

The Tata Oil Mills Company Ltd. vs Reward Soap Works on 22 April, 1982

Equivalent citations: AIR1983DELHI286, 1982(3)DRJ399, 1982RLR618, AIR 1983 DELHI 286, 1982 RAJLR 618 (1982) DRJ 399, (1982) DRJ 399

JUDGMENT

H.L. Anand, J.

(1) Tata Oil Mills Company Ltd., plaintiff, in a suit based on infringement of trade marks, copyrights, passing off and for rendition of accounts of profits, seeks to restrain the defendant, during the pendency of the suit, from manufacturing, selling, offering for sale, advertising or dealing in washing soaps under the trade marks 501, 507 or any other deceptively similar trade mark and wrappers as are identical with or deceptively similar to the wrappers of the plaintiff's 501 half bar washing soap and from infringing the registered trade marks and copyright and from passing off its washing soap and business as washing soap and business of the plaintiff.

(2) The suit is grounded on the allegations that the plaintiff has, inter alia, been producing and marketing half bar washing soap under the trade mark 501 since over 40 years and the mark has acquired a unique and enviable reputation partly on account of extensive advertisement and publicity and partly on account of the high quality of the product. It is further alleged that the distinctive and unique wrapper of 501 half bar soap used by the plaintiff since October, 1975 has also acquired a wide and enviable reputation amongst the purchasing public and the soap trade. The other features of the wrappers are the numerals 501 in red, super imposed on a white diamond device with red strips on either side. Beneath the aforesaid composition on the one side the numerals 501 are written in Devnagari script. also in a diamond device and certain descriptive matter appears on the other side. The numerals 501 are also placed at two distinctive places in Devnagari and Roman scripts respectively. The plaintiff claims that the numerals 501 and the 507 wrappers are duly registered as trade marks and the aforesaid wrapper is also registered under the Copyright Act and the washing soap is recognised not only by the numeral mark 501 but also by the distinctive wrappers in relation thereto.

(3) It is alleged that the defendant has recently started the manufacture and marketing of half bar washing soap with the deceptively similar mark 507 and in wrappers- which are colourable imitation of 501 half bar washing soap wrappers of the plaintiff. The half bar washing soap wrapper of the defendant is said to consist of colour combination of canary yellow, red and white. Canary yellow is the background colour with numerals 507 in red boldly superimposed over a white diamond device and with red strips on either side. Beneath the said composition on the one side the numerals 507 are written in Devnagari script in a diamond device and on the other side is certain descriptive matter. In addition, the numerals 507, are also placed in Devnagari and Roman Scripts at the same two distinctive positions as have been placed on the plaintiff's wrappers. It is alleged that defendant has not only adopted an identical and/or deceptively similar trade mark 507 as that of the plaintiff

but in addition has adopted an identical and/or deceptively similar wrapper as the wrapper of the plaintiff, and that the colour combination, get-up, lay-out and arrangement of the defendant's wrapper, was identical and/or deceptively similar to that of the plaintiff's wrapper solely intended to commit piracy of the plaintiff's rights in the said marks, design etc. and to pass off the defendant's goods and business as the goods and business of the plaintiff.

(4) The defendant resists the suit and opposes the application for injunction, inter alia, on the grounds that the mark consisting of the numerals 507 does not constitute an infringement of the plaintiff's mark consisting of numerals 501 and is not identical with or deceptively similar to the mark of the plaintiff, that the wrapper used by the defendant is also neither identical with nor deceptively similar to the wrapper used by the plaintiff in the marketing of its goods. Defendant, however, does not deny that the numerals 501, as indeed, the design of the wrapper are registered trade marks of the plaintiff and the design of the wrapper is also registered under the Copyright Act. Defendant, however, challenges the jurisdiction of the Court in relation to the action of infringement of trademark and of passing off on the ground that the defendant carries on its business in Nagpur and has neither manufactured nor marketed the goods within the territorial jurisdiction of this Court. Defendant does not dispute the territorial jurisdiction of this Court in relation to the claim based on infringement of Copyright by virtue of Section 62(2) of the Copyright Act 1957 but maintains that, that by itself, would not give jurisdiction to this Court to deal with the claim of infringement of trademark either in relation to the numerals or in relation to the wrapper.

(5) I have heard learned Counsel for the parties and it appears to me to be reasonable that the defendant is restrained in the terms in which the restraint order is sought by the plaintiff. True, it is doubtful if the numerals 507 per se could be said to be identical with or deceptively similar to the numerals 501, the use of the numerals 507 by the defendant on its wrapper in relation to washing soap of its manufacture in a manner which, having regard to the deceptive similarity between the get-up, the scheme, the colour and the arrangement of lettering in the two competing wrappers gives the wrapper, including the numerals, an over-all effect of deceptive similarity which would prima facie constitute an infringement of the trade marks of the plaintiff in the numerals and the wrapper as also of the Copyright in the wrapper. The comparative description of the wrappers set out in the plaint, which is amply reflected on a visual examination of the competing wrappers, leaves absolutely no manner of doubt that the wrapper is deceptively similar to the wrapper admittedly being extensively used by the plaintiff during the last many years. This deceptive similarity is likely to cause confusion in the course of trade, particularly, having regard to the cause to people who constitute the buying public in relation to washing soap. The admitted extensive popularity of the plaintiff's soap bearing the aforesaid mark and wrapper is a further aggravating factor. Prima facie, therefore, the plaintiff would be entitled to the protection sought by it.

(6) The comparative scopes of a copyright and trade mark registration are different, even though where a design on a wrapper is registered under the Copyright Act, there is, to an extent, an overlapping between the two remedies. Some controversy is no doubt possible if the mere jurisdiction of the Court to entertain an action for infringement of copyright would also give the court the necessary jurisdiction to deal with the corresponding infringement of trade mark, where both constitute part of a composite suit. In view of the undoubted jurisdiction of this court in

relation to the infringement of copyright, Court would be justified in granting injunction of both the trade mark and the copyright at this stage of the proceedings, particularly, where there is a specific averment in the plaint, whatever it may be worth, that the plaintiff has been selling the goods, inter alia, within the territorial jurisdiction of this Court.

(7) I would, therefore, grant an injunction restraining the defendant from manufacturing, selling offering for sale, advertising or dealing in washing soap under the trade mark 501, 507 or any other deceptively similar marks and wrappers as are identical with or deceptively similar to the wrappers of the plaintiff 501 half bar washing soap and from in any manner infringing the registered trade mark and copyright of the plaintiff and from passing off its washing soap and business as the washing soap and business of the plaintiff during the pendency of the suit.

(8) The cost in this application should abide the cause.