

**(2012) 04 DEL CK 0418**

**Delhi High Court**

**Case No:** Regular First Appeal (OS) 09 of 2008

Hawkins Cookers Ltd.

APPELLANT

Vs

Murugan Enterprises

RESPONDENT

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**Date of Decision:** April 13, 2012

**Acts Referred:**

- Trade Marks Act, 1999 - Section 29, 30, 30(2)

**Citation:** (2012) 189 DLT 545 : (2012) 50 PTC 389

**Hon'ble Judges:** Siddharth Mridul, J; Pradeep Nandrajog, J

**Bench:** Division Bench

**Advocate:** Sandeep Sethi, instructed by Mr. Peeyoosh Kalra, Ms. V. Mohini, Ms. Taapsi Johri and Ms. Preeti Gupta, for the Appellant; Rahul Sharma, for the Respondent

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### **Judgement**

Pradeep Nandrajog, J.

The appellant is the registered proprietor of the trademark "HAWKINS" in respect of pressure cookers and parts thereof, including gaskets, falling under Class-21 of the erstwhile Trade and Merchandise Marks Act 1958. Who has not heard about "Hawkins Pressure Cookers" It is a well known brand. The grievance relates to the respondent, M/s. Murugan Enterprises, manufacturing and selling gaskets under the trademark "MAYUR"; but on the packaging material printing:

Suitable for :

Hawkins

Pressure Cookers.

2. Whereas the words "suitable for" and "Pressure Cookers" are printed in black colour, the word "Hawkins" is printed in red colour and thus it is apparent that the intention is that the word "Hawkins" catches the eye.

3. The appellant alleges that by so writing on the packaging material, the respondent is infringing upon its registered trademark. It is the case of the appellant that the gaskets pertaining to pressure cookers are not manufactured by the respondent for any particular brand of pressure cooker, much less Hawkins Pressure Cookers and that the gaskets of pressure cookers can fit any pressure cooker manufactured by any manufacturer, for the reason all pressure cookers have the same dimensions of the mouth and hence the lid size, the only correlation is to the capacity of a pressure cooker i.e. 1 liter, 2 liter etc. Thus, the appellant contends that the respondent cannot use the word "Hawkins", which is the trademark of the appellant, in relation to the goods gaskets, forming part of Hawkins pressure cookers for the reason it is not reasonably necessary for the respondent to indicate that the gasket manufactured by it is adaptable to the pressure cookers manufactured by the appellant.

4. The appellant has lost the battle before the learned Single Judge, who has correctly noted the law on the subject, i.e. Section 30(2)(d) of the Trade Marks Act 1999, which reads as under:-

30. Limits on effect of registered trade mark.-

(1) .....

(a) .....

(b) .....

(2) A registered trade mark is not infringed where-

(a) .....

(b) .....

(c) .....

(i) .....

(ii) .....

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;

(e) ....."

5. The grievance of the appellant is to the fact that the learned Single Judge has proceeded on the basis, that as per the evidence, gaskets manufactured by the respondent are specially made, to be fitted in Hawkins Pressure Cookers, a fact noted by the learned Single Judge in paragraph 64 of the impugned decision. As per the appellant, this is not so. The gaskets manufactured by the respondent, as also other manufacturers, are neither designed, nor are capable of being designed, to be used in any particular kind of pressure cooker, for the reason all pressure cookers are so designed that the mouth of the pressure cooker and the corresponding lid is of same dimension; the only variation being with respect to the capacity of a pressure cooker. In other words, a gasket pertaining to a 1 liter capacity pressure cooker would fit all pressure cookers manufactured by all manufacturers.

6. The law on the subject need not be culled by us with reference to the decisions rendered abroad, for the reason we have at hand a statute which deals with the subject. The same is Section 30(2)(d) of the Trade Marks Act 1999, contents whereof have noted by us in para 5 above.

7. Section 29 of the Trade Marks Act 1999 relates to the protections available to registered trademarks and thus the rights available to the proprietor of a registered trademark. Section 30 of the said Act, vide sub-section (1) thereof, clearly states that nothing in Section 29 shall be construed as preventing the use of a registered trademark by any person for the purposes of identifying goods or services, in the situations contemplated by Clause (a) and (b) of Sub-Section (1) of Section 30; provisions with which we are not concerned for the case at hand.

8. Sub-section (2) of Section 30, legislates on the subject, when a registered trademark would not be infringed, and of the various situations contemplated, vide clause (d) of sub-section (2) of Section 30, is the situation where the manufacturer of goods which form part of or are an accessory to other goods for which a trademark exists is entitled to indicate that the accessory goods are adaptable to some other goods and it is reasonably necessary to so indicate. In such a situation, reference to the registered trademark of another person would not be actionable.

9. Now, at the heart of the matter in dispute in the instant appeal is: When would it be a case of the "use of the trademark being reasonably necessary in order to indicate that the goods are so adapted?

10. The answer has to be found in the meaning of the two words "reasonably necessary".

11. Of the various meanings of the word "necessary", one meaning is "inherent in the situation". Of the various meanings of the word "reasonable" one meaning is "just".

12. Thus, the twin word "reasonably necessary" would mean that inherent in the situation it would be just; and in the context of Clause (d) of sub-section (2) of

Section 30 of the Act, it would mean that where the goods which are claimed to be adaptable to some other goods would entitle the manufacturers of the goods which are adaptable to so indicate by reference to the trademark of the other goods provided it is just to so do and this would mean that the goods claimed to be adaptable are specifically manufactured to be used as a part of the other goods alone. This will not apply where the goods are capable of adaptable use to all goods manufactured by different manufacturers to which they are adaptable. In said circumstance to indicate on the goods that they are adaptable only to the goods of only one manufacturer would be a clear violation of the trademark of the said manufacturer and Section 30 (2) (d) would not come into aid.

13. Let us illustrate. "A" manufactures pump sets, having a motor, and a pulley, through the rotation of which, the pump is made to mechanically lift water. The motor, the pulley and the pump are three separate distinct constitutive elements of the pump set. The distance between the motor and the pump is unique to the pump set manufactured by "A". "B" manufactures only pulleys. These are used by various manufacturers of pump sets, saw mills, flour mills etc. i.e. wherever electrical energy has to be converted into mechanical energy. The pulleys manufactured by "B", which are adaptable to the pump sets manufactured by "A", would obviously require "B" to so inform the consumer, and in such situation, if on the packaging material "B" were to indicate that the particular pulleys manufactured by him are adaptable to the pump sets manufactured by "A" this being the only way in which "B" can inform the buyer, no infringement of "A's trade mark would result. To simply state, if "A" was to sell his pump sets under the trademark "CHAMPION", "B" would be perfectly justified in writing or printing on the packaging material: "Suitable for champion pumps". Of course, this would be subject to the condition that "B" prominently displays his trademark and does not give undue prominence to the word "CHAMPION". But, if all the pump sets manufactured by different manufacturers have same distance between the motor and the pump and identical dimensional pulleys are used in all the pump sets, it would not be a case where "B" would be entitled to print on the packaging material that the pulley manufactured by him is suitable for a particular brand of pump sets.

14. Parties had led evidence by way of affidavit, and as per the affidavit by way of evidence filed by the witness of the appellant, in para 5 it has been specifically deposed to as under:-

5. I say that the dimension of all the lids which are inward opening are the same. Therefore the gaskets for inward opening lid pressure cooker can be interchangeably used generally for all brands of pressure cookers in the market. Similarly the gaskets of outward opening lid cooker can be interchangeably used generally for all the outward opening lid of all brands of cookers in the market irrespective of their brand.

15. In paragraph 2 of the affidavit by way of evidence filed by the witness of the respondent, it is specifically deposed to as under:-

2. I state that the defendant manufactures gaskets, which are used for different types of Pressure Cookers including the Pressure Cooker manufactured by the plaintiff. I state that defendant is a second line manufacturer manufacturing an Ancillary product to the Pressure Cooker.

16. In paragraph 64 of the impugned decision, the learned Single Judge has noted that: the defendant in the affidavit has emphasized that the gaskets manufactured by them are specifically made for them to be fitted in the Hawkins pressure cookers.

17. This finding of fact recorded is contrary to the record. The positive stand of the appellant, is as deposed to by its witness, in paragraph 5 of the affidavit by way of evidence and the categorical stand of the witness of the respondent is as per paragraph 2 of the affidavit by way of evidence filed by its witness; the contents of which two paragraphs have been noted by us in paragraphs 15 and 16 above.

18. We note that the learned Single Judge has correctly noted the law: that if in the sale it becomes reasonably necessary for the manufacturer of adaptable goods, to refer to the trademark of the relatable goods, such reference would not amount to an infringement of the trademark under which the relatable goods are sold, but has misapplied the evidence on record. The error committed is by proceeding upon the premise that the evidence establishes that the respondent manufactures gaskets specifically for the special sizes of pressure cookers manufactured by the appellant, ignoring that the evidence is to the contrary. Clarifying that the undisputed evidence brings out that gaskets pertaining to pressure cookers, irrespective of the brand or the manufacturer, are identically designed for pressure cookers of different sizes i.e. smallest gaskets for one liter pressure cookers, bigger gaskets for two liter pressure cookers and yet bigger gaskets for three liter pressure cookers and so on; and thus a gasket of a particular size would fit the lid of all pressure cookers manufactured by different manufacturers of the same relatable size, would mean that it is not reasonably necessary to indicate, for the benefit of the consumer, that the adaptable goods relate to only one particular brand of pressure cookers.

19. It also needs to be highlighted that it has escaped the attention of the learned Single Judge that while writing: "Suitable for Hawkins Pressure Cookers", the respondent has given undue prominence to the word "Hawkins" by printing it in a distinct red colour and the remaining words of the sentence are printed in black colour.

20. Clarifying that the respondent, may, if it so chooses, indicate on the packaging material of the gasket that the gasket is suitable for all pressure cookers, as is being done by other manufacturers of gaskets, evidenced by Ex.PW-2/1 (Colly.), we allow the appeal and set aside the impugned judgment and decree dated January 04, 2008 and decree the suit filed by the appellant, but limited to prayer (a) and (b) thereof.

We grant the respondent three months time to dispose of the existing packaging material containing the offending printed material and for which we direct the respondent to file an affidavit in the suit disclosing the number of plastic pouches lying with it on which the offending sentence has been written. Prayer pertaining to rendition of accounts, being not pressed, is declined.

21. Decree would be drawn in terms of prayer (a) and (b) in the suit. We leave the parties to bear their own costs all throughout.