One can therefore prima-facie say that the word „Collector”, in some contexts, can be considered to be a hyponym of the word „Officer” - „Person holding an office of authority”. Based on the meaning of the word „Collector”, as defined in dictionaries and statutes, and the context in which this term is used in India („Collector” as commonly understood in India means an „Officer”, see the dictionary meaning discussed above), one can say that „Collector” is a type of „Officer” and this relationship maybe depicted in the following manner:

Officer-

Person
holding an
office of
authority

Collector Colonel Commissioner Admiral Chief
Engineer

c. This relationship may also be understood by way of this example:

The following officers were present at the event: Collector, magistrate and commissioner.

ii) „Collector” and „Officer” may also be seen as relative synonyms of the phrase/idea „Person holding an office of authority”. As discussed above, synonyms can be absolute or relative. The words „Collector” and „Officer” may also be considered as relative synonyms of the phrase/idea „Person holding an office of authority” where they are related by degree. This relationship maybe depicted in the following manner:

Person holding an office of authority Officer Collector Colonel b. This relationship may also be understood by way of this example:

The highest ranking officer of the district (Collector) was present at the event.

c. Therefore the word „Collector” is a hyponym of the word „Officer” and both are synonyms of the phrase/idea „Person holding an office of authority”. Hence, the two words are similar. Whether the words „Officer” and „Collector” are deceptively similar?

41. Turning to the question whether the two words are deceptively similar, i.e. whether confusion is likely to take place between these words, we need to explore how related ideas are stored and retrieved by the human mind.

42. Philosophers and scientists have long believed that similar ideas are associated in the brain and this association plays an important role at the time of retrieval of information. This concept of association of ideas has been explained by philosophers such as David Hume and John Stuart Mill.

43. David Hume in An enquiry concerning human understanding introduced the notion that there could be principles of connection amongst ideas and mentioned three principles of connection namely, resemblance, contiguity in time or place, and cause or effect.

44. In the 19th century, John Stuart [see Mill in Stanford Encyclopedia of Philosophy („Mill)] used Hume's idea that there could be principles of connection amongst ideas stated by and developed a theory of association to explain how the human mind associates ideas.

45. Mill's theory of associative memory proposes that if „f' and „g' are regularly presented in experience as standing in relation to „R', then the habit forms in the mind, that if we have an impression or idea of „f' then it is accompanied with the idea of „g'. „R' in Mill's theory is the connection amongst ideas stated by Hume earlier.

46. One can apply Mill's above theory to the present case in the following way:

- i. f = Officer
- ii. g = Collector
- iii. R = Person holding an office of authority.

47. 'R' in the present case is a person holding an office of authority and this is the connection between both „Officer and „Collector . We have already understood earlier that the words „Collector and „Officer are synonyms of a „Person holding an office of authority . Therefore, according to the above theory, in the human mind, when both „Collector and „Officer would be regularly presented in relation to „a person holding an office of authority a habit would form where thinking of „Officer shall bring to the mind the word „Collector .

48. The book Cognitive Psychology, Solso Et. Al, Ed. VIII talks about various theories of how knowledge is stored in the human mind. The crux of each of these theories is that similar words, concepts and items that are linked by association are grouped together in the brain.

49. For instance, the Set-Theoretical Model deals with semantic concepts. Illustratively, under this theory, a fruit would be a semantic concept and types of fruits such as banana would be grouped along with other fruits under the concept of fruit in the human mind. Even under this theory, one can prima-facie say that the words „Officer and „Collector can be grouped under the concept of „Person holding an office of Authority and/or „Collector may also be stored under the concept of „Officer .

50. It would be interesting to note that the United States Patent and Trademark Office Trademark Trial and Appeal Board in a trademark cancellation proceeding (H. Sichel Sohne, GmbH v. John Gross & Co., 204 USPQ 257), applied the concept of similarity of meanings of marks while holding the marks „Blue Nun and „Blue Chapel deceptively similar, observed as under:-

"...we are particularly aware of the close relationship between nun and chapel. In view of the fact that the prayer activity and meditation in the daily life of a nun very frequently takes place in a rather small edifice or structure known as a chapel we must conclude that the words nun and chapel are more closely allied to each other..."

Retrieving information from human memory:

51. Finding information in the organized long term memory store is aided by retrieval cues. (See Introduction to Psychology, Clifford T. Morgan et al, Ed. VII). This book explains the concept of retrieval with the following example:

"Suppose, for example, you are learning German. Some German words will at the time you encode them be readily associated with English words; Hund, the German word for dog reminds you of the English word Hound. When you later see the German word Hund, you can easily recall its English meaning because you generated the retrieval cue Hound which you encoded along with the target word Hund."

52. These cues need not directly elicit the brand name but may instead simply enhance the likelihood of a particular brand, or set of brands, being elicited (Conceptualizing and Measuring brand salience, Romaniuk and Sharp, Marketing Theory Vol. 4(4):327-342). For example, in the present case, the cue could be „Person holding an office of authority .

53. Another factor to bear in mind regarding retrieval of information from human memory is the process of reconstruction of information or the generation of false memories. Cognitive Psychology, Solso et al, Ed. VIII, explains this process in the following experiment:

"...Students read (or have read to them) the following list: Rest, Nap, Sheets, Night, Snooze, Bed, Doze, Pillow, Dream, Snore, Awake, Tired, Wake, Blanket, Slumber, Nap, Yawn, Drowsy...The researchers found...that participants recalled many of the words accurately but a large number of them recalled the word Sleep...The semantically similar and strongly associated words in the list created the false memory of having read (or heard) the word Sleep."

54. That consumers have imperfect recollection is well accepted in trademark jurisprudence. In Australian Law of Trademarks and Passing Off, D.R. Shanahan, Ed. 1990, the author talks about recall of ideas by consumers wherein an idea suggested by a mark is more likely to be recalled than the precise details of the mark.

55. A similar view is expressed in Kerly's Law of Trademarks and Trade names, Ed. XV:

"It would be too much to expect that persons dealing with trademarked goods, and relying as they frequently do on marks should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or some significant detail than by any photographic recollection of the whole."

56. In the decision reported as 171 USPQ 696 *Watercare Corp. v. Midwestco Enterprise Inc.* the United States Patent Office Trademark Trial and Appeal Board held:

"It is our opinion that such confusion is likely under the fact situation herein. The most significant feature of the marks herein involved and that one by which the goods and services of the parties will generally be referred to and called for is the literal feature of each mark, Aquacare and Watercare respectively. These marks are similar to the extent that each contains the word CARE which we are not persuaded possesses anything other than a suggestive significance as applied to water conditioning equipment and services preceded by words which are synonyms for one another. Undoubtedly, as used in connection with such goods and services, Aquacare and Watercare engender the identical commercial impression. These points of similarity are significant considering the fallibility of the memory of purchasers including those considered to be discriminating purchasers as to their recollection of trademarks and the propensity of individuals, as a result thereof, to often remember one portion of a mark and to substitute a synonyms or something similar for what they believe another portion to be."

57. So, when a consumer has to make a decision regarding a purchase, and is confronted with the product of the appellant with the mark „Collector s Choice , the word „Collector shall bring to his mind the cue „Person holding an office of authority which is related to the word „Officer since both trademarks in the present case are used in the same context for whisky. As discussed above, this cue may guide the consumer in confusing the appellant s whisky with that of the respondent or may generate a false memory that will lead to confusion.

58. According to the study on Distinctive Brand cues and memory for product consumption experiences, Warlop et al, brands that share semantic associations, like in the present case, which the study refers to as „undifferentiated brands are likely to be confused by consumers.

59. Admittedly, the labels and get up of the two products are dissimilar. However, the study on Distinctive Brand cues and memory for product consumption experiences notes that:

i. cue formed from the meaning of the brand is much stronger than the cue formed by the packaging of the product of the brand. Therefore, if the meaning of the brands is similar/same, then the difference in packaging may still lead to confusion.

ii. there is a likely consumer belief that brand names identify different choice alternatives uniquely, while packaging colours and shape often do not.

60. McCarthy on trademarks and Unfair Competition also emphasizes the importance of impact of similarity in meaning and states that "mental impact of similarity in meaning maybe so pervasive so as to outweigh any visual or phonetic differences that is the psychological imagery evoked by the respective marks may overpower the respective similarities or differences in appearance and sound."

61. A similar view was taken by the United States Patent and Trademark Office Trademark Trial and Appeal Board while deciding trademark cancellation proceedings in the decision reported as 204 USPQ 257 H.Sichel Sohne, GmbH v. John Gross & Co., wherein it held that "the fact that the marks have aural and optical dissimilarity is not necessarily controlling on the issue of likelihood of confusion in the marketplace where the marks convey the same general idea or stimulate the same mental reaction...That is, similarity in meaning or significance alone is sufficient to indicate a likelihood of confusion, especially where, as in the present case, the marks are coined or arbitrary."

62. According to Kerly's Law of Trademarks and Trade names, Ed. XV:

"Variations in details might well be supposed by customers to have been made by the owners of the trademark they are already acquainted with for reasons of their own."

63. Since the marks „Officer's Choice and „Collector's Choice are prima-facie deceptively similar as they convey the same meaning, the impact of different trade dress is highly unlikely to rule out consumer confusion between the two products in this case, especially since consumers expect manufacturers of alcoholic beverages to churn out variants. Nature of goods/ services in respect of which they are used as trademarks:

64. Admittedly, both parties are using the marks in question for whisky. The respondent uses the trademark „Officer's Choice for a series of variants as „Officer's Choice Blue as disclosed in the plaint. Therefore goods of both parties in this case are identical.

Class of purchasers who are likely to buy the goods

65. The class of purchasers of the two products are highly likely to be overlapping since the two products are whiskies and according to the appellant, the price difference between the two products is about `126.

66. In view of the above, prima-facie it is highly likely that customers of both parties for the products in question are indiscriminating purchasers. Mode of purchasing the goods or placing orders for the goods

67. According to Mill, the anticipation of the pleasure from consuming a product in the future acts as a cause for bodily motion to bring about that pleasure. Therefore, once a consumer associates the respondent's „Officer's Choice product with pleasure, the consumer shall, in anticipation of pleasure, once again select „Officer's Choice. Through repeated consumption that leads to a good experience, the meaning of the respondent's „Officer's Choice shall for the individual consumer

become associated with the good experience.

68. As noted in Distinctive Brand cues and memory for product consumption experiences, associations in memory tend to decay over time, leading to forgetting as well as recall of the wrong targets. In addition, memory for brand quality may be impeded by significant delays between consumption experiences and subsequent purchase occasions when retrieval is attempted.

69. This was also held in the decision reported as [1958] RPC 387 *Harry Reynolds v. Laffeaty s Ld., Dodwell & Coy, Ld., and S Guiterman & Coy, Ld.*, by the High Court of Justice - Chancery Division:

"I think the ordinary member of the public seeing an "Aquamatic" water pistol one day and a "Watermatic" water pistol months afterwards would be more likely to be confused, and I propose to grant an injunction and ancillary relief accordingly."

70. Therefore, the likelihood of confusion between similar marks increases with increase in passage of time and sequential consumption of the products.

71. The appellant s argument that its „Collector s Choice product is more expensive than the respondent s „Officer s Choice product does not negate the likelihood of confusion in this case for at least the following reasons:

i. The price difference between the respondent s „Officer s Choice (which according to the appellant was sold at `208 at the time of filing the suit and is now sold at `277) and the appellant s „Collector s Choice (which was sold at `404) is under `200 which is a very small difference.

ii. The respondent has stated in the plaint that it introduced a variant of its „Officer s Choice whisky called „Officer s Choice Blue in 2011. The appellant has stated in its written submissions that the respondent s „Officer s Choice Blue is in the same price range as the appellant s „Collector s Choice .

72. It is also the appellant s case that the products in question are occasional products. As discussed, likelihood of confusion increases with increase in passage of time and sequential consumption of the products. In fact the appellant has not denied that the two products are sold through common venders.

73. Based on the above, we conclude that it is likely that once a consumer is confused between the marks „Officer s Choice and „Collector s Choice , especially when it is likely that he consumes one subsequent to the other and after some time, he or she may confuse the experience associated with them.

Intention of the appellant

74. In this case, it is apparent from the appellant's reply to the Trademarks Examiner that the appellant was aware of the respondent's trademark.

75. The appellant in its reply to the examination report issued by the Trademarks Office stated as follows:

"We would like to further submit that some of the names/ marks like "OFFICER'S CHOICE" & "MINISTER" which have become customary in the current language have also been accepted by the Learned Examiners in the past so why not our mark be accepted and advertised."

76. On the facts above the possibility of appellant's dishonest intention in adopting the impugned mark cannot be ruled out at this stage.

77. As regards the question of this court's jurisdiction for entertaining the respondent's passing off claim, the same can be decided during trial as the averments in the plaint make a case for entertaining such a claim on a quia timet basis.

78. From the above analysis, we conclude that the view taken by the learned Single Judge that the use of the mark „Collector's Choice by the appellant for whisky is likely to cause confusion with the respondent's whisky sold under the mark „Officer's Choice is based on sound application of legal principles, and thus we dismiss the appeal but without any order as to costs; and the usual line of caution. Facts noted by us and law applied is limited to decide the interim measure pending adjudication of the suit on merits, which shall be finally decided uninfluenced by the present decision keeping in view the evidence led.

79. We now proceed to apply the aforesaid principles to the facts of FAO (OS) No.493/2014.

Nature of the mark:

80. We are limiting our enquiry to the respondent's registrations that are pleaded in the plaint. It is the respondent's case that it adopted the trademark „Officer's Choice for alcoholic beverages in 1988 and has been using the same ever since. The respondent has pleaded registrations for its „Officer's Choice label dating back to 1990. In our view, the trademark „Officer's Choice is an arbitrary mark for whisky and even though the two words may be common, they are arbitrary to the goods in question [See 537 F.2d 4 (2d Cir. 1976 Abercrombie and Fitch v. Hunting World,)], for the different categories of trademarks - Generic; descriptive; suggestive and arbitrary or fanciful]. An example of an arbitrary mark is „Apple the name of a common fruit, which is also a dictionary word, for computers. The Respondent's huge sales and success under the trademark „Officer's Choice as pleaded show that the Respondent has vast reputation and goodwill in the said mark. The Appellant is using a composite word mark „Officer's Special and a label.

Degree of resemblance between the marks:

81. In paragraphs 15 to 17 above we have already discussed the effect of the disclaimer on the word „Choice“ in two of the respondent's trademark registration and hence we need not reiterate the said discussion which may be read as part of the present paragraph.

82. On the question of similarity of the word marks of the parties, i.e. „Officer's Choice“ and „Officer's Special“, the Appellant had argued that it uses the prefix „Sentini“ and hence its mark is sufficiently distinct from that of the respondent, a contention which we reject since adding a prefix to an otherwise deceptively similar mark may still not sufficiently distinguish the marks as held by the Supreme Court in the decision reported as (2002) 3 SCC 65 *Laxmikant Patel v. Chetan Bhai Shah*. In any event, the font of the word „Sentini“ on the respondent's label is much smaller than that of „Officer's Special“. Therefore, the addition of the word „Sentini“ will not sufficiently distinguish the appellant's mark from that of the respondent if we were to conclude that the mark „Officer's Special“ is deceptively similar to the respondent's mark „Officer's Choice“.

83. In paragraphs 18 we have discussed the anti-dissection rule and comparing dominant part. While discussing FAO (OS) No.368/2014 we have already held that the first part of the respondent's trademark „Officer“ is dominant and is an essential feature of its mark. We are unable to decide the question of the dominance of the second part of the respondent's trademark i.e. „Choice“ at this stage without further material and thus the question could be decided after the trial.

84. The appellant had argued that under Section 17 of the Trademarks Act, 1999 the respondent would need a separate application or registration for each of the words „Officer“ and „Choice“ before it can claim infringement with respect to the same.

85. The appellant's trademark „Officer's Special“ has the word „Officer“ which is a dominant part of the respondent's trademark „Officer's Choice“. In the decision reported as 2012 (50) PTC 433 (Del) (DB) *United Biotech Pvt. Ltd. v. Orchid Chemicals and Pharmaceuticals Ltd. & Ors.* it was held as follows:

We find that the Learned Single Judge rightly held that when a label mark is registered, it cannot be said that the word mark contained therein is not registered. We, thus, are of the opinion that although the word „ORZID“ is a label mark, the word „ORZID“ contained therein is also worthy of protection. The Learned Single Judge has rightly observed that the judgment of the Supreme Court in *Ramdev Food Products Ltd. (supra)* is a complete answer. This aspect is considered and the argument of the Appellant is rejected in the following words:

"27. On whether the OCPL could successfully ask for rectification for UBPL's word mark FORZID notwithstanding that OCPL held registration only for a label mark, the judgment of the Supreme Court in *Ramdev Food Products Ltd. v. Arvindbhai Rambhai Patel* AIR 2006 SC 3304: 2006 (33) PTC 281 (SC) is a complete answer. The Court there referred to an earlier decision in *Registrar of Trademarks v. Ashok Chandra Rakhit* AIR 1955 SC 558: PTC (Suppl) (1) 1 (SC), which concerned the proprietary mark „Shree“ which formed part of the device as a whole and was an

important feature of the device. The Supreme Court observed that registration of a trademark as a whole would give the proprietor "a right to the exclusive use of the word „Shree as if separately and by itself". Therefore, it would not be correct for UBPL to contend that the registration held by OCPL does not cover the word mark ORZID".

We are in agreement with the aforesaid approach...

86. Since the appellant has prima-facie copied an essential feature of the respondent's trademark, Section 17 of the Trademarks Act, 1999 is inapplicable to this case. The appellant had also relied on the decision reported as 2010 (42) PTC 514 Del Nestle India Ltd. v. Mood Hospitality, in which it was held that the defendant therein was using the mark in question in a descriptive manner and that the plaintiff did not enjoy reputation in a part of the composite mark that was used by the defendant. Therefore, the above decision is inapplicable to the present case.

87. During the course of the hearing, the learned senior counsel for the appellant also relied on a search report from the Trademarks register for the word „Officer in class 33 (this class covers alcoholic beverages). This list cited 25 applications/ registrations with the word „Officer . The respondent submitted that out of these 25 applications/ registrations:

- 18 belonged to the Respondent
- the status of 2 was „removed
- 2 had been „abandoned
- 1 was at a preliminary stage and had not been published in the

Trademarks journal so far. Further, there was no proof of use of the said mark 1 application belongs to the Appellant for the impugned mark; The status of 1 application for „Officer's Club label is opposed. The Respondent has submitted that in any event it is the registered proprietor of the mark „Officer's Club .

88. The fact that a mark is common to the trademarks register may not mean that it is common to the trade. Furthermore, for an argument common to the trade to succeed, evidence of extensive use of the mark in question needs to be shown. The appellant has relied on copies of a few third party labels, none of which uses the mark „Officer . In the present case, the word „Officer is not common to the register and there is no evidence to show that it is common to the trade. For the above stated reasons, the decision reported as 2010(42) PTC 772 (Del) Schering Corporation & Ors. V. Alkem Laboratories Ltd., cited by learned senior counsel for the appellant is inapplicable to the present case.

89. In paragraphs 24 to 34 above we have already discussed how similar ideas are stored and retrieved in the human mind and how similarity in an idea can be created. Said discussion may be read as a part of the present paragraph pertaining to the application thereof to the facts of FAO (OS) No.493/2014.

Application of the said principles in the given case :

90. Examining the similarity in the meanings of the composite mark of the appellant and the respondent, as already discussed, the word „Officer is common to both the trademarks in question. Further, the words „Choice and „Special share a sense relation of relative synonymy where they are related by degree as explained below.

91. The word „Choice is defined by the Oxford Dictionary as:

"A person or thing specially chosen or selected; the elite; the best of a group etc."

92. The word „Special is defined by the Oxford Dictionary as:

"held in particular esteem or affection; of particular value or important to"

93. According to the Collins Word finder, Ed. 1999, „Special is synonymous with „Choice . Therefore, the meaning conveyed by the appellant s trademark „Officer s Special is similar to the meaning conveyed by the respondent s trademark „Officer s Choice . Hence, the two word marks in this case are prima-facie deceptively similar. Comparison of the labels :

94. Turning to the question of deceptive similarity of the labels of both parties, the two labels need to be noted. They would be :-

Appellant's label This is the Appellant s label for „Officer s Special which it claims to have adopted in 2007.

Respondent's labels

Label 1

Label 2

Label 3

This label is the subject matter of This label is the This label is the subject the Respondent s trademark subject matter of the matter of the registration no. 538927 for whisky. Respondent s Respondent s copyright The date of this trademark copyright registration A-57173/99 registration is 538927 registration A- dated 16.12.1999.

The word „Choice is disclaimed in 54982/98 dated
this registration. 11.08.98.

Label 4

This is the Respondent's „Officer's Special label that it submitted was approved in Chattisgarh in 2005.

Admittedly, this label was not renewed by the Respondent thereafter.

Label 5

This label is also used by the Respondent.

95. For trademark infringement, we will consider only label 1 of the respondent which is registered as a trademark in India. The respondent's word mark „Officer's Choice is an essential feature of this label as consumers are bound to refer to the respondent's product by this mark. We disagree with the appellant's argument that the only essential feature of the respondent's labels is the insignia on the label. Since we have already held that prima-facie the word mark „Officer's Special is deceptively similar to the mark „Officer's Choice, therefore, the appellant's mark „Officer's Special would prima-facie be deceptively similar to the respondent's label „Officer's Choice label, especially since consumers expect manufacturers of alcoholic beverages to churn out variants.

96. Furthermore, for the purpose of passing off, we consider labels 1, 2, 3 and 5 of the respondent. The respondent has been using the said labels and/or their minor variants with the mark „Officer's Choice since 1988.

While the labels may have been altered over the years, the word mark „Officer's Choice has remained consistent, thereby creating the same commercial impression. We do not consider label 4 for passing off since the respondent admittedly did not sell any products under this label. The appellant's label for „Officer's Special prima-facie gives the same visual impression as labels 1, 2, 3 and 5 of the respondent identified above. As discussed above, the presence of the prima-facie deceptively similar mark „Officer's Special on the appellant's label makes the label of the appellant deceptively similar to the respondent's label No.1. Furthermore, similarities that give the same overall impression between the appellant's label and respondent's labels No.2, 3 and 5, in addition to the deceptively similar mark „Officer's Special are a golden border on a white background, use of the deceptively similar mark „Officer's Special in red font and the style and font in which „Officer's Special is written on the label.

97. We therefore prima-facie conclude as follows:

- a. The appellant's word mark „Officer's Special is prima-facie deceptively similar to the trademark „Officer's Choice of the respondent;
- b. The appellant's label for „Officer's Special is deceptively similar to the trademark „Officer's Choice label

No.1 of the respondent for the purpose of infringement and labels 1, 2, 3 and 5 for the purpose of passing off.

Nature of goods/ services in respect of which they are used as trademarks:

98. Both parties are using the marks in question for IMFL. The difference between the products cited by the appellant, i.e. its whisky is produced from grains, is highly unlikely to rule out an otherwise probable likelihood of confusion. Therefore goods of the parties in this case are identical.

99. The respondent has also been using the mark „Officer s Choice for packaged drinking water as is evident from the respondent s sales promotion material filed in the suit, a copy of which is filed in the present appeal by the appellant. Since the product of the appellant, i.e. whisky/ IMFL, is allied and cognate to packaged drinking water, it is likely that consumers will be confused into believing that the appellant s „Officer s Special whisky originates from the respondent.

Class of purchasers who are likely to buy the goods

100. The class of purchasers of the two products are highly likely to be overlapping since the two products are IMFL and they are sold through common vends.

101. Further, it is highly likely that customers of both parties for the products in question are indiscriminating purchasers. Mode of purchasing the goods or placing orders for the goods

102. As discussed while discussing FAO (OS) No.368/2014, the likelihood of confusion between similar marks increases with increase in passage of time and sequential consumption of the products.

103. In the instant case, sequential consumption of the two products is of course highly probable. These products are also sold through common vendors where not only the consumer can be susceptible to confusion but also the vendors who deal in these products.

104. It is likely that once a consumer is confused between the marks „Officer s Choice and „Officer s Special , especially when it is likely that he consumes one subsequent to the other and after some time, he or she may even confuse the experience associated with them.

Intention of the Appellant

105. The stark similarities between the appellant s „Officer s Special label and that of the respondent as discussed above are unlikely to be mere coincidental, especially since the appellant s adoption of the impugned label is admittedly subsequent to that of the respondent.

106. The appellant had filed an opposition against a trademark application filed by the respondent for the mark „Officer s Choice . The appellant has stated as follows:

...The mark „Officer s Choice under the impugned application is visually, phonetically, structurally and confusingly, deceptively similar to our reputed and well known trademark „Officer s Special ...

107. Based on the above discussion, we prima-facie conclude that the appellant s mark and label for „Officer s Special are deceptively similar to the respondent s mark and labels 1, 2, 3 and 5 for „Officer s Choice and are likely to cause confusion among consumers. The appellant s impugned mark and label amount to infringement of the respondent s registered trademarks No.538927 and 610451 and passing off of the mark „Officer s Choice and labels No.1, 2, 3 and 5.

108. Turning to the question of copyright infringement in this case, we will compare for this purpose the appellant s label with labels No.4 and 5 of the respondent.

General principles for copyright infringement

109. A summary of general principles in copyright infringement of artistic work should read as under:-

i. Copyright protects expression of an idea and not the idea itself. ii. A registration is a not a prerequisite for copyright. iii. According to Section 2(c) of the Copyright Act, 1957, an artistic work means a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality; a work of architecture and any other work of artistic craftsmanship.

iv. Copyright infringement may be of the following kinds:

- a. Direct infringement
- b. Indirect infringement
Contributory/ induced infringement:

One who contributes to or promotes copyright infringement may be liable for contributory or induced infringement.

Vicarious infringement:

One who controls the acts of the infringer may be liable for vicarious infringement.

v. To establish copyright infringement, the right holder must show:

- a. Ownership of the work
- b. Copyright ability of the work
The work should be original
The work should have a „modicum of creativity
The work should be protectable expression.
- c. Copying of the work by the Defendant

This can be proved by showing substantial similarity between

protectable elements. According to Copinger and Skone on Copyright, South Asian edition, 2008, this test has been put in a number of similar ways such as „Has the defendant made a substantial use of those features of the claimant's work in which copyright subsists? In the United States, the abstraction-filtration-comparison test [as first laid down in 23 USPQ 2d 1241 (2nd Circuit 1992) Computer Associates Ltd. v. Altai Inc. has been followed by some courts for substantial reproduction, especially in software infringement cases.

110. The appellant submitted that it has a copyright registration for its impugned label. The respondent has filed a cancellation against this registration and in our view the appellant's copyright registration is not a bar to the respondent's claim enforcing its prior copyright.

111. The respondent's copyright claim is limited to infringement of labels No.2, 3 and 4 above which are covered by the definition of artistic works under the Copyright Act. In our view, the appellant's label is not a substantial reproduction of the respondent's labels No.2 and 3.

112. Comparing label No.4 of the respondent with the appellant's label which according to the respondent was approved by the Excise Commissioner of Chhattisgarh in 2005, at the very least, the combination of all features, the insignia on the label, the manner in which „Officer's Special is written in the above label are original to the respondent.

113. The appellant's label has the same colour combination, border, manner in which „Officer's Special is written across the label as the respondent's label. We therefore prima-facie conclude that the appellant's label is a substantial reproduction of the respondent's label No.4.

114. We hold that prima-facie the appellant's label for „Officer's Special infringes the label No.4 of the respondent.

115. On the question whether the respondent concealed material facts regarding the proceedings between the parties before the Excise Commissioner, in our view, the respondent has disclosed material particulars of these proceedings in the plaint. We agree with the findings of the learned Single Judge in this regard. Furthermore, the issue of infringement of trademark, copyright and passing off cannot be decided by the Excise Commissioner.

116. Dismissing FAO (OS) No.493/2014 we add the usual line of caution by simply recording that the caution noted by us in paragraph 78 above pertaining to FAO (OS) No.368/2014 shall also apply to FAO (OS) No.493/2014.

117. To summarize, both the appeals are dismissed but without any order as to costs.

(PRADEEP NANDRAJOG) JUDGE (PRATIBHA RANI) JUDGE JULY 06, 2015 mamta