

(2021) 11 DEL CK 0080

In the Delhi High Court

Case No : Civil Suit (COMM) No. 464 Of 2021, Miscellaneous Application No. 12323 Of 2021

Bacardi And Company Limited

APPELLANT

Vs

Bahety Overseas Private Limited & Ors

RESPONDENT

Date of Decision : 12-11-2021

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39 Rule 1, Order 39 Rule 2
Trademarks Rules, 2017 — Rule 23(2)(c), 26, 26(4)(i)
Trademarks Act, 1999 — Section 9(3), 28(1), 29, 29(1), 29(2), 29(2)(a), 29(2)(b), 29(3), 29(4), 31(1)

Citation : (2021) 11 DEL CK 0080

Hon'ble Judges : C. Hari Shankar, J

Bench : Single Bench

Advocate : Jayant Mehta, Anirudh Bakhru, Nageeb Nawab, Himanshu Deora, Raghav Vig, Tejaswini Chandrashekhar, Pranay Sarkar, Rajtilak Guha Roy, Jahangir Ahmad, Aditya Singla, Utsav Vasudeva, Sonali Sharma, Vaibhav Joshi

Judgement

C. Hari Shankar, J

1. The plaintiff is a well-known manufacturer of alcoholic beverages. It manufactures and sells rum-based beverages, mixed with various fruit essences, under the name "BREEZER".
2. The defendants also manufacture fruit-based beverages, which are, however, non-alcoholic. The defendants manufacture and clear its beverages under the mark "FREEZ Mix".
3. The plaintiff alleges that the defendants' product infringes the plaintiff's registered trademarks. The present suit, at the instance of the plaintiff, therefore, seeks an injunction against the defendants' product.
4. The suit is presently pending before this court, awaiting completion of pleadings. The defendants have neither filed any written statement in response to the plaint nor any reply to IA 12323/2021, preferred by the plaintiff under

Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC), despite lapse of the time granted therefor. Both sides were permitted to file written submissions. I may note, however, that the written submissions of the defendants, which runs into 41 pages, is actually a para-wise written statement in response to the plaint. Be that as it may, I have heard learned Counsel for the parties at length, and propose, by this judgment, to dispose of IA 12323/2021.

5. Mr. Jayant Mehta, learned Senior Counsel and Mr. Anirudh Bakhru, learned Counsel, have been heard on this application on behalf of the plaintiff. Mr. Pranay Sarkar, learned Counsel, argued on behalf of Defendants 1 and 2.

6. The plaintiff possesses registrations for the word mark "BREEZER" in Classes 32 and 33. The word mark and the shape mark, both are registered, in favour of the plaintiff, under Classes 32 and 33 of the Schedule to the Trademarks Rules, 2017. The shape of the bottle, in which the plaintiff manufactures and sells its product, has also been granted registration as a trademark.

7. Class 32 covers "beers and other non-alcoholic drinks and fruit juices, syrups and preparations for making beverages included in Class 32", whereas Class 33 relates to "carbonated beverages containing distilled spirits included in class 33". The following shape of the bottle in which the plaintiff sells its "BREEZER" product is also registered as a shape mark under Classes 32 and 33:

8. The plaintiff claims user since 27th February, 2003. The defendants do not dispute this claim.

9. The label of the plaintiff, on its bottle, has undergone a change with the passage of time, thus:

During the 2000s:

2012-2014:

After 2014:

10. The defendants applied, before the Registrar of Trade Marks, Delhi, on 19th June, 2015, for registration of the following device mark in Classes 32 and 33:

11. Registration was however, refused. It does not appear that this decision was challenged or carried further before any legal forum.

12. On 10th September, 2020, the plaintiff addressed a cease and desist notice to the defendants, alleging that the "FREEZ" mark, under which the defendants were clearing its beverages, was deceptively similar to the "BREEZER" registered mark of the plaintiff, and was creating confusion in the market. The defendants were, therefore, called upon to desist from using the allegedly infringing mark in future. The defendants vide its response dated 22nd September, 2020, denied the allegations.

13. The very next month, on 17th October, 2020, the defendants applied before the Registrar of Trademarks, Ahmedabad, for registration of the word mark

"FREEZMIX". The mark was registered, in favour of the defendants, on 22nd April, 2021, under Class 32, excluding alcoholic beverages.

14. The plaintiff alleges that the defendants, having thus obtained registration for the word mark "FREEZMIX", are using the mark in a manner which clearly infringes the plaintiff's registered "BREEZER" word mark as well as the registered shape mark of the bottle in which the plaintiff manufactures and sells its product. This has been depicted by the following comparative tabular statement, provided in the plaint:

15. The plaintiff, therefore, seeks an injunction against the use, by the defendants, of the allegedly infringing mark "FREEZ mix", to manufacture and sell its beverages, in a manner, which infringes the plaintiff's registered trademarks, and also results in passing off, by the defendants, of its product as emerging from the plaintiff's table.

Rival contentions

16. Mr. Mehta, learned Senior Counsel for the plaintiff, submitted that the manner in which the defendants had acted, in the matter of securing registration of its "FREEZMIX" mark, smacked of subterfuge and clearly lacked in bonafides. He pointed out that, having failed to secure registration of its "FREEZ" device mark, from the Registrar of Trademarks, Delhi, the defendants continued to use the infringing "FREEZ" mark and a month after receipt of the cease and desist notice from the plaintiff, applied to the Registrar of Trademarks, Ahmedabad, for registration of its "FREEZMIX" word mark.

17. The fact that the defendants chose to approach the Registrar of Trademarks, Ahmedabad, according to Mr. Mehta, was a clear attempt at camouflaging the earlier rejection of its application for registration of the "FREEZ" mark by the Registrar of Trademarks, Delhi.

18. Mr. Mehta, thereafter, sought to demonstrate the similarity between the shapes of the bottles in which the plaintiff and defendants were manufacturing and selling their products. The shape of the plaintiff's bottle, which was registered as a trade mark, he points out, had distinctive ridges on the cap and at the upper end of the bottle as well as a projection at the base, which he called a "champagne styled base". These distinctive features of the bottle in which the plaintiff sold its product, he submitted, were copied by the defendants. The defendants' bottle, he submits, is identical to the bottle in which the plaintiff was selling its product.

19. In this context, Mr. Mehta also highlighted the aspect of colour. He pointed out that the plaintiff's beverages were coloured, the colour being reflective of the flavour of the beverage. For example, the lime flavoured "BREEZER" was light green in colour, whereas the blackcurrant flavoured "BREEZER" was purple in colour etc. The plaintiff sells its product in bottles corresponding to the colour of the beverages contained therein. As against this, he pointed out that the

defendants' beverages are colourless. Even so, the defendants use bottles, relatable to the flavor of the defendants' product, using colours identical to those used by the plaintiff, for beverages with similar flavours. For example, he submits that the plaintiff's lime flavored "BREEZER" beverage and the defendants' lime flavored "FREEZ mix" beverage are in bottles of the same colour. As the defendants' beverage is colourless, he submits that, for a person viewing the bottles from outside, the appearance of the bottles is identical. This, too, he submits, is a clear attempt by the defendants to copy the trade dress used by the plaintiff.

20. Mr. Mehta further asserted that the word "BREEZER" and "FREEZ" were phonetically and visually similar. He also sought to draw attention to the similarity in the manner in which the plaintiff wrote "" and the defendants wrote "" on its product. Insofar as the "FREEZ mix" product of the defendants is concerned, Mr. Mehta submitted that the defendants had written the word "mix" in the label "" in such insignificantly small letters, when compared to the main word "FREEZ", as to be practically non-discernable to an average viewer viewing the product. The word "FREEZ", he points out, constitutes the prominent part of the label "". This, too, he submits, indicates a conscious attempt to capitalize on the plaintiff's goodwill.

21. In sum, Mr. Mehta submits that the overall presentation of the product of the defendants was consciously designed as to come "as close as possible" to the plaintiff's product, as to deceive a consumer into believing an association between the defendants' and the plaintiff's product. Such attempts, he submits, ought not to be countenanced by a court.

22. The definitive test, according to Mr. Mehta, is one of overall similarity, without placing the products side-by-side. He relies, for this purpose, on *Parle Products (P) Ltd. v. J.P. and Co. (1972) 1 SCC 618*, *Colgate Palmolive Company and Ors. v. Anchor Health and Beauty Care Pvt. Ltd. 2003 (27) PTC 478 (Del)* and *Corn Products Refining Co. v. Shangrila Food Products Ltd AIR 1960 SC 142*.

23. Mr. Mehta also disputes the defendants' claim, in its application for registration of its "FREEZ" mark, of user since 2001 and submits that the defendants' application for registration of the "FREEZ" device mark, as submitted to the Registrar of Trade Mark, Delhi, on 19th June, 2015 was on a "proposed to be used basis", whereas its application for the "FREEZ mix" word mark, as submitted to the Registrar of Trade Mark, Ahmedabad, claimed user of the mark since 7th May, 2018. The defendants had not placed on record, any material to substantiate its claim of user of the "FREEZ" mark since 2001.

24. Supplementing the submission of Mr. Mehta, Mr. Bakhru submits that the mark of the defendants was written in a manner and style which was so similar to that of the plaintiff, as could not but be result of a conscious attempt to infringe the plaintiff's mark.

25. Learned counsel for the plaintiff, therefore, submits that a clear case for an

interim injunction against use, by the defendants, of the infringing "FREEZ" and "FREEZmix" marks, is made out.

26. Responding to the submissions of Mr. Mehta and Mr. Bakhru, Mr. Pranay Sarkar, learned counsel for the defendants, initially invited my attention to Schedule II to the Trademarks Rules, 2017 ("the Trademark Rules") and Form TM-A, in which an applicant was required to apply for registration of a trade mark. He drew attention to Serial No. 5 of the column in the aforesaid Form TM-A, which, under the head "Category of mark", requires an applicant "to choose either of the following categories":

"1. Word mark (it includes one or more words, letters, numerals or anything written in standard character), 2. Device mark (it includes any label, sticker, monogram, logo or any geometrical figure other than word mark), 3. Colour (when the distinctiveness is claimed in the combination of colours with or without device), 4. Three dimensional trademark (it includes shape or packaging of goods), 4. Sound"

Mr. Sarkar points out, therefore, that the shape of the product was one of the sub-categories of mark included in the category "three dimensional trade mark". He, thereafter, adverted to Rule 23(2)(c) of the Trademark Rules, which reads thus:

"23. Form and signing of application, -

(2) An application for the registration of a trademark, for goods or services shall-

(c) be considered as a three dimensional trade mark only if the application contains a statement to that effect;"

He also referred to Rule 26(4)(i) of the Trademark Rules, which read thus:

"26. Representation of trade mark. -

(4) (i) Where an application for the registration of a trade mark consists of shape of goods or its packaging, the reproduction furnished shall consist of at least five different views of the trademark and a description by word of the trademark."

Based on the above, Mr. Sarkar submits that a shape could be registered as a trademark only under the category "three dimensional trade mark". Any application for registration of a "three dimensional trade mark" was required to contain a statement to that effect. Additionally, an application for registration of a trademark consisting of the shape of goods was required to contain a reproduction consisting of at least five different views of the trademark and a description by a word thereof. He invited my attention to the certificate of

registration of the shape of the plaintiff's bottle as a trademark, to submit that it did not satisfy these requirements.

27. That apart, Mr. Sarkar submits that the Trade Marks Act did not permit for registration of the bottle, per se, in which the plaintiff was selling its beverages, as a trademark. What was allowed to be registered, he submits, was only the shape of the bottle. Further elaborating on the aspect of the shape of the plaintiff's bottle, Mr. Sarkar submits that Section 9(3) of the Trademarks Act, proscribes registration of the shape of the plaintiff's bottle as a trademark, as it was common to the trade. In this context, Mr. Sarkar has invited my attention to the following shapes in which beverages were cleared by other manufacturers which were, according to him, similar to the shape of the plaintiff's bottle in relation to which it was claiming a monopoly:

"9. Absolute grounds for refusal of registration. -

(3) A mark shall not be registered as a trade mark if it consists exclusively of-

(a) the shape of goods which results from the nature of the goods themselves; or

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods"

28. Mr. Sarkar further draws attention to the documents filed with the plaint to point out that the plaintiff had discontinued the use of the "BREEZER" word mark in the stylized "" form after 2011, since which time the word "BREEZER" on the bottles in which the plaintiff sold its product was written in a straight line format, thus:

""

29. There is, submits Mr. Sarkar, no visual similarity between the "" logo of the plaintiff and the "" of the defendants. Neither are they, according to Mr. Sarkar, phonetically similar. He points out that the word "BREEZER" involves two syllables, "Bree" and "zer", whereas the word "FREEZ" consists of only one syllable.

30. Elaborating on the shape of the plaintiff's bottle, Mr. Sarkar submits that the plaintiff could not seek to monopolize the shape of its bottle, as it was common to the trade. He further submitted that consumers rarely associate a product, or its origin, with its shape and that it was only in combination with the label on the bottle that the bottle acquired distinctiveness. Mere similarity or resemblance between the shapes of defendants' and plaintiff's bottles, he submits, could not make out a case of infringement. In order to assert the shape of the bottle as a ground to allege infringement, Mr. Sarkar submits that the plaintiff would have to additionally establish that the shape of the plaintiff's bottle was unique and resulted in an inevitable association, in the minds of the public, between the said shape and the product of the defendants. No monopoly over use of containers in common use, he submits, could be claimed by anyone. To Mr. Mehta's contention

that, having itself applied, albeit in a foreign jurisdiction, for registration of its shape, the defendants were estopped from contending that the shape was not distinctive, Mr. Sarkar responds that the defendants had never sought registration of the shape of their bottles, but had sought registration of their overall trade dress, which included the bottle with its label. Mere shape, he submits, could never be regarded as distinctive.

31. Mr. Sarkar further submits that the plaintiff could not claim any monopoly on the colours of its bottles, as all seven primary colours were used by the plaintiff, and no one could claim exclusivity over primary colours. If the plaintiff were to be granted exclusivity over the colours of its bottle, Mr. Sarkar submits that the entire trade would be deprived of the use of all colours.

32. Mr. Sarkar further sought to submit that the label of the defendants, when compared holistically with the label of the plaintiff, was completely distinctive. He drew my attention to various features in one label, which was not present in the other, including the graphic hologram on the label of the plaintiff.

33. Mr. Sarkar further submitted that the product of the plaintiff and the defendants were different, as the plaintiff's product were alcoholic beverages whereas the defendants' products were non-alcoholic. As such, he submits that they cater to different classes of consumers and were not dispensed at common outlets.

34. He also drew attention to the differences in the labels of the products, as well as the manner in which the name of the product, i.e. "BREEZER" in the case of the plaintiff, and "FREEZ mix", in the case of the defendants, were depicted thereon. The trade dress of the plaintiff and the defendants' products are, therefore, he submits, completely different and could not be regarded as susceptible of being confused with one another. He also drew attention to the differences between the price of the plaintiff's and the defendants' products.

35. Mr. Sarkar placed reliance on the judgment of the Division Bench of this Court in *Britannia Industries Ltd. v. ITC Ltd.* 240 (2017) DLT 156, the decisions of learned Single Judges of this Court in *Luxembourg Brands S.A.R.L. v. G.M. Pens International Pvt. Ltd* 254 (2018) DLT 603, *Colgate Palmolive Co. Limited and Ors. v. Patel* 2005 (31) PTC 583 (Del) and *Relaxo Footwears Ltd. v. Aqualite India Ltd.* 2019 (80) PTC 190 (Del), the High Court of Calcutta in *LA Opala R.G. Ltd. v. Cello Plast and Ors* 2018 (76) PTC 309 (Cal), the House of Lords in *Reckitt and Colman Products Ltd v. Borden Inc.* (1990) 1 All ER 873 and of the Chancery Division of the High Court of U.K. in *Whirlpool Corporation v. Kenwood Ltd* (2008) EWHC 1930 (CH).

36. Briefly arguing in rejoinder, Mr. Mehta, while acknowledging that the plaintiff had, after 2011, discontinued the " " lettering on its label, nonetheless, contended that the plaintiff continued to retain goodwill in the said depiction which was, even till date, associated with the plaintiff's product alone.

37. Supplementing the submission of Mr. Mehta, Mr. Bakhru, responding to the reliance, of Mr. Sarkar, on the fact that the defendants' products were non-alcoholic whereas the plaintiff's were alcoholic, relied on the judgment of a learned Single Judge of this Court in *Allied Blenders and Distilleries Pvt. Ltd. v. Shree Nath Heritage Liquor Pvt. Ltd.* 211 (2014) DLT 346, to contend that, in fact, the chance of confusion was greater in the case of alcoholic beverages, as they are not widely advertised. The distinction sought to be drawn by Mr. Sarkar, therefore, according to Mr. Bakhru, would operate against the case sought to be canvassed by him, rather than in his favour.

Analysis

38. The plaintiff has alleged infringement, as well as passing off, against the defendants.

39. Infringement and passing off are distinct torts. The tort of infringement owes its origin to statute, whereas the tort of passing off owes its origin to common law. The indicia and ingredients of the statutory tort of infringement are to be found in Section 29 of the Trademarks 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."

40. Sub-sections (1) to (4) of Section 29 provide for an interesting interplay.

Each of these provisions applies to a situation in which the alleged infringer is neither the registered user of the registered trademark nor a person using the registered trademark by way of permitted use. Sub-section (1) envisages a situation in which the alleged infringer uses the registered trademark "in relation to goods or services in respect of which the trademark is registered". In other words, it applies only where the alleged infringer uses the registered trademark in respect of the very same goods or services in respect of which the trademark is registered, without due authority. The present plaintiff could, therefore, have invoked this provision against the defendants who was using the "BREEZER" mark in respect of the product of the plaintiff. That situation, quite obviously, does not apply here, as the defendants are not using the "BREEZER" mark.

41. Sub-section (4) applies only where all three clauses (a) to (c) of the said sub-section apply in tandem, as is apparent from the use of the word "and" between the clauses. Cumulative satisfaction of clauses (a) to (c) is, therefore, the *sine qua non*, for Section 29(4) to apply. The sub-section applies in a situation in which the impugned mark is identical or similar to the registered trademark, but is used in relation to goods or services which are not similar to those services in respect of which the mark is registered. In such a situation, infringement would nonetheless be found to exist where the registered trademark has a national reputation, of which the unauthorised use of the mark by the defendant takes unfair advantage. Sub-section (4) is also not applicable to the present case as the ingredients of clause (c) are not alleged nor pleaded and, moreover, the case of the plaintiff is that the product of the defendants is similar to that of the plaintiff.

42. We are left, therefore, with sub-sections (2) and (3), which are interconnected. Sub-section (3) applies to cases falling under sub-section (2)(c), where the marks and the goods and services are identical. This provision too is obviously, not applicable in the present case.

43. We are, then, left with clauses (a) and (b) of Section 29(2). Clause (a) applies where the marks of the plaintiff and the defendant are identical. That is not the case here.

44. It has, therefore, only to be seen whether a *prima facie* case is made out, by the plaintiff, of infringement by the defendants, within the province of Section 29(2)(b). Section 29(2)(b) would apply where

- (i) the defendant's mark is similar to the registered trademark of the plaintiff,
- (ii) the goods or services covered by the defendant's mark are identical or similar to the goods or services covered by the plaintiff and
- (iii) such identity or similarity is likely either
 - (a) to cause confusion on the part of the public or
 - (b) to have an association with the registered trademark of the plaintiff.

45. There is a fundamental difference between the torts of infringement and passing off. One relates to the marks whereas the other relates to the goods. They are distinct torts, the former not being dependent on the latter. An act which satisfies the indicia of infringement as specified in Section 29 of the Trademarks Act is per se tortious. Nothing else is required to be shown, to establish infringement. The similarity, while examining an allegation of infringement, is to be examined vis-a-vis the rival marks, and not the overall rival products. Even if, therefore, the overall product has certain distinctive features which reduce the possibility of market confusion, the tort of infringement would nonetheless be committed if any part of the overall getup of the plaintiff's product is separately registered as a trademark and the defendant uses a mark which is deceptively similar thereto. In such a case, infringement exists, ex facie, and the Court is not required to look at other points of distinction between the two products, which may otherwise be relevant for establishing an allegation of passing off.

46. Infringement can only be of a registered trademark. The plaintiff has two registered trademarks. One is the "shape mark", which covers the shape of the bottle in which the plaintiff purveys its product. The second is the word mark "BREEZER".

47. As has already been noted hereinabove, Mr. Sarkar advanced, on the aspect of the "shape mark" of the plaintiff, certain preliminary submissions based on the Trademark Rules which have been noted. He was candid in acknowledging that these submissions did not find reflection in the written submissions tendered by him. Nonetheless, as they have been urged and argued, they are required to be dealt with.

48. Mr. Sarkar had drawn my attention to Schedule II to the Trademark Rules and Form TM-A, particularly Serial No. 5 of the table contained in the said form, which he sought to juxtapose with Rules 23(2)(c) and 26(4)(i) of the Trademark Rules. Though his contention, as advanced, was somewhat confusing, I understand Mr. Sarkar to be intending to convey that (i) a shape could be registered as a trademark only under the category of "three dimensional trademarks" and (ii) for such registration to be permitted, the application for registration would have to contain a specific recital to the effect that the mark was a three dimensional trademark and was also required to be accompanied by at least five views of the mark.

49. The above assertion of the defendants, which is purely factual in nature, cannot be countenanced in the absence of pleadings. The defendants have, till date, not chosen to file either any written statement to the plaint or any response to the present application. The written submissions filed by the defendants, too, do not raise this issue. In the absence of any pleading, the lacunae being now sought to be alleged, by the defendants, in the plaintiff's application, for registration of its shape mark, cannot be countenanced as a ground to non-suit the plaintiff. Moreover, the defendants despite being aware of

the plaintiff's mark and its registration, have not chosen to apply for cancellation or revocation of the registration or to challenge the grant of registration to the plaintiff by any other means known to law.

50. That apart, the registration certificate granted to the plaintiff annexes, with it, three views of the plaintiff's mark, i.e., the shape of its bottle. In such a scenario, I am not inclined to non-suit the plaintiff, even in respect of its prayer for interlocutory injunction, on the ground that the application of the plaintiff for registration of its shape mark was not strictly in compliance with Rule 26 of the Trademark Rules.

51. Mr. Sarkar has sought to contend, many times over, that the plaintiff could not claim exclusivity or monopoly over the shape of its bottle. At an interlocutory stage and especially in the absence of any pleadings by the defendants, such a contention is clearly barred by Section 31(1) read with Section 28(1) of the Trademarks Act. These provisions read as under:

"28. Rights conferred by registration. -

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act."

31. Registration to be prima facie evidence of validity. -

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under section 57), the original registration of the trade mark and all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof."

Section 31(1) deems the original registration of a trademark to be prima facie evidence of the validity of the trademark in all legal proceedings. Section 28(1) grants exclusivity, to the registered proprietor of a trademark, to the use of the trademark in relation to goods or services in respect of which the mark is registered and to obtain relief in respect of infringement of the mark. Infringement, needless to say, would be as defined in Section 29 [See Para 39 (supra)].

52. The "shape mark" relating to the plaintiff's bottle, as well as its "BREEZER" word mark being registered, Section 31(1) deems it, prima facie, to be valid. The plaintiff is, therefore, prima facie entitled to exclusivity in respect of the use of both these marks. Not only have the defendants not chosen to impugn these marks before any forum by any means known to law, it has not even chosen to file a written statement in reply to the present plaint or to the present application. The plaintiff is, therefore, entitled to the benefit of the presumption which enures in its favour under Section 31(1). The shape of the plaintiff's bottle being registered as a trademark, any person using a bottle with the same shape

or even with a shape which is deceptively similar to the shape registered in the plaintiff's favour, infringes the plaintiff's registered trademark within the meaning of Section 29(2)(b) of the Trademarks Act, subject, of course, to the infringement being likely to cause confusion on the part of the public or result in the public presuming an association between the infringing mark and the registered mark of the plaintiff.

53. The contentions of the defendants, regarding the plaintiff not being entitled to claim exclusivity in respect of the shape of its bottle, cannot, therefore, be countenanced in view of Section 28(1) which statutorily confers such exclusivity on the plaintiff's registered shape mark.

54. The shape of the defendants' bottle is, as Mr. Mehta pointed out, identical to the shape of the plaintiff's bottle, to the extent that the defendants' bottle has also copied the 'champagne styled base' and the ridges and the design at the upper neck of the plaintiff's bottle. The contention, of Mr. Sarkar, that the caps on the two bottles are different and that the mechanism for opening the bottles is also different is irrelevant as the cap of the bottle is not part of the plaintiff's registered shape mark. The open bottle of the plaintiff which is registered as a shape mark is, prima facie, identical to the open bottle of the defendants. Indeed, Mr. Sarkar, too, did not refute this assertion of Mr. Mehta either during oral arguments or in his 41-page written note of submissions. The plaintiff would, therefore, be prima facie entitled to an injunction even on this ground.

55. Mr. Mehta has also asserted infringement, on the part of the defendants, of the registered "BREEZER" word mark of the plaintiff.

The defendants have obtained a registration for the mark "FREEZMIX". In examining the allegation of the plaintiff regarding infringement of its "BREEZER" word mark by the "FREEZMIX" mark of the defendants, one has to examine the two marks. Though, the word "FREEZMIX", per se, may not be phonetically similar to "BREEZER", the word "FREEZMIX" as it figures on the label of the defendants is clearly written in such a manner that the suffix "mix" is in disproportionally small letters, as compared to "FREEZ". At a plain glance, what strikes the eye is the word "FREEZ", and not the suffix "mix".

56. Section 29(2) applies where the similarity of the defendant's mark, with the registered trademark of the plaintiff is likely to cause confusion on the part of the public or is likely to have an association with the registered trademark. Though the words "on the part of the public" are to be found with the words "is likely to cause confusion", it is clear that association, as envisioned by the concluding part of Section 29(2), would also have to be on the part of the public. If, in other words, the mark of the defendants is so similar to that of the plaintiff as is likely to cause confusion in the minds of the public, or as is likely to lead the public to believe in the existence of an association with the registered mark of the plaintiff, the tort of infringement stands committed.

57. At the cost of repetition, it is important to note that Section 29(2) envisages

two distinct situations in which infringement can be said to have taken place. Infringement occurs where the defendant's mark either (i) causes confusion in the minds of the public, or (ii) leads the public to believe the existence of an association between the mark of the Defendant and the registered trademark of the plaintiff. It is not permissible while applying Section 29(2), to dovetail, into the element of "association", the element of "confusion". Expressed otherwise, if the Defendant uses its mark in such a way as to lead the public to believe the existence of association between the Defendant's and Plaintiff's mark, the tort of infringement, ipso facto stands committed - confusion or no confusion.

58. A careful vivisection of Section 29(2) reveals the following ingredients of the tort envisaged therein:

(i) Either the marks must be identical and the goods must be similar, or the goods must be similar and the marks must be identical, or the goods and the marks must both be identical.

(ii) Because of such similarity or identity, one of the following two consequences must result:

(a) there must be likelihood of confusion in the minds of the public, or

(b) the public must be likely to believe an association between the marks of the plaintiff and of the defendant.

59. The public is not privy to the certificate of registration issued by the Registrar of Trademarks, either to the plaintiff or the defendant. The public is only privy to the product and to the mark which is displayed and shown to it. Though the defendants' registration, on the Register of Trademarks, is for the word mark "FREEZMIX", what is shown to the public is the word "FREEZ" in disproportionately large letters with the suffix "mix" in such small letters that, at a plain glance, it is hardly noticed. The existence of the suffix "mix" therefore, cannot be a basis to hold that the public is not likely to be confused between the mark of the defendants and the mark of the plaintiff, or to draw an association between the two.

60. The question that then arises is whether the "BREEZER" mark of the plaintiff and the "FREEZ" mark of the defendants are confusingly or deceptively similar or likely to cause an association between the defendants and the plaintiff.

61. Mr. Sarkar has pointed out that the earlier curved lettering in which the mark "BREEZER" was depicted on the plaintiff's label, "", was discontinued in 2011 and that, thereafter, the plaintiff has only been using the straight lettering mark "". He contends that there is no visual similarity between "" (as written in straight letters) and the defendants' "" mark. Importantly, however, Mr. Sarkar has not disputed the similarity in lettering between the "" mark of the defendants and the "" mark of the plaintiff.

62. I may be inclined to agree with Mr. Sarkar's contention that, visually, the ""

mark presently being used by the plaintiff and the "" being used by the defendants are not visually similar. At the same time, the "FREEZ" mark of the defendants does bear some similarity in its letters with the earlier "" mark of the plaintiff. In fact, the manner in which the first and the last letters of the word are in larger sizes and the size decreases towards the middle of the word, resulting in a curved structure of the word, is similar to "" and "".

63. If one were to strictly analyse the possibility of confusion between the present "BREEZER" mark of the plaintiff and the "FREEZ" mark of the defendants, at a visual level, any real possibility of confusion between the two may be doubtful. At the same time, the plaintiff asserts, in para 52(a) that, goodwill in the public psyche in respect of the earlier "" mark of the plaintiff continues to remain. This assertion has not been rebutted by way of any written statement or even in the written submissions filed by the defendants and has, therefore, be regarded as uncontroverted. If, therefore, the public continues to identify the earlier "" mark with the plaintiff's product, the defendants' "FREEZ" mark being in lettering similar to the earlier "BREEZER" mark of the plaintiff, there is every likelihood of the public presuming an association between the mark of the defendants and that of the plaintiff and linking the product of the defendants with the plaintiff. Explained in alternate terms, it cannot be open to the defendants to contend that it can use a mark which is confusingly similar to the earlier mark of the plaintiff, with which the public continues to associate the plaintiff's product even after the plaintiff's mark has changed, or which would result in an association in the minds of the public between the product of the defendants and the plaintiff. The similarity in lettering between the defendants' "" mark and the erstwhile "" mark of the plaintiff, in my view, cannot be gainsaid. Given the assertion of continuing goodwill in the earlier "" mark of the plaintiff, which remains unrebutted, I am of the prima facie opinion that the use, by the defendants of its "" mark has every likelihood of creating an impression of association, in the minds of the public, between the mark of the defendants and the plaintiff's establishment.

64. Besides, Mr. Anirudh Bakhru, learned Counsel has also pointed out that, on its social media website, and on its web-pages, the plaintiff is still using the erstwhile mark "". The following copy of the webpage has been annexed with the plaint:

65. "FREEZ" and "BREEZER" are also, in my view, phonetically similar. What is required is phonetic similarity and not phonetic identity. Courts have held "Amritdhara" and "Lakshmandhara" [Amritdhara Pharmacy v. Satya Deo Gupta, AIR 1963 SC 449], "Aristoc" and "Rysta" [Aristoc Ltd v. Rysta Ltd, 62 RPC 65 (HL)] and "Gluvita" and "Glucovita" [Corn Products Refining Co. v. Shangrila Food Products Ltd, AIR 1960 SC 142] to be phonetically similar. In Aristoc [Aristoc Ltd v. Rysta Ltd, 62 RPC 65 (HL)], the "manner in which the words are pronounced in English" was held to be significant. The following principle enunciated in Aristoc [Aristoc Ltd v. Rysta Ltd, 62 RPC 65 (HL)], on the aspect of phonetic similarity,

has been cited, with approval, in several decisions, including *F. Hoffman-La Roche & Co. Ltd v. Geoffrey Manner & Co. Pvt Ltd* [(1969) 2 SCC 716]:

"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants."

When applying the test of phonetic similarity, therefore, one has to compare the marks from the point of view of a person of imperfect recollection, and not one who is familiar with the marks. Additionally, minor variations of a syllable here and a syllable there may not make a difference, if the marks are, overall, phonetically similar. Viewed thus, there can be no doubt that "BREEZ" and "FREEZ" are phonetically similar. The mere addition of the second minor syllable "er" in the former mark cannot, in my view, render the marks phonetically dissimilar, especially given the manner in which "BREEZER" is pronounced in English, with emphasis being laid on "BREEZ", "er" being, phonetically, the minor syllable.

66. As I have already observed hereinabove, the word "FREEZ mix", though registered as a single word mark, has been, *prima facie* deliberately, broken up by the defendants, into "FREEZ" and "mix" on its label, with "mix" figuring in disproportionately small letters as compared to "FREEZ". In fact, for a member of the public, unaware of the registration actually granted to the defendants, the brand of the defendants as displayed on its label, appears to be "FREEZ" and not "FREEZ mix". The suffix "mix" as used on the label, clearly conveys an impression that it has been used so as to indicate the nature of the product which otherwise goes by the name "FREEZ". Between "BREEZER" and "FREEZ", I am of the opinion that there is a considerable degree of phonetic similarity, sufficient, at any rate, to result in confusion, or association of the product of the defendants with the plaintiff, especially when seen in conjunction with the lettering used by the defendants, which is deceptively similar to the earlier lettering which the plaintiff was using for its "BREEZER" mark.

67. As the Plaintiff was also pleads similarity in overall trade dress, I also called for samples of the bottles, as sold in the market to be produced in Court. Photographs of the bottles, thus produced, may be placed on record, thus:

At a bare glance, it is apparent that

- (i) the shape of the Defendant's bottle is identical to that of the Plaintiff, in respect of which the Plaintiff has a valid and subsisting trademark registration,
- (ii) both bottles have an identical 'champagne style base',
- (iii) the neck design of the bottles is also identical, and
- (iv) the defendant has used colours on the its label, cap and the bottle identical to those used on the plaintiff's bottles.

Prima facie, therefore, the defendants have consciously attempted at adopting a trade dress so similar to that of the plaintiff as would lead an uninformed and unwary customer to justifiably presume an association between the two marks.

68. There is also substance in the contention of Mr. Mehta regarding apparent lack of bonafides on the part of the defendants. The defendants first applied before the Registrar of Trademarks, Delhi for registration of its "FREEZ" device mark. At that time, there was no "MIX" suffix. That application was filed on 19th June, 2015, and was refused by the Registrar of Trademarks, Delhi. Apparently, the refusal was never challenged by the defendants and attained finality. It was only when, despite this, the defendants continued to use the "FREEZ" mark, and the plaintiff was constrained to issue a cease and desist notice to the defendants on 10th September, 2020, that practically a month thereafter, the defendants applied for registration of its "FREEZMIX" word mark. For reasons recondite, which the defendants would have to answer, this application was preferred before the Registrar of Trademarks, Ahmedabad. Prima facie, the Court is inclined to believe that the defendants had chosen the Ahmedabad Registrar of Trademarks, as its earlier application for the registration of the "FREEZ" device mark already stood rejected by the Delhi Registry. Having thus obtained registration for its "FREEZMIX" word mark, the defendants proceeded to use the mark, on its label, in such a fashion as to imitate the lettering of the plaintiff's "BREEZER" mark and reduced the "mix" suffix to inconspicuously small letters. The entire attempt, prima facie, appears to have been to capitalise on the plaintiff's goodwill.

69. Where an attempt to confuse or deceive is discernible, the court leans in favour of finding the attempt to have been successful, rather than a failure. Dishonesty, in cases of intellectual property infringement, imperils the case of a defendant to no insubstantial extent. [Munday v. Carey (1905) 22 RPC 273 ; J.R. Parkington and Coy. Ltd. v. Frederick Robinson, Ltd. (1946) RPC 17; Midas Hygiene Industries P. Ltd. v. Sudhir Bhatia 2004 (28) PTC 121 (SC); Cadbury India Ltd. & Ors. v. Neeraj Food Products (2007) 35 PTC 95]

70. Mr. Sarkar also sought to contend that the products of the defendants and the plaintiff are distinct, the former being non-alcoholic and the latter being alcoholic. In the present day and time, it is a matter of common knowledge that the plaintiff's "BREEZER" product is often sold at normal retail outlets, which also supply non-alcoholic beverages. The nature of the goods is similar, as they are both beverages, for drinking. It is, again, a matter of common knowledge that

several manufacturers of alcoholic beverages also manufacture non-alcoholic beverages. There is no reason to believe that a connoisseur of the plaintiff's alcoholic "BREEZER" would not partake of the defendants' non-alcoholic "FREEZ mix". The triple identity test, of similarity of marks, similarity of products and availability through common sources, is also, therefore, satisfied in the present case.

71. Mr. Sarkar also sought to contend that the shape of the plaintiff's product was common to the trade. It has been held in *Phonepe Private Limited v. EZY Services* (2021) 86 PTC 437, *Bharat Biotech International Ltd. v. Optival Health Solutions Pvt. Ltd.* (2020) 269 DLT 296 and *Bigtree Entertainment Pvt. Ltd. v. D. Sharma* (2019) 77 PTC 411, that the question of whether a particular mark is common to the trade is essentially a question of fact. Once the mark is registered, at an interlocutory stage, the Court would be loath to deny the registered trademark the statutory protection against infringement which Section 28(1) of the Trademarks Act confers on it, on the ground that it is common to the trade.

72. The plaintiff, therefore, has, in my view, made out a prima facie case for grant of interlocutory injunction on the basis of infringement of its registered trademarks.

73. In view thereof, it is not necessary to enter into the aspect of passing off on which, I, therefore, do not propose to say anything further.

74. As a result, the defendants are restrained, pending disposal of the suit, from using the impugned marks, inter alia, "FREEZ", " ", " " or any mark/label/sign/device/name or domain name, which is identical with and/or deceptively or confusingly similar to the plaintiff's "BREEZER", " " or " " marks, or the plaintiff's registered shape mark, in any manner whatsoever.

75. IA 12323/2021 is allowed accordingly.