

(2008) 08 DEL CK 0009

Delhi High Court

Case No: I.A. 11786 of 2006, 298 and 837-838 of 2008 in CS (OS) 2000 of 2006

Britannia Industries Ltd.

APPELLANT

Vs

Cremica Agro Foods Ltd.

RESPONDENT

Date of Decision: Aug. 1, 2008

Citation: (2009) 1 ILR Delhi 575 : (2008) 38 PTC 89

Hon'ble Judges: S. Ravindra Bhat, J

Bench: Single Bench

Advocate: Kalyan V, for the Appellant; Shailen Bhatia and Ekta Nayar Saini, for the Respondent

Final Decision: Dismissed

Judgement

S. Ravindra Bhat, J.

In this action for passing off, the Plaintiff seeks a permanent injunction against the Defendant to restrain its use of the trademark "GREETINGS" in relation to biscuits. This order will dispose of the Plaintiffs application for ad-interim injunction, and the Defendant's application under Order 39, Rule 4, for vacation of the subsisting injunction. Two other applications are also disposed of by this order. An ex-parte injunction had been issued against the Defendants enjoining their use of the mark, on 20-12-2006.

2. The Plaintiff, a company incorporated since 1918, with its registered office at Kolkata, claims to be engaged in the production and distribution of a wide range of bakery and confectionary products. It owns several brands and sub-brands. It has registered trademarks such as "Britannia"; "Britannia Eat Healthy, Think Better"; it also avers to owning registered "sub-brands" such as "Good Day"; "Little Hearts" "50-50" "TIGER" etc. It alleges to have launched the "GREETINGS" range of biscuits in a festival pack, in the September 2005, specially to cater to the festive season of Divali and Christmas. According to the suit averments, this sub-brand contains combination pack containing biscuit packets, cookies and cakes.

3. The Plaintiff alleges that considerable amounts were spent by it in the advertisement campaign ("media blitzkrieg"). It relies on a large number of invoices issued by advertising companies and concerns, as well as TV channels, for airing its advertisements, in promotion of the product. According to averments, the expenditure on the media campaign for the product in 2005-2006 was Rs. 1.65 crores and for the next year, till filing of the suit, it was Rs. 1.15 crores. According to the Plaintiff, the combination pack idea was a success, evidenced by its sales - to an extent of 780 tonnes or Rs. 6.5 crores in 2005-06 and 1500 tonnes or Rs. 14 crores, the next year.

4. The Plaintiff also alleges that it applied for registration of the word mark, with its present get up, in the same year, 2005 and its application is pending. According to the Plaintiff, the label and combination pack "Greeting" is a unique and distinctive mark, combining various distinctive features, resulting in substantial public recognition of the package with the makers of "Britannia" brand of products. The product thus has acquired distinctiveness, and the mark- a combination of visual and word marks, a secondary meaning. The word "Greeting" is neither descriptive of the products, nor is generic; it is arbitrary, and universally identified with the Plaintiffs' Britannia range of food products.

5. The positioning of the mark "Greetings" with the umbrella brand "Britannia" (so the Plaintiff says), is today accepted as a symbol of the Plaintiffs reputation and goodwill assuring the public that bakery products made and sold under the original recipe, processes and quality standard which it is responsible for maintaining. According to the Plaintiff, the trade mark "Greetings" is a unique and distinctive combination of various features with a distinctive colour scheme rendering it distinctive as a whole; being a skillful blend of the features with distinctive features constituting the label as a whole which uniquely makes "Greetings" an artistic work.

6. It is claimed that the Defendants have sought to appropriate the mark "Greetings" with a view to encash on the Plaintiffs reputation and goodwill in it and pass off its products as those of the Plaintiffs. The Plaintiff alleges that adoption and use by the Defendant of the mark "Greetings" in relation to bakery products has an inherent element of mis-representation to the consumer public that such bakery products owes its origin to the Plaintiff. Plaintiff claims that Defendant has adopted an identical or similar writing style for its use of the word "Greetings" with a line below the word mark. On a closer scrutiny, no doubt, the line may be different; yet the unwary customer would be trapped into believing the Defendant's mark to be the Plaintiffs. The mis-representation is the direct effect of the Defendant's acts of slavish imitation and commercial piracy of the distinctive "Greetings" name and mark.

7. Mr. Kalyan V., learned Counsel for the Plaintiff reiterated the submissions made in the pleadings. According to the counsel, the Defendant's claim of using the mark "Greetings" since 2002 is suspect. It is alleged that the Defendant has not

corroborated using that mark with any objective material apart from advertisements in the vernacular, issued in 2004. It is also alleged that the invoices filed do not reveal use of the word "Greetings" to establish alleged prior user. On the other hand, counsel contended that the materials produced by the Defendant showed that invoices were in respect of the Assorted Biscuits.

8. Learned counsel submitted that on a proper application outlined by the Supreme Court in [Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.](#), this Court should confirm an ex-parte injunction granted earlier.

9. The Defendant, in the written statement and pleadings in the interlocutory applications, claims to be using the mark "Greetings" since 2002. It has also counter claimed against the Plaintiff and alleged that the word "Greetings" is a common word. The Defendant avers to using the box bearing the trade mark greeting since 2002. It alleges having advertised extensively about the "Greetings" mark ever since 2002.

10. The Defendant company, it is contended, is a well reputed concern, providing quality products and has several associates companies. According to it, these associate companies are supplying products even to Mc Donald's. Being a later adopter of the work mark "Greetings" in respect of the biscuits and assorted bakery products, the Plaintiff cannot claim exclusivity or distinctiveness to restrain the Defendant from using it. It is alleged that the Plaintiff has deliberately and mischievously given its entire advertisement expenditure in relation to all its products including TIGER and other brands.

11. The Defendant claims to be using the words "Ms. Bector" and "Cremica" as well as "Greetings" which contain assorted gift pack. Its invoices, therefore, describe the products sold as "assorted biscuit pack". However, the Defendant's advertisements are clear indicator of the goods made available to the public. They reveal assorted biscuits under the trademark "Greetings". The Defendant uses the expression "Greetings" with the description "Festive Box"-also used in the invoices. This combination of word Festive Box with "Greetings" is used as description of the product in newspaper advertisements.

12. According to the Defendant, the sales figures for the product sold under the trademark "Greetings" for varied period is as follows

Sl. No	Year	Amount
1.	2002-2003	69,96,140
2.	2003-2004	77,14,129
3.	2004-2005	1,03,90,208
4.	2005-2006	1,31,74,470

13. Learned Counsel for the Defendant submitted that the word "Greeting" is a common and a dictionary word and, therefore, public juris. He relied upon the decision of this Court reported as [S.B.L. Ltd. Vs. Himalaya Drug Co.](#), and the decision of the Supreme Court reported as J.R. Kapoor v. Micronix India 1994 (14) PTC 260 (SC). It was also submitted that the application of the test in relation to passing of action in Cadila Health Care Ltd. (Supra) disentitles the Plaintiff to ad interim injunction. According to the counsel, the Plaintiff was unable to establish that a common word such as "Greeting" with multiple uses and admittedly an unregistered mark had acquired as distinctive a meaning or association in relation to its (the Plaintiffs) goods or products as to be described a work mark with a secondary meaning. Learned Counsel submitted that so far as the colour combination etc. are concerned, they are common to the trade because on festive occasions, gift boxes are usually wrapped in packaging of varied colour combination such as red, pink, blue, yellow etc.

14. Learned Counsel submitted that the advertisements placed on record by the Defendant clearly show that it has prior user of the mark, since 2002, and, therefore, the Plaintiff cannot claim any injunction. He also relied upon the decision of the Supreme Court in [Hardie Trading Ltd. and Another Vs. Addisons Paint and Chemicals Ltd.](#), to say that the "use" is not confined necessary to sale alone but otherwise also.

15. The battle lines, in this case are clear enough; both rival marks are concededly not registered. The Court has to, therefore, direct its enquiry as to who prima facie was the prior user; if the Defendant was prior user, has it shown material of sufficient or adequate use of the mark and independently whether the Plaintiff has been able to establish that the "Greetings" mark used by it concededly since 2005 has acquired such distinctiveness as to denote secondary meaning in relation to its products.

16. Decisions of the Supreme Court in [Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories](#), ; [Amritdhara Pharmacy Vs. Satyadeo Gupta](#), ; [Parle Products \(P\) Ltd. Vs. J.P. and Co., Mysore](#), [Heinz Italia and Another Vs. Dabur India Ltd.](#), have reiterated the tests which courts should adopt while determining whether the Defendant has "passed off" his goods or products as the Plaintiffs. The tests broadly indicated are:

(a) The nature of the marks, i.e., whether the marks are world marks or level marks or composite marks, i.e., both world and level marks.

(b) The degree of resemblances 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 education and intelligence and a degree of care they are likely to exercise in purchasing the goods.
- (f) The mode of purchasing the goods or placing orders for the goods.
- (g) Any other surrounding circumstances.

17. In this case, the rival marks are a combination of word mark and visual mark. In one sense they are composite marks. The goods are bakery and confectionery products. As far as the word mark is concerned, "Greetings" is a common dictionary word with no association to such goods. It is, therefore, an arbitrary word mark so far as biscuits, cakes and bakery products are concerned. So far as the other aspects in Cadila Health Care and the other decisions are concerned, the class of purchasers who are likely to buy the goods is the general consumer public who purchase bakery products. In this context, both parties i.e. the Plaintiff and the Defendant claim that their products are sold during the festive seasons as they are combination packages. The Plaintiffs packages comprises biscuits, cookies and cakes where as the apparently the Defendant's products are a combination of assorted biscuits.

18. As far as word marks go, in *Biswaroop Roy Choudhary v. Karan Johar* 136 (2006) DLT 458 this Court propounded a rule of caution in the following terms:

Where words or phrases in common parlance are sought to be used with exclusivity, the Court should take care to determine which of the parties has ended its journey or traversed appreciably longer way in the use of such words as a trademark or as a title. Normally, proprietary or exclusive use of a common word should not be given jural imprimatur.

There is undoubtedly some body of authority supporting protection for word marks, or combination of common words. *Globe Super Parts v. Blue Super Flame* AIR 1986 Del. 245 : 1986 (6) PTC 235 (Del), was a case where the two common words "Super" and "Flame" joined together were declared as coined words and protection was granted. In *Reddaway v. Banham* (13) 1896 RPC 218 "Camel Hair" was concerned with a trademark in relation to belts made out of Camel hairs. Though both are common words yet they were construed as descriptive of the article, denoting the goods of a particular manufacturer, entitling him to restrain others from using them as to deceive purchasers. In [Laxmikant V. Patel Vs. Chetanbhat Shah and Another](#), the trade mark of the Plaintiff was Mukta Jeevan Colour Lab whereas the Defendant adopted the mark QSS Mukta Jeevan. The Plaintiffs claim to distinctiveness of the mark, and allegation of deception by the Defendant, was upheld. On the other hand, *W.N. Sharpe LD v. Solomon Bros LD* 1915 RPC 15. held that certain words such as "good", "best", "superfine" are incapable of adoption. They cannot have a secondary meaning and are not capable of registration. *Parsons Bros. and Co. v. John Gillespie and Co.* 1898 15 RPC 57 is a case where the court held that the "Flaked Oatmeal"

must be shown by the Plaintiff not to be a part of the common stock of language or the Plaintiff must show that the term being originally descriptive of the articles has now come to denote the goods made by the Plaintiff. In *Standard Ideal Co. v. Standard Sanitary Mfg. Co.* 1910 RPC 789, "Standard" was held not to be a valid trade mark. Thus, the test is always subjective to every case and the court has to determine whether common words having no nexus to the goods or services for which a given mark are used, acquire such a reputation, distinctiveness or secondary meaning as to denote a source specific association. The product, the length of time of its visibility and the length of time of its association with the mark, its association or dissociation with generic terms, etc are all pointers; relevant for judicial determination.

19. The Plaintiff has placed on the record a certificate by its Financial Manager about sales figures in relation to the "Greetings". Additionally, it has filed copies of invoices vide copies of 45 invoices between the period October 2005 to February 2006, issued by SET T.V., Star T.V., ZEE Delhi Film Ltd., Media Pvt. Ltd., SONY Entertainment etc. as evidence of its advertisement campaign. Each invoices described the duration of the advertisement and the amount Plaintiff had to pay. All the invoices describe "Greetings". Significantly, the Plaintiff has not produced any invoice pertaining to sales of its products for this period or any other period. The Defendant has produced an advertisement dated 6.11.2004 in the Hindi Daily "Dainik Jagaran" in relation to its combination pack "Greetings", in purple colour also containing the two expressions "Ms. Bector" and "Cremica". Other advertisements produced dated 07.11.2004, 08.11.2004, 26.10.2005, 27.10.2005, 30.10.2005 have been placed on the record. It has relied on 63 invoices, in relation to sale of assorted biscuits pack. These include 17 invoices relating to orders for printing of cartons for "Cremica Festive Pack" from the period 09.09.2003 to February 2006. It has also relied upon invoices for designing services rendered to it for designing and art work in relation to the festive pack. A copy of that design has also been filed on the record.

20. On a close analysis of the pleadings as well as the documentary evidence, this Court is of the opinion that prima facie the Plaintiffs claim for distinctiveness and acquisition of secondary meaning in relation to its mark "Greetings" has not been established. At best, the material on record shows that it launched the "Greetings Package" in September 2005 and spent substantial amounts towards its advertisement in the Electronic Media. It relies to only one certificate issued by its Finance Manager for the expenditure incurred for advertisement. On the other hand, it has not shown any objective material to substantiate its claim for sale to the tune of Rs. 6.5 crores and Rs. 14 crores for two years as averred in the plaint. The Defendant's materials include about 10 newspaper advertisements; besides it has also filed copies of invoices for the period 2002-2006 and bills/invoices for having ordered the printing of the festive carton pack.

21. This Court in its judgment reported a [Revlon Inc. and Others Vs. Sarita Manufacturing Co.,](#) held that dissemination of knowledge of a trade mark in respect of a product through advertisement in the media amounts to "use" of the mark. This reasoning to a certain extent finds support in the Supreme Court judgment in Hardie Trading Ltd. and Anr. (supra). In this case, the Defendant has been, in the opinion of the Court able to demonstrate use of the word-mark "Greetings" with the combination of the visual mark in relation to the biscuits since 2002. The advertisements are clearly of 2004, in any event, prior to the Plaintiffs claimed user.

22. Trade mark law should not, it has been held, to be stretched to push out an honest concurrent trader. In [London Rubber Co. Ltd. Vs. Durex Products,](#) , it was held by the Supreme Court that-

Even so, if there is honest concurrent use I should think the small trader is entitled to protection of his trade mark. Trade mark is a kind of property and is entitled to protection under the law, irrespective of its value in money so long as it has some business or commercial value. Not merely the interest of the public but also the interests of the owner are the subject and concern of trade mark legislation.

23. This Court is of the opinion that an overall conspectus of the relevant factors, the Plaintiffs claim for an interim injunction is unfounded. At this stage, the court does not engage itself in a detailed scrutiny; the trial would doubtless unravel the Plaintiffs detailed evidence about distinctiveness of the mark, claimed by it, and the secondary meaning it attributes to "Greetings". For purposes of deciding these applications, the materials are insufficient to entitle it to ad-interim injunctive relief. For these reasons, I.A. 11786/2006 (under Order XXXIX Rules 1 and 2 Code of Civil Procedure) has to fail. The reasoning indicated above also in the opinion of the Court would be dispositive of I.A. 298/2008, a composite application by the Defendant under Order XII Rule 6 CPC read with Order XXXIX Rule 4 Code of Civil Procedure. As far as the claim for a decree on admissions is concerned, the court finds that the pleadings of the Plaintiff do not amount to an unambiguous admission of the kind entitling the Defendant to a decree for dismissal of the suit.

24. For the above reasons, I.A. 11786/2006 is dismissed. For the same reasons, I.A. 298/2008 are disposed off. I.A. 837/2008 is another application under Order 39 Rule 4 and I.A. 838/2008 is the Defendant counter-claimants application under Order XXXIX Rule 1 and 2. The court is of opinion that the Defendant cannot, at this stage, in a retaliatory move, seek injunction after the Plaintiff has been in the market these last 3 years. The said applications too are therefore, disposed off. The interim injunction made on 20.12.2006 is hereby vacated.