
(2000) 07 MAD CK 0094

In the Madras High Court

Case No : Original Application No's. 742 to 744 of 1999 in C.S. No. 939 of 1999

Britannia Industries Ltd.

APPELLANT

Vs

Sara Lee Bakery

RESPONDENT

Date of Decision : 14-07-2000

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2
Designs Act, 1911 — Section 47, 53

Citation : AIR 2000 Mad 497

Hon'ble Judges : M. Karpagavinayagam, J

Bench : Single Bench

Advocate : P. Chidambaram, for Kurian and Kurian, for the Appellant; Kapil Sibal for Mohan Parasaran, for the Respondent

Final Decision : Dismissed

Judgement

M. Karpagavinayagam, J.—Britannia Industries Limited having its Registered Office at Calcutta, the plaintiff herein, pending the suit in C. S. No. 939 of 1999 seeking the relief of permanent injunction, mandatory injunction, etc. has filed three applications in O.A. Nos. 742, 743 and 744 of 1999 praying for interim reliefs as against Sara Lee Bakery India Private Limited, Chennai, the defendant herein.

2. The prayer in O.A. No. 742 of 1999 is to grant interim injunction restraining the respondent/defendant from committing the acts of piracy of the applicant's registered design of its biscuits by the manufacture of the impugned product "Milk Wala" "Milk Cream Biscuits" bearing the design which is identical with or similar to the applicant's design.

3. In O.A. No. 743 of 1999 the relief sought for is for the grant of interim injunction restraining the respondent from reproducing and publishing the biscuit wrapper which is deceptively similarly or reproduction of the features of the applicant's biscuit wrapper.

4. O.A. No. 744 of 1999 relates to the prayer for grant of order of injunction restraining the respondent from manufacturing or dealing in biscuits having the shape/ design identical with or deceptively similar to the applicant's biscuit shape and passing off.

5. This Court, while ordering notice on 9-12-1999 was pleased to grant interim injunction for a limited period. On service of notice, the respondent entered appearance through his counsel and filed counter. Thereafter both the parties filed several rejoinders and reply affidavits along with the typed sets.

6. For disposal of these three applicants, the counsel for the parties were heard at length.

7. Before referring to the respective contentions raising various issues, it would be better to refer to the case of each of the parties.

8. The case of the applicant/plaintiff, in brief. Is as follows :--

"(a) The applicant is a company engaged in the business of manufacturing and marketing various food items, such as bread, biscuits, confectionary, cakes , etc. One of the products manufactured by the applicant is a biscuit by name "Milk Bikis Milk Cream" which was launched in Oct. 1996. The same is available to the customers as a pack of 100 gms and 200 gms in a distinctive wrapper. The applicant's biscuit is circular in shape with funny face on one side. The other side of the biscuit is plain. In between the two biscuits is a filling -- filled with milk cream, a round nose and the mouth in the shape of a smile with two teeth visible -- the two teeth being filled with cream. The novelty of the biscuit lies in the shape and the configuration of the face on the one side and the plain biscuit on the other side with milk cream filled in between the biscuits. The biscuit is packed in the wrapper. A navy blue background with stars, on which "the trademark "BRITANNIA" is written. The slogan :

"Eat healthy, Think Better " appears below the red pentagonal device. Below this, is the name of the Biscuit Milk Bikis in red colour with the words "Milk Cream" underneath. On the right portion of the wrapper is a funny face on the upper portion of the biscuit with the design mentioned above. In the lower portion, it is shown that the milk is being poured from a jar. Rectangular lines in yellow bordered in red surround the funny face.

(b) Since the design is novel and original, the applicant registered the said design in Class 12 of the IV Schedule of the Designs Rules on 11-4-1996 vide Design No. 171091. It has also registered its copyright in the work "Britannia Milk Bikis Milk Cream" with the copyright office and the registration number is A-55541/98. The applicant's product has been manufactured and marketed ever since Oct. 1996 and are widely known in the market, as the same was popularised through publicity by spending considerable amount.

(c) At this stage, the respondent/defendant introduced the offending product as "Milk Wala" which is similar to the product of the applicant in all respects,

namely, wrapper design and product. The offending product with wrapper is deliberately made to resemble applicant's product and wrapper and would cause the public to mistake the offending product for the applicant's product. The offending biscuit is also visually similar to that of the applicant. Thus, the act of the respondent is a piracy of the registered design and consequently, violating the registered copyright of the applicant in that the offending wrapper and passing off goods as that of the applicant/plaintiff, as the design of the biscuits and wrapper is same and similar. Hence, the suit for permanent injunction and other allied reliefs along with these applications for interim reliefs."

9. The case of the respondent/defendant is summarised as follows :--

"(a) The parent company, namely, Sara Lee Corporation is a global manufacturer and marketer of high quality brand name products for consumers throughout the world. In 1997, the parent company entered into the Indian market as part of its expansion programme. In order to deal with the business of manufacturing and marketing high quality biscuits, the parent company established Sara Lee Bakery India Private Limited. Chennai. the respondent company herein in Oct. 1997 as a wholly owned subsidiary company. They also entered into an agreement with Nutrine Group in March. 1998, thereby acquired the biscuit business of the said group. The Nutrine Group had been using the brand name "Milkawala in respect of its milk biscuits since 1986. A Trademark application has also been filed with the Trademark Registry in the year 1991 for registering the mark "Milkawala". They also obtained a copy of the legal user certificate dated 17-5-1999 recording the assignment of "Nutrine" trademark in respect of Bread, Biscuits, etc. by Nutrine confectionery in respondent's favour.

(b) The facial biscuit moulds have been common in the biscuit trade in U.S.A. and other developed countries. Since the facial moulds as well as other business are treated as novel in India, the respondent applied and obtained registration of its biscuit design on 1-4-1999 in certificate bearing 179167 in respect of its facial design. The applicant cannot claim monopoly for the particular variety of funny face or on any facial engraving on biscuits. The applicant is claiming an exclusive right in respect of an entire range of biscuits in the shape of different faces, which is not permissible under law. The wrapper of the respondent, has been prominently displaying its trademark as "Nutrine and "Milkawala". The pictorial representation of the funny face on the biscuit wrapper of the applicant is a descriptive matter. Moreover, the face in the offending design is entirely different from that of the applicant's design.

(c) Any manufacturer is entitled to launch a biscuit with a different facial expression and to represent the design on the biscuit wrappers. The applicant cannot prevent the competitors from using the descriptive words such as Milk Cream, Milk Biscuits, etc. In the same way. It cannot prevent its competitors from using other descriptive devices on the wrapper. The sign of the respondent's biscuits is entirely different from the applicant's biscuits. The differences are easily perceivable even by young customers. In fact, the

Controller of Patents and Designs has already recognized this fact and has granted a design registration certificate on 1-4-1999 in respect of the respondent's biscuits.

(d) The applicant's biscuits with wrapper and the respondent's biscuits with wrapper are visually dissimilar in all material respects. There is not even the remotest chance of any reasonable person or young customer to confuse one product for the other. Therefore, the applicant/plaintiff would not be entitled to interim reliefs, as the suit itself is an abuse of process of law."

10. Mr. P. Chidambaram, the learned senior counsel representing M/s. Kurian and Kurian, appearing for the applicant/ plaintiff, elaborately argued by referring to the various portions of the plaint, affidavits, and the documents filed by both the parties, that the applicant would be entitled to interim reliefs sought for in these applications by citing several authorities to substantiate his submission. The gist of his submission is as follows :--

"The applicant/plaintiff is the registered proprietor of the design bearing No. 171091 dated 11-4-1996 issued by the Controller General of Patents & Designs and Trademarks, the novelty being in the shape and configuration of the biscuit. By the grant of registration u/s 47 of the Designs Act, the applicant would be entitled to prevent any person from applying to any article in any class of goods in which design is registered a fraudulent imitation thereof or an obvious imitation thereof. In the present case, the respondent's biscuit bears all the essential features of the applicant's biscuit and is a fraudulent/obvious imitation. The obvious imitation is something close to the original design, resemblance to the original design being immediately apparent to the eye. Fraudulent imitation is an imitation deliberately based upon the registered design and less apparent than an obvious imitation. To determine whether two designs are identical or not, it is not necessary that the two designs should be exactly the same. The main consideration is whether the broad features of shape and the figuration are same or nearly the same. The respondent cannot raise the ground available for cancellation of a registered design u/s 51A of the Act, as he has not resorted to independent proceedings u/s 51A of the Act for cancellation of the registration. When the respondent has not taken any steps to cancel design u/s 51A, he cannot take defence that his design is new or original in the suit based on registered design. Moreover, the applicant's registration in the year 1996 being prior in point of time would be entitled to protection over the respondent's registration which was made only in 1999. Similarly the design is to be judged by the Court through the eyes of the customer. In the instant case, the customer is a child. If this Court would compare both the designs through the eyes of the children customers, then this Court would be able to conclude that the impugned design bears the overall similarity to the applicant's design and the same would be likely to mislead the person usually dealing with one to accept the other. One of the essential features of the wrapper of the applicant as well as the respondent is a funny face biscuit depicted thereon. Therefore, the wrapper is a

substantial copy of the applicant's wrapper prelected by registered copyright. Thus, the visual similarity in the design between the applicant's biscuit and the respondent's biscuit and the depiction of the funny face biscuit on the wrapper would certainly induce customers into believing that the two products emanate from the same manufacturer or have some connection with each other and thereby constitutes passing off."

11. Arguing contra. Mr. Kapil Sibal, the learned senior counsel representing Mr. Mohan Parasaran, appearing for the respondent/defendant, while countering the said submissions with equal vehemence, would contend that the design and the wrapper of the applicant and the respondent is entirely different and the visual comparison of both the design and wrapper would show striking differences between them and consequently, the question of passing off the goods as that of the applicant would not arise and thus, the applicant would not be entitled to interim reliefs. He also would cite number of authorities, which we shall see later.

12. Before dealing with the merits of the respective contentions, it is better to refer to some of the aspects which have been incidentally referred to by the counsel for parties.

13. When this Court passed an order of interim injunction in these applications on 9-12-1999, the applicant/plaintiff, as pointed out, has not brought to the notice of this Court that the respondent also has registered its design with authority concerned. When we go through the interim order, it is clear that this Court would state "it is seen from the records that the design of the applicant has been registered whereas the respondent has not registered the said design". In the plaint and affidavit, the applicant has mentioned about the registration of the design by the applicant alone. It is now brought to the notice of this Court through the counter that the respondent also has registered its design on 1-4-1999 in No. 179167.

14. The plaintiff registered the design on 11-4-1996 in Design No. 171091 in Class 12 of the IV, Schedule of the Designs Rules and the respondent/defendant has registered its design on 1-4-1999 through the Design Registration Certificate bearing No. 179167. Thus, it is clear that both the parties have registered their respective designs before the Controller General of Patents and Designs and Trademarks.

15. It is the contention of the applicant/ plaintiff that u/s 51-A of the Act. he filed an application for cancellation of the registration granted in favour of the respondent before Calcutta High Court in D.No. 204 of 2000 on 5-2-2000, whereas the respondent/defendant has not taken any steps to seek cancellation of the design registered in favour of the applicant by invoking Section 51-A of the Act and therefore, the respondent cannot take defence that the design of the applicant/plaintiff is not a new or original in the suit based on the registered design.

16. On the other hand, it is the contention urged on behalf of the respondent

that the registered design by the applicant is a previous publication of design in India and even otherwise u/s 51-A(1)(a)(iii), the applicant's design is neither new nor original, but still remain and there is no satisfactory answer from the applicant to the said plea. However, the respondent would state in the argument notes filed before this Court that the respondent is independently instituting the proceedings u/s 51-A of the Designs Act for cancellation of the applicant's registered design so as to get over the technicality posed by the applicant.

17. That apart, after hearing the arguments from the respective counsel, the matter was reserved for orders and in the meantime, the respondent/defendant has filed a separate application u/s 51-A of the Designs Act before this Court for cancellation of the applicant's design and in the said proceedings, the applicant/plainliff took notice. Thus, it is obvious that the designs of both the parties have been registered by the Controller General of Patents, Designs and Trademarks and both of them have initiated separate proceedings to cancel their respective design registration.

18. It is the contention of the respondent through the counter-affidavit dated 6-1-2000 that the applicant/plaintiff is not the author of the design and the facial biscuit moulds have been common in the biscuit trade in the U.S.A. and other developed countries and that the catalogues containing the various facial engravings /designs on biscuits have been freely available in India for many years. Along with the counter affidavit, he has also filed catalogue published by a reputed biscuit mould maker "Errebi". But. the same was denied by the plaintiff/applicant through the additional affidavit dated 31-1-2000 stating that the catalogues published by Errebi are not freely available in India and were also not available at the time the plaintiff obtained registration of their design. However, refuting this statement made by the plaintiff/applicant, the respondent through the sub rejoinder dated 8-2-2000 reiterated that the catalogues on biscuit moulds are freely available in India and to substantiate the same, he also filed letters from a few biscuit mould manufacturers in India who confirm the availability of such catalogues in India.

19. In the letter dated 7-2-2000 addressed to the respondent by one Shakthi Enterprises of Hyderabad, the said Shakthi Enterprises informed the respondent that they are competent to supply various designs contained in the ERREBI 1993 enclosed therewith. The similar Setter was addressed to the respondent by National Engineering Works also. These documents have been produced in support of the respondent's case that the facial designs on biscuits including Happy/Funny faces have been available in the global market including India for many years. Through yet another additional affidavit dated 10-2-2000 filed on behalf of the respondent, the respondent categorically stated the above fact by enclosing a letter dated 18-9-1999 received from another mould manufacturer, by name BISMALC Manufacturer, Bangalore enclosing ERREBI catalogue. In the said affidavit, it has further been stated that the biscuit moulds of Happy faces were in fact supplied by Errebi to the plaintiff/applicant and this fact was known

to them through a facsimile communication dated 9-2-2000 from ERREBI and thus, the applicant deliberately suppressed the material information that they had procured the Funny face design from none other than ERREBI, The information dated 9-2-2000 has also been enclosed along with the said additional affidavit. By way of reply, the plaintiff/applicant filed another affidavit dated 16-2-2000. He has stated that the mould supplied by M/s. Errebi was on the basis of design and drawing supplied by the plaintiff to M/s. Errebi and that design was not taken or copied from any Errebi catalogue. The applicant also produced yet another communication dated 12-2-2000 from Errebi stating that they do not have any agent or representative in India conveying their catalogues or otherwise representing them any business in India.

20. While considering the counter-affidavit, rejoinder, reply, etc. along with the various documents filed thereof. I am of the consider view that these factors relating to the correspondence between Errebi and the parties inclusive of the pendency of the 51-A proceedings initiated by both parties would not be of any relevance to decide the question posed before this Court in these applications.

21. It is the submission of the learned counsel for the applicant that the applicant is the proprietor of the funny face design and the same has been registered with authority and therefore, he would be entitled to the protection under the Designs Act against the respondent/defendant though he had also registered the design belatedly.

22. On the other hand, it is contended by the respondent/defendant that the design of the biscuit which has been registered by the respondent with authority is entirely different and distinct from the design of the applicant and more so, when the design of the respondent has been registered, he would also be entitled to the similar protection in respect of the design registered by him.

23. The very same argument has been advanced in respect of the wrapper also. Therefore, Instead of going into the contention regarding the pendency of the 51-A proceedings and the question regarding the engagement of Errebies with reference to the moulding of the design, it would be more appropriate to consider the question which is raised in this case as to whether the design and wrapper of the respondent/defendant are Identical with or similar to that of the applicant/plaintiff, as the answer for this question alone which has arisen in these applications, would solve the situation.

24. The plaintiffs case is mainly based on the design registration of the funny face biscuit. The other two claims are under the Copyright Act and Common Law. namely infringement.

25. The test of infringement under the Designs Act is "fraudulent obvious imitation," Under the copyright law, it is "reproduction of work or substantial part thereof." in passing off action, the test is "deceptive similarity."

26. Let us now take the infringement under the Designs Act.

27. According to the applicant, the respondent's design in respect of its biscuits is similar if not almost identical to the biscuits manufactured by the applicant.

28. For succeeding on its plea on design infringement the applicant will have to establish imitation by the respondent of the applicant's facial design and such imitation should be either fraudulent or obvious but an Imitation all the same.

29. According to the applicant, the design applied by the respondent need not be an exact replica of the applicant's design. but there shall be an element of Imitation of design, which is obvious in the present case.

30. On the contrary, the respondent would state that there is no imitation fraudulent or obvious and much less any similarity between the facial designs of the two biscuits.

31. So, the question which arises, at this stage, is. how to compare both the designs in order to find out whether there is any similarity or imitation. With regard to this aspect. there are various decisions cited by both.

32. Before dealing with the same it is worthwhile to refer to the statutory provisions relevant to an action based on a registered design. The word "design" has been defined in Section 2(5) of the Designs Act.

"2(5). "Design" means only the features of shape, configuration, pattern or ornament applied to any article by any Industrial process or means, whether manual, mechanical or chemical separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as denned in Clause (v) of Sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958, or property mark as defined in Section 479 of the Indian Penal Code."

33. The operative words areshape, configuration, pattern or ornament. These are not protected in the abstract but must be applied to an article. For the protection of a design any person claiming to be the proprietor of any new or original design not previously published in India may apply to the Controller General of Patents, Designs and Trade Marks for registration of the design.

34. u/s 43 of theAct, when a design is registered the date of the application for registration is taken as the date of registration. Once a design is registered a certificate of registration is granted to the proprietor of the design by the Controller. u/s 47, every registered design has a copyright in the design during 5 years from the date of the Registration which may be extended for further consecutive period of 5 years.

35. u/s 2(4), the copyright is defined as it means the exclusive right to apply a design to any article in any class in which the design is registered. As per Section 14(c), "proprietor of a new or original design" means the author of the design, and where the property in or the right to apply the design has devolved from the

original proprietor upon any other person, includes that other person.

36. In Section 51-A, registration of a design may be cancelled on specified grounds including the ground that the design is not a new or original design. Section 53 deals with the piracy of registered design. Section 53 provides thus :--

"53 (1). During the existence of copyright in any design it shall not be lawful for any person --

(a) for the purpose of sale to apply or cause to be applied to any article in any class of goods in which the design is registered, the design or any fraudulent or obvious imitation, except with the licence or written consent of the registered proprietor, or to do any thing with a view to enable the design to be so applied."

37. There shall be sufficient resemblance between the infringing design and the plaintiffs registered design to be found an action for infringement u/s 53 of the Act. It is not every resemblance in respect of the same article which would be actionable at the instance of the registered proprietor of the design. The copy must be a fraudulent or obvious imitation. The word "imitation" does not mean "duplication" in the sense that the copy complained of need not be an exact replica. Therefore, the Court is required to see in particular as to whether the essential part of the base of the applicant's claim for novelty in the design form part of the infringing design.

38. The task of the Court is to Judge the similarity or difference through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser. In judging the articles solely by the eye the Court shall see whether the infringing design is an obvious or a fraudulent Imitation.

39. "Obvious imitation" means something which strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. In other words, an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.

40. "Fraudulent imitation" which is based upon the registered design is, an imitation which may be less apparent than an obvious imitation. The fraudulent imitation, although is different in some respects from the original, and in other respects which render it not obviously an imitation may yet be an imitation perceptible when the two designs are closely scanned.

41. One of the tests to find out the identity or sameness of the design is to find whether there are substantial differences between the design subsequently registered and the design which was earlier registered. These differences cannot be based on purely subjective or utilitarian or aesthetic considerations. The differences must be objective in its essential features. A general view of the features of both the designs should be looked into to find out if the one design is as good as the other, and the conclusion is to be arrived at by visual examination

of the two things. Similarity of device in external appearance may be a relevant factor in considering the substantial differences between the two but is certainly not a determining factor.

42. Looking at the definition of the "design", infringement of the design applied to an article is to be judged solely by the "eye". The "design" does not include any mode or principle of construction or anything which is in substance a mere mechanical device. Therefore, all that is required to be seen in an action for infringement of design is the "sameness" of the features of shape, configuration, pattern etc.

43. For determining whether two designs are identical or not, it is necessary that the two designs should be exactly the same. The main consideration to be applied is whether the broad features of shape, configuration, pattern etc. are same or nearly the same and if they are substantially the same, then it is the case of imitation of the design of one by the other.

44. In a case where the registered design is made up of a pattern which has no striking feature in it, but it appeals to the eye as a whole, it may be that another design may be an imitation of it which makes the same appeal to the eye, but if a design has in it a striking feature which catches and holds the eye, and which is the one thing that strikes the eye when one looks at the design which otherwise may be like a registered design but which eliminates the striking feature or alters it so that it is not recognisable, in such a case it is impossible to say that one is the imitation of the other.

45. To establish the infringement where the shape or configuration of the whole of the article is the essence of the design, there shall be shown to be something reasonably approaching to identity.

46. These are all the guidelines given by the various Courts in the following authorities with reference to the comparison of the similarities found in the designs :--

- (1) Caslrol India Ltd. v. Tide Water Oil Co. (I) Ltd. 1996 PTC (16) 202 (Cal);
- (2) Wall pa per Manufacturers, Ltd. v. Deny Paper Staining Company 1924 (42) RPC 443;
- (3) Sherwood and Cotton v. Decorative Art Tile Co. 1887 (4) RPC 207;
- (4) Dunlop Rubber Co. Ltd. v. Golf Ball. Developments Ltd. (1931) (48) RPC 268;
- (5) Altert India v. Naveen Plastics 1997 PTC (17) 15;
- (6) Western Engineering Co. Vs. Paul Engineering Co., ;
- (7) Mount Mettur Pharmaceuticals (P.) Ltd. Vs. A. Wander, ;
- (8) Sommer Allibert (U.K.) Ltd. v. Flair Plastics Limited 1987 RPC 599;

(9) Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, ..

47. In the light of the above guidelines, let us now compare the design on the biscuits of the parties.

48. According to the plaintiff, the defendant's design in respect of its biscuits is similar if not almost identical to the biscuits manufactured by it. According to the defendant, the plaintiff is not entitled to monopoly under the Design Act in respect of entire class of facially engraved biscuits but he would be entitled to the monopoly only in respect of the features of shape, configuration and pattern or ornaments applied to biscuits.

49. In the light of the above submissions, we have to see that the features of the shape and configuration of the biscuits of the plaintiff have been copied by the defendant, as their registration of the design not in respect of the entire class of facially engraved biscuits.

50. In the instant case, if we look at the differences between the plaintiff's design and defendant's design on the biscuit with eye of the children customer, it cannot be said that the features in the biscuit are substantially similar. Though some of the differences are superficial. I find that there are various substantial differences which make the design of the defendant indicating that it is not an imitation of the plaintiff's design.

51. Some of the substantial differences are as follows :--

(1) in the plaintiff's biscuit, there are two prominent eye brows on a very little forehead. In the defendant's biscuit, there is a forehead covered by a dotted pirate's cap.

(2) There are two round eyes in the plaintiff's design. In the defendant's design, only left eye is visible and the right eye is closed by a patch attached to a string running right across the forehead.

(3) The nose found in the plaintiff's design is a protruding one with a protruding circle around it. But, in the defendant's design, the nose is bulbous with a depression around it.

(4) in the plaintiff's design, the mouth is open with two white teeth. But, in the defendant's design, there is a very big smile without protruding teeth.

(5) in the plaintiff's design, the chin portion shows the protruding line running in a semi-circular fashion from one cheek to the other through the lower chin. But, this is absent in the defendant's design.

(6) Space available between the mouth and the lower chin in plaintiff's design is large. But, there is little space below the mouth and the lower chin in the defendant's design.

52. In this context, it would be worthwhile to refer to the decision, wherein it is held that the children are not likely to be deceived in the matter of purchase and

article like biscuits for their own consumption out of their pocket money 1998 (15) RPC 141.

53. The relevant observation in the above decision is given below :--

"The class of customers who buy are, according to the evidence, chiefly children, working men. domestic servants, and those who have not every facility for making home made lemonade from the lemons. A good deal of argument was addressed to me as to whether that class of customers was, or was not, more likely to be deceived than the more educated class. I am satisfied not only by the evidence, but from my own knowledge of the world -- and I cannot shut out my knowledge of certain classes of people-- that, with reference to some articles, children are less likely to be deceived than grown up people are in a matter of this description. If they are going to purchase an article for their own consumption out of their pocket money, or the pennies, which are not too frequent with them possibly, they are careful to get that which they intend to get. I think it is quite possible that a child would be less careful being sent to buy some articles of domestic use than he would if going to buy something for his own consumption."

54. The above observation, in my opinion, would squarely apply to the present facts of the case. As mentioned above, if I look at both the designs in the eye of the customer, namely, children, it is clear that the main features in both the biscuits are not substantially same. Therefore, I am inclined to hold that there is no infringement by the respondent/defendant in respect of the Design Act.

55. Let us now deal with the claim by the applicant/plaintiff in respect of the wrapper under the Copyright Act.

56. According to the applicant, he registered his copyright in the work "Britannia Milk Bikis Milk Cream 100g" with the Copyright Office and the registration number of the copyright is A-55541/98. A copy of the extract from the Registrar of Copyrights along with the artistic work made in the wrapper duly certified by the copyright office has been produced before this Court is Document No. 3. The offending wrapper of the respondent "Milk Wala" "Milk Cream Biscuits" is deceptively similar to the applicant's wrapper. The packing of the offending wrapper is deliberately made to resemble the applicant's wrapper and would in fact cause the public to mistake the offending product for the applicant's product. The offending wrapper has been produced as Document No. 9 and the applicant's wrapper has been produced as Document No. 4. The respondent has violated the registered copyright of the applicant, since the offending wrapper is deceptively similar to that of the applicant. The respondent has also adopted a very similar colour scheme to that of the applicant's wrapper. One of the essential features of the wrapper of the applicant and the respondent is the funny face biscuits depicted thereon. As such , the offending wrapper is a substantial copy of the applicant's wrapper protected by the Copyright Act.

57. According to the respondent, the visual comparison of the wrapper of the

applicant and the respondent would show only difference and no similarities and even if it is granted that the particular funny face design is depicted on the applicant's wrapper, it is a distinguishing feature, and the respondent's wrapper is entirely different from that of the applicant and the same would not lead to confusion among the consumers. The counsel for the respondent also would point out that it has been conceded by the counsel for the applicant during the course of argument that it is only affected by depiction of facial design of the respondent on its wrapper and not by colour scheme or get up of the wrapper.

58. On considering the submissions by both, it is clear that the claim in respect of the Copyright Act by the applicant, in respect entirely rests on its design claim. A similar meticulous description of the respondent's wrapper would disapprove the applicant's claim of similarity between these products. On comparison, if viewed as a whole, the wrappers will not deceive or cause confusion in the minds of the customers as to the source of the manufacture in respect of these products. In other words, a visual comparison of the applicant's wrapper and the respondent's wrapper will lead to the conclusion that they are totally dissimilar in material respects.

59. The following are the material differences between the two wrappers :--

1) in the wrapper of the applicant, we find Navy Blue background with numerous white stars of varying sizes, but in the respondents wrapper, the background is white with light blue swells.

(2) On the left side of the applicant's wrapper, there is a device of a white flag having a flutter along with a red pentagonal device comprising rectilinear sides and outwardly curvaceous upper arm appearing within. The applicant's trade mark "Britannia" appears in white thick lettering with a green leaf superimposed upon red pentagonal device. The slogan "Eat Healthy Think Better" appears below the red pentagonal device. Below the slogan is the expression "Milk Biks" in red colour and below the expression "Milk Biks" it is written as "Milk Cream" in blue colour against white background. The expression "Nourishing Milk Cream Biscuits" is displayed in white lettering on a blue strip immediately below the expression "Milk Cream". Inside the semi circle is a cowherd milking a cow in a natural scenery.

On the left side of the wrapper of the respondent, there is a red arch with a semi circular blue strip beneath it. The respondent's trade "Milkwala" is printed in white thick lettering upon the red arch strip. The expression "Milk Cream Biscuits" is found in yellow colour upon the blue semi-circular strip. The two dimensional depiction of the respondent's product, namely, Pirate faced biscuits in a reclined position and partly immersed in milk.

(3) On the right side of the wrapper of the applicant, a funny face on the upper portion of the Biscuit is found standing vertical to the lower portion of the Biscuit into which milk is being poured from a jar, rectangular lines in yellow bordered in red surround the funny face. Above the facial depiction, the respondent's

trademark "Nutrine Biscuits" is clearly written. The word "Nutrine" appear -ingin white lettering is on a red background and the word "biscuits" appearing in red lettering is on a white background.

(4) On the reverse of the applicant's wrapper, the nutritional information has been set up. This is absent in the respondent's wrapper. On the applicant's wrapper, the name and address of the applicant have been disclosed in clean letters. On the respondent's wrapper, the respondent's name and address have been disclosed in clean letters.

60. The above material differences would clearly show that the various features found in these two wrappers are different.

61. One of the safest test as laid down by the Supreme Court in R.G. Anand Vs. Delux Films and Others, to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original.

62. It is also held in the above decision, where apart from the similarities and coincidences appearing in the two works which are incidental, there are also material and broad dissimilarities which would negative the intention to copy the original, no infringement of the copyright comes into existence.

63. If the above test is applied in the present case, it is clear, on comparison, that it cannot be contended that the offending wrapper appears to be the copy of the applicant's wrapper. Hence, there is no infringement in respect of the Copyright Act also.

64. We will next deal with the question relating to the Passing Off.

65. As we have considered the earlier two points in detail and come to the conclusion that both are not similar, the same reasoning would apply to this point too.

66. It is the contention of the plaintiff/ applicant that the respondent is passing off his gauds as that of the applicant and the sale of the offending biscuit is causing and is likely to cause the public to associate the same with the applicant. It is also the case of the plaintiff/applicant that the comparative study of the two products would lead to an irresistible conclusion that the offending product marketed by the defendant/respondent is deliberately made to look like that of the applicant and the common man would be led to believe that the product of the same and thereby, the respondent has indulged in the dishonest action with a view to take dishonest benefit of the goodwill and reputation attaching to the applicant's product.

67. On the other hand, it is the case of the respondent that the respondent is a highly reputed multi-national company which is only seeking to build up own name by fair means and that any attempted passing off of the goods as that of

the applicant will be detrimental to the respondent itself and not to the applicant. It's further case is that the respondent had sufficiently distinguished its product from the applicant's product, as the respondent's product is substantially dissimilar from the applicant's product.

68. As detailed above, the applicant has conspicuously displayed its trademark "Britannia" on the wrapper of its biscuit. Similarly, the respondent has been prominently displaying its trademark "Nutrine" and "Milkwala" on the wrappers of its biscuits. The pictorial representation of the "funny face" on the biscuit wrapper by the applicant is a descriptive matter, which is aimed at informing the consumer as to what is contained inside. Similarly, the other manufacturer also is entitled to launch a biscuit with a different facial expression and to represent the design on the biscuit wrappers. Therefore, the applicant cannot seek to appropriate the entire range of biscuits in respect of all the facial engravings and prevent other manufacturers from competing with it by manufacturing biscuits in the class and to make proper representation by showing the distinguished features regarding their goods on the wrappers. The features contained in the design and wrapper in both the products are entirely different and the differences are easily perceivable even by young consumers. As pointed out by the learned counsel for the respondent, the name "Milkwala" and "Nutrine" are the main distinguished features of the respondent's product apart from the device of a man milking a cow.

69. It is well settled that any person who is entitled to make or sell an article may tell the public what article it is that he makes or sells, may employ the terminology of the trade, or may sell it under the name which the article bears in the market, provided he does nothing to represent his goods to be of the manufacture or selection of some other person.

70. The two dimensional representation of the design biscuits are bona fide made by the respondent in order to Inform the consumer as to what is contained Inside. In view of the similarities pointed out above, it cannot be claimed that the product of the respondent is deliberately made to look like that of the applicant. Even as regards the phonetic similarity, the applicant's product is called "Britannia Milk bikis Milk Cream", whereas the respondent's product is known as "Nutrine Milkwala Milk Cream Biscuits". Therefore, in view of the apparent dissimilarity, it cannot be said that the shop keepers and customers will mistake one product for the other.

71. As mentioned above, the consumers, especially children have been making conscious choice according to their taste, from amongst various brands. It shall also be noticed, at this juncture, that the biscuit is packed in the package and package wrapper is with a distinguished feature. In the light of the fact situation, it cannot be contended that the respondent is trying to pass off its goods as that of the applicant nor is there any possibility of the public mixing up one product for the other.

72. The grant of an interlocutory injunction during the pendency of legal proceedings is a matter requiring the exercise of discretion of the Court. Under Order 39 of the Code of Civil Procedure, jurisdiction of the Court to grant the order of temporary injunction or to Interfere with an order of interlocutory injunction is purely equitable.

73. While exercising the discretion, the Court applies the following tests :--

- (1) Whether the plaintiff/applicant has a prima facie case;
- (2) Whether the balance of convenience is in favour of the plaintiff/applicant;
- (3) Whether the plaintiff/applicant would suffer an irreparable injury if his prayer for interlocutory injunction is disallowed.

74. The object of the interlocutory injunction is to protect the plaintiff against injury by violation of his right for which he could not be adequately compensated in damages recoverable in the action if the uncertain ties were resolved in his favour at the trial. However, the need for such protection has to be weighed against the corresponding need of the respondent/defendant to be protected against injury resulting from his having been prevented from exercising his own legal rights for which he could not be adequately compensated. In other words, the Court must weigh one need against another and determine where the "balance of convenience" lies.

75. These are the principles laid down in M/s. Gujarat Bottling Co. Ltd. and others Vs. Coca Cola Company and others, .

76. It is also well settled that an interlocutory injunction will not normally be granted where damages will provide an adequate remedy, if the claim succeeds ultimately. Furthermore, the Court will not grant an interlocutory injunction unless satisfied that there is a real probability of the plaintiff succeeding on the trial of the suit.

77. Applying these principles to the present case, it appears to me that the grant of an injunction would be to cut off for good the road to commercial success of a business competitor, especially when I am not able to see the situation where the plaintiff would certainly succeed in the trial. Even in the event of the plaintiffs success, damages will be an adequate remedy. The balance of convenience lies in favour of refusing the interlocutory relief that is sought. The granting or withdrawing of interlocutory relief would depend upon the ability of either party adequately to be compensated in monetary terms and ultimately, on the balance of convenience.

78. The plaintiff's claim is that his company is reputed and very well known in the market. Equally, the respondent also would claim that he is a global manufacturer and marketer of high quality of brand name products throughout the world. Therefore, the defendant's ability to pay damages in the event of a decree in favour of the plaintiff is also a factor which tilts the scales against the

plaintiff/applicant.

79. In short, I am not able to accept the argument of the learned senior counsel appearing for the plaintiff/applicant that the design and the wrapper are similar though not identical, as there is no prima facie case made out to establish the same. In view of above finding, I am constrained to hold that a case for grant of interim injunction sought for by the applicant is not made out. particularly when the balance of convenience is only in favour of the respondent.

80. In the result, the applications seeking for the interim reliefs are dismissed. However. I make it clear that the observations made in this order are confined only for the purpose of disposal of these interim applications and that they do not affect the merits of the respective contentions during the course of trial in the suit.

81. After pronouncement of the order, Mr. Kurian. the learned counsel appearing for the applicant/plaintiff would submit that the applicant/plain tiff has been all along enjoying the order of interim injunction and since by virtue of the order of this Court, the interim injunction has been vacated and as they Intend to file an appeal before the Appellate Court, it may be appropriate for this Court to suspend the above order for a limited period so that the applicant/plaintiff may be able to get the interim relief before the Appellate Court. However, the learned counsel appearing for the respondent/defendant opposed the said request.

82. In view of the circumstances shown by the learned counsel for the applicant/plaintiff, I deem it proper to suspend the order for a period of two weeks from today to enable the applicant/plaintiff to approach the Appellate forum. Accordingly ordered.