

(1996) 02 DEL CK 0047
In the Delhi High Court
Case No : FAO (OS) No. 1 of 1996

Kellogg Company

APPELLANT

Vs

Pravin Kumar Bhadabhai and another

RESPONDENT

Date of Decision : 15-02-1996

Acts Referred:

Citation : (1996) 36 DRJ 509

Hon'ble Judges : Dalveer Bhandari, C.J;M. Jagannadha Rao, J

Bench : Division Bench

Advocate : Mr. Arun Jaitley, Mr. Pravin Anand and Ms. Binny Kalra, for the Appellant; Mr. S.K. Bansal and Mr. Bhagwati Prasad, for the Respondent

Judgement

M. Jagannadha Rao, C.J.—This is an appeal by the plaintiff, Kellogg Company against the order of the learned single Judge in is 2094/94 in Suit 432/94 dated 31.10.1995. By that order, the learned Single Judge dismissed the application of the appellant for grant of temporary injunction under Order 39 Rule 1 CPC against the respondent. The dispute pertains to trade mark, emphasis being on trade dress. Though reference is made in the grounds of appeal to the carton being a piece of artistic work within Section 2(c) of the Copyright Act, arguments were mainly focussed on "trade dress".

2. The appellant Kellogg's Company sells Corn Flakes with cartons which describe the cartons as "Kellogg's CORN FLAKES" (the original and the best). The respondent is selling corn flakes using a carton more or less similar in size but with the title "AIMS ARISTO CORN FLAKES" written just at the place where appellant's display the words "Kellogg's CORN FLAKES". This is done at the left hand top of the carton. The appellants grievance in the suit as well as in the is was that the carton was likely to confuse the buyers of corn-flakes and there was every likelihood of consumers purchasing the respondent's goods in the belief that they were of the appellant. The learned single Judge after referring to the case-law pertaining to "trade dress", of the appellant dismissed the is observing :

"If the trade dress in this case is as was found in the above case (i.e., Colgate Palmolive and others v. K. F. Pattron ((1978) RPC 635). I would have had no hesitation to accept the arguments of Mr. Anand. Applying the test laid down therein, I am of the view that the trade dress of the defendant in this case is entirely different from the trade dress of the plaintiff and there is absolutely no scope for any confusion."

On that basis, the learned Judge stated that the appellant had not proved prima facie case nor balance of convenience and hence no injunction could be granted.

3. In this appeal, we have heard learned counsel, for the appellant at the stage of admission. Learned counsel for the defendant was also present.

4. It was contended before us that the learned single Judge, having accepted the legal principles relied upon for the appellant in respect of "trade dress" erred, on facts, in holding that there was no scope for confusion among the consumers. It was pointed that the size and shape of the carton was similar being rectangular, that in the words "FLAKES" in the appellant's carton the words L and A were joined together closely or rather touch each other, that respondent also described his goods as original and the best, that both contain a picture of the corn flakes, that there was a small square on the left hand top where the words "Kellogg's CORN FLAKES" were written inside the square, and that the respondent had also put a square on the left hand top with the words "AIMS ARISTO CORN FLAKES". It was further stated that in all the cartons of Kellogg's in regard to various commodities, there was a red-band at the top which took off from the square on the left top and ran horizontally across on the front top into the right and to the other sides and respondent also used a similar red band taking off horizontally from the square on the left top. It was also argued that even in regard to the square on the left side top, Kellogg's used an inner red border, then a white gap, and then an outer green border, running all along the sides of the square while respondent was also using the same red and green borders for the square on the left top. It was argued that these similarities in dress were so clear that purchasers were sure to be misled. It was submitted that there was a presumption that the consumer's memory was short and if a consumer had purchased a carton of appellant's at one point of time, he would easily mistake the respondent's carton for the appellant's. It was further submitted that respondent had done this with dishonest intention.

5. Before we go into the above aspects, it is necessary to refer to a few more facts. If we look at the appellant's carton, we find that the words "Kellogg's" is displayed very prominently in fairly big letters, above the words, "CORN FLAKES" in the square on the left hand top. Then to the right of the words "Kellogg's CORN FLAKES" there is the picture of the face of a hen, up to its neck. There is a bowl containing corn flakes and a cherry therein with a big spoon. Pouring of milk is shown into the plate. On the right side of the carton, it is stated prominently that the flakes are 99% fat free.

6. When we come to the respondent's carton, we have in the left hand top rectangle the words "AIMS ARISTO" corn flakes prominently written. We also have ISI in a smaller rectangular bracket but shown quite prominently below the rectangle on the left-top, a plate blue in colour with corn flakes and cashew etc. There is no picture of milk pouring into the plate.

7. In other words, while in the rectangle on the left hand top, the words Kellogg's corn flakes are prominent for the appellant, the words "AIMS ARISTO" corn flakes appear very prominently for the respondent at the same place.

8. It is true that the appellant has referred to certain similarities in the size and shape of the carton, there being a square on the left top with word "KELLOGG'S CORN FLAKE'S; the words L and A being joined, border being red and green and a red band running round in the top horizontally. It is true that these similarities were not set out in the order. But in our prima facie view, the prominent display of the words "Kellogg's" in bold red letters in white background inside the square on the left-top appellant's carton cannot go unnoticed by any buyer. We have to understand the learned Judge's words "trade dress of the plaintiff is entirely different", in that light, prima facie.

9. The law relating to "trade dress" is very clear. Kerly in "Law of Trade Marks" (12th Ed. 1986, para 16.67) says that it is usually true in some degree that a trader's goods are recognised by their general appearance, or "get-up". Accordingly, resemblance or "get-up" is not uncommonly an ingredient in passing-off, and it is possible for imitation of get-up alone to amount to passing-off. Such cases are rare, since few traders rely on get-up alone to distinguish their goods, so that trade names and word trade marks are ordinarily present too, and the author says :

"and in these days, in this country, a difference in names is enough to warn the public that they are getting one trader's goods and not the others" (Sapers v. Specters (1953) 70 RPC 173".

In Fisons Ltd. v. E. J. Goodwin 1976 RPC 653, the plaintiff's bag displayed the words "Fison's Gro Bag" while the defendant's bag contained the words "Goodwin's Crop-Bag; and it was held that the prominence given to the name overshadowed the other similarities in get-up. The plastic bags were peculiar. The plaintiffs were manufacturers of the plastic bag filled with a peat-based compost from which plastic rectangles could be removed thereby exposing the compost beneath the plastic. Seedlings could then be planted in the compost so that the bag could function as containing growing element. The bag was partly over-printed with horticultural decoration and instructions and marked "Fisons Gro Bag". They were in market for 2 years. The defendants were peat merchants and got plastic bags produced with "identical size" and which bore "over-printed" instructions and decoration somewhat similar to those of the plaintiff's bag. While refusing injunction, Brightman J. observed that even accepting that the plaintiff's had a get-up reputation in their growing bags and though there were

obvious similarities between the bags in issue, it was inconceivable that any one seeing the defendant's grow bag could fall to observe that it was a product of the defendants" and that a normal purchaser could not be misled. He further said that "if the Fisons Gro-Bag had not contained the name "Fisons" or if the name "Goodwins" had not been so prominently displayed, by the defendants, he might have reached a different conclusion. He doubted whether they could have done more to signify to a buyer that he was watching at a product of Goodwins and not at a product of Fisons".

10. *King & Co. Ltd. v. Gillard & Others* 22. RPC 327, was also a case of similar "get-up". The plaintiff was selling, for 15 years, dried materials for soup in packets of certain size, shape and printing put in steel boxes of a peculiar kind, with the words "Edwards" displayed thereon. Later, defendants started selling similar preparations for soup which were put up in a series of similar packets and boxes, and the name "Gillard's" appearing at the place where Edwards" appeared on the plaintiff's goods. The plaintiffs also complained against the wrapper of the defendants containing untrue statement as to Prize medals and awards in the same manner as the true statements of the plaintiff. Kekewich, J. refused to grant injunction and in the Court of appeal, while confirming his order, Romer L.J. observed that the word "Edwards" being printed prominently on the packets and the words "Gillard" printed on defendant's packets, there was no scope for confusion in spite of the similarity in the packets and boxes.

11. In yet another case, relating to similarity in trade-dress, the Privy Council, in *Cadbury Schweppher Pty. Ltd. v. The Pub-Squash Co. Ltd.* (1981) RPC 429, confirmed the judgment of Powell J. of the Supreme Court of New South Wales. In that case, the plaintiffs were selling lemon squash under the name "Sole" in greenish-yellow cans with a medallion type label. The defendants launched a lemon squash called "Pub Squash" and the label was of a medallion type bearing the words "Pub Squash" on the label. The cans were of the same size and shape with colour yellow as those of plaintiff. The proceedings of the plaintiff brought on the ground of passing off, unfair trading etc. were dismissed. Judgment of Powell J. is elaborate and he held that the defendants had sufficiently differentiated their product by their "name". On appeal to the Privy Council, it was observed that over emphasis on advertised description of a product might indeed lead to stifling of competition. Lord Scarman said :

"But competition must remain free, and competition is safeguarded by the necessity for the plaintiff to prove that he has built up an intangible property right" in the advertised description of his product, or, in other words, that he has succeeded by such methods in giving his product a distinctive character accepted by the market. A defendant, however, does no wrong by entering a market created by another and then competing with its creator. The line may be difficult to draw; but, unless it is drawn, competition will be stifled."

Their Lordships then said that the test applied by, Powell J. in the instant case was that one has to see whether the consuming public would be confused or

misled by the get-up, the formula or the advertising of the respondent's product into thinking that it was the appellant's dissimilar product. Powell J. held on the facts, that the public were not so deceived .

12. In *Schweppers Ltd. v. Gibbens* (1905) 22 RPC, the appellant was selling Soda Water in bottles, with a neck label around then, the body of the label being of chocolate colour with a white border and a red medallion in the centre of the label. The respondents, subsequently, sold soda water in bottles with a somewhat similar neck label round them in same colour and with a central red medallion. However, appellants' labels showed "Scheweppe's soda water" printed on them in white characters while respondents' contained the name "Gibbens Soda Water". Action by plaintiffs failed. It was held by the House of Lords that a fraudulent intent cannot be presumed inspire of the similarities in the bottles, labels colour and medallion because the distinguishing feature of name adopted by defendants showed that they had no intention to deceive purchasers. Lord Halsbury LC said :

"I should have thought if you looked at the two bottles together no human being could have mistaken one for the other. If "Royal" and "Flag" were sufficiently distinctive in the case to which the learned counsel called our attention *Payton & Co. v. Shelling, Lampard & Co.* 17 RPC 628, I should have thought "Gibbens" and "Schwappes" are equally impossible to be confounded with each other."

Lord Halsbury said it was "ridiculous" to apply the principle of similarity in trade dress in such a situation. He said :

"I can quite understand a case in which, although colourably a defendant has introduced his own name, yet the nature of the wrapping up, the nature of the package itself, or, in this case, the shape of the bottle, may all have been so closely imitated that the mere introduction of some distinctive mark, to which no ordinary observer would have applied his mind, will not get rid of the obvious intention to pass one goods off as the other; but to apply the proposition to this case appears to me to be a little short of ridiculous".

It was held that the name of "Gibbens" was so plainly placed upon the bottle as it could possibly be and it was in the place where "Schweppers" was on the bottle of the appellant, and there was no intention to deceive.

13. The above case also answers the contention of fraudulent intent argued by the appellant's counsel before us. Similar views as to absence of fraudulent intent were expressed in *Schweppers Pty Ltd. v. The Pubsqaush Co. Ltd.* (supra), also, to which we have already referred and which came from New South Wales before the Privy Council (1981) RPC 429 (PC).

14. In the present case, in spite of any other close resemble ness in the cartons, the name "AIMS" written prominently on the respondents carton would, in our view, prima facie, as in case before Lord Halsbury show that there was no intention on the part of the defendant to play fraud by misrepresenting his goods

as the goods of the appellant. In that very case, Lord Hal bury emphasized the need to see the whole description on the goods as one whole and not the individual features in isolation. He said :

"Inasmuch as you and certainly not to impute fraud without proof, you are not to suggest that people are fraudulently committing some commercial trick without sufficient evidence, and I cannot conceive here how anybody could gravely argue that the one thing could be mistaken for the other by anybody who looked at it.

**** * * * * * The whole question in these cases is whether the thing - taken in its entirety, looking at the whole thing, is such that in the ordinary course of things a person with reasonable apprehension and with proper eyesight would be deceived."

Thus, the above case also lays down that the trade dress or rather the whole thing must be seen in its entirety and not parts in isolation. It is not permissible, Therefore to say that the square on the left side top had a small red and green border or there was a red band horizontally and defendant's carton if examined from close quarters, showed these features. Viewed as a whole, one can see that the words Kellogg's, and AIMS are prominently displayed on each and Therefore there can be no confusion, prima facie.

15. That brings us finally to the question of the failing memory of the customer. The argument is that customer's have short memory and that if the trade dress is similar, the customers are likely to get confused.

16. It has now been held that there are limitations to the theory of imperfect memory. Halsbury's Laws of England (4th Ed.) (Vol. 48, para 139) says that this principle of imperfect recollection must not be pressed too far. It says :

"The Tribunal must bear in mind that the marks will not normally be seen side by side and guard against the danger that a person seeing the new mark may think that it is the same as one he has seen before, or even that it is a new or associated mark of the proprietor of the former mark. However, the doctrine of imperfect recollection must not be pressed too far Chappie Ltd. v. Spratt's Patent Ltd. (1954) 71 RPC 455 . Marks are often remembered by general impressions of by same essential feature (Decordova Vick Chemical Co. (1951) 68 RPC 106 (PC) 289, (on appeal 71 RPC 348. (CA).

In fact in Schweppers Ltd. case above referred to, Lord Halsbury said "and if a person is so careless that he does not look, and does not, treats the label fairly but takes the bottle without sufficient consideration and without reading what is written very plainly indeed up - the face of the label on which the trade has placed his own name, then you certainly cannot say he is deceived in fact, he does not care which it is. That would be the true interference which I think a person would draw from conduct so described."

17. Having dealt with the contention of imperfect memory of the customer ,we shall now deal with the class of purchasers, which is also an important factor.

who are the persons who go to purchase "Kellogg's" Corn Flakes ? Prima facie, in our opinion, these people belong to a middle-class or upper middle class and above who are fairly educated in English and are able to distinguish "Kellogg's" and what is not "Kellogg's". In American Jurisprudence (2d) (Trade Marks Supp. para 19 page 178) it is said that it is necessary to note the fact :

"that customers for fasteners are sophisticated and discerning, that defendant acted with goods faith.

The case was one where customers purchasers of fasteners in the automobile industry. (Standard Pressed Steel Co. v. Midwest Chrome Process. Co. (LDC III (US PU 106))). Again Kerly, Law of Trade Marks (12th Ed. 1980) (Para 1706) says that :

"If the goods are expensive and not of a kind usually selected without deliberation, and the customers generally educated persons, these are all matters to be considered (Piano list (1906) 23 RPC 774, Cloudiness Ash v. Invica (1911) 28 RPC 597 : 29 RPC 465 (CA) (HL (dentists), Rysta (1943) 60 RPC 87.

18. In Piano list's (supra) case an application was made for the registration as a trade mark of the word "Neola" for "piano player" being a musical instrument included in class 9". Coming to know of this application, the registered proprietors of the trade mark "Pinole" who were registered for all goods in class 9, opposed the above application for registration. The Registrar overruled the objection and ordered registration. On appeal, Justice Parker said that having regard to the kind of customers" for such goods and the distinction in the names, there was not likely to be any confusion and dismissed the appeal.

19. If that was so between "Neole" and "Pinole", the case of Kellogg's and AIMS, in our prima facie view, presents no difficulty for distinct identification. Parker J. in fact observed in the above case :

"Of course, one knows that the persons who buy these articles are generally persons, of some education, my opinion is, having regard to the nature of the customer, the article in question and the price at which it is likely to be sold, and all the surrounding circumstances, no man of ordinary intelligence is likely to be deceived ..."

We are, on the facts of the case before us, prima facie of the same opinion in regard to Kellogg's and AIMS.

20. Learned counsel for the appellant placed reliance on Colgate-Palmolive Ltd. v. K. F. Pattron, (supra). In that case, the plaintiff was selling toothpaste as "Tringate". The appellant used packages with colours red, white and dark blue the respondents also used red, white and blue. It was held that the defendant borrowed features from the plaintiff's packaging, tubes and labels and the ordinary purchaser of normal memory was not to be expected to examine the goods keeping them side by side, and the get-up would cause confusion. In our prima facie view, this case is clearly distinguishable because, apart from the fact

that the get up was the same, the name used by the defendant was found to be deceptively similar. The question of imperfect memory was relevant there because the purchaser could be a person who would not discern whether the tooth paste was Colgate or Tringate.

21. We shall now deal with likewise *Tavener Rutledge Ltd. v. Specters Ltd.* (1989) RPC 83, cited for the appellant. There, no doubt, both parties sold sweet or "fruit drops" in decorated tins. No doubt the names, Taverners fruit flavoured drops and Specters fruit flavoured drops were somewhat different but, if one looks at the box, one can find the trade dress was too prominent and the names not that prominent. The learned Judge Dankwerts, J. held that it was possible that purchasers might get confused. *Prima facie*, the case goes against the view expressed by the House of Lords in the cases referred to above. Further this case has been placed in a special category by writers because here the picture of the sweets on the top of the boxes was so similar, spreading over the entire face of the box, and the learned Judge felt more impressed by that fact though the names were not so similar, this view appears from Halsbury's Law of England 4th Ed. para 168 which says that we should look at the photographs of the boxes. Kerly says (para 16.6.7) that this case was treated as a case of deliberate copying offending plaintiff's copyright. It was also held that there was infringement of registered trade mark. So far as passing off was concerned, it was seen as a case where having regard to the arrangement of the picture of the sweets on the top of the box, that a person with imperfect memory could be misled. *Monday v. Cxarey* (1905) 22 RPC 273, cited for the appellant is also distinguishable. The appellants mark there was of an "ace of clubs" with the word "club" upon bottles which were sold with label "Club Black Enamel", while defendants did likewise sell with "ace of spades" and label "hub Black Enamel". Injunction was granted on the ground of fraudulent get up. The words "Hub" and "club" were treated as similar and likely to create confusion. This case is also distinguishable.

22. In the result, on our *prima facie* conclusions, we reject the plea of similarity or likelihood of confusion, we reject the plea of fraud as well as the one based on imperfect memory. We are of the view, *prima facie* that even though the get up is similar, the different names Kellogg's and AIMS ARISTO prominently displayed, make all the difference and this is not a fit case for interference with the order of the learned Single Judge refusing injunction.

23. These are *prima facie* views and it is made clear that the suit will be disposed of on the basis of such evidence as may be produced therein without being influenced by anything said here. Appeal is dismissed.