

(2012) 07 DEL CK 0226

In the Delhi High Court

Case No : I.A. No. 6010 of 2012 (u/O 39 R 1 and 2 r/w Sec. 151 CPC) in CS (OS) 865 of 2012

Godfrey Phillips India Ltd.

APPELLANT

Vs

Dharampal Satyapal Ltd. and Another

RESPONDENT

Date of Decision : 02-07-2012

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Section 151
Copyright Act, 1957 — Section 14, 2(c), 44
Registration Act, 1908 — Section 48

Citation : (2012) 191 DLT 109 : (2012) 51 PTC 251

Hon'ble Judges : A.K. Pathak, J

Bench : Single Bench

Advocate : Rajiv Nayar with Ms. Prathiba M. Singh, Mr. Sudeep Chatterjee and Ms. Anusuya Mehrotra, for the Appellant; Sudhir Chandra, with Mr. Gaurav Barathi, Anuj Gupta, Piyush Joshi and Mr. Nidhish, for the Respondent

Final Decision : Dismissed

Judgement

A.K. Pathak, J.—By this order I shall dispose of an application under Order 39 Rules 1 and 2 read with Section 151 of the Code of Civil Procedure, 1908 ("Code", for short) whereby plaintiff has prayed that the defendants be restrained from manufacturing, marketing, selling or offering for sale "Tulsi Saada Pan Masala" or any other product using the advertising slogan and campaign "Swad Badi Cheez Hai" or any other slogan or campaign which may be complete imitation of the slogan and campaign of the plaintiff, that is, "Shauq Badi Cheez Hai" so as to result in acts of infringement of copyright, passing off, unfair competition and dilution. Plaintiff has filed this suit for permanent injunction regarding acts of infringement of copyright, passing off, unfair competition, dilution, rendition of accounts/damages, delivery up etc., against the defendants.

2. Plaintiff as well as defendants are engaged in the similar trade. Plaintiff is engaged in manufacturing, marketing, distribution and sale of, inter alia, "Pan

Masala". Plaintiff launched its product "Pan Vilas Pan Masala" sometime in the beginning of the year 2010. Defendants are also engaged in the manufacturing, marketing, distribution and sale of "Pan Masala" under the mark "Tulsi Sada".

3. Plaintiff has alleged that it had engaged an advertisement agency "M/s Meridian Communication Pvt. Ltd.", Mumbai for its brand development, brand launch strategy and conceptualizing and creating the advertisement campaign in the year 2008. The said agency created an advertisement campaign in respect of "Pan Vilas Pan Masala". The slogan "Shauq Badi Cheez Hai" was created as a punch-line in the advertisement. The slogan forms a key element of the plaintiff's promotional activities and advertising campaign and has been displayed at positions of prominence through extensive advertisements in the print media, radio and on television. The slogan is the punch-line of the advertisement of the plaintiff on television which also forms a sizable part of the voice over in advertisements on radio channels as well. Campaign is designed in a manner that it embodies the spirit of connoisseurs who will go to any lengths to fulfill their quest for the best. The campaign features a well known Bollywood actor Manoj Bajpai in the character of a "Nawab" who is extremely particular about the finer things in life such as ironing creases out of newspapers before reading, using German binoculars, attending events with foreign ambassadors and riding antique Victorian bicycles; eventually the advertisements go on to show how his quest for the elusive perfect taste ends with "Pan Vilas Pan Masala" with a voice over of the slogan "Shauq Badi Cheez Hai". The slogan forms the theme of the entire campaign. The advertisements have struck a chord with the consumers and they relate the slogan exclusively to the product of the plaintiff.

4. Plaintiff has invested more than Rs. 25 crores in the advertisements during a short span of two years. The product of the plaintiff has received enormous recognition from the consumers and its sale during the financial year 2010-11 was Rs. 2456.7 lacs and during the year 2011-12 is Rs. 10562.7 lacs. Plaintiff has applied for registration of the slogan with the Trade Mark Registry, in respect of the slogan "Shauq Badi Cheez Hai", in Hindi as well as English language.

5. Plaintiff alleges that it is the proprietor of the copyright in respect of the slogan "Shauq Badi Cheez Hai", which is original literary work of the plaintiff created through an advertisement agency, thus, plaintiff is entitled to copyright protection and no third party has a right to use the same. Plaintiff also enjoys the statutory trade mark rights as well as the common law rights in the slogan "Shauq Badi Cheez Hai".

6. Defendants are the competitors of the plaintiff. Defendants have imitated the various distinctive and key characteristic features and properties of the plaintiff's slogan "Shauq Badi Cheez Hai" with minor variation in respect of their products, that is, "Tulsi Saada Pan Masala". Defendants started using the slogan "Swad Badi Cheez Hai", which is imitation of the plaintiff's slogan and campaign. Defendants have also started airing on television an advertisement that seeks to derive an unfair benefit by copying substantial aspects from the plaintiff's

campaign. Defendants have adopted the similar slogan as well as the campaign to encash the plaintiff's enormous goodwill and reputation in the field. Defendants have also based their campaign expressing the luxurious taste relating to their product. Deliberate and conscious attempt of the defendants to imitate, copy and plagiarise the plaintiff's campaign may be evidenced from the fact that the defendants have copied the punch-line of the campaign in order to obtain unfair benefit. The voice over in the defendants' advertisement has no element of originality and is a slavish copy of the plaintiff's slogan. Defendants have only replaced the word "Shauq" with "Swad" while retaining the slogan. The slogan and the campaign adopted by the defendants are likely to create confusion in the minds of unwary consumers to believe that defendants' product is an extension of plaintiff's product. The imitation is not merely restricted to the slogan but also to various other features which establish that the copying is not merely a coincidence but a premeditated attempt to cash in on the goodwill and reputation enjoyed by the plaintiff. It is alleged that conduct of the defendants constitutes (a) infringement of copyright in the slogan; (b) passing off; (c) acts of unfair competition and (d) dilution.

7. In their reply to the application defendants have denied that the slogan and campaign of the plaintiff has been copied by them. It is alleged that slogan of the defendants, that is, "Swad Badi Cheez Hai Swad Se Badhkar Kuch Nahi Tulsi Saada Pan Masala" is totally different and dissimilar from the slogan and campaign of the plaintiff "Shauq Badi Cheez Hai". Defendants have led comprehensive and complete emphasis on the word "Swad" which is even used twice in the slogan that too along with the name of the brand of the defendants "Tulsi Sada Pan Masala". "Pan Masala" by the defendants is promoted and endorsed by referring it with the rich taste and delectable flavor only and nothing else. The slogan of the defendants is wholly and completely different from the slogan and punch-line of the plaintiff as there is remarkable difference in the contents, style along with the meaning of the two. It is denied that defendants' slogan and campaign amount to infringement of the plaintiff's statutory rights or common law rights. Plaintiff does not possess an exclusive right over the alleged slogan "Shauq Badi Cheez Hai" as the same forms an intrinsic part of the "current language", which is most commonly used in the trade. Such words and expression are not only common but perhaps in a sense, necessary to describe the characteristics or attributes of the product as the product is a "Pan Masala", which is targeted to the consuming market. Defendants allege that plaintiff's slogan "Shauq Badi Cheez Hai" does not fall under the purview of "literary work" within the meaning and scope of the Copyright Act, 1957 (hereinafter referred to as "the Act") therefore, enjoys no protection, inasmuch as, slogans are not protectable under the Act. As per the defendants, they are not guilty of passing off as there is no similarity between the slogan and campaign of the plaintiff, vis-?-vis, defendants' slogan and campaign. The mark of the plaintiff is read/spoken as "Shauq Badi Cheez Hai"; whereas the slogan used by the defendants reads as "Swad Badi Cheez Hai Swad Se Badhkar Kuch Nahi Tulsi Saada Pan

Masala". There is no likelihood of the consumer getting deceived or confused from the two marks since defendants have even used the name of their product "Tulsi Sada Pan Masla" along with the mark "Swad Badi Cheez Hai Swad Se Badhkar Kuch Nahi". It is denied that the slogan of the defendants is imitation of the plaintiff's slogan. Defendants have asserted that the slogan of the plaintiff is neither distinctive nor has any acquired distinctiveness. Furthermore, slogan of the defendants "Swad Badi Cheez Hai Swad Se Badhkar Kuch Nahi Tulsi Saada Pan Masala" does not amount to misrepresentation or likely to cause confusion, thus, question of passing off does not arise. It was also denied that plaintiff has statutory right in the trade mark, that is, the slogan "Shauq Badi Cheez Hai". It is stated that the plaintiff's application for registration is still pending and the mark has yet not been registered, thus, plaintiff has no statutory right in the said slogan, which otherwise is different than the defendants' slogan. It was denied that the defendants have copied the plaintiff's advertisement. It is alleged that the voice over in the defendants' advertisement is not a slavish copy of the plaintiff's slogan. There is no similarity in the advertisement and voice over between the plaintiff's and defendants' advertisement campaigns. Defendants were well established in the trade since the year 1929 and currently is valued at Rs. 1850 crores. Defendants' total revenue only from the "Pan Masala" segment is to the tune of Rs. 500 crores, thus, defendants have not to encash upon the reputation and goodwill of others.

8. I have heard the learned senior counsel of both the parties and perused the entire record including audio, visual and print advertisements.

9. There can be no conflict as regards legal proposition as propounded by the plaintiff's Senior counsel that the registration of copyright is not compulsory for the purpose of enforcing copyright by a party. In *Burroughs Welcome (India) Ltd. versus Uni-Sole Pvt. Ltd. & Anr.* 1999 PTC (19) 188, Supreme Court has held that Section 44 of the Copyright Act, 1957 provides for registration of work in which copyright exists but in order to claim copyright registration is not necessary. This is because registration is only to raise a presumption that the person shown in the certificate of registration is the author. This presumption is not conclusive, but no further proof is necessary unless there is a proof rebutting the contents of the said certificate. u/s 48 of the Registration Act, therefore, the act of registration is ex-facie prima facie evidence of the particulars incorporated in the certificate. There is no provision under the Act which deprives the author of his rights on account of non-registration of the copyright. There is nothing in the Act to suggest that the registration is condition precedent to the subsistence of the copyright or acquisition of copyrights or ownership thereof or for reliefs of infringement of copyrights. In *Frito-Lay India and Others Vs. Radesh Foods and Another*, a Single Judge of this Court has held that for the purpose of infringement a copyright need not be registered.

10. The next question which is to be delved upon is whether the slogans and/or phrases are copyrightable or not. As per learned senior counsel for the

defendants, the slogan "Shauq Badi Cheez Hai" is wholly and totally common phrase and embodies commonly used words in the Hindi language. There is nothing original in this slogan which is not copyrightable. As per Nimmer on Copyright, Article 20.01 (B) at Page 2-15 "words and short phrases such as names, titles and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents are not subject to copyright".

11. Section 2(c) and (o) of the Copyright Act, 1957 define "artistic work" and "literary work" respectively. Relevant it would be to refer to these sections, which reads as follows:-

2(c) "artistic work" means:-

(i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;

(ii) a work of architecture; and

(iii) any other work of artistic craftsmanship; 2(o) "literary work" includes computer programmes, tables and compilations including computer databases;

12. A perusal of the above referred definition creates a serious doubt about slogans being covered under the said definitions. In Pepsi Co. Inc. and Another Vs. Hindustan Coca Cola and Others, a Single Judge of this Court held that advertisement slogans are, prima facie, not applicable under the Copyright Act and they may be protected under the law of passing off in case the plaintiff makes out a case. An appeal was filed before the Division Bench against the said order, which has been disposed of vide judgment titled Pepsi Co., Inc. and Others Vs. Hindustan Coca Cola Ltd. and Another, wherein, the view taken by the Single Judge that the advertisement slogans are, prima facie, not applicable under the Act has not been reversed by the Division Bench even though injunction, which was declined by the Single Judge, has been granted in respect of the commercial advertisement as it was found that the advertisement of respondent has copied the theme of appellant's advertisement. In para 35 of the judgment, it was held as under:-

We were shown the commercial of roller coaster during the proceedings by both parties. By seeing the same an impression which one gathers is that roller coaster of the respondent is a copy of the theme of the roller coaster of the appellant. The roller coaster commercial of the appellant is an original work of the appellant, therefore, covered u/s 14 of the Act. Not only the presence of roller coaster is replica of the appellant's commercial but even the dress of the boys is also similar. Relying on the observation of Apex Court in the case of R.G. Anand Vs. Delux Films and Others, it can, prima facie, be concluded that the roller coaster commercial of the respondent is nothing but a literal imitation of the copyright work of the appellant with some variations here and there. Having

said so we would be failing in our duty by not restraining the respondents from showing its roller coaster commercial in the present form.

13. In *Khemraj Shrikrishandas Vs. Garg and Co. and Another*, a Single Judge of this court in para 8 has observed as under:-

Copinger on Copyright, 11th Edition, in paragraph 230 on page 108 stated that the titles to books, newspapers and periodicals though often coming before the courts on the question of copyright therein are not generally in themselves the proper subjects of this right that it is difficult to say that there is any original literary work in the formation of one or two words into a title and that the words or phrase chosen may be original in their application to the subject matter of the work to which they are applied. Further (in paras 233 and 235 on pages 110 and 111) learned author proceeds to say that titles of books are, in certain circumstances, protected from imitation by means of a "passing off" action...

14. I am of the view that the slogan "Shauq Badi Cheez Hai", being combination of common words, would not fall within the scope of "Artistic/literary work" under the Act. Slogan "Shauq Badi Cheez Hai" does not appear to be an outcome of great skill, inasmuch as, it uses the short stereo type combination of words. In fact, both the slogans, that is, "Shauq Badi Cheez Hai" as well as "Swad Badi Cheez Hai" are commonly spoken in Hindi language in day to day life. That apart, the slogans, in my view, are not copyrightable. Plaintiff can at best press for a passing off action by making out a case in its favor.

15. Plaintiff has relied upon a judgment titled *Chemical Corporation of America versus Anheuser-Busch, Incorporated* 134 USPQ 524. In the said case appellant claimed itself to be owner of the slogan "Where there's life...there's Bud". This slogan was used by the appellant for sale of Budweiser beer. Respondent, a combined floor wax and insecticide manufacturer, started using the slogan "Where there's life....there's Bugs" for its product "floor wax". Court was of the view that the slogan would cause confusion in the minds of the public as to the source of the floor wax product and would damage the "public image" of the appellant by associating in the minds of the public the idea of bugs with a food product. This is what weighed in the mind of the Court while granting the injunction. This judgment is of no help to the plaintiff.

16. As regards infringement of trade mark on the pretext of the slogan "Shauq Badi Cheez Hai" having been applied by the plaintiff for registration with the Trade Mark Registry is concerned, in my view, no statutory right flows in favor of the plaintiff since the mark has yet not been registered. Thus, the plaintiff can at best claim passing off action with regard to the mark/slogan "Shauq Badi Cheez Hai".

17. I do not find any similarity in both the advertisements, which may be sufficient to deceive the unwary customers. Both the campaigns depict different ideas, inasmuch as, the slogans convey different meaning. The advertisement of the defendants is hardly of a few seconds. In the defendants' advertisement only

one stretched hand is shown putting a small tin of "Tulsi Sada Pan Masala" on a table lying in a room, which appears to be a part of a luxurious apartment and/or office, with the background sound uttering slogan "Swad Badi Cheez Hai Swad Se Badhkar Kuch Nahi Tulsi Saada Pan Masala". This advertisement ends with the slogan. In contrast, advertisement campaign of the plaintiff is lengthier and it depicts bollywood actor Manoj Bajpayee as a "Nawab" leading a luxurious life style, living in a palace, reading newspaper after ironing the same in order to remove folds, using German binoculars, attending meetings with foreign ambassadors and hosting parties and riding antique Victorian bicycle etc. This advertisement depicts his quest for perfectionism which ends with "Pan Vilas Pan Masala" with a voice over "Shauq Badi Cheez Hai". Both the advertisements are different and in no manner cause any confusion in the minds of unwary customers which may comprise of persons of all the segments including persons living in far off villages including the illiterate ones; more so, when product of the plaintiff as also of the defendants is clearly visible and noticeable in advertisements, inasmuch as, background sound in the slogan of the defendant also refers to the name of the product "Tulsi Sada Pan Masala" at the end of slogan. These distinguishable features rule out any confusion or doubt in the minds of consumers, to buy the product of the defendants by taking it as that of plaintiff.

18. For initiating a passing off action, plaintiff has to prove that its slogan has acquired such a reputation sufficient enough to connect the product of the plaintiff with the slogan by the consumers. It has to be shown that slogan has become so distinctive of a product that it has acquired secondary meaning. It has further to be shown that the use of such slogan or deceptively similar slogan by the defendant would be sufficient to deceive the customers into thinking that defendant's goods are that of the plaintiff. Passing off is an action in deceit. In *Khemraj* (Supra) a Single Judge of this Court held, thus "that the action for infringement of a trade mark or copyright is a statutory remedy and in pursuing it, the plaintiff must prove his title and exclusive right to use the trade mark (or work) in question and further establish that the defendant has infringed the same by identical or deceptively similar or colourable imitation of it. In such a case, if otherwise established, it is no valid defense on the part of the defendant that it has been sufficiently indicated on the infringing goods that they are not of the plaintiff, but of the defendant. On the other hand, action for passing off is a common law remedy and its gist is deceit and not infringement of a right to exclusive user. In such an action, the plaintiff may, if so advised, prove his title to the exclusive use of the trade mark (or copyright) but he need not do so. What is however essential for the plaintiff to establish are: (1) distinctive features: (2) substantial user and (3) wide reputation. The law casts an obligation on the defendant not to pass off his own goods (or work) as if they had been produced by the plaintiff and the court will enforce this obligation. In such a case, the defendant can escape the liability by showing that his goods (or work), though similar, distinctly indicate that they do not originate from the plaintiff but have

been produced by the defendant. Element of deceit may exist in both kinds of action but it is of the essence of the passing off action. Actual deception is not required to be proved, but reasonable ground for apprehending deception must exist. In *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories*, the Apex Court held that the use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the *sine qua non* in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that 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.

19. Defendants have not adopted the slogan of the plaintiff as it is. Both the slogans convey different meaning. "Shauq Badi Cheez Hai" of the plaintiff conveys passion of a person for good things in life be it clothing, housing, mode of commutation etc; whereas defendants' slogan "Swad Badi Cheez Hai" denotes only to the taste in respect of eatables/food products. Both these slogans convey different meanings making less chances of confusion in the mind of consumers of the products including persons living in the remote areas. The difference of meaning of "Shauq Badi Cheez Hai" and "Swad Badi Cheez Hai" is known to everyone. That apart, a perusal of both the advertisements makes it clear that defendants have neither copied the whole or substantial part of the plaintiff's advertisement nor the idea and/or theme of the advertisement, inasmuch as, the products have been named. Both the advertisements as well as slogans are distinct making no possibility of confusion in the minds of the consumers to accept the product of the defendant as that of the plaintiff. In the facts of this case, I do not find that there is any chance of any confusion or the consumers getting deceived by the slogans. All other judgments relied upon by the plaintiff are in the context of different facts and are of no help to the plaintiff.

20. For the forgoing discussions, in my view, plaintiff has failed to make out a, *prima facie*, case in its favor seeking passing off action. It is not the case of the plaintiff that defendants are new entrants in the field. Defendants are engaged in

the same trade for the last several years and have a reputation with regard to its product. Plaintiff has, thus, failed to disclose a prima facie case that defendants have adopted the slogan, which otherwise, is distinct, to ride on the reputation and goodwill of the plaintiffs. Accordingly, in my view, plaintiff shall not suffer any irreparable loss and injury in case the injunction is not granted. Balance of convenience is also not in favor of the plaintiff. For the foregoing reasons, in my view, plaintiff has failed to make out a case of injunction, as prayed for in the application. Application is dismissed.