

(2011) 12 DEL CK 0322

Delhi High Court

Case No: Regular First Appeal No. 819 of 2010

M/s. JSR Enterprises

APPELLANT

Vs

M/s. Groversons

RESPONDENT

Date of Decision: Dec. 15, 2011**Acts Referred:**

- Civil Procedure Code, 1908 (CPC) - Section 96
- Copyright Act, 1957 - Section 13

Citation: (2012) 50 PTC 199**Hon'ble Judges:** Valmiki J Mehta, J**Bench:** Single Bench**Advocate:** M.K. Miglani with Mr. Kapil Kr. Giri, for the Appellant; Saif Khan with Mr. Manish Biala and Mr. Vaibhav Raina, for the Respondent**Final Decision:** Disposed Off

Judgement

Valmiki J Mehta, J.

The challenge by means of this Regular First Appeal filed u/s 96 of the Code of Civil Procedure, 1908 is to the impugned judgment of the Trial Court dated 31.8.2010 decreeing the suit of the respondent/plaintiff against the appellant/defendant as per the following operative part of the judgment:-

65. In view of aforesaid discussion and findings on the above issues, the suit of the plaintiff is decreed for decree of permanent injunction and the defendant, its agents, dealers, distributors, stockists, partners, proprietors and all other persons acting on behalf of the defendant are restrained from selling, offering for sale or otherwise dealing in hosiery & readymade garments including undergarments and other allied and cognate goods so as to infringe the copyright of the plaintiff as appearing at point A on Ex.PW1/3 by putting on their goods, packing cartons/boxes, advertisements, etc. and from passing off its goods as that goods of plaintiff by user of artistic work as appearing at point A on Ex.PW1/3 and from infringing the

registered trade mark No. 1377019 in class-25 registered in favour of plaintiff. The plaintiff shall also be entitled to decree for a sum of Rs. 1,00,000/- (Rupees one lakh only) on account of damages which shall be paid by the defendant within one month from today failing which the plaintiff shall be entitled to simple interest at the rate of 8% per annum on the said amount. The plaintiff shall also be entitled to cost of the suit. Decree sheet be prepared accordingly. File be consigned to record room.

2. The limited issue in the present matter can be better understood when we take a look at the logos and the two packagings of the respective parties. The parties are selling ladies garments and undergarments. The scanned copies of the two sides of the packagings, also containing the trademarks with logos, of the appellant/defendant and the respondent/plaintiff are as under:-

3. Before I go into the issue of the comparison of the packagings, it is relevant to note that there is no dispute that both the parties were once carrying on business together and both the parties admit that both of them can use the trade mark "Paris Beauty" with respect to the products in question.

4. There are two-fold issues which are called for determination in the present appeal as per the arguments as raised by the parties. The first issue is of whether the wave line appearing at the bottom of the logo using the expression "Paris Beauty" can be said to be such original work so as to claim copyright in the same. Related to this aspect is the stand/case of the respondent/plaintiff that there is a dishonest adoption by the appellant/defendant of this wave line. The second aspect is with respect to issue of alleged passing off of the goods by appellant/defendant as if the goods are of the respondent/plaintiff.

5. A comparison of the packagings shows that the overall background colour scheme of the packaging of the appellant/defendant is light green, whereas it is a light brown or beige colour so far as the respondent/plaintiff is concerned. The two logos are also vastly different, leaving aside the issue of expression "Paris Beauty" which both the parties are entitled to use. The logo of the appellant/defendant prominently shows "JSR" whereas in the logo of the respondent/plaintiff the expression "Groversons" is clearly found. Whereas the slogan of the appellant/defendant is "soft comfort inner wear", the slogan of the respondent/plaintiff is "wear comfort in style". The expression "Paris Beauty" is written in a dark blue background so far as the appellant/defendant is concerned and light red/pink background so far as the respondent/plaintiff is concerned. I may lastly note that the fonts with respect to the expression "Paris Beauty" in the respective packagings are also completely different.

6. So far as the issue with respect to a copyright claim in the wave line is concerned, I may refer to Section 13 of the Copyright Act, 1957 which requires that before there is a copyright in a work, the work should be an original work. Therefore, unless the work is an original work, there cannot subsist a copyright in the work. The wave line

in question which is appearing at the bottom of the boxes of the respective parties in which the expression "Paris Beauty" is written, is not in my opinion such original work that exclusivity of copyright with respect to the same can be claimed. Such a wave line, has no originality in it inasmuch as different types of shapes and presentation of lines such as the present, cannot be said to be an "original" work as required u/s 13 of the Copyright Act, 1957 for claiming exclusivity by way of copyright in the same. Of course, there may arise an issue of passing off and dishonesty of adoption, and which aspect I would be dealing with here-in-after.

7. Even on the aspect of passing off, I feel that there cannot be passing off in the facts and circumstances of the present case. Passing off takes place when a person who has acquired goodwill with respect to a trade mark under which goods are sold, then, such person's trade mark taken with the goods is copied by another person causing passing off of the goods of the original person by the person who is said to pass off his goods as that of the original person. There is a difference between passing off action and an infringement action. Whereas the infringement action pertains only to the trade mark, in a passing off action, various aspects/factors have to be examined because passing off is qua the goods taken alongwith the trade mark and not solely qua the trade mark.

I have already reproduced the respective packagings of the parties. I have also referred to the different colour schemes, the differences in the logos, differences of the fonts and the differences of the slogans, besides the prominence of the expression "JSR" so far as the appellant/defendant is concerned and "Groversons" so far as the respondent/plaintiff is concerned. Once it is not disputed that both the parties are entitled to use the expression "Paris Beauty", then when the totality of the respective packagings are taken, including the significant differences in the logos, the indubitable conclusion which emerges is that there cannot take place passing off in the facts of the present case. Merely because the appellant/defendant is said to have adopted the wave line in a dishonest manner, cannot change the conclusion with respect to non-existence of passing off in the facts and circumstances of the present case because there are a number of differences in the two packagings and the logos, whether of the colour scheme of the packagings, whether of colour scheme of the boxes in which expression "Paris Beauty" is written, whether of the differences in the slogans or whether in the prominence of the manufacturer's initials/name, i.e. "JSR" so far as the appellant/defendant is concerned and "Groversons" so far as the respondent/plaintiff is concerned. Therefore, in my opinion, there also does not arise an issue of passing off in the facts of the present case by the appellant/defendant when it is selling its goods.

8. No other issue is urged or pressed before me.

9. In view of the above, appeal is accepted and the impugned judgment and decree is set aside. It is held that there is no copyright entitlement of respondent/plaintiff to the wave line in question and nor can it be said that there is any passing off of

goods by the appellant/defendant by representing that the goods are in fact of the respondent/plaintiff. Parties are left to bear their own costs. Appeal is allowed and disposed of accordingly.