
(1991) 09 BOM CK 0030

In the Bombay High Court

Case No : Notice of Motion No. 1795 of 1991 in Suit No. 2583 of 1991

Hindustan Lever Limited

APPELLANT

Vs

Nirma Private Limited, Ahmedabad

RESPONDENT

Date of Decision : 09-09-1991

Acts Referred:

Copyright Act, 1957 — Section 15(2), 17, 2, 48, 51

Designs Act, 1911 — Section 2(5)

Trade and Merchandise Marks Act, 1958 — Section 2, 29

Citation : AIR 1992 Bom 195

Hon'ble Judges : D.R. Dhanuka, J

Bench : Single Bench

Advocate : J.I. Mehta and Virendra V. Tulzapurkar, instructed by M/s. Crawford Bayley and Co, for the Appellant; M.H. Shah, J.J. Bhatt and Vikram Trivedi, instructed by y M/s. Manilal Kher Ambalal, for the Respondent

Judgement

1. Hindustan Lever Ltd., has filed this suit against Nirma Private Ltd., seeking permanent injunction restraining the defendant from using in relation to soaps or detergent powder the impugned carton, a photograph of which is annexed as Exhibit "O" to the plaint, or any other deceptively similar carton. Both the plaintiff and the defendant manufacture various products inter alia, the detergent powder known in the trade as "Surf and "Nirma" respectively. The plaintiff claims to be registered proprietor of various trade marks referred to in the plaint since decades. The plaintiff also claims to be owner of copyrights in various labels -- artistic works used by the plaintiff on their cartons in relation to its product "Surf". The plaintiff contends that since about March 1991, the defendant is indulging in colourable imitation of the plaintiffs trade mark and artistic labels and is passing off their product as if associated with the plaintiff. The plaintiff has framed its cause of action in the suit on the footing of alleged infringement of registered trade marks of which the plaintiff is proprietor, passing off as well as alleged infringement of plaintiff's copyrights in original artistic works referred in the plaint.

2. The plaintiff is the registered proprietor inter alia of the following trade marks and artistic works :--

(a) Word mark "starlight";

(b) Word "surf per se No. 132479 in respect of bleaching preparation and other substances for laundry use etc., falling in Class 3 of the Fourth Schedule to the Trade Marks Rules (vide certified copy of entry from the register -- Exhibit "I" to the plaint);

(c) Label Surf No. 240234 in respect of scope and detergents, preparations and substances for laundry use, cleaning preparation etc. falling in Class 3 of the Fourth Schedule to the Trade Mark Rules (vide certified copy of the entry in respect of this registration --Exhibit "J" to the plaint);

(d) Label Surf No. 363888 in respect of soaps, detergents etc., falling in Class 3 of the Fourth Schedule to the Trade Mark Rules.

This mark is limited to the colour scheme and is associated with trade mark No. 132479 and 240234 (Exhibit "K" to the plaint);

(e) Label Surf No. 363896 in respect of soaps and detergents falling in Class 3 of the Fourth Schedule to the Trade Mark Rules --not limited to any colour (Exhibit "L" to the plaint);

(f) Starlight word per se No. 87137 in respect of soaps falling in Class 3 of the Fourth Schedule to the Trade Mark Rules --(Exhibit "N" to the plaint);

(g) Artistic work -- Label -- under Nos. A-44275/84 and A-44276/84 dated 9th March 1984 duly registered under Copyright Act, 1957 (Exhibits "Y-1" and "Y-2" to the plaint);

(h) Artistic work (Exhibit "D" to the plaint) prepared by the Artist Shri Mohan Khare as per details set out in his affidavit (Exhibit "Y-3" to the plaint).

3. The plaintiff contends that the essential feature of their trade mark consists not merely of the word "Surf or "Starlight" but also consists of the device of a star flash or star burst with rays emanating therefrom, its colour scheme, and get up viewed as a whole. The defendant denies the allegation. The defendant has highlighted some of the dissimilarities in the two labels apart from denying the claim of the plaintiff. The above referred device of a star flash or star burst with rays emanating therefrom used by the plaintiff on its cartons for the product "Surf is hereinafter referred to as "the star device" for the sake of brevity. The plaintiff has caused the said device registered with the Registrar of Copyrights as an artistic work under the Copyright Act, 1957. Since about February 1990, Shri Mohan Khare, as artist, has prepared the label with the star device after incorporating therein the picture of a lady and a young boy. Since February 1990, the plaintiff has been using the said artistic label (copy whereof is Exhibit "D" to the plaint) on its cartons pertaining to the said product. The said now device is substantially similar to the star device coupled with the picture of a lady and a

young boy. The application of the plaintiff for registration of this particular label i.e. Exhibit "D" to the plaint is pending with Registry. No other manufacturer of the same or similar product has been using the above referred star device with similar colour scheme and get up or otherwise save and except the defendant. The defendant has also commenced user of the impugned device vide Exhibit "O" to the plaint only since March 1991. Both the plaintiff and the defendant prominently use their word mark "Surf" and "Nirma" respectively on their respective labels. The plaintiff claims exclusive right to use the above referred star device with the colour scheme and get up as used by the plaintiff on its carton since decades. The plaintiff contends that the defendant cannot be excused in law for colourable imitation of the said device merely because of their having introduced a few changes in the colour scheme etc. as indicated on label as Exhibit "O" to the plaint.

4. The prayers made by the plaintiff in this notice of motion are as under :--

"(a) That the defendant by itself, its servants, representatives, printers, distributors, stockists and agents be restrained by an order and injunction of this Hon'ble Court from in any manner using in relation to soaps or detergent powder the impugned carton a photograph of which is annexed as Exhibit "O" to the plaint or any other deceptively similar carton so as to pass off or enable others to pass off the defendant's goods as and for the goods of the plaintiff;

(b) That the defendant by itself, its servants, representatives, printers, distributors, stockists and agents be restrained by an order and injunction of this Hon'ble Court from in any manner using in relation to soaps or detergent powders or washing powders the impugned certain being Exhibit "O" to the Plaint so as to infringe the plaintiff's registered trade marks bearing Nos. 87137, 240234, 363898 and 363896;

(c) That the defendant by itself, its servants, representatives, printers, distributors, stockists and agents be restrained by an order and injunction of this Hon'ble Court from in any manner using and/or selling and/or offering for sale and/ or exposing for sale and goods in the carton being Exhibit "O" to the plaint or any other colourable imitation thereof so as to infringe the plaintiff's copyright subsisting in its original artistic works as appearing in Exhibits "Y-1", "Y-2" and "D" to the plaint;

(d) That the defendants be ordered and decreed to deliver up to the plaintiff for distribution all the impugned cartons, dyes and articles and effects bearing the impugned label mark;

(e) For ad interim reliefs in terms of prayers (a), (b) and (c) above;

(f) For the costs of the suit; and

(g) for such further and other reliefs as the nature and circumstances of the same may require".

5. In my judgment, the plaintiff has made out a strong prima facie case in respect of its cause of action based on alleged infringement of essential feature of its trade mark i.e. partly (not wholly) as well as alleged infringement of copyright in artistic works referred to in Exhibits "Y-1", "Y-2" and "D" to the plaint and the balance of convenience also lies in favour of granting the interim injunction as sought for in this behalf. However, I am not prepared to grant interim relief in terms of prayers (a) and (d) of the notice of motion. In respect of cause of action based on alleged passing off, the plaintiff's case is not equally strong in view of incorporation of added material by the defendant on the impugned label (Exhibit "O" to the plaint). Reasons for taking the above view are indicated hereinafter.

6. The material facts required to be set out for the purpose of this order are as under:--

(a) On 11th August 1898, the plaintiff's predecessors, Lever Brothers Limited, adopted the word mark "Starlight". On this day, the secretary of the said company made a declaration to the above effect which was registered by the concerned Registry at Calcutta soon thereafter.

(b) The plaintiff company is a well known company engaged in the manufacture of soaps and detergents. The defendant company also is a well known company engaged in the manufacture of soaps and detergents.

(c) The plaintiff is the proprietor of the trade mark "Surf" (word per se). The said trade mark is registered under No. 132479 as of 9th February 1949. The defendant is the proprietor of the trade mark "Nirma".

(d) In respect of the above product sometime in the year 1967, the plaintiff adopted a label mark applied to a cardboard carton, as more particularly described in paragraph 5 of the plaint. The said label mark had a distinct colour scheme of blue, white, yellow get up. One of the essential features of the said carton was the device of a star flash or star burst showing a star in white with rays emanating therefrom in white against a blue background.

(e) The plaintiff caused various label marks to be registered as per details already set out in paragraph 2 of this order.

(f) The above referred product of the plaintiff was marketed and advertised with the use of the label mark which can be described for the sake of brevity as "the star device", the star flash or star burst coupled with distinct colour scheme and get up. The said label became popular in the trade as distinctive of the plaintiff.

(g) In February 1990, the plaintiff made a slight change in the main cardboard carton by introducing the device of a lady and a young boy, retaining all other features i.e. two star flash or star bursts and rays emanating therefrom. The plaintiff has made an application for registration of this new label mark sometime in the month of June 1991. M/s. Lintas India Ltd. have been engaged by the plaintiff from time to time for preparing its artistic labels to be used on the

cartons for packing its products. The plaintiff has paid the stipulated consideration to the author of the artistic work employed through M/s Lintas India Ltd. In respect of unregistered artistic work (Exhibit "D" to the plaint) already adopted by the plaintiff since February 1990, one Mr. Mohan Khare has filed an affidavit dated 24th June 1991 stating therein that he has prepared the artistic work for the plaintiffs Extra Action Surf carton (Exhibit "D" to the plaint) and that all the ownership rights and copyright titles in the said artistic carton of Surf are the exclusive property of the plaintiff.

(h) On 9th March 1984, the plaintiff caused its artistic label used on detergent powder "Surf under the provisions of the Copyright Act, 1957. One Mr. B. G. Naik of M/s. Lintas India Ltd. was the author of the said artistic work. It was first published in India in the year 1976 by Hindustan Lever Ltd. It was then published from time to time by Hindustan Lever Ltd. Clause 11 of the certified extract from the register of copyrights (Exhibits Y-I to the plaint) bearing Registration No. A 44275/84 reads as under :--

"All rights held by Hindustan Lever Limited, Hindustan Lever House, 165/166, Back-bay Reclamation, Bombay 400020."

A copy of the certified extract from the statutory register of copyrights issued by the Registrar of Copyrights is undoubtedly the prima facie evidence of particulars set out in the statutory register. Exhibit "Y-1" shows that the artistic label containing the star device of a star flash or a star burst was duly registered by the Registrar of Copyrights in the year 1984 with the remarks that the said artistic work was first published in India in the year 1976 by Hindustan Lever Ltd. and the copyrights therein vested in the plaintiff.

(i) On 9th March 1984, the plaintiff caused another artistic label i.e. artistic work to be registered with the Registrar of Copyrights. The said label was also prepared artistically by Mr. B. C. Naik of M/s. Lintas India Ltd. The said label is substantially similar to the label at Exhibit "Y-1" to the plaint, with the difference that the title of the work evidenced by Exhibit "Y-1" is "High Power Surf carton and the title of the label evidenced by Exhibit "Y-2" is "New Super Surf carton. In the contra of the label as Exhibit "Y-1", the following words are written :--

"Washes Whitest.... and it shows."

In the centre of the label at Exhibit "Y-2", it is written "for super whiteness".

(j) Sometime in the month of March 1991, the defendant started using a cardboard carton having particular colour scheme, lettering, lay out and get up indicated on Exhibit "O" to the plaint. According to the plaintiff, the device adopted and the label used by the defendant as indicated on Exhibit "O" to the plaint was colourable imitation of the label marks of the plaintiff which were duly registered and amounted and amounts to infringement of the plaintiff's rights as registered proprietor of trade marks, passing off of the plaintiffs goods and also the infringement of the copyrights in the artistic works evidenced by Annexures

"Y--1", "Y-2" and "Y-3" to the plaint.

(k) By their Advocates" letter dated 20th April 1991, addressed to the defendant, the plaintiff protested against the use of the above referred device/label on the cartons of the defendant's product known as "Super Nirma" inter alia on ground of infringement of plaintiff's rights and the alleged colourable imitation of their label marks and the artistic works. Correspondence ensued. The defendant filed a suit against the plaintiff in the City Civil Court at Ahmedabad, being Suit No. 3214 of 1991, on the ground that the detergent powder manufactured and sold by the defendant by using their trade mark "Super Nirma" as well as the label/pack/ carton in which the same were sold were in no way deceptively similar nor were likely to cause any confusion in the mind of any consumer or use of the said label or carton constituted an infringement of the copyright of the plaintiff in the artistic work in the plaintiff's label/pack/carton of the defendant as alleged. By an ex parte order of ad interim injunction dated 17th June 1991, the learned Judge of the City Civil Court at Ahmedabad restrained the plaintiff herein from objecting to the defendant's selling their products under the trade mark "Super Nirma" and in the labels/packs/cartons in which they were being sold and also restrained the plaintiff from harming the reputation and goodwill of the defendant by issuing any advertisement, write up in journals in any manner directly or indirectly. By an order dated 28th June 1991, the learned Judge of the City Civil Court, Ahmedabad, passed a clarificatory order observing that the ad interim injunction dated 17th June 1991 did not restrain the plaintiff herein from taking any legal action in the Court of law subject to the condition that the plaintiff herein shall disclose the fact of the Ahmedabad suit including the ad interim order in whatever proceedings resorted to by the plaintiff and in case the plaintiff herein intended to obtain any ad interim relief, the plaintiff must indicate to the defendant in advance as if a caveat was filed by the defendant for the same. The plaintiff has complied with the conditions imposed by the said order dated 28th June 1991 while filing of this suit and taking out the notice of motion for appropriate interim reliefs.

(l) On or about 18th July 1991, the plaintiff filed this suit against the defendant for a permanent injunction restraining the defendant from in any manner using in relation to soaps or detergent powder the impugned carton, a photograph of which is annexed is Exhibit "O" to the plaint, or any other deceptively similar carton so as to pass on or enable others to pass on the defendant's goods as and for the goods of the plaintiff. By prayer (b) of the plaint, the plaintiff has prayed for a permanent injunction restraining the defendant from using the impugned carton so as to infringe the plaintiff's registered trade marks bearing Nos. 87137, 240234, 363888, 363896 and 553096. By prayer (c) of the plaint, the plaintiff has sought a permanent injunction restraining the defendant from using and/or selling and/ or offering for sale and/ or exposing for sale any goods in the carton at Exhibit "O" to the plaint or any similar artistic works and colourable imitation thereof, so as to infringe the plaintiff's copyright subsisting in its original artistic works as appearing in exhibits Y-1, Y-2 and D to the plaint.

The plaintiff has also claimed a decree for damages, accounts and various other reliefs including interim reliefs.

7. The plaintiff has formulated its alleged cause of action in the plaint on three different footings i.e. infringement of essential features of registered trade marks of the plaintiff by taking the device of a star flash or star burst showing a star in white with wave emanating therefrom against a blue background with minor variation of no consequence; (b) passing off of the product "Super Nirma" as if associated with the plaintiff and (c) infringement of copyright in the artistic work evidenced by certificates of registration at Exhibits Y-1 and Y-2 to the plaint and also the artistic work evidenced by the label Exhibit "D" to the plaint.

8. The label (Exhibit "D" to the plaint) has been used by the plaintiff in respect of its product "Surf since February 1990. The essential feature of the star device of a star flash or star burst substantially appears in the label Exhibit "D" to the plaint with the difference that the said carton introduces the device of a lady and a young boy as a change and also uses the words "With Stay Fresh Perfume" in the centre. Basically, the star device adopted in the said label is identical with the device forming part of the registered label marks of the plaintiff, at any rate substantially similar.

9. In order to prove that the star device is the essential and distinctive feature of its label mark as understood in the trade for decades, the plaintiff has annexed copies of various wall paintings and advertisements used by the traders, retailers etc. during the course of years, copies whereof are annexed at Exhibits "H" to "H-9" to the plaint. The plaintiff's case is convincing.

10. The plaintiff has averred in the plaint that none of the other manufacturers of detergent powder has been using the star device of a star flash or star burst with rays emanating therefrom as a part of get up for the washing powder marketed by them as the said device is treated in the trade as distinctive of the plaintiff's goods. In paragraph 16 of the plaint, the plaintiff has set out details of different get-ups and devices used by well known manufacturers of detergent washing powders like Godrej Soaps Ltd., Sarabhai Surfactants Ltd., Tata Oil Mills etc. In paragraph 16 of the plaint, the plaintiff has averred that the defendant alone has adopted the impugned colour scheme, lay out and get up and the device of the star flash and/or star burst by the impugned carton (Exhibit "O" to the plaint) with ulterior motive. The plaintiff has complained of similar attempts by the defendant in respect of its other products in the past, I propose to decide this motion independently of controversial past and ignore both sides' version in respect of other matters with which the Court is not directly concerned in this notice of motion.

11. In the notice-dated 20th April 1991 (Exhibit "T-I" to the plaint), the plaintiff inter alia pointed out that in one of the long side panels of the carton of the detergent powder marketed by the defendant, vide Exhibit "O" to the plaint, it was alleged that the carton/ label (meaning thereby the defendant's label) was

registered under the Copyright Act, 1957 under C.R. No. A-13287 of 1975 and that the licensee was Nirma Private Limited. The plaintiff made searching enquiries from the defendant in this behalf. In paragraph 2.16 of letter dated 31st May, 1991 (Exhibit T-4" to the plaint), M/s. Y. J. Trivedi & Co., Advocates representing the defendant, admitted that the defendant's label was not registered under the Copyright Act as printed in one of the long side panels of the carton. In the said paragraph of the letter, it was stated by the learned Advocates for the defendant as under:--

"As regards your contention about the copyright registration mentioned in one of the long panels in my clients" label, my clients want to make it clear that the same appears to have been a printing mistake because of printing of various labels for various products....."

During the course of inspection of documents also it was admitted by the defendant as recorded in letter dated 21st May 1991 (Exhibit "T-3" to the plaint) that the said registration No. A-13287 of 1975 was in respect of Nirma (word per se) and not of the impugned carton. To my mind, the above-referred error was not caused as a result of printing mistake. Taking an overall view of the matter, I find the conduct of the defendant blameworthy.

12. It cannot be disputed that the defendant has conspicuously and prominently printed the words "Super Nirma" on the carton Exhibit "O" to the plaint. It is, therefore, contended on behalf of the defendant that the consumers who want to purchase washing powder known as Surf would purchase the plaintiff's product known as Super Surf and those who want to purchase the product of the defendant known as Super Nirma would purchase the said product and the chances of confusion or deception were practically nil. This submission of the defendant is relevant only in respect of the cause of action based on alleged passing off and not other causes of action like infringement of registered trade mark. The submission proceeds on the footing that the imitation of label or device loses its significance once the name of the manufacturer or its brand is conspicuously printed. The submission made on behalf of the defendant is too wide and not in conformity with well settled principles of law. It all depends as to whether on an overall view of the matter, case of infringement is made out by the plaintiff and no answer to these problems can be fitted in a strait-jacket.

13. There can be no dispute about the well settled principles of law having bearing on this case. The dispute between the parties regarding the application of these principles to the facts of this case will be considered separately. The relevant principles deduced from Standard Works of wellknown authors and relevant case law are as under:--

(A) A mark is infringed by another, even without using the whole of it, he uses one or more of its essential features. (Paragraphs 14.21 of Kerly's Law of Trade Marks and Trade Names, 12th Edition). The identification of an essential feature depends upon facts of each case. The identification of an essential feature of the

mark depends partly on the Court's own judgment and partly on the Burden of the evidence that is placed before it."

(The underlining is done to supply emphasis)

(B) The essential feature of the mark may consist of device or the get up used on the label or the carton in addition to the brand name or the word mark used for the product. V the rival trader adopts such device of another, the rival trader infringes the trade mark of the other though not wholly. It is no answer to a plea of infringement of the registered trade mark or one of its essential features that the defendant has incorporated additional material in its mark including describing its own brand name or name of the manufacturer thereon conspicuously. In large number of decided cases noticed in paragraph 14.25 of Kerly's Trade Mark, one finds instances of infringements by marks which prominently display the defendant's name. By and large, paragraph 14.25 of the above Standard Works and the decided cases noticed therein provide a complete answer to one of the important contentions of the defendant. Incorporation of "additional material" may be a good defence in a passing off action if the goods in question are clearly distinguished as defendant's goods by reason of incorporation of additional material on the impugned mark, but not an answer to a statutory action alleging infringement.

(C) Get up or the device used on the label is liable to be treated as an essential feature of the mark. The unwary purchasers of consumer goods attach considerable importance to get up or the device forming part of the carton or label particularly semi-illiterates and illiterates.

(D) Whether the mark used by the defendant infringes the plaintiff's mark or not must be decided by applying the test as to what would be the general impression of an unwary customer of imperfect recollection while seeing the impugned carton. The test of keeping the goods of two manufacturers or the cartons or the labels side by side and comparing the similarities and/or dissimilarities thereon meticulously is not a correct test to be applied.

14. Shri J. I. Mehta, the learned counsel for the plaintiff, has relied upon the judgment of the House of Lords in the case of Saville Perfumery Ltd. v. June Perfect Ltd., reported in (1941) 58 RPC 147. In this case, the trial Court had dismissed the plaintiff's action. The Court of Appeal allowed the appeal. The House of Lords substantially dismissed the appeal of the defendant although it deleted one of the three injunctions granted by the Court of Appeal. In the judgment of the Court of Appeal delivered by the Master of the Rolls, Sir Wilfred Greene, at page 162 of the report, the relevant proposition of law is well explained and the discussion on the subject is helpful and illuminating. The learned Master of Rolls observed as under:--

"Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any."

The Court of Appeal relied upon its earlier judgment in the case of *Bale and Church Ltd. v. Sutton Parsons & Sutton and Astrah Products*, (1934) 51 RFC 129, where Lord Justice Romer had quoted with approval the passage from *Kerly's Trade Marks* and had observed that if some of the essential features were copied, it was sufficient to constitute infringement. Lord Justice Viscount Maugham, speaking for the House of Lords, accepted the principles laid down by the Court of Appeal at page 175 of the said decision as a correct statement of law.

15. In *Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.*, , Ramaswami, J. speaking for the Bench of our Supreme Court approved the dictum of law laid down by the House of Lords in the above referred case reported in (1941) 58 RPC 147 and its ratio. In this case, the plaintiffs were registered proprietors of the registered trade mark "Ruston" in respect of diesel internal combustion engines. The defendant started using the word "Rustum India" on similar engines manufactured by it. The suit was dismissed by the Court below. In appeal, the High Court held that there was deceptive resemblance between Ruston and Rustam and the defendant's mark constituted infringement of the plaintiffs mark. It was held in this case that the fact that the word "India" was added to the defendant's trade mark was of no consequence and the plaintiff was entitled to succeed in action for infringement of trade mark. Similar view has been taken by our Court in several cases and it appears to be unnecessary to multiply authorities.

16. Shri J. I. Mehta, the learned counsel for the plaintiff, has also relied upon the judgment of the Supreme Court in the case of *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories*, . In this case, Ayyangar, J. speaking for the Bench of the Apex Court observed that the added material would constitute defence in a passing off action if it was sufficient to distinguish the defendant's goods from those of the plaintiffs but not in an infringement action.

17. The learned counsel for the plaintiff has also relied upon a Division Bench judgment of our High Court in the case of *M/s. National Chemicals and Colour Co. and Others Vs. Reckitt and Colman of India Limited and Another*, . This judgment is directly relevant on the question of formulation of test to be applied while judging the question as to whether the defendant has infringed the trade mark by colourable imitation of the mark or not. It was held by the Hon'ble Division Bench that the Court has to decide this question by considering the overall impression of the mark in the minds of general public and not by merely comparing the dissimilarities in the two marks. The learned counsel also relied upon the judgment of our High Court in the case of *James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd.*, . In this case, the Appellate Court disagreed with the approach of the learned single Judge i.e. Shah, J. The learned single Judge had held that there was no close resemblance between the two trade marks by comparing the said marks side by side. In paragraph II of the above referred appellate judgment, Chagla C.J. speaking for the Division Bench of our High Court prefaced his observations by reference to the judgment of the

learned single Judge as under (Para 11 of AIR):--

"The learned single Judge in his careful judgment had meticulously examined the points of similarity and dissimilarity between the trade mark of the appellant and the trade mark of the respondents and had come to the conclusion that the points of difference were so numerous and the points of similarity so few that in his view there was no such resemblance as was likely to cause confusion."

In the above referred judgment, the learned Chief Justice further observed as under (Para 11 of AIR):--

"With very great respect, in our opinion, that was not the correct approach to the matter. What the learned Judge should have done was not to keep these two trade marks before him and to find out how they differ and how little they resemble; what he should have done was to decide for himself what was the distinguishing or essential feature of the appellants' trade mark, and then, looking at the trade mark of the respondents, to ask himself whether there was any resemblance in the trade mark of the respondents to that distinguishing or essential feature."

This judgment was carried in appeal to the Supreme Court and the judgment of the Hon'ble Supreme Court is reported in *National Sewing Thread Co. Ltd. Vs. James Chadwick and Bros. Ltd. (J. and P. Coats Ltd., Assignee)*, . Mahajan, J. speaking for the Bench of the Hon'ble Supreme Court agreed with the view taken by the Division Bench of our High Court.

18. It has been contended by the learned counsel for the defendant that the cartons of the plaintiff and the defendant are substantially dissimilar. A list of such dissimilarities is annexed as Exhibit "E" to the affidavit of Shri Vithaldas Hirji Somaiya, an officer of the defendant, being affidavit dated 31st July 1991. I have carefully gone through the affidavit as well as Annexure "E" thereto and the plaintiffs rejoinder thereto. The alleged dissimilarities are of no consequence. It has been contended by the learned counsel for the defendant that the concerned product is known in the trade by its name. The brand name Surf which is the essential feature of the plaintiffs mark and the brand name Nirma is the essential feature of the defendant's mark -- says the learned counsel for the defence. The brand name of the two goods is undoubtedly one of the essential features of the mark but that is not all. The star device with star burst or star flash and the rays emanating therefrom in background of certain colour coupled with certain get up is also the equally important essential feature of the plaintiffs mark. It has been contended by the learned counsel for the defendant that the colour scheme of the defendant's mark evidenced by Exhibit "O" to the plaint is different and not a colourable imitation of the colour scheme of the plaintiff's label. In particular, it has been emphasised that the colour yellow has not been used by the defendant in Exhibit "O" to the plaint, which colour is predominant part of the plaintiffs mark. It has been submitted that the get up and appearance of the two marks is substantially different and no one is likely to be confused or deceived. I am not

impressed at all by the defendant's case on overall view of the matter notwithstanding the omission of colour yellow from the defendant's mark.

19. In the affidavits filed by the defendant, the defendant has denied that the star device of the star flash or star burst showing a star in white with rays emanating therefrom in white against a blue background is an essential feature of the plaintiff's mark. After going through the considerable material produced before me and the detailed submissions made by the learned counsel on both sides at the Bar, I have come to the conclusion, though prima facie, that the device of a star flash or star burst showing a star in white with rays emanating therefrom in white against a blue background is one of the very essential features of the plaintiff's label mark enumerated in paragraph 5 of the plaint and is so understood in the trade for decades. The above referred device adopted on the label has become distinctive of the plaintiff by reason of its constant user for decades. Sales figures of the product of the plaintiff annexed to the plaint also support the plaintiff's case. The defendant has undoubtedly made some variations and alterations in the colour device while introducing the carbon at Exhibit "O" to the plaint. In my judgment, such minor changes in the colour scheme are of no significance as the defendant has colourably imitated the essential features of the star device and the general get up of the plaintiff's carton. The contention that the star device or the rays emanating from the star flash is not an essential feature of the plaintiff's mark does not appeal to me at all. Several affidavits of the consumers have been filed on both sides. The plaintiff has filed the following affidavits:--

(1) Affidavit of Bhikaji Pandurang Joshi, dated 4th August 1991. In paragraph 9 of this affidavit, it is stated that the average consumers like him identifies the SURF with its colour-scheme of blue, red and white get up and star burst, star flash, rays emanating thereto in white against blue background and any other product with similar in this style would be confused to be SURF and/ or manufactured by Hindustan Lever Limited. The star device with the above referred get up is a part of several registered labels relied upon by the plaintiff during the course of years and is used by the traders and retailers in their shops while advertising the goods.

(2) Affidavit of Mrs. Madhuri Shirish Joshi, dated 5th August, 1991;

(3) Affidavit of Shri Bhagwandas Dilani, dated 5th August, 1991;

(4) Affidavit of Shri Mahindra Liladhar Thakker, dated 5th August 1991;

(5) Affidavit of Shri Harmeet Singh Sethi, dated 6th August 1991; and

(6) Affidavit of Shri Atul N. Visarie, dated 6th August 1991.

20. As against these affidavits, the defendant has also relied upon the following affidavits of consumers:--

(1) Affidavit of Shri Maheshkumar son of Vadilal, dated 6th August 1991;

(2) Affidavit of Shri Rajendra Kumar Patel, dated 5th August 1991; and

(3) Affidavit of Mohanlal Talreja, dated 5th August 1991.

The last two affidavits are from grocers of Ahmedabad who have deposed to the effect that the products Super Nirma and Surf are so side by side and it does not create any confusion and deception because the names Surf and Nirma are quite different and distinct. After giving my anxious thought to the problem. I do record that I am considerably impressed by the affidavits filed on behalf of the plaintiff, in addition to my own judgment of impression formed on my mind while comparing the registered marks with the impugned carton Exhibit "O" to the plaint.

21. There is one more facet of the matter which is of considerable significance. The plaintiff has clearly demonstrated -- almost beyond doubt -- that except the impugned carton at Ex. O to the plaint, no other manufacturer in India is using the star device or star flash or star burst with the rays emanating therefrom. Let me clarify that my strong prima facie findings in favour of the plaintiff and against the defendant are based on substantial imitation of the star device adopted by the defendant and not on imitation of colour scheme as such. Normally, no exclusiveness may attach to use of any particular colour in the trade. If there is substantial imitation of get up and the device which is essential feature of the mark, the case would be different. This case appears to fall in this category. The intention of the defendant appears to be to indulge in unfair trading by skilful imitation of essential features of the plaintiff's mark as would be obvious also from the discussion in subsequent paragraphs of this order.

22. In the defendant's carton, one finds a reference to the use of the logo "CC with arrow" which is to be found on the plaintiff's carton. What is the explanation of the defendant on this aspect? M/s. Colour Carton Limited is a well known quality printers in the industry. Mr. K. C. Daruwalla, Executive (Marketing) with Colour Cartons Ltd. has stated in his affidavit dated 19th August 1991, after setting out details, that M/s. Colour Cartons Ltd. have not prepared the art work Exhibit "O" to the plaint and their monogram appears on the carton at Exhibit "O" unauthorisedly and-without permission. It appears that the defendant had approached M/s. Colour Cartons Ltd. for printing cartons in connection with a proposal to print cartons for packing their product to be exported to Soviet Russia. It appears that the said proposed transaction between the defendant and M/s. Colour Cartons Ltd. did not materialise. The defendant had supplied draft of the proposed label to M/s. Colour Cartons Ltd. for improvement. Since the quotations given by M/s. Colour Cartons Ltd. did not find favour with the defendant. M/s. Colour Cartons Ltd. returned the rough draft label back to the defendant. It is the assertion of Mr. Daruwalla in his affidavit that the above referred event has no nexus with unauthorised use of their monogram on certain Exhibit "O" to the plaint by the defendant. The carton Exhibit "O" to the plaint coupled with the said monogram given an impression that Exhibit "O" was prepared and designed by the above printers when it is an admitted fact that M/

s. Colour Cartons Ltd. had nothing to do with preparation of Exhibit "O" to the plaint. It is the case of the plaintiff that the artist of the defendant must have prepared carton Exhibit "O" to the plaint after keeping the plaintiffs carton and labels, before him. The impugned carton Exhibit "O", to the plaint is a colourable imitation of the plaintiffs carton with a deliberate intention to harm the goodwill of the plaintiff. The plaintiff has submitted that it is for the defendant to explain as to how the logo "CC with arrow" appears on the defendant's carton. In the affidavits filed on behalf of the defendant, it is alleged that M/s. Colour Cartons Ltd. had implanted their logo on the draft work returned by them to the defendant when the deal for entrustment of printing work did not materialise between the defendant and M/s. Colour Cartons Ltd. and the monogram of the above referred printers identical to what is printed on the plaintiffs labels appears on the impugned carton Exhibit "O" to the plaint by mistake. It is not possible to accept this unnatural and involved explanation of the defendant.

23. The defendant has relied on affidavit of one Mr. Khurana dated 14th August 1991. The said Mr. Khurana has stated on oath that he had prepared the design of the carton (Exhibit "O" to the plaint) by taking ideas from the designs shown in various books. The said Mr. Khurana has averred that he has not taken any features for this label from the plaintiff's Surf label. It is further averred that the rays device is placed on the said label only to show whiteness that the cloth may acquire after use of the said detergent powder. In my opinion, the said affidavit is vague and unreliable. It does not state as to when Mr. Khurana was employed by the defendant. It does not state as to when the design was prepared. It does not state as to from which pages of the book the artist had received his ideas to prepare Exhibit "O" to the plaint. I am not prepared to attach any weightage to the affidavit of Mr. Khurana at this stage as it does not ring true. In spite of some change in the details of the colour scheme and in spite of prominent display, of the trade mark "Nirma" on Exhibit "O" to the plaint, I have reached a strong prima facie conclusion that the defendant did adopt essential part of the plaintiff's mark by colourable imitation of the star device with a star flash and rays emanating therefrom in a particular background, which has a substantial chance of creating confusion. The figures of sales of these goods given by both sides annexed to the respective affidavits need not be referred to in detail. The said figures are eloquent.

24. It is now time to refer to some of the contentions urged on behalf of the defendant in respect of the plaintiff's plea based on alleged infringement of copyright.

25. Section 2(c) of the Copyright Act, 1957 defines an "artistic work" to mean "a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph. .". It is indisputable that an artistic label which can be registered as a trade mark under the Trade Marks Act can also be registered as an artistic work under the Copyright Act, 1957. The label annexed to the certified extracts from the Register of Copyrights are the labels of artistic work

which were published by the predecessors of the plaintiff many years ago.

26. Once it is held that these labels enjoy the benefit of the Copyright Act, 1957, the next question which arises is as to whether the defendant has infringed the copyrights in the said labels as claimed by the plaintiff? The learned counsel for the defendant has contended that the plaintiff has not proved that the plaintiff is the owner of the copyrights in respect of the said labels attached to Exhibits "Y-1" and "Y-2" to the plaint. u/s 17 of the Copyright Act, 1957, the artist concerned is entitled to copyrights except in cases specified therein. If the artist has made the work of art in the course of employment under a contract or service or apprenticeship, the employer concerned is entitled to the copyrights in the artistic work as the first owner thereof. Section 48 of the Copyright Act, 1957 reads as under:

"48. The Register of Copyrights shall be prima facie evidence of the particulars entered therein and documents purporting to be copies of any entries therein, or extracts therefrom certified by the Registrar of Copyrights and sealed with the seal of the Copyright Office shall be admissible in evidence in all Courts without further proof or production of the original."

27. The learned counsel for the defendant has contended that in spite of notices served on the Advocates for the plaintiff, the plaintiff has been unable to produce the contracts of employment between the plaintiff and the artist Mr. B. G. Naik and it should, therefore, be taken that the plaintiff is not the owner of the Copyright in the artistic work evidenced by certificate (Exs. Y-1 and Y-2 to the plaint). It is not possible to accept this submission in view of the strong prima facie presumption attached to the said certificates u/s 48 of the Copyright Act. The certificate at Exhibit "Y-1" states that the label attached thereto was first published by Hindustan Lever Limited in 1976. The said certificate clearly describes Hindustan Lever Limited as the owner of the copyright. Similar is the case in respect of the artistic work (Exhibit "Y-2" to the plaint). I have no doubt in my mind that the plaintiff has paid the necessary consideration to the artist Mr. B.C. Naik through M/s. Lintas Ltd. and the plaintiff is entitled to all the copyrights in respect of the labels since long. It was contended by the learned counsel for the defendant that the said label is a design which was capable of being registered under the Designs Act, 1911 and the copyright attached to the said labels, if any, has ceased to be operative by virtue of the provisions contained in Section 15(2) of the Copyright Act, 1957. With respect to the learned counsel, I find no merit whatsoever in this contention. The expression "design" has been defined in Section 2(5) of the Designs Act, 1911. The said expression has been authoritatively interpreted in various judgments, of various High Courts. To give an illustration, one may usefully refer to the judgment of Chinnappa Reddy, J. in the case of Ampro Food Products Vs. Ashoka Biscuit Works and Others, . It was held in this case that a design is necessarily part and parcel of the article manufactured while a trade mark is necessarily not so. Thus the label to be put on a carton to be used as a container for the goods can never

amount to design within the meaning of Section 2(5) of the Designs Act. Section 15(2) of the Copyright Act, 1957 has no application to this case. No such contention is raised in any of the affidavits filed on behalf of the defendant.

28. The learned counsel for the defendant then argued that the impugned label was not a copy or substantial copy of the label registered, vide certificate (Exhibits "Y-1" and "Y-2" to the plaint). On this aspect, one may usefully refer to the judgment of the High Court of Madras in the case of C. Cunniah and Co. and Others Vs. Balraj and Co. and Another, . It was held by the Hon"ble High Court of Madras that to constitute infringement of copyright, degree of resemblance and substantial resemblance was sufficient and exact resemblance was not necessary. It was held by Ganpatia Pillai, J. speaking on behalf of the Bench, that in every intelligent copyright there are bound to be a few changes. In my judgment, with respect to the learned counsel for the defendant, only a few changes have been introduced in Exhibit "O" to the plaint, but substantially the label to be used on the carton Exhibit "O" is an obvious colourable imitation of the star device of the label used by the plaintiff for decades with ulterior motive and the points of dissimilarities are totally inadequate to wipe out the general impression of an unwary purchaser of imperfect recollection. It cannot be forgotten that the defendant appears to have intentionally planned a strategy of imitating the star device of the plaintiff and even the monogram of the plaintiffs printer appears unauthorisedly on Exhibit "O" to the plaint.

29. The plaintiff has made out a strong prima facie case regarding the cause of action based on infringement of their label marks referred to in the notice of motion as well as infringement of copyrights as discussed above. As regards alleged passing off of the defendant's goods as if of the plaintiff, the defendant has an arguable defence in view of incorporation of additional material in Exhibit "O" to the plaint and conspicuous printing of their brand name" Super Nirma" etc. thereon.

30. The next question which arises is as to on whose side the balance of convenience lies and whether I should deny relief to the plaintiff at this interlocutory stage. In my view, the balance of convenience is definitely in favour of the plaintiff and not in favour of the defendant. The defendant can market its product without adopting the carton Exhibit "O" to the plaint or any other label deceptively similar to the label mark of the plaintiff or the essential features thereof.

31. Taking an overall view of the matter, I pass the following order:--

(1) I refuse to grant interim relief in terms of prayer (a) of the motion as both sides have an arguable case.

(2) Notice of Motion is made absolute in terms of prayers (b) and (c) thereof only.

(3) Prayer (d) of the Notice of Motion is declined.

(4) Having regard to the overall view of the matter, I direct the defendant to pay

to the plaintiff a sum of Rs. 5,000/- as costs of this Notice of Motion.

32. In order to enable the defendant to have a fair chance to file an appeal and apply for stay, operation of this order shall remain stayed for a period of four weeks from today. The defendant shall give one week's notice to the plaintiff before moving the appellate Court.

33. Issue of certified copy is expedited.

34. Order accordingly.