
(2005) 10 P&H CK 0041
In the Punjab And Haryana At Chandigarh
Case No : F.A.O. No. 233 of 2004

Heinz Italia S.R.I. Via Cadolini and Another	APPELLANT
Vs	
Dabur India Ltd.	RESPONDENT

Date of Decision : 27-10-2005

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, 151
Trade and Merchandise Marks Act, 1958 — Section 29

Citation : (2006) 143 PLR 223 : (2006) 32 PTC 238 : (2006) 3 RCR(Civil) 310

Hon'ble Judges : Tapen Sen, J

Bench : Single Bench

Advocate : Anuradha Salhotra and Sachin Kapoor, for the Appellant; M.L. Sarin and Vivek Sood, for the Respondent

Final Decision : Dismissed

Judgement

This Judgment has been overruled by : Heinz Italia and Another Vs. Dabur India Ltd., (2007) 104 CLT 719 : (2007) 4 CTC 810 : (2007) 35 PTC 1 : (2007) 7 SCALE 608 : (2007) 6 SCC 1

Tapen Sen, J.—This appeal is directed against the Order dated 11.12.2003 passed by the Additional District Judge, Gurgaon in Civil Suit No. 2 of 2003 whereby and whereunder he was pleased to hold that there was no prima facie case in favour of the Appellants for grant of ad interim injunction and, therefore, dismissed their application filed under Order 39 Rules 1 and 2 of the Code of Civil Procedure.

2. Learned Counsel for the Appellants submitted that the Appellant No. 1 is the proprietor while the Appellant No. 2 is the licenced user of the trade mark "GLUCON-D" which is registered under registration No. 305664/30. Registration was made on 21.5.1975 in relation to goods described as:

GLUCOSE (FOR FOOD), FLOUR AND PREPARATIONS MADE FROM CEREALS, BREAD, BISCUITS (NOT FOR ANIMALS), PASTRY AND CONFECTIONARY (NON-

MEDICATED), MILK CHOCOLATE.

3. According to Ms. Anuradha Salhotra, the initial registration was in the name of GLAXO LABORATORIES (INDIA) LIMITED and in 1994 the trade mark "GLUCON-D" became the property of HEINZ ITALIA S.R.I, (the Appellant No. 1). It is further submitted that the trade mark "GLUCON-D" was being used in India by the predecessors of the Appellants namely GLAXO LABORATORIES since 1990 and by them since 1994. The goods under the trade mark "GLUCON-D" have consistently been sold in a package which is distinct, being green in colour showing a family of three together with the words "GLUCON-D". In July 2002, the Appellants came to learn that the Respondents (Dabur India Limited) had launched a product under the trade mark "GLUCOSE-D" in a packet which was deceptively similar to the package containing the product "GLUCON-D" of the Appellants. It is stated that thereafter the Appellants, sent notice to the Respondent to desist from using such a package but, they refused to comply. Thereafter, the Appellants filed a suit for infringement and for passing off in the Court of learned District Judge at Gurgaon and the same came to be registered as Suit No. 2 of 2003. The Plaint was accompanied by an Application under Order 39 Rules 1 and 2 for grant of interlocutory injunction restraining the Respondents, their successors, assigns, representatives and servants from using the trade mark "GLUCOSE-D" or any other trade mark that was deceptively similar to the registered trade mark belonging to the Appellants namely "GLUCON-D". The Appellants before the Court below came out with a case that the package of "GLUCOSE-D" was so very identical to the package of "GLUCON-D" that the overall impression which came to be given out was that any average man of imperfect reflection was bound to get confused. In reply to the notice sent by the Appellants, the Respondent admitted the use of the trade mark "GLUCOSE-D" but denied that the boxes/package used by them were similar to the ones used by the Appellants.

4. The Respondent before the Court below contested the suit and opposed the grant of ad interim injunction. According to them, the expression "GLUCOSE" was a generic description of the product being sold by the Respondent and no monopoly could be claimed in respect of such an expression by anyone. According to them, the expression "GLUCOSE" signifies well known ingredients used in the composition of the product namely, Dextrose Monohydrates and Vitamin-D which constitute Glucose. It was also their case that there was no infringement of the trade mark "GLUCON" by user of the generic description of the goods by the terms "Glucose-D" and that there was no deception nor any similarity between the Cartons of the two products inasmuch as they had specifically used the words "DABUR GLUCOSE-D" and that they had been selling their goods as such, having a green background since 1989 without any objection. They also asserted that the colour green was chosen by the Legislature in the Notification under the Provisions of Prevention of Food Adulteration Rules, 1955 as a colour symbolising "vegetarian food". The Respondents also contested the suit on the ground that they were in the market

since 1989 and that the suit was filed in the year 2003 within which time, the Appellants had never raised objections.

5. The learned Court below, after having carefully gone through the details of the arguments, came to the conclusion that there was no prima facie case in favour of the Appellants for grant of ad interim injunction and accordingly, dismissed their application under Order 39 Rules 1 and 2 with an observation that nothing stated in the said Order shall be deemed to be an expression on the merits of the case.

6. Before proceeding any further, it would be relevant to mention and take note of the fact that the Impugned Order dated 11.12.2003 was in relation to an application under Order 39 Rules 1 and 2 read with Section 151 of the CPC wherein prayer inter alia had been made for grant of an ad interim injunction till the decision of the suit.

7. It is in that context that this Court must also proceed so as not to prejudice the case of the parties in any manner whatsoever, as any conclusive finding given in this application may be fatal to the case of either of the parties. It is in that background that this Court proposes to dispose of this application on some very short points without entering into the maze of arguments made by the learned Counsel appearing for the Appellants, at this stage.

8. During the course of arguments, attention of this Court was drawn to the photocopy of the certified copy of the registration No. 305664/30. Upon perusal thereof, two things that stare at me on the face are: (a) the column relating to the Goods Description and, (b) one of the conditions/limitations attached. The Goods Description reads as follows:-

GOODS DESCRIPTION : GLUCOSE (FOR FOOD), FLOUR AND PREPARATIONS MADE FROM CEREALS, BREAD, BISCUITS (NOT FOR ANIMALS), PASTRY AND CONFECTIONERY (NON MEDICATED), MILK CHOCOLATE.

The Conditions and Limitations reads as follows:-

REGISTRATION OF THIS TRADE MARK SHALL GIVEN NO RIGHT TO THE EXCLUSIVE USE OF THE LETTER "D". [SIC]

The third equally relevant factor is the registration of the Trade Mark Type which says "GLUCON-D".

9. The goods described under this trade mark is, as noticed above, are GLUCOSE for food and it also includes GLUCOSE for flour and preparations made from cereals, GLUCOSE used in bread, GLUCOSE used in biscuits but not for animals, GLUCOSE used in pastry and confectionary which are not medicated and GLUCOSE used in milk chocolates. Thus, the trade mark is GLUCON-D but under its registration it has been clarified that it will contain GLUCOSE used in the aforementioned items for food.

10. The word "GLUCOSE" means grape sugar or Dextrose and it is a word which

is included in all the dictionaries of the World. Thus, the word GLUCOSE cannot be said to be a monopoly or an exclusive prerogative of a particular person or a particular entity. As has already been stated above the word GLUCOSE is a general word signifying grape sugar or Dextrose and anything that signifies grape sugar or Dextrose means, in the English Scientific language as "GLUCOSE".

11. Similarly, the letter "D" is a letter of the English alphabet and it also cannot be claimed by any individual or a person or a body of persons to be their exclusive prerogative or monopoly. It is a letter that belongs to the World just like the word "GLUCOSE". In fact in the "Conditions and Limitations", it has also been clearly clarified that the registration of the trade mark GLUCON-D shall give no right to the exclusive use of the letter "D". In this context, the observation of the Hon^{ble} Supreme Court of India in the case of Corn Products Refining Co. Vs. Shangrila Food Products Ltd., attains significance and is worth reproducing as under: -

(15) The series of marks containing the common element or elements therefore only assist the applicant when these marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that the Deputy Registrar looked into his register and found there a large number of marks which had either "Gluco" or "Vita" as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user at all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made to Kerly p. 507 & Willesden Varnish Co. Ltd. v. Yound & Marten Ltd. (1922) 39 RPC 285 . It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks "Glucose Biscuits", Gluco biscuits" and "Glucoa Lactine biscuits". But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having "Gluco" or "Vita" as a prefix or a suffix.

[underlining by this Court]

12. Upon a perusal of the aforementioned facts and also taking into consideration the case of the Appellants to the effect that they have come in the market only in the year 1994 or 1990, there is no explanation forthcoming as to why they waited for such a long period of time till 2003 to file the Suit. It is the case of the Respondents that they are in the market since 1989. In this context, the statements made in paragraph 2 of the written statement are worth looking into and which reads as under:-

2. The suit is also liable to be rejected being without any cause of action. No case for infringement of any trade mark or copyright or passing off has been made out by the plaintiffs. The Defendant is using the trade mark DABUR in relation to Glucose-D. "Glucose-D" is a generic expression and description of the product being sold and no monopoly can be claimed therein by any one including the Plaintiffs. "Glucose" is the generic common name of the ingredient "Dextrose Monohydrate". the ingredient predominantly used in the composition along with Vitamin-D and some minerals "GLUCOSE-D" is a generic description of composition marketed by both the parties, comprising combination of "Glucose" (Dextrose Monohydrate) and "Vitamin-D". It is therefore described as "Glucose-D" and marketed under defendant's worldwide famous trade mark and name "DABUR". Plaintiffs have no right to oppose use of such trade description by the defendant under any law. Therefore, there is no infringement of Plaintiffs' registered trade mark which is "Glucon-D". Secondly, the description and generic name "Glucose-D" has been in commercial use by the defendant since 1989 extensively and countrywide. It is now too late in the day for the Plaintiffs to raise any objection, whatsoever, to such use any such purported claim grossly suffers from acquiescence.

[Underlinings by this Court]

13. From a perusal of the rival contentions of the parties, it is evident that while the Appellants are using the word "GLUCON-D", the Respondents on the other hand, have used two common English words namely, "GLUCOSE" and the letter "D". This, therefore cannot mean to be in infringement because under the provisions of Section 29 of the Trade and Merchandise Marks Act, 1958, a registered trade mark is infringed by a person who, uses a trade mark which is identical with or deceptively similar to the registered trade mark of somebody else. While the Respondents have used a common English word, namely, "GLUCOSE" and the letter "D" on their packet, they have taken sufficient care to mention the words "DABUR" making it clear that it is a product of their Company.

14. Only on the aforementioned short point, this Court does not consider it appropriate to enter into the merits of the case because this Court is of the view that the learned District Judge, while dealing with the application under Order 39 Rules 1 and 2 of the CPC has correctly come to the conclusion that there was no prima facie case for grant of ad interim injunction.

15. It would therefore be relevant to take note of the observations of the learned Court below made in paragraph 19 which are of such a nature that this Court is of the view that the said Court was absolutely correct in coming to the conclusion that no prima facie case for grant of injunction was made out in favour of the Appellants even on the basis of the principles of passing off. Paragraph 19 reads as follows:-

19. The defendant has high-lighted several distinguishing features in paragraph-3 of its written statement, between the cartons of the plaintiffs product

and that of the defendant. Those distinguishing features are indeed visible between the two cartons which have been placed on record by the plaintiff at pages 278 and 279 of the list of documents attached with the plaint. The most distinguishing feature in two cartons is that the plaintiff had described its product as "Glucon-D instant energy" within a triangle whereas no such triangle had been used by the defendant who has rather described its produce as "Dabur Glucose-D" with a yellow slanting strip running immediately beneath containing words "non-stop Energiser" instead of words "instant energy" used by the plaintiffs. The other bold distinction striking to the eye in the two wrappers is the picture of a young boy jumping with joy with a football touching his head and a clock running on his side in the front panel of defendant's wrapper which features are totally missing in the packaging of the plaintiffs. So, the Court is of the considered opinion that no prima facie case for grant of injunction is made out in favour of the plaintiffs even on the basis of principle of passing off.

[underlinings by this Court]

16. Let it be recorded that on the basis of the aforementioned observations made in paragraph 15 by the learned Court below, one of us also, while admitting this Appeal, had refused to grant interim relief by Order dated 15.1.2004.

17. On the overall considerations therefore, this Court is of the view that there is neither any prima facie case nor any balance of convenience involved or made out justifying the claims of the Appellants for an Order under Order 39 Rules 1 and 2 of the Code of Civil Procedure.

18. For the foregoing reasons, this Court is of the view that there is no merit in this Appeal. It is accordingly dismissed but without any costs.