
(2015) 09 BOM CK 0081

In the Bombay High Court

Case No : Notice of Motion (L) No. 1824 of 2015 in Suit (L) No. 696 of 2015

Faber-Castell Aktiengesellschaft and Others

APPELLANT

Vs

Cello Pens Pvt. Ltd. and Others

RESPONDENT

Date of Decision : 03-09-2015

Acts Referred:

Citation : (2016) 1 BomCR 129 : (2015) 3 MIPR 57

Hon'ble Judges : G.S. Patel, J

Bench : Single Bench

Advocate : Venkatesh Dhond, Senior Advocate, Rashmin Khandekar, Hemant Thadhani, Rahul Dhote and Minesh Andharia i/b Krishna and Saurastri Associates, for the Appellant; Himanshu Kane, N. Pendsey, Bhavin Shah and Bhavya Mohan, instructed by AZB and Partners, Advocat

Judgement

G.S. Patel, J—The Plaintiffs and the Defendant¹ are fighting over crayons.

2. According to the Plaintiffs, Faber-Castell AKG and A.W. Faber-Castell (I) Pvt. Ltd. (together, "Faber-Castell"; separately "Faber-Castell AKG" and "Faber-Castell India", respectively),² they have since 2010 marketed in India through the 2nd Plaintiff a set of 24 crayons in quite luscious colours, of a distinctive type and in unique packaging. Faber-Castell says that the Defendant, Cello Pens Pvt. Ltd. ("Cello"), has not merely copied every single aspect of the Faber-Castell product "down to the last millimetre", as Mr. Dhond who appears for them puts it, but have infringed Faber- Castell's design. The cause of action in the suit is in design and copyright infringement combined with a cause of action in passing off.

3. The Notice of Motion was first moved quite recently, on 9th July 2015. Since then a very large number of Affidavits have come to be filed. The paper-book in the Notice of Motion alone is now over 647 pages and has gone to the stage of a Sur-Sur-Sur- Rejoinder. Despite this volume and bulk, the issue is narrow, especially because Mr. Dhond limits his application at the final hearing of this Notice of Motion to his cause of action in passing off. The rest, as he quite correctly says, can await the trial.

4. Mr. Dhond places his case thus: First, the Plaintiffs' product has a unique and novel shape. By this he means the triangular or three-sided shape of the 24 crayons in the package, as also the presence on all three faces of the crayon's shank of two parallel lines of tiny protuberances or raised dots. Whether these are purely functional to provide a better grip as Mr. Kane for Cello claims, or whether these dots are what is described in this branch of the law as "capricious" is a matter to which I will turn shortly. The second aspect to Mr. Dhond's argument is the manner in which the crayons are presented in a tray, i.e., in two subsidiary recessed trays facing each other and set in a larger outer container. Given that the crayons all also have sharpened points - and the fact that they are sharpenable and erasable is also said to be distinctive - when placed like thus, these crayons look nothing so much as vibrantly coloured missiles in antipodal silos: one battery of these crayonmissles faces the other across the demilitarized zone of shallower recesses (ditches, in our martial analogy) that hold, predictably, a benign eraser and a useful sharpener. The larger container tray, in stealthy black plastic, slides out of a colourful carton, one that is predominantly red. The carton itself has two fenestellae through which the inner contents are partially visible. There are, in addition, certain elements to the packaging itself, i.e., its predominantly red colour scheme, the scattering of logos and icons on the package, and so on. My military parallels notwithstanding, this is a bright and cheerful package such as would certainly entice and excite a young child: the packaging is vivid and eye-catching, and the crayons are - there is no other word for this - gorgeous. They have a sheen to them that other rival products lack. At a single glance, they evoke even in the adult mind memories of a simpler, kinder, less complicated time.

5. The outer packaging is, however, by now of little consequence since Mr. Kane states that Cello's outer packaging has been withdrawn from the market and an entirely new and dissimilar packaging has been, or is about to be, introduced. The annexure to this order, provided by Mr. Dhond, has representations of the competing products in a tabulated comparison.

6. Faber-Castell AKG is a very old company. It was established in 1761. It is widely renowned for its range of quality writing products and instruments: pencils, both normal and mechanical or automatic, coloured pencils, crayons, pens, inks and so on. Its sets of colour pencils and crayons have been available overseas for many decades. Faber-Castell India launched this set of crayon products in India in July 2010. Mr. Dhond points out that in the four or five years since the launch in India, Faber-Castell has had a total sale of nearly Rs. 5 crores of these crayons. There is a tabulation set out in the plaint itself³ and a statement certified by the Chartered Accountants is also on file.⁴ In addition, the Plaintiffs claim to have spent nearly Rs. 50 lakhs on publicity and promotion.

7. Faber-Castell says that Cello's rival products, though apparently manufactured in January 2014, entered the domestic Indian market for the first time only in September 2014. At that time, Cello's products was sold in the

packaging that has now been discontinued (in May 2015). The product line itself, however, continues to be offered although in a different container. Cello is itself no neophyte or upstart in the field. It has been in existence since 1995. It makes a wide range of stationery and writing instruments. It has high volumes in sales. In July 2014, Societe Bic ("Bic"), the well-known French writing instruments and stationery manufacturer, acquired a 75% stake in Cello's writing instruments business. Bic itself makes a range of products from stationery to lighters, shavers and more.

8. Mr. Dhond is careful to point out that Faber-Castell AKG has itself for a considerable period in the past made and sold pencils and automatic or rotating pencils with the same features of parallel lines of surface dots, or in a triangular form, or both. He claims, however, that since 2010, Faber-Castell India is the only domestic manufacturer and vendor of this type of crayon products in India. The product as sold in this form, with these features, and in this packaging has in that time come to be associated uniquely with Faber-Castell. The promotional material indicates, he says, that there are four key elements to the products: their triangular shape, that they are erasable; that they are sharpenable; and that they have a non-slip grip. The arrangement of these crayons in a particular fashion in a tray is also, he says, unique and novel. Mr. Dhond is careful to point out that he does not claim any monopoly on the triangular shape itself, nor in the existence of some form of surface roughening to provide a better grip, or even in the erasability or sharpenability of the crayons. What Faber-Castell does claim is that the combination of all these facets in this particular manner and presentation goes beyond the merely functional. It is entirely aesthetic and novel, and certainly unique to Faber-Castell and no one else. One look at the product identifies it instantly as a Faber-Castell offering. When, therefore, Mr. Dhond speaks of a "novelty in shape and configuration", I understand him to mean by this both an aesthetic or an artistic shape and design or, more usefully for our purpose, something that is entirely "capricious". It was, for example, entirely possible for Cello to array its crayons in a single file. Others have done just that. Yet others have placed them in quadrants. It was possible for Cello to make crayons of an entirely different length or thickness, and to provide another, equally functional yet aesthetically distinct, non-slip surface. Mr. Dhond urges that merely because a certain feature also serves a functional purpose, this does not by itself eclipse its aesthetic or novel qualities. It is one thing if the feature is only functional and has no discernible aesthetic, unique aspect. At the other end of this legal spectrum lies a feature that is wholly non-functional, that is to say, purely aesthetic. Somewhere in between lies a design that is at once functional in its purpose and entirely aesthetic and novel in its realization of that functionality. Pure function is at one end of this scale. Pure form, with no element of functionality, at the other. The battleground is in the space between. The same functionality, he says, may be realized in a variety of forms, and it is a particular form that is adopted that can be said to be unique, not its underlying functionality. He points out that other manufacturers also make non-slip crayons,

or ones that claim to provide a good "grip", but they use an entirely different aesthetic method of achieving this. Some provide ridges. Others use a raised spiral, like ivy climbing a trellis stem. In some, the shank itself is cylindrical.

9. Cello's product, he says, bears an unholy resemblance to the Faber-Castell product. This is no mere copy. This is a wholesale passing off of Cello's product as that of Faber-Castell's. The rival product is complete piracy, the most slavish imitation imaginable. There is absolutely no method to distinguish between the two except this: that the words Faber-Castell and the miniscule logo embossed on one face of the triangular shank of each crayon of Faber-Castell's set are missing in Cello's. Rotate the crayon's shank to the next face and neither product can be told one from the other. Given the target audience, viz., children, the chances of confusion are not just exceedingly high: they are certain. This is not a case of a "similarity" or "deceptive similarity". The two products, Mr. Dhond says, are indistinguishable. It is Mr. Dhond's case, as indeed it must be in a case of passing off, that not only have Faber-Castell's products acquired a significant reputation and standing in the market but they have also acquired a secondary significance in that they are at once visually identifiable as those of Faber-Castell and of Faber-Castell alone. The Plaintiffs themselves have won several awards for their products; some details are set out in the plaint.

10. According to Mr. Dhond, Cello's case on affidavit seems to be this: that it is nothing more than a serendipity that its products come to have exactly the same shape, features and configurations as Faber-Castell's. Cello claims that each of these features - the triangular shape, the raised dots, the sharpenable aspect, the erasability, the alignment in the trays, the dress and so on - are all matters in the public domain. Cello has only put all of this public domain matter together. It is only coincidental that the end result of Cello's efforts just happens to mirror Faber-Castell's. A more dishonest defence, Mr. Dhond says, and I think quite correctly, is difficult to conceive. This seems to me an egregious case of passing off. It is true that there are products in the market that have crayons but none are the kind of exact replica of Faber-Castell's products that Cello makes.

11. Mr. Kane for Cello charges Faber-Castell with suppression: the plaint carefully omits mention of the crucial fact of prior publication of Faber-Castell AGK's designs of this very nature in respect of writing instruments and of these crayons themselves. This suppression is material, he submits, because each of the elements to which Mr. Dhond refers is purely functional and not a "capricious" addition. If there is in fact prior publication, in Mr. Kane's submission, then the case of infringement of design cannot be sustained, especially at an interim stage; and it is then not permissible for Faber-Castell to allege only passing off in the manner that they now seek to do. They must show that they have acquired a reputation and goodwill and such exclusivity in the features to which Mr. Dhond alludes that the product refers to, and only to Faber-Castell. It must show that the matters sought to be protected are neither purely descriptive nor purely functional. In addition, Faber-Castell has the task of showing that despite the

existence of several distinguishing marks, confusion is inevitable or has in fact actually occurred.

12. A word first, about this term "capricious", one that I have used three times already. It is, as I understand, a term of art in the field. It is today carried forward from the judgments of several decades ago, and I believe it was first used in a stricter and more formal, even antiquarian, sense than we are wont to do today. It meant then "fanciful" or "witty", a usage now obsolete.⁵ Today, it connotes a conduct or act that follows no predictable pattern, determined or marked by whim rather than reason.⁶ Its many synonyms show our understanding to be of significant negative implications: arbitrariness, whimsy, unevenness in dealing, unpredictability, impulsiveness, fickleness, erraticism; being volatile, unstable, temperamental.⁷ In the context of design law, it means none of these things. It does not mean frivolous, flippant or facetious. It means, at least in my comprehension of it, simply something that is not purely functional; a triumph of form over function, perhaps. It speaks to the existence of an aesthetic or artistic appeal in a design as opposed to one that serves only a functional purpose.

13. It is in this context and with this interpretation that I propose now to examine one of the rival elements a little more closely. This is the series of dots that embellish the three flanks of each crayon's shank. Mr. Kane would have it that these raised dots are only functional, and the matter ends at that. I do not think this is correct. This over-simplifies what Faber-Castell's crayons have on them. There are two parallel lines of dots upto about two-thirds of the length of each of the three flat planes of each crayon's shank. The remaining one-third length on two of the three planes is bare. On the third flank, after the parallel lines of dots, is a miniscule Faber- Castell logo and then the words "Faber-Castell". This logo and name are missing in Cello's crayons. But it is not the logo or the name that matters; they are not the only artistic elements here. So too are the twin parallel lines of dots. There is nothing to suggest that the functionality of a better grip is afforded by or only by this twin series of parallel lines of dots and of such parallel lines extending only to this specific extent or length. Indeed, the suggestion, as far as I can tell, is that any sort of disruption in the smoothness of the crayon's shank should assist, to greater or lesser degree, in providing a better grip: a groove, perhaps, or a spiral ridge, a rifling and so on. There may be other functionalities that serve this purpose too: a movable flange, perhaps, or a single line of large raised dots, crenellations, embrasures, or philtrum-like scoops.

14. This question - whether an exact replica made by a defendant can be permitted to continue in such a case - has frequently occupied courts both here and abroad. It is an accepted position in law that mere copying is not passing off. That however is not the case that Mr. Dhond makes when he cites the decision of the Chancery Division in *Jones v. Hallworth*. 14 RPC 225 The issue before that court related to bundles of polishing cloths and the Court posed the question in

precisely the manner that it arises here: would an ordinary, unsuspecting and unwary purchaser intending to buy a box of crayons that he knows is manufactured and sold by Faber- Castell, be induced to buy, or even by inadvertence buy, the rival product by Cello in the belief that it was manufactured and sold by Faber-Castell? If the answer to that question is yes, then Mr. Dhond is undoubtedly entitled to an injunction. In matters such as this, as the court in *Jones v. Hallworth* held, ultimately it is the perception of the court that turns the tide. Like beauty, it lies in the eye of the beholder. Unlike beauty, a matter entirely subjective, a judicial perception is supposedly more objective. That, as far as I can tell, is about the only difference.

15. I have seen the two rival products. I have also incidentally seen a number of other crayon boxes, but I will come to that a little later, as that is yet another limb to Mr. Dhond's argument. Between the two rival products, there is, in my perception of it, no distinction at all. Indeed, I should find myself in the greatest of difficulty if asked to tell one from the other and would have to examine each very closely indeed to be able to draw any distinction. There is a passage in *John v. Hallworth* that merits reproduction not only for the mellifluous language in which the legal proposition is expressed but because it seems to me to place with unerring accuracy the very proposition that Mr. Dhond canvasses today.

"... I only refer to it as showing what the difficulty is; because there, the Court of Appeal, consisting of three learned Judges, all thought - their three pairs of eyes all thought - that the similarities were supreme, as the differences were of little moment. The difficulty of the task imposed upon the Judge consists in what I have stated. One has to go through a certain process of induction; because in no case that ever I tried and in no case that I ever heard of was it not possible for the Defendant to say, "I am perfectly at liberty to make this article; I am at perfect liberty to call it so-and-so; I am perfectly at liberty to attach to it such-and-such a name," and so on to the end of the chapter. If you take - as, of course, Mr. Bigham, as an advocate, did take - the points of similarity in detail, it is often not very difficult - sometimes it is extremely easy - to show that in all those points of similarity the Defendant is perfectly right and has played the part of an innocent man. That applies directly to this case. No one contends that the Defendants are not entitled to manufacture and sell polishing cloths; nobody contends that they are not entitled to manufacture and sell polishing cloths of certain sizes, or to impress thereon by printing or otherwise certain words; nobody contends that they are not at liberty to make these of Egyptian or American cotton, and, if they make them of Egyptian cotton alone, or of Egyptian and American cotton mixed, not to produce them of a certain colour. Nobody contends that this fact pile velveteen is not open and common to the trade and suitable to the particular article; that it may not be singed; that it may not be scoured. All those things are perfectly common to the trade; every one of them may be done with perfect innocence. But, by an inductive process, one may come to this conclusion, that every one of those perfectly innocent things when combined in a series may produce something which is the reverse of innocent."

(Emphasis supplied)

16. This is true of the present case as well. There is no reason, for instance, if, as Mr. Kane insists, the twin lines of raised dots are purely functional, they should not extend the entire length of the shank but should instead stop precisely at the point where Faber- Castell has chosen to stop them, leaving space for their logo and name. Indeed, I imagine I should have to subject the crayons to the most detailed examination and even then I might not be able to tell: I would not know, for instance, if in looking at the Cello product, Faber-Castell, in its corporate or marketing wisdom, had decided to put out crayons that did not bear its logo or name imprinted on the shanks. I would have to imagine for myself that that which is not is an indicator of a differentiation. Of what might the then "missing" Faber-Castell logo and name be indicative: proof of absence or absence of proof? This is no idle speculation: if we rotate any of the Faber-Castell crayons exactly one-third of a turn and set it side by side with the Cello crayon of the same colour, this is very much the dilemma that confronts us. In neither product do we then see the Faber-Castell logo nor the name. How would we tell one from the other? If the answer to that is that the "dots" in the Cello product are somewhat squarer than those in the Faber-Castell crayons, then that is surely too insignificant a distinction to be of any consequence.

17. Our own Courts are no strangers to these cases. Mr. Dhond, not unexpectedly, cites the decision of a learned Single Judge in M/s. Whirlpool of India Ltd. Vs. M/s. Videocon Industries Ltd., (2012) 5 ALLMR 691 : (2012) 114 BOMLR 2818 : (2013) 1 MhLj 197 : (2012) 52 PTC 209 That was a battle of washing machines. There, as in the present case, the argument was that the features sought to be protected were purely functional and lacked all redeeming aesthetic or non-functional aspects. Mr. Justice Kathawalla dealt with this argument:

"In such cases, the conundrum of functionality is resolved by taking note of the fact that it would make no impact on the article's functionality, if the function could be performed by the use of another shape as well. The fact that there are umpteen number of shapes in which washing machines are sold clearly shows that the external shape has nothing to do with the function sought to be performed. In the present case, it surely cannot be argued that the constraints of functionality were such that the Plaintiff's design was the only design which could have been devised. Since the external shape of the Plaintiff's washing machine has nothing to do with the function it performs and since the Plaintiff in the present case is seeking enforcement of its entire design and not an individual component thereof, the case law cited by the Defendant in support of its defense attributing features of the Plaintiff's design to functional requirements, has no bearing on the present case."

(Emphasis supplied)

18. This finding in Whirlpool is, in my view, exactly applicable to Mr. Dhond's

case. As I have noted it is not sufficient for a defendant to say that all that it has done is to take one aspect of its product from one source, another from another source and so on "to the end of the chapter" till they have, by the most curious but unexplained coincidence, arrived at a product that is so completely indistinguishable from that of the plaintiff seeking protection. What Mr. Dhond seeks to protect is not only this or that feature. It is the aggregate or concatenation of the very many features, big and small, brought together in a unity identifiable as that of Faber-Castell.

19. Mr. Kane submits that unless the features themselves are shown to be artistic embellishments bereft of any functional element, no protection can be granted. The mere copying of a shape or the mere replication of Faber-Castell's tray, crayon, triangular shape, sharpened point or erasable quality is not in itself sufficient. Others have sharpenable crayons in the market, he says and points to certain illustrations annexed to the Affidavit filed by the Defendant. Yet others have crayons that are erasable. And there are even those that have both, and some that arrange them in a tray with individual holding racks. I believe this argument to be disingenuous and, to the extent that it is based on *Benchairs Limited v Chair Centre Ltd.*, 1974 RPC 429 more than somewhat misplaced. Apart from anything else, the portions in the report emphasized by Mr. Kane are from the decision of Graham J, sitting singly. The appellate decision, by Russell LJ for the Court, allowed the appeal with costs.

20. As I have noted the Whirlpool decision itself considers a situation where a particular feature or element has both form and function. The existence of function if combined with form does not disentitle it from all protection altogether. Indeed in the decision cited by Mr. Kane it was held that when a defendant does something further to suggest that the articles that he sells are those of the plaintiff and even if he does so by indirect representation such as by imitating a get up by enclosing the articles in a distinctive package similar to that of the plaintiff, the plaintiff would be entitled to an injunction. The word "get up" itself is explained as something that is, to use the word again, capricious and as I have already explained this does not mean arbitrary or frivolous. It means something that is fanciful or an embellishment.

21. Another learned Single Judge of this Court (Dr. D.Y. Chandrachud J as he then was) also considered this issue in *Gorbatschow Wodka K.G. Vs. John Distilleries Limited*, (2011) 4 ALLMR 374 : (2011) 4 BomCR 1 : (2011) 4 MhLj 842 He reiterated the well settled principles that a Court must have due regard to the overall impact of the rival marks or goods and that the law recognized the importance of the shape in which a trader chooses to sell his goods. A considerable amount of authority was discussed, including, I must note, a decision of another learned Single Judge of this Court⁸ in *M/s. Kemp and Company and another Vs. M/s. Prima Plastics Ltd.*, (1999) 1 ALLMR 64 : (1999) 1 BomCR 239 I only note this because Kemp and Company is a decision on which Mr. Kane relies. In *Gorbatschow Wodka KG*, Chandrachud J held that the test is

whether the shape adopted by the plaintiff is "capricious", meant purely to give the article a distinctive appearance and characteristic of that particular manufacturer's goods. Secondly, he held that a conscious imitation by a defendant of the various constituent elements that go into the uniqueness of the plaintiff's product must lead to a conclusion that confusion and deception are both, respectively, inevitable and intended.

22. I also do not see how the decision in *M/s. Kemp and Company and another Vs. M/s. Prima Plastics Ltd.*, (1999) 1 ALLMR 64 : (1999) 1 BomCR 239 can be said to be of any possible assistance to Mr. Kane. Citing *Copinger and Stone James on Copyright*, the Court held that a mere copy is not per se a false representation. The plaintiff must show more than a mere copy or a mere similarity. Where an article is fashioned in an unusual way to lend it a distinctive appearance characteristic of one party's product range and that party can establish a reputation acquired over some appreciable time, then putting a virtually indistinguishable copy or replica of it in the market complete with these uniquely identifying and distinguishing features would amount to a misrepresentation that the rival product too emanated from the claimant.

23. There is then the decision of another learned Single Judge of this Court⁹ in a case that concerned Faber-Castell AKG itself: *Faber Castell Aktiengesellschaft v. Pikpen (P.) Ltd.* 2003 (27) PTC 538 (Bom) It was in relation to Faber-Castell's highlighter or text liner markers. Bobde J set out the unique features of the plaintiffs' product. After considering the various provisions of law, he granted the injunction. While doing so, he considered certain defences that have echoes in the defences taken by Mr. Kane before me. One of these defences taken before Bobde J was that the design was previously published. In that case, of course, the submission was that the design registration was liable to be cancelled. This is precisely Mr. Kane's formulation here and a statement is made that Cello has indeed filed an application for cancellation as well. That is a separate matter that will take its own course but that is not in itself a reason to deny relief on the ground of passing off if a sufficient cause has been made out. Bobde J also addressed the question of whether the plaintiffs' goods taken as a whole could be said to have nothing so distinctive about them as to uniquely identify them as goods of the plaintiffs. The two products - the Faber-Castell highlighter and the Pikpen highlighter - were compared as a whole. The court returned a finding that Pikpen was attempting to pass off its goods as Faber-Castell's. Having regard to the unique features of Faber-Castell's products in the present case, I find I am unable to arrive at an answer different from that of Bobde J.

24. There are several other cases in this same vein. I do not think it is necessary to multiply authorities.

25. The previous discussion already establishes that Cello's use of the twin parallel dotted lines to two-thirds of the length of each flank of the triangular crayon's shank is entirely an artistic element unique to the Plaintiffs. There is no reason at all, and nor is there any material before me to suggest that the only

way to provide a sure grip is to have just this set of dots in two parallel lines to just this extent.

26. I also believe Mr. Kane slightly misunderstood Mr. Dhond's submission on a transborder reputation. All that Mr. Dhond sought to suggest was that while the crayons in question entered the market in India in 2010 they had long been so produced, had enjoyed a reputation for excellence, and were also known for their unique characteristic in overseas markets. *Smithkline Beecham Plc. and Others Vs. Hindustan Lever Limited and Others*, (2000) 52 DRJ 55 I do however find Mr. Kane's citation of a passage from Halsbury's Laws of England, 5th Edition (2014) to be of immense relevance, though perhaps not in the way Mr. Kane intends. Paragraph 306 of that text makes it clear that mere copying is not actionable in the absence of misrepresentation in English Law. So long as the goods are sufficiently distinguished by other means, the reproduction of one person's product will not enjoy protection and no order or injunction in passing off will result. The task, therefore, is to assess what is it in the defendants' product that might lead a purchaser - and in this case I am acutely aware that our quidam purchaser might be an reluctant or unwilling parent attempting to pacify a particularly petulant child - from being able to tell the Cello's products from Faber-Castell's. Left to myself, I could not tell the difference. I very much doubt that the harried parent would. To say then that there is this or that distinguishing feature which is minor and indiscernible - there is in fact such a minor difference even in the price, no more than Rs. 10/-, just to add to the already existing confusion - or that there are certain features that are common to the trade and it is only these that have been used, is I think no answer at all when one finds that every single feature that is being used in a unique fashion by Faber-Castell in creating their products has been replicated, as Mr. Dhond put it, down to the last millimetre, in Cello's product. This is an exact fit with the *Jones v Hallworth*, *Whirlpool* and *Pikpen* tests. Indeed, other than the embossing of the Faber-Castell name and logo on one face of the triangular crayon, I do not see how at a visual glance anyone would be able to tell one product from the other. To adopt one feature may be happenstance; two might be coincidence; to replicate them all, Mr. Dhond insists, and I think with some considerable justification, is, if not actually enemy action, certainly deserving of an injunction.

27. There is in *Jones v Hallworth* a passage that is remarkably close to this case:¹⁰

Now, it is a strange accident, to begin with, that, the Plaintiffs having produced these polishing cloths in five sizes, the Defendant has produced his polishing cloths in the same five sizes. I know that he has since produced a sixth, and Mr. Hallworth has told me that the sixth has been the most successful. That appears to be only of late date, and, bearing in mind what he says, that he has not had a large sale at all of any, I do not think that that comes to a matter of very great weight. But for a long time, at any rate, until arrangements were made for producing a different size, the Defendant produced precisely the same five sizes

as the Plaintiff produced. Now, is that an accident, or is it intentional?

(Emphasis supplied)

28. The last question that remains is whether the Plaintiffs would be entitled to an injunction and whether, in other words, monetary compensation might suffice, and where lies the balance of convenience. I believe this question answers itself. The longer these rival products remain in the market, the greater the continuing and ongoing, and perhaps incalculable loss to Faber-Castell and to the market they have built up. In my view, the injunction must follow. The preservation of the status quo demands it.

29. In view of the fact that Mr. Dhond does not press prayer clauses (a) and (b), because the Defendants have changed the outer packaging colour combination and art work, there will be an injunction in terms of prayer clauses (c) and (d), which read thus:

"(c) that pending the hearing and final disposal of the suit, the Defendants by themselves and/or through their servants, agents, dealers, manufacturers, directors, partners, owners, proprietors and/or otherwise howsoever be restrained by an order and injunction of this Hon''ble Court from this Hon''ble Court restraining the Defendant by itself, and/or through its servants and agents from using and/or causing to be used and/or manufacturing and/or selling in any manner the impugned product with the impugned trade dress and/or packaging and/or get up being Exhibit H hereto which is deceptively and/or confusingly similar to the trade dress and/or packaging of the Plaintiffs'' product being Exhibit D hereto so as to pass off and/or enable other to pass off their impugned product as and for that of the Plaintiffs;

(d) that pending the hearing and final disposal of the suit, the Defendants by themselves and/or through their servants, agents, dealers, manufacturers, directors, partners, owners, proprietors and/or otherwise howsoever be restrained by an order and injunction of this Hon''ble Court from using and/or applying in any manner the impugned design relating to crayon and/or features of shape and configuration being Exhibit J hereto and/or any other design relating to crayon and/or features of shape and configuration which is/are fraudulently and/or colourably and/or obviously similar in any manner whatsoever to those of the Plaintiffs as shown in Exhibits F and G hereto so as to pass off and/or enable other to pass off the impugned design relating crayon as and for that of the Plaintiffs;"

30. Counsel for Cello seeks a stay of the operation of this order for four weeks. This is opposed by Mr. Dhond and, in my view, rightly. To grant stay would be to permit Cello to continue in the tort. Cello's products do not appear to be in the market today. The application for stay is made on the basis that Cello seeks to "liquidate its existing inventory". That is telling. If ever there was a case to reject an application for stay, this is it: I do not see why a stay of this order should serve as an opportunity to Cello to now flood the market with its rival products in

the guise of "liquidating inventory". The application for stay is rejected.

1The 2nd Defendant, ebay India Pvt Ltd, was directed to be deleted by a separate order. 2The 2nd Plaintiff is the wholly-owned Indian subsidiary of the 1st Plaintiff. 3Plaint, para 18, pp. 10-11 4Motion, p. 341. 5dictionary.com: <http://dictionary.reference.com/browse/capricious> 6Oxford Illustrated Dictionary, 1975 ed.: Guided by whim; inconstant, irregular, incalculable 7The New Thesaurus, Roget's II; Houghton Mifflin, 1980 8R.M. Lodha J., as he then was 9S.A. Bobde J., as he then was 10Supra, at p. 237