

(2005) 10 DEL CK 0084

In the Delhi High Court

Case No : IA 3412 and 4489/03 in CS (OS) No. 672/03

Colgate Palmolive Co. Limited and Another

APPELLANT

Vs

Mr. Patel and Another

RESPONDENT

Date of Decision : 06-10-2005

Acts Referred:

Constitution of India, 1950 — Article 141

Trade and Merchandise Marks Act, 1958 — Section 10, 10(1), 17, 18(4), 19

Trade Marks Act, 1999 — Section 10, 100, 159(1), 159(2), 159(4)

Citation : (2005) 31 PTC 583

Hon'ble Judges : Mukul Mudgal, J

Bench : Single Bench

Advocate : Sudhir Chandra, Praveen Anand and Binny Kalra, for the Appellant; Parag Tripathi and Pratibha M. Singh, for the Respondent

Judgement

Mukul Mudgal, J.—A chromatic monopoly in respect of red and white colours claimed by the plaintiff by virtue of the registration of its mark is the issue which arises in this application for interim relief which affects not only the large tooth paste market in India in particular but also the issue of exclusive rights to a particular colour scheme generally.

2. The plaintiff No. 1 Colgate Palmolive Co. Ltd. and plaintiff No. 2 Colgate-Palmolive (India) Limited have filed the present suit for permanent injunction restraining infringement of trade mark and copyright, passing off, unfair competition, damages, rendition of accounts against the defendant No. 1, Director of Ajanta India Limited, and defendant No. 2, Ajanta India Limited.

3. The plaintiffs have averred that they are an undoubted international market leader in the tooth paste trade and the plaintiff No. 2 is manufacturing and marketing Colgate toothpaste in India since 1937. The core issue enumerated above arises in view of the fact that the plaintiffs had always marketed their product with the red carton and the word COLGATE was inscribed on the said red carton in white colour and the other small print on the carton was also in white

colour. The word COLGATE has been inscribed in a particular font. The mark of the plaintiffs is registered in India since 1954. It is not in dispute that the plaintiffs are not only the market leader internationally but are market leader in this country also. For ready reference the registered mark of the plaintiffs, along with the details of registration certificate is reproduced as under:

4. The gravamen of the grievance raised by the plaintiffs is that in order to encash the popularity and goodwill of the plaintiff's product achieved by dint of hard work and consistent excellence of its product over a prolonged period of time, the defendants have sought to market a product in a red carton with letters in white colour so as to imitate the plaintiff's product and its carton in order to unfairly ride on the bandwagon of success and fame of the plaintiff's product.

5. The averments of the plaintiffs are as follows:

(a) That they are the proprietors of the well-known trademark "COLGATE" and the plaintiff No. 2 has been manufacturing and marketing dental products in India under the said trademark in the packaging bearing a distinctive get-up and colour scheme comprising a red background and its trademark "COLGATE" in white. The registration of the plaintiff No. 1's trademark vide trademark registration No. 167064 in India is since 15th December, 1954 that of the mark registered vide trademark registration No. 319139 is in India since 1st October, 1976 and that of the label mark limited to colours red and white vide trademark registration No. 190279 is in India since 12th May, 1959.

(b) By virtue of priority in adoption, extensive and continuous use, promotion and publicity of the distinctive get up and red and white colour scheme in respect of their dental products, the said get up and the red and white colour scheme has attained immense reputation and goodwill and acquired a secondary significance as indicative of the trade origin of the plaintiff's dental products. The consumers instantaneously associate the said red and white colour scheme with the plaintiff's dental products and purchase these products often by referring only to the get up by which they are innately familiar. The get up and the colour scheme has acquired a prominent place in the personal toiletries of a large majority of Indian households.

(c) From time to time the plaintiffs have also amended the get up of cartons of Colgate dental cream so as to add a swirl or Pincer device and a touch of yellow in the left corner of the panels of the carton. However, the red and white colour combination has been retained in all such amended versions of the plaintiff's cartons. The colour combination of the plaintiff's carton and the overall get-up has an inherent distinctiveness and has retained a recognizable uniformity and constitutes a trade dress in relation to plaintiff's product for over a period of 70 years of continuous and extensive use. The plaintiffs have thus acquired common law rights in addition to the undisturbed and exclusive trade mark rights.

(d) In February 2003, the plaintiffs came to know that the defendants in their carton and packagings have misappropriated the plaintiff's "COLGATE" dental

cream trade dress in terms of lay out, get up and colour combination.

(e) The defendant's product is obviously inspired by the distinctive trade dress and reputation of the plaintiff's Colgate Dental cream packaging. The defendant No. 2 being a new entrant in the field is undoubtedly familiar with the plaintiff's product and their trade dress and has consciously chosen to copy the same from the most significant to the most minor details. The following significant features have been copied from the plaintiff's packaging:

(i) The primary colour combination of red and white.

(ii) The representation of the trademark in white against a predominantly red background.

(iii) The use of the swirl device.

(iv) The eye-catching placement of yellow and blue splashes.

(v) The placement of prominent features such as yellow promo stickers and USPs in bold white with dark outlines.

6. According to the plaintiffs, the following rights of the plaintiffs are violated:

(i) TRADE MARK RIGHTS

The registration of label mark under No. 190279 in class 3 limited to the colours red and white and registration No. 319139 pertaining to COLGATE Dental Cream red and white label, vests statutory trademark rights in the plaintiffs, which the defendants have infringed by adopting a visually and structurally similar label.

(ii) COPYRIGHT

The defendant's imitation of plaintiff's product's get up and red and white colour scheme is infringement of the copyright of the plaintiffs in the artistic work.

(iii) COMMON LAW RIGHTS

Adoption of an identical get up and colour scheme by the defendants is vocative of the common law rights of the plaintiffs as it would lead to deception because the consumers would be led to believe that the defendant's products actually emanate from the plaintiffs as the products are identical and sold through identical trade channels to the same class of consumers.

(iv) UNFAIR COMPETITION

The defendants, by copying the get up and the colour scheme similar to that of the plaintiffs, have surpassed norms of honesty and fair trade practices, which will lead to unfair competition as the defendants will ride on the success and reputation of the plaintiffs.

(v) DILUTION

The use of deceptively similar trade dress by the defendants with respect to their products will lead to dilution, erosion and whittling away of the selling power, distinctive quality and value of the established trade dress of the plaintiffs.

7. Since the plaintiff's Colgate Dental Cream trade dress has a high degree of inherent distinctiveness by its extensive use over a long period of time over a wide geographical area, the plaintiffs are entitled to protection against its violation by the defendants by adopting the impugned trade dress which will result in diminishing the reputation and goodwill attached to the plaintiff's trade dress and cause a reduction in the strong identification value thereof. Consequently, the plaintiffs have prayed for permanent injunction inter alia restraining the defendants from manufacturing, selling or offering for sale etc. the toothpaste, dental cream or any cognate product in red and white carton or any other packaging deceptively similar to plaintiff No. 1's Colgate Dental Cream label amounting to infringement of the registered trade mark Nos. 190279 and 319139. The prayer for rendition of account was also made, Damages to the tune of Rs. 5,00,000/- were also claimed.

8. The pleas advanced by Shri Sudhir Chandra, the learned senior counsel for the plaintiffs assisted by Shri Pravin Anand during the hearing of this interim application can be summarized as follows:

(a) Firstly, a claim has been made by the plaintiffs for infringement by the defendants by virtue of registration of trade mark "COLGATE" vide registered trade mark No. 190279 in white colour on a red coloured background in its favor. Once the essential feature of the registered trademark i.e. the same colour scheme is adopted by the defendants, so far as the registered trade mark is concerned, no further burden lies on the plaintiff to prove that the similarity is also deceptive in nature.

(b) Secondly, qua the deception contended by the plaintiffs de hors its plea in respect of infringement, the defendants have in any event resorted to passing off their product as that is akin and similar to the plaintiff's product so as to cause a confusion and deception in the market place persuading the unwitting prospective customers into buying the defendant's product under the mistaken belief that the product belongs to the plaintiffs. The red colour of the carton, the white fonts and the distinctive manner of their depiction by the plaintiffs have been adopted dishonestly by the defendants so as to ride on the bandwagon of the success of the plaintiff's product.

This in sum and substance is the essence of the case of the plaintiffs set up and urged against the defendants in this interim relief application.

9. In the written statement and the pleas advanced by the defendants through their senior counsel Shri Parag Tripathi assisted by Ms. Pratibha M. Singh, it has been inter alia urged as follows:

(a) The plaintiffs have been avoiding the healthy competition offered by the

defendants by indigenous efforts to make available by the defendants the standard quality goods at an affordable price. Since the defendants have made available standard quality goods at much lesser price than the plaintiffs, this has instigated the plaintiffs, which are a large multi-national, to bring an action against the defendants inspired by being fully conscious of the fact that they have no case in facts as well as in law.

(b) "Red" and "white" are basic colours and their use is common to the trade which cannot be monopolized by any of the parties.

(c) The defendant's product is sold under the trade mark "AJANTA" and enjoys immense reputation and goodwill all over the world and there cannot be any deception by selling goods under the name of "AJANTA" when the plaintiff's mark is "COLGATE" which is totally different both phonetically and visually.

(d) No rights can be claimed against the basic colours such as red and white. In any event the artistic work used by the defendants is different from that of the plaintiffs, and enjoys its own reputation and goodwill.

(e) The addition of various features to get up and design from time to time cannot give the plaintiffs any particular right to any particular artistic design.

(f) The defendants are using red and yellow as prominent colour. Apart from the colour scheme, the get up of two cartons is different and an entirely different trade mark has been prominently used and printed by both the parties.

(g) The trade marks "AJANTA" and "COLGATE" are phonetically and structurally different from each other and there cannot be any deception or confusion as alleged in the plaint. The colour combination of red and white due to usage has become common to the tooth paste trade and cannot be owned by any particular business concern. The pleas of dilution, ownership or copyright have also been denied.

(h) That a large part of the plaintiff's pleas are based not on the registered mark which was the document annexed with the plaint but on subsequent modifications and alterations of the plaintiff's registered mark. In so far as the registration and its effect leading to the claim of infringement is concerned it can only be on the basis of the registered mark.

10. The plaintiffs' plea with respect to infringement and passing off is being considered in the light of trademarks registered vide trademark registration No. 190279 dated 12th May, 1959 and trademark registration No. 319139 dated 1st October, 1976 since the infringement with respect to these trademarks has been averred in the plaint, and not in the light of the trademark registered vide trademark registration No. 167064 dated 15th December, 1954.

11. The first question which arises for determination in this suit is whether the Trademarks Act, 1999 (hereinafter referred to as the "New Act") applies to the facts of the present case or the Trade and Merchandise Marks Act, 1958

(hereinafter referred to as the "Old Act"). The plaintiffs contend that the New Act has no application to the present case by virtue of Section 159(4) of the New Act, according to which legal proceedings pending at the time when the New Act came into force, will continue as if the New Act had not been passed. Section 159(4) of the New Act reads as follows:

"159. Repeal and savings. -- (1) ...

(2) ...

(3) ...

(4) Subject to the provisions of Section 100 and notwithstanding anything contained in any other provision of this Act, any legal proceeding pending in any court at the commencement of this Act may be continued in that court as if this Act had not been passed."

12. On the other hand, the learned senior counsel for the defendants Shri Tripathi contended that the Court should harmoniously interpret the Old and the new Act and decide according to New Act, because as per Section 159(2) of the New Act, a registration certificate given under the Old Act continues to be in force and has effect as if made, issued given or done under corresponding provisions of the new Act. Therefore, the registration certificate of the plaintiff under the old Act would be presumed to have been issued under the new Act and would be governed by the new Act. Section 159(2) of the new Act reads as follows:

"159. Repeal and savings. -- (1) ...

(2) Without prejudice to the provisions contained in the General Clauses Act, 1987 (10 of 1897), with respect to repeals, any notification, rule, order, requirement, registration, certificate, notice, decision, determination, direction, approval, authorisation, consent, application, request or thing made, issued, given or done under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall, if in force at the commencement of this Act, continue to be in force and have effect as if made, issued, given or done under the corresponding provisions of this Act."

13. In my view, the New Act is not applicable to the present case by virtue of the effect of the non-obstante clause contained in Section 159(4). Moreover, the present suit was filed on 24th March, 2003 whereas the New Act came into force on 15th September, 2003 which clearly shows that the New Act came into force after the present suit was filed, thus rendering it inapplicable to the facts of the present case. In any event if there are any savings under the New Act as per Section 159(1), they relate only to the notification and approval, certificates etc. so as to make them applicable and effective under the New Act even though issued under the Old Act. The existing legal proceedings such as the present suit are separately provided for in Section 159(4) of the New Act and legal proceedings pending cannot be considered to be falling u/s 159(1) of the New

Act. The said Section 159(4) clearly demonstrates that the existing proceedings are governed by the 1958 Act.

14. The second issue which requires determination is whether the word "COLGATE" inscribed in the colour scheme of red and white in the plaintiff's product constitutes a composite trade mark by virtue of Section 10 of the Old Act. The learned Counsel for the defendants has urged that by virtue of Section 17 of the New Act, the colour scheme ought to have been separately registered in addition to the registration of the word "COLGATE". Section 10, which is the same in Old Act and the New Act, and Section 17 of the New Act read as under:

"10. Limitation as to Colour -

(1) A trademark may be limited wholly or in part to one or more specified colours, and any such limitation may be taken into consideration by the tribunal having to decide on the distinctive character of the trademark.

(2) So far as a trademark is registered without imitation of colour, it shall be deemed to be registered for all colours."

"Section 17 of New Act.

17. Effect of registration of parts of a mark -

(1) When a trademark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trademark taken as a whole.

(2) Notwithstanding anything contained in Sub-section (1), when a trademark

(a) contains any part -

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character.

The registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trademark so registered."

15. Shri Tripathi, the learned senior counsel for the defendants has submitted that u/s 10 of the Old Act the registration of the colour is in nature of a limitation imposed and is not a grant of an additional right to the person seeking registration. He has further submitted that the trade mark of the plaintiff has been limited to one colour scheme. In my view the plea of the defendant is not justified as merely by the process of being limited to a particular colour or colours the efficacy of the registration would not be whittled away or diluted. The learned senior counsel for the plaintiff Shri Sudhir Chandra's plea is that such limitation has in fact made the effect of registration more focussed and

accentuated because the Tribunal in considering the distinctive character of the trade mark is duty bound to give effect to the limitation of the registration of the trade mark to one or more colours. In my view the limitation of the right to one or more colour cannot be considered to be diluted or limited within the said colour scheme. The word "limitation" in Section 10(1) of the Old Act Therefore must receive the meaning that while restricting the mark to one or more specified colour such limitation cannot have the effect of curtailing the effect of the registration of that mark for the colour(s) for which registration has been granted. No doubt there is a limitation on the exercise of the mark by it being confined to one colour or as a colour scheme of two colours red and white, but that limitation is the restriction to the extent which does not grant the plaintiff any right to use his mark for any other colour. However, within the registered colour scheme, there cannot be said to be any limitation. The word "limitation" thus refers to the limitation to, and not of, that particular colour(s). To avail the benefit of Section 17 of the Old Act, the registered trade mark must not contain any matter which is common to the trade or is otherwise of a non distinctive character. The defendants' plea that the word "COLGATE" ought to have been registered separately apart from a registration of the red and white colour scheme Therefore cannot be countenanced, as in the white and red colour background the inscribed word "COLGATE" in the registered mark indeed seeks to make distinctive the plaintiffs' mark in its red and white colour scheme. In any case Section 17 of the New Act is not applicable in view of the provisions of Section 159(4) of the New Act which has already been discussed above.

16. The plea of the plaintiffs is that the limitation u/s 10 of the Old Act is different from the limitation and disclaimer imposed by the Registrar of Trade Mark u/s 18(4) of the Old Act i.e. before acceptance or u/s 19(b) of the Old Act i.e. after acceptance and Section 17 of the Old Act. The said Sections 2(1)(j), 17, 18(4) and 19(b) of the Old Act read as under:

"2. Definition and interpretation -(1) In this act, unless the context otherwise requires.--

...

(j) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof;

...

17. Registration of trade marks subject to disclaimer.... If a trade mark....

(a) contains any part--

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-

distinctive character.

the tribunal, in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register, that the proprietor shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the tribunal holds him not to be entitled, or make such other disclaimer as the tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration:

Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made."

"18. Application for Registration.--(1) ... (2) ... (3) ... (4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit."

"19. Withdrawal of acceptance....

(b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted,

the registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted."

The Trade Mark Tribunal in considering the distinctive character of the trade mark is thus required to take into account the registration of trade mark to one or more specified colours. I have already held that the limitation of the mark to one or more colour cannot curtail the effectiveness of the said registered mark in any manner save its restriction to one or more colours and consequently, the defendant's plea about the curtailed effect of the registration of the plaintiff's mark in the red and white colour, cannot be accepted.

17. The colour scheme of red and white when supplanted by the word/logo COLGATE in respect of the plaintiff's registered mark however acquires a different connotation entitling such a composite mark protection from infringement .In coming to this conclusion, I am guided by the copy of the form TM-1 in which the colour limitation voluntarily sought by the plaintiffs was granted by the Registrar of Trade Marks. The form TM-1 showing the registration of the plaintiff's mark reads as follows:

"Register Trade Marks Details for 190279

Registration Date: 12/05/1959

Renewal Date: 12/05/2001

Journal No. 265 - 0

Status : Registered

Trade Mark Type Device

Word Mark COLGATE

Goods Description : DENTAL CREAM.

Condition & Limitations:

History Date:

COLGATE - PALMOLIVE COMPANY (A CORPORATION organized UNDER THE LAWS OF THE STATE OF DELAWARE UNITED STATES OF AMERICA), COLGATE-PALMOLIVE BUILDING, 300 PARK AVENUE, NEW YORK 22,

UNITED STATES OF AMERICA MANUFACTURERS AND MERCHANTS,

C/O CRAWFORD BAYLAY & CO., STATE BANK BUILDINGS, BANK STREET, FORT BOMBAY 1

DENTAL CREAM.

THE MARK IS LIMITED TO THE COLOURS RED AND WHITE, AS SHOWN IN THE REPRESENTATION ANNEXED HERETO."

(underlining supplied)

18. This certificate clearly shows that the registration vide trademark registration No. 190279 u/s 10 of the old Act pertains to the word COLGATE in white on a red background. The effect of such a certificate of registration and the averred infringement of that registered mark by the defendants are being considered in this judgment. The mark was limited to the colours red and white as shown in the representation annexed which representation clearly included the word/mark "COLGATE". This contradicts the plea of the plaintiff that the registration No. 190279 was limited only to colours red & white. The above registration shows that the word mark shown in the representation annexed was COLGATE. Thus the sentence in Annexure D "The mark is limited to the colours Red & White as shown in the representation annexed hereto" means the mark "COLGATE" limited to Red & White colours and not registration of red & white colour scheme on its own.

Registration of the mark limited to colours "Red and White" Along with the mark "COLGATE" does give the plaintiff company exclusive rights to such a registered mark but does not necessarily make the red and white colour scheme implicate an essential feature thereof. In fact the word "COLGATE" inscribed on a Red & White background together with the red and white colour conjointly constitute the essential features of the plaintiff's trademark. Even the wording of Section 17(1) of the New Act though not applicable directly are instructive and furnish an

indication of the current legislative intent. Section 17(1) of the New Act stipulates that when a trade mark consists of several matters, its registration shall confer on the proprietor exclusive rights to use the trade mark taken as a whole. This indicates the legislative intention as expressed in the New Act. In the present case the trade mark as a whole comprises of red and white colour scheme with the word "COLGATE" inscribed in a particular white font on a red background. The trade mark in order to avail of the benefit of the effect of registration u/s 17(1) of the New Act must comply with the mandate of the said sub-section and the protection against the infringement of the registered mark is only available to the composite mark. In fact what was sought to be registered and indeed secured protection was the word "COLGATE" written in white in a particular font and manner on a red background and not the colour combination of Red & White alone. The red and white colour combination is a widely used colour combination in the dental cream market and cannot be held to be a distinctive feature of the plaintiff mark, so as to be monopolized exclusively by the plaintiffs. In *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories*, it was held as follows:

"In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

(underlining and italics supplied)

Relying on the above extracted italicized portion of Durga Dutt's case beginning from "if the essential feature and ending at would be immaterial", the plaintiff counsel Shri Chandra contended that once any essential feature of the mark was copied/adopted, the other differences in get up, packing, writing of the mark or trade origin would be immaterial in a case of infringement. Thus since red and white colour scheme was an essential feature of the registered mark of the plaintiffs", its adoption tantamounted to infringement of the plaintiff's mark by the defendants' mark irrespective of the other differences.

19. Therefore as per Durga Dutt's case (supra) it is only when the essential features (plural) of a trademark are purloined by the defendant, a case for infringement arises. But this is not so in the present case as it has already been held that the essential features of the plaintiff's mark are the word "COLGATE"

and red and white colour scheme taken together. While "COLGATE" is certainly an essential feature which will be, and is, entitled to protection but the generic colour scheme of red and white on its own without the addition of the mark "COLGATE" cannot be said to constitute a feature which is so essential so as to entitle the plaintiffs to urge infringement by the mere adoption of such a colour scheme by some one else.

20. The plea of the plaintiffs about red and white colour scheme being entitled to protection from similar competing products is being considered in the light of the plaintiff's claim for the infringement of its mark without the plaintiffs being required to prove any likelihood of deception. The plaintiff's plea if accepted would effectively bar the colour combination of red and white from the tooth paste trade. Thus if any other rival manufacturer were to use a red background with white lettering for its carton and product it would straight away amount to infringement according to the plaintiff's submission. In my view the plaintiff's submission qua its plea on infringement if accepted would amount to depriving the concerned trade, the colour combination of red and white without any proof of similarity and likelihood of deception. Considering the fact that nature has only seven primary colours, the effect of such interpretation would be to effectively deprive the trade, one seventh out of the available spectrum of colours. A plea of such monopoly over the colour red combined with white print as advanced by the plaintiff can not be accepted.

21. In so far as Durga Dutt's case (supra) strongly relied upon by the plaintiffs is concerned, the learned Counsel for the defendants has stated that the principle of law laid down by Durga Dutt's case (supra) was as follows:

"...in an action for infringement, the plaintiff must, no doubt, make out the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's right are violated."

22. He further submitted that the above principle of law was illustrated further by the Hon'ble Supreme Court in the following terms:

"Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

(underlining supplied)

23. He has further submitted that the Hon'ble Supreme Court has clearly laid

down that for infringement the plaintiffs must no doubt make out that the use of the defendant's mark is likely to deceive but it is only when the similarity between the two marks is so close visually, phonetically and otherwise and the court reaches the conclusion that there is imitation, no further evidence is required to establish the violation of the plaintiff's right. He, Therefore, highlighted that this was principle laid down by the Supreme Court and the illustration of the principle in another manner by giving an example could not be said to be the true essence of the judgment of the Hon"ble Supreme Court as fervently contended by the plaintiffs. He has in particular, laid stress on the plural in "essential feature(s)" of the trademark described by the Hon"ble Supreme Court and submitted that it is not one essential feature whose adoption could lead to the violation but the essential feature(s) of the trademark whose adoption could amount to violation. He submitted that if this meaning is given, both the extracts of the said paragraph of the Supreme Court judgment complement each other, otherwise if the plea of the plaintiff is upheld, it would lead to a situation where one part of this judgment in Durga Dutt's case would suggest that the plaintiff must make out a case of deception even in a claim for infringement whereas the other part of the judgment indicates that the mere adoption of an essential feature would be sufficient and no other evidence is required to be led. He has further highlighted the position of law laid down in Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co., wherein it was held by the Hon"ble Supreme Court as follows:

"In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the register, but something similar to it, the test of infringement is the same as in an action for passing - off. In other words, the test as to likelihood of confusion or deception and arising from similarity of mark is the same both in infringement and passing-off actions."

(underlining supplied)

24. He has further submitted that in Ruston & Hornsby's case (supra), it was held that the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions. He has thus urged that once the interpretation given in the Durga Dutt's case (supra) suggested by the defendant is adopted then there is no conflict between the Durga Dutt's case and Ruston & Hornsby's case and has further submitted that this Court should not lightly accept the plea that the latter judgment in Ruston & Hornsby's case of the Hon"ble Supreme Court is contrary to that of earlier judgment in Durga Dutt's case if both the judgments can co-exist as per the interpretation canvassed by the defendants.

25. In my view to accept the plaintiff's plea that in Durga Dutt's case the Hon"ble Supreme Court held that if any essential feature of the mark had been adopted by the defendant then notwithstanding the marked differences showing

a different trade origin infringement was established, would be to read the above passage of the judgment of the Supreme Court in isolation. Firstly, the judgment of the Supreme Court clearly uses the phrase "essential features" in plural and not just "any essential feature" in singular clearly showing that at least more than one of the essential feature of the plaintiff's mark have to be adopted to signify infringement. In the present case even if the plaintiff's case that the word "COLGATE" and the red and white colour scheme, both constitute essential features, then at best the defendants could have been held to have adopted only one of the essential features i.e. "red and white" colour scheme and not essential features in plural as required by the above judgment. Secondly, in the earlier portion of the paragraph relied upon by the plaintiffs, as extracted above it has been held that even in an action for infringement the plaintiff must make out that the use of the defendant's mark is likely to deceive unless the similarity between the two marks is visually or phonetically so close that the Court reaches a conclusion that there is an imitation. In my view the defendant's mark "AJANTA" is visually and phonetically not so close as to indicate a blatant imitation, straightaway leading to an inference of infringement notwithstanding the red and white colour combination. It is only when the above visual, phonetic and other tests lead to a conclusion that there was imitation, that no further evidence is required to be led. It is the above passage which is explained by the Hon"ble Supreme Court in the latter part of the paragraph in Durga Dutt's case (supra) by giving an illustration of the adoption of essential features in plural. This interpretation of the judgment of the Hon"ble Supreme Court in Durga Dutt's case harmonizes not only both portions of the above paragraph of the judgment of the Supreme Court but also leads to the conclusion that the law laid down in Ruston & Hornsby's case (supra) by the Supreme Court to the effect that the tests as to likelihood of confusion and deception and arising from similarity of the mark are the same both in actions for infringement and passing off, need not be held to per incuriam as urged by the learned Counsel for the plaintiffs Shri Sudhir Chandra.

26. At this stage, it is also necessary in any event to deal with the plea of the plaintiffs that the above mentioned judgment in Ruston & Hornsby's case is per incuriam since the court did not notice the earlier judgment in Durga Dutt Sharma's case. The plaintiffs rely on State of Bihar Vs. Kalika Kuer @ Kalika Singh and Others, wherein it was held as follows:

"5. At this juncture we may examine as to in what circumstances a decision can be considered to have been rendered per incuriam. In Halsbury's Laws of England (4th Edn.) Vol. 26: Judgment and Orders: Judicial Decisions as Authorities (pp. 297-98, para 578) we find it observed about per incuriam as follows:

"A decision is given per incuriam when the Court has acted to ignorance of a previous decision of its own or of a court of coordinate jurisdiction which covered the case before it, in which case it must decide which case to follow; or when it

has acted in ignorance of a House of Lords decision, in which case it must follow that decision; or when the decision is given in ignorance of the terms of a statute or rule having statutory force. A decision should not be treated as given per incuriam, however, simply because of a deficiency of parties, or because the court had not the benefit of the best argument, and, as a general rule, the only cases in which decisions should be held to be given per incuriam are those given in ignorance of some inconsistent statute or binding authority. Even if a decision of the Court of Appeal has misinterpreted a previous decision of the House of Lords, the Court of Appeal must follow its previous decision and leave the House of Lords to rectify the mistake."

Lord Godard, C.J. In *Huddersfield Police Authority v. Watson*, 1947 KB 842 : (1947) 2 ALL ER 193, observed that where a case or statute had not been brought to the court's attention and the court gave the decision in ignorance or forgetfulness of the existence of the case or statute, it would be a decision rendered in per incuriam.

6. In a decision of this Court reported in *Government of Andhra Pradesh and Another Vs. B. Satyanarayana Rao (Dead) by Lrs. and Others*, it has been held as follows:

"The rule of per incuriam can be applied where a court omits to consider a binding precedent of the same court or the superior court rendered on the same issue or where a court omits to consider any statute while deciding that issue... We, Therefore, find that the rule of per incuriam cannot be invoked in the present case. Moreover, a case cannot be referred to a larger Bench on mere asking of a party. A decision by two Judges has a binding effect on another coordinate Bench of two Judges, unless it is demonstrated that the said decision by any subsequent change in law or decision ceases to laying down a correct law."

8. In *State of U.P. and Another Vs. Synthetics and Chemicals Ltd. and Another*, this Court observed:

"40. "Incuria" literally means "carelessness". In practice per incuriam appears to mean per ignoratium. English courts have developed this principle in relaxation of the rule of stare decisis. The "quotable in law" is avoided and ignored if it is rendered, "in ignoratium of a statute or other binding authority". (*Young v. Bristol Aeroplane Co. Ltd.* 1944 KB 718 Same has been accepted, approved and adopted by this Court while interpreting Article 141 of the Constitution which embodies the doctrine of precedents as a matter of law."

27. In my view, it is settled law in so far as this Court is concerned that it is not for this Court to hold judgments of the Hon"ble Supreme Court to be per incuriam as evident from the judgment in *Common Cause v. UOI* reported as AIR 1997 Del 93 wherein it was held by a learned Single Judge of this Court, Madan Lokur, J., as under:

"34. Learned Counsel for the contesting respondents wanted me to hold that Supreme Court Dr. G.N. Khajuria and others Vs. Delhi Development Authority and others, was decided per incuriam. I am afraid that is not possible. I am bound by the decisions of the Supreme Court and am obliged to follow the law laid down by the Supreme Court. Whether a decision of the Supreme Court is per incuriam or not is for the Supreme Court to decide and not the High Court. Anyway, this controversy is now academic in view of my conclusion stated above."

(underlining supplied)

I am in respectful agreement with, and indeed am bound by the above position of law laid down by this Court. Thus, even if I were to come to a conclusion that the interpretation of Durga Dutt's case and Ruston & Hornsby's case were not capable of a harmonious construction it is not open for a single Judge of the High Court as per the above position of law laid down in Common Cause's case, to hold the judgment of the Hon'ble Supreme Court to be per incuriam.

28. The next contention of the plaintiffs is based on the doctrine of essential features. The meaning of the phrase "essential feature(s)" has been explained in the case of Seville Perfuming Ltd. v. Fine Perfect Ltd. reported as RPC (Vol. LVIII) 1 wherein it was held as follows:

"In the present case, for example, the evidence makes it clear that traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark..."

(underlining supplied)

29. The plea raised by the plaintiffs is that the doctrine of essential feature means that if the trade mark is a composite mark comprising of one or more elements which constitute a registered trade mark then any one of them if adopted by a rival manufacturer might lead to confusion and so long as any element Constituting a trademark is adopted and is an essential feature of the mark, infringement u/s 29 is proved and no other similarity needs to be established in so far a registered mark is concerned.

I am unable to agree with the aforesaid plea of the learned Counsel for the plaintiffs. Taking the present case, instead of a red carton with white lettering, if a white carton contains red lettering on it was adopted by a competition, such a carton could also lead to a conclusion of infringement if the plaintiffs' plea is accepted, if both red and white colours on their own without the word "COLGATE" were treated as one of the essential features of the plaintiffs' mark. This interpretation would also be contrary to the law laid down in Durga Dutt's

case which required the adoption of essential features and not a solitary essential feature by the defendant so as to uphold the plea of infringement. However, by no stretch of imagination such a white carton with red lettering could be said to be misleading the general purchasers which include illiterates and children. In Durga Dutt's case (supra), it has been held that :

"The identification of the essential features of the mark is in essence on a question of fact and depends on the judgment of the court based on evidence laid before it as regards the usage of trade. It should, however, be born in mind that the object of the enquiry in ultimate analysis is whether mark used by the defendant as a whole is deceptively similar to that of regd. trade mark of the plaintiff."

In view of the position of law laid down in Durga Dutt's case (supra) that the identification of the essential features of the mark is in essence on a question of fact and depends on the judgment of the court based on evidence laid before it as regards the usage of trade, I am satisfied that the word "COLGATE" as depicted in white upon red back ground (in the registered mark which is one of the documents annexed to the plaint) both conjointly constitutes essential feature of the plaintiff's mark. The word "COLGATE" also on its own does form an essential constituent feature of the plaintiff's mark. However, the red and white colour combination which in essence is really a red colour printing in white font, is not on its own an essential feature of the plaintiff's mark and giving such an interpretation to the words "essential feature" which would reserve the red and white colour scheme to the plaintiff exclusively, is stretching the meaning of the word essential feature to artificial limits not warranted by or contemplated under the provisions of the Act.

30. The learned Counsel for the plaintiff contended that the registration of the combination & colours, Red & White, makes the colour scheme itself an essential feature. He relies on the judgment of this Court in Anglo-Dutch, Colour and Varnish Works Private Limited Vs. India Trading House, where it was held as follows:

"10. It was argued by Shri. J.R. Goel on behalf of the defendant that there is nothing distinctive in the colour combination of the plaintiff's container and the plaintiff could not have a trademark in colour combination. I am afraid I cannot agree with this submission. The colour combination is not descriptive but is distinctive. The definition of the "mark" as contained in Clause (j) of Section 2 of the Trade and Merchandise Marks Act, 1958 is not exhaustive and the definition is such that there is practically no limit to the combination of various types of marks. A dealer can Therefore have a trade-mark in combination of colours though not on an individual colour. In the present case, the combination of violet background and a large circle with white background and grey lettering is distinct combination of colours and there is no legal bar to a person acquiring a trade-mark in such combination of colours for his containers."

(underlining supplied)

31. Even the above judgment relied upon by the plaintiffs in Anglo Dutch's case (supra) clearly shows that the "combination of colours" referred to in the above judgment was in reference not only to the combination of colours but also additional features such as a large circle and grey lettering. The above reference to the trade mark in combination of colours has to be understood in the context of the other features described above in addition to the colour combination which together constituted a trade mark entitled to protection by virtue of such registration. In the instant case too, the colour combination of red and white on its own does not identify the source of the product since the red & white colour combination is quite generic in nature and common to toothpaste trade as demonstrated by the various products and their labels relied upon by the defendants. Moreover, there is nothing innovative or distinctive in using the colour "white" for writing the word mark "COLGATE", since white is a colour commonly used for writing alphabets/numerals on coloured backgrounds.

32. The plaintiffs have also pleaded that the plea of the defendant that the red and white label is common to the toothpaste trade is not justified because the brands relied upon by the defendants are (a) not commercially available in India (b) do not have a market share and hence undetectable (c) have a different get up (d) relate to different products (e) actions have been initiated against other brands by the plaintiff.

The Corn Products Refining Co. Vs. Shangrila Food Products Ltd., has been cited by the plaintiff to contend that products which do not have an established presence in the market cannot be considered in order to reject/grant a registration.

In my view the principle laid down in Corn Product's case is not applicable to the present issue about the monopoly over red and white colours claimed by the plaintiff in respect of tooth paste packaging. The established presence in the market may have a bearing on the issue of passing off but does not have a bearing in so far as the issue of the red and white being a common colour combination in toothpastes is concerned. The defendants had contended that in the toothpaste trade the colour combination of red and white is common to the trade. The defendant had given a list of 16 Indian and 8 international toothpastes along with their annexed labels to establish the common occurrence of red colour as well as red and white colour combination in the toothpaste industry. Furthermore, it is the plaintiff who has claimed that it is a world leader in toothpaste trade and has referred to its worldwide presence in the toothpaste market so as to inter alia establish its transborder reputation. In this view of the matter the existence of the colour combination red and white in the international market not having been denied, the defendants have in my view prima facie established that colour red as well as red and white combination are common to the toothpaste trade internationally. The fact that some of the brands have a negligible presence in the Indian market or have been sued by the plaintiff or are

under a settlement with the plaintiff, still does not detract from the fact that the colour red and the red and white colour combination are common to the toothpaste trade.

33. While the law laid down in other common law jurisdictions such as the U.K. and U.S.A. is not binding on this Court but it can nevertheless furnish a useful guide for this Court. At this stage it is profitable to set out the following position of law laid down in *Campbell Soup Co. v. Armour & Co.* 81 USPQ 430:

at para 6 page 432, it was observed that

"... It is worth the space involved to call attention to just what it is the plaintiff's claim. Their suit here is based solely upon their claimed exclusive right to the use of red and white in packaging their food products. While their registration describes the red over white as a rectangular design, when the colours appear on their packages they appear in the form of an endless band which runs around the entire container. The Campbell red is not the same as the Carnation red. Indeed, the Carnation red is not the same on all of its products, according to the sample labels offered in the plaintiff's exhibits. The red used by Armour is a specially blended color. The usual Armour Label is white over red instead of red over white, as the plaintiffs use the colour, but in some cases Armour uses red and white bands vertically.

What the plaintiffs are really asking for, then, is a right to the exclusive use of labels which are half red and half white for food products. If they may thus monopolize red in all of its shades the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out...."

(underlining supplied)

At para [8], it was observed

"That a man cannot acquire a trade mark by color alone has been stated a good many times in decisions and textbooks...."

"...When we say that plaintiffs cannot have exclusive right to a trade mark of a red and white, label, we are by no means denying their right to acquire a trade mark when the color is combined with other things in a distinctive design. As a matter of fact, the distinctiveness of plaintiff's packages does not depend upon colour alone, although each has been granted registration of a trade mark described in terms of color. Each has its name in one of the color bands in a uniform and specified type of script. Each has a very distinctive design on its label. Carnation has a small bouquet of carnation flowers. Campbell has a medallion of individual design, Armour, too, does not depend upon color alone. It uses different colors with different products and each has the Armour name in an individual type of script accompanied by the star which it says has been the mark of its goods over many years.

"In denying the plaintiffs the exclusive use of color alone we are not passing upon the question whether they have acquired trade marks entitled to protection, in the sum total of the combinations which make up their respective labels for their goods."

(underlining supplied)

34. In order to counter the position of law laid down in Campbell Soup's case (supra) the plaintiff had relied on the judgment in the case of Master Distributors v. Pako Corporation, 25 USPQ 1794, wherein the following position of law was laid down:

"We are not persuaded by the three traditional arguments against protection - the color depletion theory, shade confusion, and the functionality doctrine. Nor are we impressed by the argument that "consistency and predictability" require a per se prohibition against trademark protection for color alone. We believe that not allowing manufacturers to protect color marks when all the traditional requirements have been met will actually promote inconsistency and confusion.

Proponents of the color depletion theory assert that there are only a few possible colors a manufacturer can choose for a product, and allowing one manufacturer to monopolize one color "in all of its shades" will inhibit competition. Campbell Soup Co. v. Armour & Co., 175 F. 795, 81 USPQ 430, cert. Denied, 338 U.S. 847 (1949) 83 USPQ 543. We agree that allowing a manufacturer to monopolize red "in all of its shades" would deplete the color choices available to other market participants. Allowing a manufacturer who has met all the normal requirements for obtaining trademark protection to protect a specific shade of color, however, is another matter...."

35. In my view, this judgment agrees with the Campbell Soup's case (supra) and in fact relates to shades of colours and not a particular colour. Even if this decision is held to take a view contrary to that in Campbell's soup's case (supra), I would prefer the reasoning laid down in Campbell's soup's case as it is more logical and appeals to this Court as it inhibits a chromatic monopoly.

36. In Life Savers Corporation v. Curtiss Candy Co., 85 USPQ 440, it was held as follows:

4. "That a man cannot acquire a trade mark by color alone has been stated a good many times in decisions and text books." Campbell Soup Co., et al. v. Armour & Co., 3 Cir., 175 F. 795, 81 USPQ 430. As a rule color cannot be monopolized to distinguish a product. Diamond Match Co. v. Saginaw Match Co., 6 Cir. 142 F. 727, cert. Den. 203 U.S. 589, Color is not subject to trade mark monopoly except in connection with some definite arbitrary symbol or design. James Heddon's Sons v. Millsite Steel & Wire Works, Inc., 128 F. 6, 53 USPQ 579. In the Campbell Soup Co. case, supra, the court said 81 USPQ 432:

"What the plaintiffs are really asking for, then, is a right to the exclusive use of labels which are half red and half white for food products. If they may thus

monopolize red in all of its shades the next manufacturer may monopolize orange in all of its shades and the next yellow in the same way. Obviously, the list of colors will soon run out."

(underlining supplied)

37. In *GAF Corporation v. Ciba-Geigy Ltd.*, 184 USPQ 253, it was held as follows:

"[3] Applicant's cover is green, the entire cover is green. The overall application of color green to cover of a book lacks distinction. It is matter of common knowledge that covers of books are presented in overall colors and it is clear beyond per adventure that the color green of applicant's goods is not capable of distinguishing applicant's book as to origin from other books having green covers. Further, color is not subject to trademark exclusiveness except in connection with some definite arbitrary symbol or design. See: *Life Savers Corporation v. the Curtiss Candy Co.*, 85 USPQ 440 (CA 7, 1950); *Lucien Lelong, Inc. v. Lenel, Inc. et al.*, 85 USPQ 117 (CA 5, 1950); *National Candle Company Inc. v. Viscount Manufacturing Co., Inc.*, 130 USPQ 452 (DC NJ, 1961); *Landis Machine Co. v. Chaso Tool Co., Inc.*, 53 USPQ 200 (DC Mich., 1942); *Neuhoff Brothers v. Oscar Mayer Packing Co., Inc., et. al*, 98 USPQ 194 (DC Tex. 1953); *Fram Corporation v. Boyd*, 109 USPQ 4 (CA 5, 1956); *Mershon Company v. Pachmayr*, 105 UPSQ 4 (CA 9, 1955). Since applicant cannot acquire exclusiveness in a green colored cover for books, said color cannot be capable of distinguishing applicant's publication."

(underlining supplied)

38. In *Mershon Co. v. Pachmayr*, 105 UPSQ 4, it was held as follows:

"[6] Pachmayr argues that the symbol is non-effective because a color is involved. We do not read the cases as excluding color from being an element in a trade name or mark. We do not hold that color alone can be protected as a mark, but certainly color can be an element of a mark,

"... if it be impress in a particular, design, as a circle, square, triangle, a cross or a star."

quoting from *Leschen & Sons Rope Co. v. Broderick*, 1906 201 U.S. 166. The California District Court of Appeal, in *So. Calif. Fish Co. v. White Star Canning Co.*, 1920 45 CA 426, is to the same effect."

39. The plaintiffs have also relied on the decision of the U.S. Supreme Court in *Qualitex v. Jacobson*, 514 US 159 wherein it was held that even a single colour can be registered as a trademark. There was some confusion about the law laid down in this judgment itself which was clarified by the U.S. Supreme Court in the *Walmart* decision, wherein it was held that colours cannot be given trademark protection unless they have acquired a secondary significance.

40. It is also worthwhile to quote McCarthy on Trademarks where at para 7.44 it was observed as follows:

"Prior to the Supreme Court's 2000 Wal-Mart decision, some had read the Court's Qualitex opinion as not settling the issue of whether a single product color can ever be so unusual as to be "inherently distinctive" and hence, protectable without proof of secondary meaning. However, in the author's opinion, the Court, albeit not in so many words, said that for this type of trademark or trade dress, a single color per se can never be classified as inherently distinctive and will always require proof of secondary meaning for protection and registration.

This dispute came to an end when the U.S. Supreme Court in its Wal-Mart decision cleared up once and for all any lingering doubts about the rule in the Qualitex case. In Wal-Mart, the Supreme Court looked back to its previous decision and stated that in Qualitex, it had held that no single color can ever be inherently distinctive. Single color always requires proof of secondary meaning."

(underlining supplied)

Thus, even in the U.S., the position of law is that colours per se cannot be claimed as trade marks. It has been consistently held that colour must combine with other things to acquire a distinctive design which may afford protection to the defendant.

41. In the book "Designer's guide to color" by James Stockton, it has been stated as follows:

"The many psychological aspects of color often seem more emotional and personal than scientific, the determining agreement in relation to colors is sometimes difficult. However, most people do agree that some color combinations imply heat and some cold, and that some cannot pleasure and other pain. Painters, and particularly the Impressionists, have relied on these ideas to produce dimension, form and mood. Red can be among other things, either a welcome or a warning, conveying either warmth or danger. The "voice" of a color depends largely on the colors that are placed next to it--the essence of this book.

Roche Laboratory has developed an elaborate "spectrum of human emotions" color wheel. It is beautifully presented in *Living by Design: Words and Pictures*, by Pentagram (published by Lund Humphries, London, and the Whitney Library of Design, New York, 1978). Unchallenged, it assigns "reserved" to blue, "active" to red, and so on. Regardless of the absolute accuracy of these designations, that moods can be evoked and manipulated by our historical and cultural associations with color is certain. Some combinations immediately evoke the 1950s, the military, the Federal period, and a feeling of the baroque. Generally, color can produce an appropriate setting, tone or mood for the subject at hand. This sort of color use is nowhere more powerful than in the theater, opera and ballet. On stage, color is seldom static; and constantly layered and shifting combinations of color and are carefully modulated and controlled can benefit an entire production. As in the print media, the trained and deliberate placement on

stage of small areas of color contributes to the emotional impact of the larger piece."

(underlining supplied)

"Variations on Red

About 4000 years ago in the Orient people dabbed red clay on their lips to ward off unwanted spirits, and even in recent times some Asian fishermen have worn red loin cloths to ward off sharks; red has endowed with special charms. In fact, along with black and white red may be one of humankind's three basic colors, as defined by some anthropologists and ethnologists. While and red are associated with life activities; black usually indicates death, misfortune or evil, or simply opposition to white's yielding and acceptance and purity. As clearly in opposition as are black and white to North American eyes are red and white to people in other quarters of the world, and dichotomous red generally assumes the most active and overt role."

(underlining supplied)

"Although it is an alternative way of getting your message across, you need more than just a broad swathe of colour. Malboro's brand is indicated by the red & white chevrons, but without the shape. I am not sure how effective it could be. There is a stage when colour ceases to be ownable." (Jez. Frampton, Chief Executive of brand consulting Interbrand [Http://ad-rag.com/114708.php](http://ad-rag.com/114708.php))

42. The above texts and the colour diagrammes also indicate that the exclusivity and monopoly of a colour and a colour scheme is not favored. Not only is the red colour one of the seven primary colours but it along with white and black colours has in fact been described as one of the three basic colours in nature. Furthermore, even though the colour combination of the registered mark indicates red and white, in essence the carton of the plaintiffs for which registration has been granted is entirely in red except the logo in the form of the word "COLGATE" and other small ancillary words such as the price, quality etc. which are printed in white. It is this placement of small print in white containing the word "COLGATE" in a small area placed on the back ground in red which contributes to the commercial impact of the plaintiff's carton in the market place and indeed gives exclusivity and distinctiveness to the plaintiff's mark. Thus, the mark COLGATE in white on a red background highlights the plaintiff's product and gives a distinct identity to the combination, and such a combine is certainly entitled to protection from not only passing off, but infringement too. However, I am also of the view that the red and white colour combination per se without the word/mark "COLGATE" is not entitled to protection from infringement.

43. Thus, in so far as the plea of infringement of the registered mark of the plaintiffs by the defendant's mark is concerned, I am unable to come to a finding that in view of the aforesaid discussion, the plaintiff's mark can be said to have been infringed by the defendant's mark.

44. However, de hors the finding that there was no infringement of the plaintiff's registered mark by the defendant's mark, the plea of passing off is required to be considered on its own. The Hon'ble Supreme Court in *Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*, , laid down the following authoritative position of law in respect of tests for ascertaining passing off:

"35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

36. Weightage to be given to each of the aforesaid factors depending upon facts of each case and the same weightage cannot be given to each factor in every case."

45. In *Vicco Laboratories, Bombay Vs. Hindustan Rimmer, Delhi*, which on facts was rather similar to the present case, the following position of law was laid down by this Court in respect of two competing creams:

"13. The plaintiff's claim passing off by the defendants of their product as and for the product of the plaintiff's on the basis of copy of the distinctive get-up and colour scheme of the collapsible tubes and the cartons by them. The defendants are not entitled to represent their goods as being the goods of the plaintiffs. The two marks "Vicco" and "Cosmo" used by the plaintiffs and defendants respectively are no doubt different and the mark "Cosmo" by itself is not likely to deceive but the entire get-up and the colour scheme of the tube and carton adopted by the plaintiffs and the defendants are identical in every detail and are likely to confuse and deceive the customer easily. The get-up and the colour scheme of the plaintiffs adopted in every detail by the defendants for their tube and carton cannot be said to have been adopted by the defendants unintentionally. Further the defendants allege that they started selling their

product in the carton and tube in question from No. 1977 while the plaintiffs have been selling their product in the said carton and the tube since April, 1975, the suit was originally filed in Feb., 1978 at Bombay and ex-parte injunction was granted on 29th August, 1978. The plaintiffs are prior users of their product in the carton and the tube."

46. It was also held by this Court as under in Colgate Palmolive Company and Another Vs. Anchor Health and Beauty Care Pvt. Ltd.,

"54. May be, no party can have monopoly over a particular colour, but if there is substantial reproduction of the colour combination in the similar order either on the container or packing which over a period has been imprinted upon the minds of customers it certainly is liable to cause not only confusion but also dilution of distinctiveness of colour combination. Colour combination, gel up, lay out and size of the container is sort of trade dress which involves overall image of the product's features. There is a wide protection against imitation or deceptive similarities of trade dress as trade dress is the soul for identification of the goods as to its source and origin and as such is liable to cause confusion in the mind of the unwary customers particularly, those who have been using the product over a long period."

47. There were several other judgments cited by both counsel on the issue of passing off but in my view since the Hon"ble Supreme court has settled the law in Cadila Health Care's case (supra) and I have also extracted the position of law laid by this Court on almost identical facts in VICCO Laboratories case and Colgate Palmolive's case, it is not necessary to consider any other judgments for disposal of the present interim relief application. A perusal of two competing products as per the plaintiff's contention reveals as follows:

-----					No.
Colgate	Dental	Cream	Ajanta	Dento	White
-----					a.
Carton is predominantly red, white					Carton is predominantly red, white and yellow and yellow

b. Bright yellow slicker like devices Bright yellow sticker like devices contain square shaped promo flashes contain square shaped promo flashes in red and blue on two panels of in red and blue on two panels of carton. carton.

c. On the yellow promo flash, the words On the yellow promo flash, the words "Special Offer" are written in yellow "Introductory" are written in yellow colour superimposed on a red ribbon colour superimposed on a red ribbon like patch. like patch in a similar position as the CDC pack

d. On the yellow promo flash "for 50g" On the yellow promo flash "50 g" is written in white colour written in white colour superimposed superimposed on a dark blue on a dark blue rectangular narrow rectangular narrow patch. patch.

e. In the yellow pramo flash the price is In the yellow pramo flash the price is

written in red colour with a shadow written in red colour with a shadow effect. effect.

f. On the front panel "Now Calcium + On the front panel "With Calcium + Minerals" is written in yellow colour. Sorbitol" is written in a yellow patch.

g. Swirl device in blue and yellow on Swirl device in grey and blue on all all panels. panels.

h. The mark "Colgate" is written in The mark "Ajanta" is written in white white colour with a shadow colour with a shadow embossed embossed effect on a red background effect on a red background

i. "Strong Teeth" written in a slightly "Dento White" is written in a slightly italicised font in white colour placed italicised font in white colour placed to the left of the yellow promo flash to the left of the yellow promo flash

j. The printed carton has a high level of The printed carton has a high level of gloss gloss

k. Carton shows a muscle tooth device Carton shows a similar device of on one panel. muscle tooth on one panel.

l. Four benefits of using the toothpaste Four benefits of using the toothpaste are written in white on one panel next are written in white on one panel next to small squares with blue tick marks to small squares with blue tick marks inside the squares. inside the squares.

m. The reverse/declaration panel shows The reverse/declaration panel shows the MRP and the Mfg date written the MRP and the Mfg date written vertically while the remaining vertically and the remaining declarations are written horizontally declarations are written horizontally

n. The front panel of the tube is a lamy Tube is a lamy tube with a white tube with a red plastic cap with plastic cap with striations. striations.

48. In considering the plea of passing off, I have only referred to the registered mark registered vide trademark registration No. 190279 and trademark registration No. 319139 averred in the plaint and annexed thereto but have not referred to several variations adopted by the defendants.

49. In the plaint, the plaintiffs have contended that they have amended the get up of the carton for "Colgate Dental Cream" by adding a swirl or pincer device on the left corner of the panels of the carton. They have also contended that a patch of yellow colour was added on the panels and on the visible flaps of the carton. However, the red and white combination was retained in the amended version of the carton.

50. The plaintiffs have further contended that they have made corresponding changes in the get up of the "Colgate Dental Cream" tubes by adding yellow

colour in the shape of strips and bands with slogans imprinted in blue and white colour upon them. Thus, the aggregate impression of the packaging of the plaintiff's product is a combination of red and white colours with a bit of yellow and blue and this, combination according to the plaintiff's is unique to its mark.

51. However, if one takes a look at the carton of the plaintiffs comprising of registered trademark 190279, it shows that the word "COLGATE" in white on a red background i.e. the "red and white" combination still remains the predominant feature of the plaintiff's mark even in the altered marks and the addition of a swirl or pincer device in blue or a splash of yellow colour do not alter this predominant feature giving the plaintiff's mark a distinctive identity entitled to protection from passing off.

52. After taking into account the similarities in the defendant's product which has been registered by comparing it with the plaintiff's registered mark, I am of the view that in respect of the competing two products, there is sufficient resemblance between the plaintiff's and the defendant's product to justify the plea of passing off. This is illustrated by the following similarities:

(i) The adoption of a red coloured background by the defendant to the similar extent as that of the plaintiff on the front panel of the carton.

(ii) The adoption of white colour for inscribing the brand name AJANTA is similar to the brand name "COLGATE" which is also inscribed in white colour.

(iii) Similarity in the size of the two brand names "COLGATE" and "AJANTA".

(iv) Similar placement of the two brand names "AJANTA" and "COLGATE" on the front panel of the carton.

(v) The plaintiff being the established market leader had already established a market reputation in respect of its red and white product marked "COLGATE".

(vi) The nature of goods in respect of which the two marks "COLGATE" and "AJANTA" are used as trademark are the same i.e. toothpaste.

(vii) Toothpaste is a fast turnover item and an intending purchaser who may or may not be literate is not likely to bestow much attention on a daily use product such as a toothpaste.

53. The above noted factors do show that the defendant's get up is inspired by the plaintiff's product. The toothpaste markets have purchasers from all strata of society and having various levels of education and awareness and they may not notice the difference in the brand name and are likely to get influenced by the overall packaging and get up of the two cartons. This possibility is heightened by the fact that toothpaste is a high turnover consumer item where a purchaser is unlikely to bestow adequate attention to the product.

54. In VICCO Labs" case (supra) once the cartons and tubes were found to have a similar get up and colour scheme for a similar product i.e. a face cream, then

the mere fact that the defendant's product, which was a later entrant into the market, bore the mark "COSMO" as opposed to the plaintiffs' mark "VICCO" was not held sufficient to deny the plaintiff an injunction on the ground of passing off. Similarly in Colgate Palmolive's case (supra) it has been also held by this Court that a substantial reproduction of the packaging of an established product not only causes confusion but also the dilution of the distinctiveness of the prior established product. In my view, the plaintiffs' product being a prior product as a cumulative result of the features summarized above would have been entitled to protection against the defendants' product from passing off. The plaintiffs have also claimed interim relief for infringement and passing off in respect of the packaging which has undergone changes from time to time by addition of features such as swirl/pincer device, eye-catching yellow and blue splashes, placement of prominent features such as yellow promotional slickers, USP, price in bold white and dark outlines. I have not considered the relief of passing off in respect of the altered mark in the present order. Firstly, in so far as infringement is concerned, the prayer in the plaint itself confines it to Regn. No. 190279 and 319139 and consequently the relief for infringement cannot be considered beyond the two registrations noted above. In so far as the relief of passing off in respect of the alterations to the originally registered mark is concerned it is also not being considered in this judgment. This is due to the fact that details of when the additional features were incorporated and thereafter copied and adopted by the defendants have not been given in the plaint.

55. However, during the course of the arguments, suggestions were invited from the parties and the parties have given their suggestions for alternate packaging. In my view the suggested carton of the defendants which is marked as "XX" would not amount to passing off of the plaintiff's product as per the principles laid down in the above noted judgments. The only change made to "XX" given as sample by the defendant is that it will be required to print AJANTA in Hindi also in golden colour. The said carton is reproduced as under:

56. These differences enumerated under between the plaintiff's registered mark and the defendant's altered and approved label marked "XX" are sufficient to avoid any confusion:

(a) The defendant's mark "AJANTA" is inscribed in Golden colour while the plaintiff's mark "COLGATE" is inscribed in white Colour.

(b) The defendant's carton has a splash of white colour on the left hand side.

(c) The price of the product is written in red colour with the splash of white colour in the background.

(d) On the right side of the defendant's carton "XX" carton, there is a splash of blue colour and SHINY white TEETH DENTO WHITE TOOTHPASTE is inscribed on it in white colour.

57. Consequently, the defendants are hereby directed to inscribe the above mark

"AJANTA HEALTH" shown in Hindi along with the two swirls on left and right of the said mark in Golden Colour in the instead of the colour white as shown in Carton "XX".

58. The findings in this judgment can be summarized as follows:

(i) The Trade and Merchandise Act, 1958 i.e. the Old Act applies to the present case by virtue of Section 159(4) of the Trade Marks Act, 1999 i.e. the New Act, which provides that the legal proceedings pending at the time when the New Act came into force, will continue as if New Act had not been passed. Since the legal proceedings were instituted on 24th March, 2003 and the New Act was enforced on 15th September, 2003, the New Act does not apply to the facts of the present case.

(ii) The word "limitation" u/s 10 of the Old Act does not mean a limitation imposed on the person seeding the registration of the trademark. Thus, the limitation of the right to one or more colour scheme u/s 10 of the Old Act cannot be considered to be diluted or limited within the said colour scheme.

(iii) As evident from the Register Trade Mark Details for 190279, registration of trademark u/s 10 of the Old Act was of the word "COLGATE" in white colour on the red background and not the red and white colour scheme alone. Thus the essential feature of the plaintiffs' mark is "COLGATE" inscribed in white colour on a red background and not red and white colour combination alone. Thus, the adoption of the mark "AJANTA" written in white colour on a red background does not constitute infringement by the defendants of the plaintiffs' mark.

(iv) Red is a basic colour and the red & white colour combination is common to the tooth paste trade in the domestic as well as the international market and cannot be monopolized by any party.

(v) Judgments of the Hon'ble Supreme Court cannot be held to be per incuriam by a Single Judge of the High Court.

(vi) The defendants are liable to be enjoined for passing off since there was sufficient resemblance between the plaintiffs' and the defendants' product.

(vii) In view of the altered packaging suggested by the defendant marked "XX" there would be no passing off once the product is marketed by the defendants as per the approved packaging. Substitution of "gold" for "white" in the Hindi inscription "AJANTA HEALTH" & the swirls surrounding the Hindi inscription is to be incorporated in packaging marked "XX".

59. In terms of the aforesaid order, interim relief injunction application stands disposed of & the interim order is modified & the defendants are permitted to market their product provided it is as per packaging "XX" modified by this order to the extent of the addition of "Ajanta Health" in Hindi in Gold on the packaging marked "XX". Let the suit be listed before the Judge in charge, Original Side for further orders on 4th November, 2005.