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**(2008) 02 CAL CK 0036**

**In the Calcutta High Court**

**Case No :** GA No. 2430 of 2007 and CS No. 138 of 2003

Heinz Italia S.R.L and Another

APPELLANT

Vs

Dabur India Limited and Others

RESPONDENT

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**Date of Decision :** 20-02-2008

**Acts Referred:**

Civil Procedure Code, 1908 (CPC) — Section 10

**Citation :** (2008) 2 CHN 682 : (2008) 38 PTC 652

**Hon'ble Judges :** Sanjib Banerjee, J

**Bench :** Single Bench

**Advocate :** S.K. Kapoor and Ravi Kapoor, for the Appellant; Siddhartha Mitra and Mousumi Bhattacharya, for the Respondent

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## **Judgement**

Sanjib Banerjee, J.—A Supreme Court order passed in a suit filed elsewhere by the plaintiffs against the first defendant in respect of the packaging for the same product used earlier by the first defendant, is cited as the basis for seeking an interlocutory injunction in the present suit.

2. The first plaintiff as assignee of the trademark "Glucon-D" is the proprietor of the mark which is registered in class 30 in respect of glucose for food, flour and preparations made from cereals and the like. The label is also registered in class 30. The second plaintiff is a subsidiary of the first plaintiff and has been permitted by the first plaintiff to use the word and label marks in the country. The second plaintiff manufactures and markets what it claims to be an instant energy drink under the said word and label marks. The plaintiffs claim that such product has been marketed in India for at least four decades. The products come in three variants: in regular, tangy orange and lemony lime flavours. The plaintiffs say that the distinctive packaging in which their product is sold has a striking colour scheme of predominantly green with the photograph of a happy family of father, mother and son depicted on the front of the packet. The essential features of the packaging are the word "Glucon-D", the picture of the happy family and the background colour green. The plaintiffs are also the owners

of the copyright in the artistic work used on the packaging.

3. The plaintiffs are a part of an international conglomerate having substantial presence in the food business. The first defendant is an Indian house of repute also engaged, in the manufacture of food products. The product of the defendants carrying the "Glucose-D" mark is similar to the plaintiffs' product sold under the "Glucon-D" mark and part of a host of like goods in the market. In the earlier suit, instituted in Gurgaon, the plaintiffs complained of the first defendant attempting to filch their trade by using a green packet depicting a smiling family of father, mother, daughter and son. According to the defendants, such packet was discontinued by the first defendant by end 2002 but was made the subject-matter of the Gurgaon suit instituted on February 19, 2003. From January, 2003 the defendants claim to have used a package depicting a happy family of father, mother and son engaged over a football against a green background with a splash of lighter green thrown in as the immediate backdrop.

4. The Gurgaon Court declined to grant any interim relief to the plaintiffs on the ground that there were several distinguishing features between the cartons of the plaintiffs' manufacture and those of the defendant in such suit. The plaintiffs carried the order of the Additional District Judge to the Punjab and Haryana High Court which declined to immediately interfere. In the SLP arising from the Punjab and Haryana High Court order of October 27, 2005, the Supreme Court found in favour of the plaintiffs and held that the packets in question were so similar that they could confuse a purchaser. The Supreme Court noticed that the first defendant had "time and again made small changes in their packaging (in) an attempt to continue to mislead the purchaser and make it more difficult for the appellants (plaintiffs here) to protect their mark, which the record shows has acquired an enviable reputation in the market which is sought to be exploited by the respondent."

5. It is such dictum of the Supreme Court that the plaintiffs bring as the principal weapon to take the wind off the defendants' sail, that the grievance as at the time of the institution of the suit is no longer relevant. The plaintiffs say that the first defendant has changed its packaging in respect of the product about seven times in recent memory with the object of dislodging the claim brought in successive suits. The plaintiffs complain that each change by the first defendant of its package has been a mere colourable imitation of the one used previously with the overall mala fide intent of trading on the goodwill of the plaintiffs and their product.

6. By the time this application has been taken up, the first defendant has abandoned, on its admission, the packaging that the plaintiffs complained of in the suit. The present packet used by the first defendant is that of a boy clad in blue jeans, T-shirt and a green jacket exulting in a burst of energy depicted by the yellowish splash immediately behind the boy in the predominantly green background of the packet. The word "Dabur" indicating the stable from which the product comes is more prominent above the writing "Glucose-D" in the

packaging used by the first defendant at present. The defendants submit that nothing in its present packet except the green background would be of any similarity with the plaintiffs' packaging and, since the plaintiffs cannot complain of the generic and descriptive "Glucose-D" used by the defendants, the defendants' new packet is altogether dissimilar in its trade dress, get up, colour scheme and presentation.

7. The present suit was filed shortly after the Gurgaon suit. At the ad interim stage of the plaintiffs' first interlocutory application in this Court, an order of injunction was passed but on the returnable date the order was modified by directing the defendants to keep accounts.

8. The defendants applied u/s 10 of the Code for stay of the suit. But before such application was taken up, the plaintiffs' first interlocutory application was dismissed on August 29, 2003 on the ground that the suit was not maintainable. The Appellate Court set aside the order of August 29, 2003 and by its order of December 2, 2003 restored the order of May 15, 2003 that required the defendants to keep accounts.

9. In April, 2004 the defendants' application u/s 10 of the Code was allowed and the trial of the suit stayed. The order on the application u/s 10 has since been set aside by the Appellate Court.

10. After the Supreme Court order in the Gurgaon suit, the plaintiffs were energised to take out the present application and sought an ad interim order which was refused. The resultant appeal brought no cheer to the plaintiffs and they again knocked at the Supreme Court doors. The Supreme Court did not go into the merits urged in the SLP as the plaintiffs' present application had ripened for hearing. By an order of January 25, 2008 this Court was directed to take up the hearing of this application within three weeks from the date of receipt of a copy of the order and dispose of the same within a week thereafter, uninfluenced by the observations made earlier on this application or the appeal arising therefrom. The Supreme Court order was brought to the notice of this Court on February 13, 2008 and the matter was heard on February 14, 2008. The defendants were required to prepare a chart annexing the various packets used by the plaintiffs and the defendants since or about the year 2000 and the matter was kept for receipt of the chart on February 18, 2008.

11. The chart has been made over by the defendants and the matters covered by the seven pages of the chart are undisputed. The first page shows the plaintiffs' packet bearing its registered label. The second page is an orange packet of the tangy orange flavour drink sold by the plaintiffs where the picture of the family is slightly different and a glass of an orange drink spilling over upon ice being thrown into it is shown. The third page of the chart is the defendants' packet used prior to the Gurgaon suit regarding which the plaintiffs had no grievance as would appear from paragraph 8 of the plaint relating to the Gurgaon suit. The fourth page of the chart brings out the defendants' packet complained of in the

Gurgaon suit. The fifth page relates to the defendants' packet adopted in January, 2003 and the subject-matter of the complaint in the present suit. The sixth page of the chart shows the present packet adopted by the plaintiffs after the Supreme Court order in the Gurgaon suit and the seventh page shows the packet relating to a similar product marketed by another entity under the brand "Glucovita" also displaying a happy family against a predominantly green background. The plaintiffs suggest that the saga depicted by the marginally changing packets brought to the market by the defendants would show the element of deceit essential for the Court to recognise in an action of such nature. The test, assert the plaintiffs, is not by comparing the two products or the packets to discover the distinguishing features of either, but to remove the plaintiffs' packet and assess whether on a look at the defendants' packet, one would associate that with the plaintiffs'.

12. The plaintiffs refer to a judgment reported at *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.*, and rely on paragraphs 17 and 18 thereof. The plaintiffs say, relying on the similar situation in the "Glucovita" mark in the said Supreme Court report, that the packets relevant for the purpose of the present proceedings would convey the ideas of glucose and life-giving properties or vitamins such that a would be customer of average intelligence would take the defendants' product thinking it to be of the plaintiffs. The judgment was rendered in a matter arising out of registration and the considerations that are relevant as whether a mark should get on to the register or remain thereon, The likelihood of confusion is one of the relevant factors, just as in a case of the present nature.

13. The plaintiffs have also relied on another judgment reported at *N.R. Dongre and Others Vs. Whirlpool Corpn. and Another*, for the proposition that a passing off action is maintainable even against a registered owner of a mark. But there is no discussion as to the proposition in the Whirlpool judgment, as the principle is acknowledged in Counsel's concession. Such issue is, however, irrelevant in this case.

14. The defendants suggest that it has come to be accepted in the trade that energy drinks of such kind are all packaged in green packets and the mere fact that the defendants use the colour green would not entitle the plaintiffs to an injunction. The defendants have not attempted to justify the use of the packet that is the subject of the plaintiffs' complaint in the suit, but submit that upon the change of the packet following the Supreme Court order, the plaintiffs should have no further grievance. The defendants submit that the pendency of the contempt proceedings launched by the plaintiffs before the Supreme Court covering even the defendants' present packet should not weigh with Court in finding in favour of the plaintiffs as regards the defendants' latest packet.

15. Apart from the Glucovita packet, the defendants had referred to other manufacturers of like product using similar-coloured packets with photographs of smiling members of a family. Such matters were referred to by the defendants in

an earlier application in this suit being GA No. 1675 of 2003. Annexures "H", "I", "J", "K" and "L" of the defendants' affidavit of June 21, 2003 showed packets used by other manufacturers of the same product, all in green and each of them carrying photographs of a family of three either in the front or on the reverse. The plaintiffs have referred to the affidavit used on their behalf on July 9, 2003 to the effect that the Glucovita packet (Annexure "H" of the defendants' earlier affidavit) was substantially different from the plaintiffs' trade dress; that the plaintiffs had proceeded against, the manufacturers of the packet shown at Annexure "I" of the defendants' earlier affidavit and such manufacturer had agreed in the Delhi suit to change its get-up; and, that the products shown in Annexures "J", "K" and "L" to the defendants' earlier affidavit were not in use.

16. What the defendants have been able to establish is that there are many manufacturers of the same product primarily containing dextrose monohydrate that have been and are sold in green cardboard or like boxes. What the defendants have further been able to show is that the photographs of the family on such packets have been used by manufacturers other than the plaintiffs. The plaintiffs' word mark, to the extent the plaintiffs can claim exclusivity over it, is restricted to the word "Glucon". The plaintiffs cannot claim exclusive rights over the "D" used as part of its product name as the same may refer to vitamin-D contained in the plaintiffs' product. In any event, the defendants have asserted that their product contains vitamin-D and the brand name used by the defendants is descriptive of the product and the vitamin ingredient therein.

17. In an action of the present nature, the plaintiff brings forth a case of deceit—the customers being deceived into buying the defendant's product on their understanding that it was of the plaintiffs; and of the defendant using such ploy to further its business by cashing in on the goodwill and reputation of the plaintiff or its product. There is no doubt that the tests that have been laid down for assessing a matter of such nature, would entitle the plaintiff to an order of injunction in respect of the defendants' packet used at the time of institution of this suit. Though in not so many words, the defendants have conceded as such in abandoning such packet. Whether or not the photograph of a family had become generic to products of such nature manufactured by different entities, the plaintiffs' label registration would be enough for them to obtain an order of injunction against the defendants' packet at the time of institution of the suit. Such an order would be on the overall impression of the defendants' packet with the photograph of the family being the most prominent feature thereof. The colour scheme, the predominantly green background of the packet would come into play and weigh with Court, but only because of the most distinctive feature of the plaintiffs' packet, that of a happy family, also being used on the defendants' packet.

18. It would not be such an open and shut case for the plaintiffs, if the photograph was of similar import on the defendants' packet but the background was altogether different." Conversely, if the most prominent feature of the

plaintiffs" distinctive packet, that of the smiling family, were not used by the defendants, the mere identity of the background colour even upto the verisimilitude of hues, may not entitle the plaintiffs to an order of injunction. The test is one of impression, impression not by comparison but by the recall value: whether a would be customer would recall the plaintiffs" and reach out for the defendant's product on his inattentive association of the one for the other.

19. Just as the goodwill of the plaintiff, at least at the interlocutory stage, is to be protected both under the statute and at common law, the registration or extensive use cannot be a ticket to a monopoly over the product. The plaintiffs here can claim no rights over the colour green used in its packets, whether or not such colour has become generic to similar products.

20. Since the mark "Glucose-D" is entirely descriptive both as to its glucose content and as to the "D" of vitamin-D, the defendants may not have any exclusive rights in respect thereof but have such rights that would permit them to use such mark, with a host of others if the others so chose, irrespective of the plaintiffs" registered "Glucon-D" mark. The Supreme Court has not pulled up the defendant for its word mark "Glucose-D" but the order is restricted to the deceptively similar packaging that the defendants indulged in that was the subject-matter of the Gurgaon suit. Annexure "H" to the petition that the plaintiffs complain of and the manner of the defendants" packaging in the form in which it is presented, entitles the plaintiffs to an order of injunction in terms of prayers (b) and (c) of the notice of motion. The plaintiffs are also entitled to an order in terms of prayer (d) restraining the defendants from passing off their goods as or for the goods of the plaintiffs.

21. But such orders must be kept confined to the packaging forming Annexure "H" and should not be understood to spill over to the packets used by the defendants since June 15, 2007, that of the jeans and T-shirt-jacket clad teenager exulting in a splash of yellow depicted on a green packet. The present packaging of the defendants would not lead unwary customers of the plaintiffs" product with ordinary intelligence and imperfect recollection to reach out for the defendants" product thinking it was the plaintiffs". In the context of the suit, and the case in the plaint, it may not have been necessary to take notice of the defendants" new packet. But since the original direct reliefs claimed in the suit may have become inappropriate upon the defendants abandoning the infringing packet, the plaintiffs have pressed for an injunction even on the defendants" new packet (albeit without any amendment of the plaint) and the defendants have stood their ground, not on the technical plea that the Court could not have heard the plaintiffs" challenge to the new packet, but on merits. Courts take into account changed circumstances and subsequent events to avoid repetitive actions. In an action for passing off, where the plaintiff seeks an injunction not only in respect of the one or more offending marks on which it founds its cause of action but also on marks which are deceptively similar or a colourable imitation of the plaintiff's, the Court can allow a plaintiff to assail a mark

adopted subsequent to the institution of the suit. The reliefs claimed in this suit would encompass a challenge by the plaintiffs to the defendants' present packet, which challenge has been received but found to be unmeritorious.

The plaintiffs will also be entitled to the costs of this application assessed at 3000 GMs.

Urgent photostat certified copies of this judgment, if applied for, be issued to the parties upon compliance with all requisite formalities.