

This Application Under Order Xiv Rule 8 ... vs Uni-Sole Pvt. Ltd. And Another [1999 Ptc ... on 11 November, 2011

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Bench: Vinod K.Sharma

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.11.2011

CORAM

THE HON'BLE MR. JUSTICE VINOD K.SHARMA

O.A.Nos.682, 683 & 684 of 2011

in

C.S.No.541 of 2011

ORDER

COMMON ORDER

O.A.No.682 of 2011:

This application under Order XIV Rule 8 of O.S. Rules read with Order 39 Rule 1 & 2 of C.P.C. has been filed to grant ad-inteim injunction restraining the respondents, their distributors, stockist, servants, agents, retailers, representatives of any other person claiming under/through them from in any manner infringing the applicant's copyright as contained in their "Medimix" pouches/labels/ packing materials in respect of the trademark 'Medimix and/or the device/ logo/artistic as contained in plaint document No.2 and/or plaint Doc.No.4 and/or plaint Doc.No.6 by manufacturing, selling, offering for sale, stocking, advertising, either directly and/or indirectly any goods and in particular any soaps and/or costmetic products employing the said mark/device/logo/artistic work as contained in plaint Doc. No.7 or either independently or in part or otherwise and/or by using any other

mark/device/logo/artistic work identical with and/or deceptively similar to applicant's artistic work as contained in plaint doc.No.2 and/or plaint doc.No.4 and/or plaint Doc. No.6 or in any other manner whatsoever, pending disposal of the suit.

O.A.No.683 of 2011:

This application under Order XIV Rule 8 of O.S. Rules read with Order 39 Rule 1 & 2 of C.P.C. has been filed to grant ad-inteim injunction restraining the respondents, its distributors, stockist, servants, agents, retailers, representatives of any other person claiming under/through them from in any manner infringing the applicant's registered trademark "Medimix" and/or the device/ logo/label/artistic work by manufacturing, selling, offering for sale, stocking, advertising, either directly and/or indirectly any goods and in particular any soaps and/or costmetic products under the trademark and/or the label as contained in plaint Doc.No.6 or either independently or in part or otherwise and/or under any other mark/device/logo/artistic work identical with and/or deceptively similar to applicant's registered trademark or in any other manner whatsoever, pending disposal of the suit.

O.A.No.684 of 2011:

This application under Order XIV Rule 8 of O.S. Rules read with Order 39 Rule 1 & 2 of C.P.C. has been filed to grant ad-inteim injunction restraining the respondents, their distributors, stockist, servants, agents, retailers, representatives of any other person claiming under/through them from in any manner manufacturing, selling, offering for sale, stocking, advertising, either directly and/or indirectly any goods and in particular any soaps and/or costmetic products employing the mark/device/logo/artistic work in respect of their goods as contained in Plaint Doc.No.7 and/or any other mark/device/logo/artistic work which is identical with or deceptively similar to applicant's trademark, device/logo/artistic work as contained in plaint doc.No.2 and/or plaint doc.No.4 and/or plaint Doc. No.6 so as to pass off the respondents' products as and for the products of the applicant's or in any other manner whatsoever, connected with the applicant.

2 M/s.Cholayil Private Limited, a company registered under Companies Act has filed the suit under Order IV Rule 1 of O.S.Rules, read with Sec.27, 134 and 135 of Trade Marks Act, 1999 and Sec.51, 55, 58 and 62 of the Copyright Act, 1957 for perpetuall prohibitory injunction, as also mandatory injnction for directing the defendants to surrender to the plaintiff for destruction all packed soaps, goods, labels, dyes, blocks, moulds, screen prints packing materials, advertisements, and other materials and to render accounts of pofits made by sale of soaps, under the label deceptively similar to that of the plaintiff.

3 The plaintiff has also prayed for to grant damages to the tune of Rs.25,01,000/- (Rupees twenty five lakhs and one thousand only) for the act of passing off, and infringement of trademark and

copyright.

4 The plaintiff submits to be the most famous and respected Ayurvedic families of Kerala, and practicing Ayurveda and holistic healthcare system for several generations. Dr.V.P.Sidhan, developed a unique soap, Medimix, the flagship brand of the plaintiff.

5 The company is engaged in manufacture and marketing for soaps, talcom powders, Pharma products and Consumer Health products under the brand name such as Medimix, Cuticura, Rituta, Yakrita, Grahi, DQR, Dasamoolakaduthrayam, Rumacide-G, Smilak Plus, Suseeta, Posna, Tejaswini, Oaril, Hapy Morning, Bubhush and Vitaking and earned goodwill and reputation for its quality products over the years.

6 The Ayurvedic soap manufactured by the plaintiff, is sold under the brand name "Medimix" which was adopted by the plaintiff as early as in the year 1969. (However, the certificate of incorporation of the plaintiff attached with the plaint is dated 27.12.2005). The plaintiff for the reasons best known, has failed to file the original certificate of Incorporation.

7 The plaintiff has also placed on record the assignment of interest by Ms.Sujatha Keshavan, in favour of the plaintiff company by deed of assignment dated 19.8.2008. This document shows the assigned work, which is printed on the wrapper of Medimix which was assigned to the plaintiff on 19.8.2008.

8 The plaintiff in the pleading, has submitted that the trademark "Medimix" has been used by the plaintiff for over 42 years which is now marketed in pouches/labels with trademark along with a distinctive artistic work, which was assigned to the plaintiff on 19.8.2008.

9 The plaintiff/applicant is using the trademark along with artistic work openly, continuously and extensively to market its Ayurvedic soaps. The "Medimix" soap is marketed through Dorcas Market Makers Private Limited, a subsidiary company of the plaintiff.

10 The Medimix labels have been placed on record. The artistic work is said to be the creation of Ms.Sujatha Keshavan which as already noticed above, stands assigned to the plaintiff. The plaintiff, therefore, claims to be the absolute owner of trademark "Medimix" since 1969, and the owner of copyright in the original artistic work since 2005.

11 The case of the plaintiff, is that the use of similar trademark or artistic work by anyone without the consent of the plaintiff/applicant constitutes an infringement of the plaintiff's right under the Trademarks Act and Copyright Act and further amounts to a tort of passing off.

12 The plaintiff has placed on record the Chartered Accountant's certificate, showing sales and promotional expenses by M/s.Dorcas Market Makers Pvt. Ltd. The public/consumers recognise the Trademark and label which is a registered trademark to be that of the plaintiff alone. The soap is marketed throughout the country. The Trademark stands registered in the name of the plaintiff/applicant vide registration No.1394556.

13 It is pleaded by the plaintiff, that in June 2011, the plaintiff discovered that the defendant was fraudulently and dishonestly indulging in manufacture and sale of Soap under the trademark "Herbal" employing a label identical to that of the plaintiff's "Medimix" label, which is not permissible as it is the plaintiff who is alone entitled to use the trademark "Medimix" in view of its registration, and for the goodwill achieved by its marketing, for number of years.

14 The Trademark of the defendant is claimed to be deceptively similar to the plaintiff's "Medimix" label. The defendants thus deliberately adopted a visually similar label to that of the plaintiff, and employed an identical deceptively similar device and label for its soaps, with the dishonest intention, to encash upon the mammoth reputation of the plaintiff's "Medimix".

15 The colour combination, getup and appearance of the defendants label is identical with that of the plaintiff. The identical/deceptively similar label, is thus causing confusion in the minds of consumers and traders at large with regard to the origin of the products, and thereby results in deceiving them and inducing them to buy the defendants' goods, believing it to be that of the plaintiff or associated with the plaintiff.

16 The plaintiff being the Proprietor of the trademark "Medimix" and the owner of its artistic work is entitled to exclusively use and no other person can use trademark/label either identical or deceptively similar to that of the plaintiff.

17 It is the case of the plaintiff, that due to defendant's infringing the trademark and copyright, has resulted in adversely affecting its sales and reputation of the plaintiff/applicant.

18 For the purpose of Court fee, the plaintiff tentatively estimated damages at Rs.25,01,000/-(Rupees twenty five lakhs and one thousand only). For bringing the suit, within the pecuniary jurisdiction of this Court, whereas no basis or details of the damages has been pleaded or shown in the suit. It is a commercial transaction, and the necessary facts and details of damages suffered could safely be pleaded, as in absence of necessary pleadings no evidence can be led.

19 Along with the suit, the plaintiff has filed three interim applications, referred to above for grant of interim injunction.

20 The first defendant has filed counter affidavit wherein the averments made in the applications are denied. The case set up by the defendant/respondent, is that "Green colour" is associated with herbal products. Similarly, the depiction of herbs, nuts, spices and certain fruits like citrus, gooseberry, papaya are also associated with herbs. The aurvedic medicinal preparations invariably depict mortar and pestle, and it is only the manner of depiction which differs in each product. Therefore, nobody can claim monopoly over the above depictions unless, it is identical to the other.

21 It is also the stand of the defendant that the plaintiff has not produced any proof for alleged user of the artistic works of trademark depicted in the plaint in the year 2005, as the assignment deed is dated 19.8.2008. It was not possible for the plaintiff to use the artistic work and label Mark since 2005, as pleaded in the suit/ applications.

22 It is also pleaded that no documentary evidence have been placed to show the user of the specific label; The defendant/ non applicant has not used the label or published artistic work, as claimed by the plaintiff.

23 It is also the case of the defendant/non applicant that plaintiff appears to have commenced the use of subject label only recently and is not entitled to claim reputation or goodwill in respect of the impugned cases.

24 The defendant/non applicant was incorporated in the year 1984 in ayurvedic medical research and development and has developed many herbal based and other personal care products like the tooth paste, tooth powder, tooth brush, soap, hair oils, baby oil, hygiene product, conditioner, shampoo, body wash, etc. for market in India and export market. The products of the defendants/non applicants are exported to U.S.A., Canada, France, U.K. and other countries under the trademark "AMAR" which is a registered trademark of the respondent/defendant.

25 The defendant/respondent introduced the "Amar Herbal Soap" consisting of 18 herbs in the year 2010, and due to the goodwill and reputation enjoyed by the defendant/non applicant, this products was well received. The distinctive label used for the product had depiction of a heap of fruits, leaves and herbs in a metal bowl. The vertical border of the label bear greenery. The words "Amar Herbal" is written prominently in colour combination of red, black, white and green.

26 The distinctive artwork used by the defendant/non applicant is the creation of its Managing Director in the course of employment. The trademark "Amar" is registered vide registration No.1318089 in Class 3, which is valid and subsisting.

27 The defendant/non applicant have pointed out the following differences in primary label design Plaintiff's Medimix Label Defendants' Amar Herbal Label 1 Mortar and Pestle device is depicted Wide mouthed Metal Bowl is depicted 2 Mortar is empty with pestle alone partially visible Metal Bowl is filled with fruits, nuts, herbs and leaves 3 Leaves and flowers are depicted outside the Mortar Fruits, nuts, herbs and leaves are heaped into the Metal bowl 4 Background colour combination is yellow and olive green Background colour is white and pale green 5 Leaves and flowers spread around the mortar Fruits and leaves do not spread/spill outside the bowl 6 Dark green band along border Pale green vegetation is used 28 The stand of the defendant/non applicant, therefore is that there is not even remote similarity between the labels of the plaintiff and that of the defendant's. The defendant/non applicant has also produced monthly sales turnover and pleaded that trademark "Amar" is being used for more than three decades in Indian and foreign markets.

29 The defendant/non applicant denied use of trademark "Medimix" by the plaintiff/applicant for over 42 years, on the ground that plaintiff company was initially incorporated in the year 1994. The averments in the plaint/ applications are denied in view of assignment of artistic work in the year 2008.

30 The defendants/non applicant has also denied the allegation of fraud and dishonesty. The averments made in the rest of the paragraphs of applications are also denied, and it is prayed that

the applications be dismissed with exemplary cost.

31 The learned counsel for the plaintiff/applicant in support of the applications, referred to Sec.2(m) of the Trademark Act 1999, which defines the mark to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof, to contend, that the shape of packing and colour combination used by the plaintiff/applicant will be covered under the definition of mark and the use of deceptively similar packing, with similar colour combination amounts to breach of trademark.

32 The learned counsel for the plaintiff/applicant thereafter referred to Sec.10 of the Trademark Act, which stipulates that a trademark may be limited wholly or in part to any combination of colours, and any such limitation is to be taken into consideration by the tribunal called upon to decide the distinctive character of the trademark, where the trademark is registered without limitation of colour, it shall be deemed to be registered for all colours and finally reference was made to Sec.29 of Trademark Act which reads as under:

"29. Infringement of registered trade marks (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of-

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person. using by way of permitted use, uses in the course of trade, a mark which-

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he-

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising-

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly."

33 By referring to provisions of the Act, the contention of the learned counsel for the plaintiff/applicant, was that the packing used by the defendants is deceptively similar especially the colour design adopted by the defendant which is identical and similar, which can lead to deception to the customer.

34 At the time of arguments, the learned counsel for the plaintiff/applicant, contended that though the word "Medimix" and "Herbal" is not phonetically similar, but the colour combination used in packing materials amounts to infringement of the registered trade mark of the plaintiff/applicant as the plaintiff/applicant has got Trademark registered as per packing.

35 In support of the contention, that colour alone can serve as a trademark, the reliance was placed on the judgment of the U.S. Supreme Court in the case of *Qualitex Co. v. Jacobson Products Co.* [U.S. (1995), 1] wherein the Hon'ble U.S. Supreme Court was pleased to lay down as under:

"The question in this case is whether the Lanham Trademark Act of 1946 (Lanham Act), 15 U.S.C. 1051-1127(1988 ed.and Supp. V), permits the registration of a trademark that consists, purely and simply, of a colour. We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark."

This proposition cannot be disputed, as Sec.10 of the Trademark Act also permits registration of colour combination as a trademark, but in the present case, registration of trademark of the plaintiff/applicant is not with regard to colour combination, but trademark "Medimix" as packed.

36 The learned counsel for the plaintiff/applicant thereafter referred to judgment in the case of *Baker et. al. v. The Master Printers, Union of New Jersey* (47 USPQ 69) wherein it was laid down as under:

"UNFAIR COMPETITION:

General Principles Men seeking symbol to identify themselves and product of their labor should select trade mark different from trade marks or symbols of others already established in competitive field, object being to have mark and good will which stand apart from all others; most successful form of copying is to employ enough points of similarity to confuse public with enough points of difference to confuse courts, but instant court enjoins defendants."

This is a judgment of District Court, D.New Jersey, U.S.A. which cannot be quoted as precedent. However, the principle laid down therein cannot be disputed, as it is well settled law that it is not

similarity or dissimilarity, but as to whether a product of the party can be passed on by deceptively similar product of another.

37 The learned counsel for the plaintiff/applicant also placed reliance on the judgment in the case of Fort James Operating Co. v. Royal Paper Converting Inc. (1983 USPQ2D 1624) wherein it has been held as under:

"The new factor we consider is the similarity or dissimilarity of the marks. Indoeing so, we are mindful of the proposition that when marks appear on virtually identical or closely related goods, the degree of similarity of the marks necessary to support a finding of likely confusion is not as great as when the goods are different. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Further, in the case of design marks, the question of likelihood of confusion must be decided on the basis of the visual similarity of the marks. See In re ATV Network Limited, 552F.2d 925, 193 USPQ 331 (CCPA 1977). By definition, this is a subjective determination and must take into account the overall commercial impressions created by the marks rather than any detained analysis thereof. In re Joseph Lieberman and Sons, Inc. 156 USPQ 700 (TTAB 1968); and Hupp Corporation v. AFR Corporation 157 USPQ 537 (TTAB 1968)."

This judgment again lays down general principle of law, which are well recognised by the Courts in India.

38 The reliance was thereafter placed on the judgment of the Hon'ble Mumbai High Court in the case of Burroughs Welcome (India) Ltd. vs. Uni-Sole Pvt. Ltd. And another [1999 PTC (19) 188] wherein the Hon'ble Mumbai High Court, was pleased to lay down that in case of infringement of artistic work, the substantial similarity, colour combination and nature of getup is sufficient for grant of interim injunction, as actual reputation of artistic work is not test and manner and dissimilarity in two products can be of no consequences.

39 The learned counsel for the plaintiff/applicant also placed reliance on the judgment of the Hon'ble Delhi High Court in the case of Microfibres Inc. vs. Girdhar & Co. & another [2009(40) PTC 519 (Del.) (DB) 519] wherein the Hon'ble Division Bench of Delhi High Court was pleased to lay down as under:

"46. We thus summarize our findings as follows: -

(a) The definition of 'artistic work' has a very wide connotation as it is not circumscribed by any limitation of the work possessing any artistic quality. Even an abstract work, such as a few lines or curves arbitrarily drawn would qualify as an artistic work. It may be two dimensional or three dimensional. The artistic work may or may not have visual appeal.

(b) The rights to which a holder of an original artistic work is entitled are enumerated in Section 14(c) of the Copyright act.

(c) It is the exclusive right of the holder of a Copyright in an original artistic work to reproduce the work in any material form. For example, a drawing of an imaginary futuristic automobile, which is an original artistic work, may be reproduced in the three- dimensional material form using an element, such as a metal sheet.

(d) The design protection in case of registered works under the Designs Act cannot be extended to include the copyright protection to the works which were industrially produced.

(e) A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher protection to pure original artistic works such as paintings, sculptures etc and lesser protection to design activity which is commercial in nature. The legislative intent is, thus, clear that the protection accorded to a work which is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure art.

(f) The original paintings/artistic works which may be used to industrially produce the designed article would continue to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and would be entitled to the full period of copyright protection as evident from the definition of the design under Section 2(d) of the Designs Act. However, the intention of producing the artistic work is not relevant.

(g) This is precisely why the legislature not only limited the protection by mandating that the copyright shall cease under the Copyright Act in a registered design but in addition, also deprived copyright protection to designs capable of being registered under the Designs Act, but not so registered, as soon as the concerned design had been applied more than 50 times by industrial process by the owner of the copyright or his licensee. h. In the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work per se.

(i) If the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act. If it is a design registrable under the Designs Act but has not so been registered, the Design would continue to enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process for more than 50 times is reached. But once that limit is crossed, it would lose its copyright protection under the Copyright Act. This interpretation would harmonize the Copyright and the Designs Act in accordance with the legislative intent."

40 To contend, that the artistic work of the plaintiff/ applicant can only be exclusively used by the plaintiff/applicant, and violation thereof amounts to violation of the copyright. That the packing and design of the defendant product is deceptively similar to that of the plaintiff, therefore, the plaintiff/applicant is entitled to interim injunction, as prayed for.

41 The reliance was thereafter placed on the judgment of this Court in the case of R.Gopalakrishnan vs Venkateswara Camphor Works [2001 PTC (Mad) 233] wherein this Court was pleased to lay down, that when two marks are deceptively similar, then intention to deceive need not be proved, as where the get-up and collocation of the words and colour are not purely accidental but the sequence of the words and placement are identical, there is infringement entitling the plaintiff to get an injunction against the defendant.

42 This judgment cannot advance the case of the plaintiff/ applicant as getup and collocation of the words is not as both the products similar i.e. "Medimix" has no resemblance with the word "Herbal". Furthermore, the word "Medimix" is written in capital letters, whereas the word "Herbal" is in running english, even the artistic work and design is totally different.

43 The reliance was also placed on the judgment of the Delhi High Court in the case of R.G.Anand vs. Delux Films and others [PTC (Suppl)(1) (Del)(DB) 412] wherein the Hon'ble Delhi High Court, was pleased to lay down that for taking action under the Copyright Act, what is perceived is not thought or information, but the original expresion of thought or information to some concrete form and therefore, it is an infringement only if the defendant makes an unlawful use of the form to which the thought or information is expressed.

44 This judgment has no application to the question in issue in this case.

45 The reliance was also placed on the judgment of the Calcutta High Court in the case of ITC Ltd. v. Crescendo Tobacco Agency and another [2011 (46) PTC (Cal.) 65] wherein the Hon'ble Calcutta High Court was pleased to lay down as under:

"14. The test, at the end of the day, is still in the eye. As to whether the get-up of one product is a copy of another cannot be told by placing the two products side by side and counting either the similarities or the differences. The more trustworthy assessment would be to remember the plaintiff's product and view the defendant's. If the eye reminds one of the plaintiff's product upon looking at the defendant's, not only because of a similar colour combination but also on the impression of the other distinctive features, an injunction may issue. If a fleeting glance at the defendant's product throws up images of the plaintiff's product, the test is met. If the eye does not recall the plaintiff's product upon a look at the defendant's, the injunction has ordinarily to be refused."

46 The contention of the learned counsel for the plaintiff/ applicant therefore was that the get-up of one product is copy of another cannot be determined by placing two products side by side and by counting either the similarities or the differences, but only to remember one product with that of

another to form opinion, as to whether there is a chance of deception.

47 Even if this criteria followed, it cannot be prima facie accepted, that a person can mistake a word "Medimix" with "Herbal" as both are distinct and different names not even remotely connected, besides the fact that there are lot of differences between the two in the colour combination also.

48 The learned counsel for the plaintiff/applicant thereafter placed reliance on the judgment of the Hon'ble Supreme Court in the case of Ruston & Hornsby Ltd. v. Zamindara Engineering Co. [PTC (Suppl)(1) (SC) 175] wherein the Hon'ble Supreme Court was pleased to hold that use of "Rustam India" is deceptively similar to plaintiff's registered mark "Ruston" which entitled the plaintiff to initiate action for infringement. The Hon'ble Supreme Court was further pleased to lay down in the said case that in an action for infringement, the question is whether the defendant is selling goods so marked as designed to lead the purchaser to believe that they are that of the plaintiff's, but in an infringement action, the issue is whether the defendant is using a mark which is same or colourable imitation of plaintiff's registered trademark.

49 The judgment again cannot advance the case of the plaintiff/ applicant as the words are not phonetically similar nor it can be said that packing of "Herbal" soap is imitation of the "Medimix" packing which could result in deception, as most of the soaps have same packing.

50 The reliance was thereafter placed on the judgment of the Hon'ble Supreme Court in the case of Parle Products (P) Ltd. vs. I.P. & Co., Mysore [A.I.R. 1972 SC 1359] wherein it is laid down, that the test for determination of a trademark to be deceptively similar to the registered one would be, if a person is likely to accept the another one, if offered, instead of original one. The Hon'ble Supreme Court was pleased to lay down as under:

"9 It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the color scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluko Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in ,our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs goods, he might easily mistake the

defendants' wrapper for the plaintiffs if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the Bar as in our view each case will have to be, judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it.

51 Similarly, reliance was placed on the judgment of the Hon'ble Supreme Court in the case of Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd. [2001(1) CTMR (SC) 288] wherein the Hon'ble Supreme Court was pleased to lay down as under:

"for deciding the question of deceptive similarity the following factors are to be considered:

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. Both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods and

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

Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case."

52 The question to be decided in this case therefore, will be;

"whether the soap "Medimix" is deceptively similar to "Herbal" because of some resemblance of packing of this product ?

53 The test for determination of trademark to be deceptively similar to the registered one would be, if a person is likely to accept the other, if offered by taking it to be the original.

54 It may also be noticed that identification of essential features of the mark is an essence of question of fact, to be decided by the Court, on the basis of evidence led having regards to trade use.

55 The Hon'ble Supreme Court in the case of Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories [PTC (Suppl)(2) (SC) 680] was pleased to lay down as under:

"28. When once the use by the defendant of the mark which is claimed to infringe the plaintiffs mark is shown to be "in the course of trade,, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the, plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiffs registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide s. 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks-the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiffs mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff."

The reliance was placed on this judgment by the the learned counsel for the plaintiff/applicant as also learned counsel for the defendant/respondent.

56 Therefore, in this background of the settled law, if the question is considered, no other conclusion than the one that the plaintiff/applicant has failed to make out a prima facie case, for grant of injunction. "Medimix" and "Herbal" are not phonetically similar. The artistic work of which

strong reliance is placed was admittedly assigned to the plaintiff/applicant only in the year 2008 and therefore the contention, that this was used since 1969 of incorporation of the company, cannot be accepted. The colour combination and artistic design in packing material of both products are also different. The original look of the both the products also does not lead to the conclusion that label and packing of the defendant is deceptively similar or can lead to confusion in the minds of customer about the product.

57 The defendant is well recognised company. When the products are tested on the basis of settled principle of law referred to above, it cannot be said that the man of ordinary prudent is likely to be misled to take one product for the another. There are more dissimilarities than the similarities. The similarity is only regarding box, in which soap is packed which cannot be said to be registered as most of the soap packing is in similar boxes. The plaintiff has failed to make out a prima facie case to seek injunction. The balance of convenience is also not in favour of plaintiff. The plaintiff cannot be said to suffer irreparable loss, as in case of success, the plaintiff can be compensated with damages.

58 Consequently, all these applications are dismissed. It is made clear that the observations made hereinabove are only for the purpose of disposing of the interlocutory applications, and be not to be taken as expression on merit of the controversy which is to be determined only after the evidence led by the respective parties.

No cost.

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