

(1987) 12 DEL CK 0003
In the Delhi High Court
Case No : FAO (OS) No. 219 of 1986

M/s. Johnson and Johnson and another	APPELLANT
Vs	
Christine Hoden India (P.) Ltd. and another	RESPONDENT

Date of Decision : 04-12-1987

Acts Referred:

Citation : AIR 1988 Delhi 249

Hon'ble Judges : Y.K. Sabharwal, J;S.S. Chadha, J

Bench : Division Bench

Advocate : Anoop Singh, H.P. Singh and Manmohan Singh, for the Appellant;
Mohan Dewan, N.K. Bhardwaj and Feroze Andhyarujina, for the Respondent

Final Decision : Dismissed

Judgement

Y.K. Sabharwal, J.—The appellants are plaintiff's in the original suit (hereinafter referred to as "Plaintiffs"). Plaintiff No. 1 is a Corporation organised under the laws of New Jersey, U.S.A. Plaintiff No. 2 is a Company incorporated under the Companies Act, 1956. Plaintiffs' trade mark is STAYFREE". The plaintiff's have brought a passing off action. According to the plaint, since June 1978 plaintiff No. 1 has permitted plaintiff No. 2 to use the said trade mark "STAYFREE" in respect of sanitary napkins manufactured by them and since then they have used the said mark in respect of sanitary napkins manufactured and marketed by them in India under a licence granted by plaintiff No. 1. The plaintiff's claim that the mark "STAYFREE" has acquired a wide reputation and goodwill in India and has come to be associated by the traders and members of public in India exclusively with the plaintiff's. Along with the plaint a statement showing sales figures of the goods sold under the mark "STAYFREE" in India from 1978 till Dec. 1985 has been filed. Another statement showing amounts spent on advertisements and publicity has also been filed. They claim that the mark "STAYFREE" has acquired a vast and enviable reputation and goodwill and has become distinctive of their goods.

2. Plaintiff No. 1 applied for registration of the trade mark "STAYFREE" under

application No. 369841 dt. 18th Dec, 1980 in respect of sanitary napkins and personal hygiene products used in menstruation claiming user since 1978. The application was advertised in the Trade Marks Journal on 16th Aug. 1984. On 26th Nov., 1984 defendant No. 1 filed a notice of opposition to the said application. The said proceedings are pending. It has been further averred in the plaint that since June, 1978 the plaintiff's have adopted polythene packs having distinctive colour scheme of blue, pink and white getup which is easily recognisable by the customers. On the packing, the mark "STAYFREE" has been prominently displayed and the catchy legend "NO BELTS; NO PINS; NO STRINGS" is printed. It is claimed that in or about Feb., 1986 the plaintiff learnt that the defendants have also used the marks "STAYFREE" in respect of sanitary napkins and have substantially copied the plaintiff's pack and the mark "STAYFREE". According to the plaintiff's, the defendant No. 1 also adopted their packing which has a deceptively similar getup and colour scheme as that of the packing of the plaintiff's viz. blue, yellow and white combination. They further claimed that the defendants have fraudulently and blatantly adopted the same wordings viz. "No Belts, No Pins, No Strings" with the whole aim and intention to trade upon the enviable reputation and goodwill acquired by plaintiff No. 2 in respect of their goods and to make dishonest and illegal gains. The suit is pending.

3. Pending the disposal of the suit the plaintiff's by an application under O. 39, Rr. 1 and 2 read with S. 151, C.P.C. sought temporary injunction restraining the defendants, their servants and agents from in any manner using the mark "STAYFREE" or the impugned legend "No Pins, No Belts, No Strings" on any packing for sale of sanitary napkins. The respondents are defendants in the original suit (hereinafter referred to as "the defendant"). In opposition to the claim made by the plaintiff's various preliminary objections have been raised by the defendants in their reply. The defendants opposed the application for grant of temporary injunction primarily on four points. Firstly, that their trade mark is "Comfit Always" and not "Stayfree". Secondly, that the word "STAYFREE" is a common descriptive word for the product and is incapable of distinguishing the goods; thirdly that the words "STAYFREE" is a common dictionary word and was in existence much before either of the plaintiff's came into existence and lastly that there is no likelihood of any confusion or deception.

4. The learned single Judge has dismissed the application of the plaintiff's for grant of temporary injunction. The learned single Judge has come to the conclusion that there is no likelihood of deception and it cannot be said that anyone would be misled. The learned single Judge has further come to the prima facie conclusion that both packings are quite distinctive. The further finding of learned single Judge is that the word "STAYFREE" has reference to the user, that is, it gives a message to the user. The learned single Judge is of the view that it cannot be said that the defendants are marketing their goods in the packing with the mark "STAYFREE". On the basis of the material placed on the record by the parties the learned single Judge had held :- "the plaintiff's have not been able to

show that the use of the words "STAYFREE" by the defendants on their packing is calculated to deceive the customers as such."

5. The learned counsel for the plaintiff's has not objected to the colour scheme of the packing of the defendants nor has he objected to the use of the legend "No Belts, No Pins, No Strings" for the purpose of decision of this appeal. The same was the position before the learned single Judge although in the application the plaintiff's did claim an order of restraint for the use of the colour scheme and the aforesaid legend by the defendants. Now the only objection is to the use of the word "STAYFREE" on the packing of the defendants. Shri Anoop Singh has made two contentions. One, that the use of the mark "STAYFREE" by the defendants is likely to deceive the customers and general public and (2) that the mark "STAYFREE" is distinctive of the goods of the plaintiff's and that the conclusion of the learned single Judge on both these points is not sustainable.

6. It is always a question of fact in each case whether the deception or confusion is likely to be caused or not by use of the impugned mark. Both the learned counsel have cited various judgments in support of their respective contentions. Although precedents act as good guide for achieving clarity and help the court in coming to a just conclusion but in the end, in these cases, the court has to put itself in the position of an average customer and ask a question to itself whether there is a likelihood of a deception or confusion or not and then answer the question on that basis. Lord Langdale MR nearly a century ago said that "A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practice such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person." The aforesaid statement was referred to with approval by Lord Scarman in *Cadbury Schweppes Pty v. Pub Squash Co. Pty*, (1981) 1 All ER 213.

7. I will proceed further by keeping in view the aforesaid statement of principle which has been widely accepted by courts of law. In so far as the facts and circumstances of the present case are concerned it is the admitted case of the parties that the average customers are literate and semi literate ladies. In this view of the matter one will have to put himself in the position of a literate or a semi literate lady and then look for an answer. Another factor to be kept in view is that the trade mark of the defendants, which is prominent on their packings, is "COMFIT ALWAYS". The plaintiff's have no objection to the use of the trade mark "COMFIT ALWAYS". As stated above, for the purposes of this appeal, the plaintiff's have also no objection to the use of the colour scheme as is being used by the defendants. Plaintiffs have also no objection to the use of the legend "No Pins, No Belts, No String". The only objection is to the use of the word "STAYFREE". The main thrust of the argument of the learned counsel for the plaintiff's is that the defendants have used the word "STAYFREE" seven times on their packing with a view to deceive and confuse the customers and they are

selling their goods under the pretence that they are the goods of the plaintiff's and that defendants cannot be permitted to practice such a deception. In this case the question is not as to what would be the effect if "STAYFREE" is used as a trade mark. The question is can the plaintiff's stop the defendants from using the word "STAYFREE" in the manner being used by the defendants and whether it has the effect as is being suggested by the plaintiff's.

8. The contention of the learned counsel for the plaintiff's is that the intention of the defendants in using the word "STAYFREE" is dishonest and, therefore, it is a fit case for grant of an order of restraint against them. Reference is made to *Lakbir Singh Vs. Bakhat Singh and Another*, . In this case the learned single Judge of this Court on comparison of the two marks came to the conclusion that there was similarity between the two devices and the adoption of a similar trade mark by the respondents was obviously with a view to exploit the reputation which the appellants trade mark had already acquired. In other words, the court came to the conclusion that there was likelihood of deception and confusion and, therefore, reversed the decision of the Assistant Registrar in granting registration of the mark in question in that case. Mr. Anoop Singh, submitted that the learned single Judge came to the conclusion that the use of the word "STAYFREE" by the defendant could not be innocent, which in other words, according to the learned counsel, means that the use of the word "STAYFREE" was dishonest. The argument proceeds that where you see dishonesty then even though the items of similarity are less the courts ought to pay great attention to the items of similarity and less to the items of dissimilarity. (See *Monday v. Carey* (1905) 22 RPC 273). What is the effect of this principle on the present case and on the impugned mark has been considered in later part of this judgment while deciding the question of deception and confusion.

9. It is well established that the marks must be compared as a whole. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. (See *F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd.*,).

10. Next it is the contention of the learned counsel for the plaintiff's that by use of the word "STAYFREE" the defendants enable the traders, which generally are Chemists and General Merchants who sell these goods, to tell a lie or to make a false representation to the ultimate customer. In such an event the defendants are liable to be restrained, is the argument of the learned counsel. Reference is made to the decision of Chancery Division in *John Walker and Sons Ltd. Co. v. Henry Ost and Company Ltd.*, 1970 RPC 489 for the proposition that no one is entitled to represent his goods as being goods of another man; and no man is permitted to use any mark, sign, or symbol, device or other means, whereby without making a direct false representation himself to the purchaser who

purchases from him, he enables such person to tell a lie or to make a false representation to somebody else who is the ultimate customer. There can be no dispute to the above statement as generally put. This position has been accepted for more than a century that "Nobody has any right to represent his goods as the goods of somebody else." (See *Reddaway v. Banham* (1896) 18 Q.B. 499). But all these questions are connected with the ultimate question whether there is likelihood of confusion and deception to an average unwary customer. If there is likelihood of confusion or deception the injunction has to follow. If there is no likelihood of confusion or deception then there is no question of enabling another person to make a false representation to an ultimate customer or even enabling a trader to tell a lie or to make false representation to the ultimate customer. Similarly in *Lever v. Goodwin* reported in (1887) 4 RPC 492, the Chancery Division proceeded on the similar getup of the two wrappers and came to the conclusion that the getup of the defendants' soap was a fraudulent imitation of the getup of the plaintiff's soap and puts into the hands of shopkeeper, the means of deceiving the ultimate purchaser.

11. Actual deception is not required to be proved. It is the tendency to mislead or confuse that forms the gist of passing off action and the plaintiff's need not establish fraud nor that anyone was actually deceived or that he actually suffered damage. (See *Ellora Industries Vs. Banarsi Das Goela and Others*, .)

12. Mr. Anoop Singh contended that both marks will not be available with the customer at the same time. I am conscious of the well settled principle that the two marks have to be compared, not by placing them side by side but by asking oneself, whether having due regard to relevant surrounding circumstances, the defendants' mark as used, is similar to the plaintiff's mark as would be remembered by persons possessed of an average memory with its usual imperfections and it has then to be determined whether the defendant's mark is likely to deceive or cause confusion. Before I start considering the items of similarities and dissimilarities of the plaintiff's and defendant's mark it is useful to remind oneself with the accepted principle that in passing off action defendant may escape liability if he can show that the added matter is sufficient to distinguish defendants' goods from those of the plaintiff's. (See *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories*,).

13. The judgment of the Division Bench in *B.K. Engineering Co. Vs. Ubhi Enterprises (Registered) and Another*, relied on by learned counsel for the plaintiff turned on its own facts as in that case the two marks were substantially similar, namely, "B.K." and "B.K.81". On comparison of the two marks the Division Bench came to the conclusion that the defendants' mark was deceptively similar to that of the plaintiff's and was likely to cause confusion in the minds of the general public and consequently the plaintiff was held entitled to a temporary injunction restraining defendants from using the trade mark "B.K. 81". The judgment of *Globe Super Parts Vs. Blue Super Flame Industries*, also had its own peculiar facts. In this case the defendant was earlier working for the

plaintiff for nearly 12 years as a Contractor and started the business when the contract was terminated. Under these circumstances the learned single Judge came to the conclusion that the word Super Flame had been deliberately incorporated in the trading style/trading name of defendant No. 1 and defendant No. 2 was the father of the owner of defendant No. 1. It was this defendant No. 2 who was the contractor of the plaintiff for nearly 12 years. The conclusion drawn was that the word Super Flame was used in trading style by the defendant only with a view to filch the business of the plaintiff. Accordingly, the plaintiff's were held entitled to permanent injunction restraining the defendants from using the words Super Flame in their trading style.

14. In Charan Dass v. M/s. Bombay Crockery House, 1984 PTC 102, a learned single Judge of this Court restrained defendants from using the word "perfect" in defendants' mark Trishil Perfect" and "Vijay Perfect" because defendants, up to 1981, were stocking and selling the stores manufactured by the plaintiff's under plaintiff's" registered trade mark "Perfect" and "Swastik Perfect". The learned Judge came to the prima facie conclusion that defendants can easily pass off their goods as those of plaintiff's.

15. The central question in each case is whether the name or description given by the defendant to his goods is such as to create a likelihood that a substantial section of the purchasing public will be misled into believing that his goods are the goods of the plaintiff. The main question is not the intention of the defendant in using certain words but the probable effect of such action on the minds of the customers. In the end the court has to trust to its own perception into the mind of the reasonable man. In the words of Lord Scarman "balance is to be maintained between the protection of a plaintiff's" investment in his product and the protection of. free competition". On which side the balance lies is to be seen in the facts and circumstances of each case.

16. Now I will turn to the two packings, one of the plaintiff's and other of the defendants, in an attempt to decide as to whether there is a likelihood of deception or confusion or not and on which side the balance tilts. Before I narrate the points of similarities and dissimilarities, it has to be kept in mind that the ultimate customers in the present case are admittedly literate and semi literate ladies and not illiterate. The only grievance made is about the use of the words "STAYFREE". It is said that "STAYFREE" has been used seven times by the defendants and on this hypothesis the argument built is that defendants' goods can be sold as those of the plaintiff's" and there is likelihood of deception and confusion and in any case it provides the trader with an opportunity to give to the ultimate customer the goods of the defendants even though the customer may be wanting to purchase the goods of the plaintiff's. With the assistance of the learned counsel for the parties I have examined the packings of the plaintiff's and of the defendants. It is apparent that the plaintiff is using the mark "STAYFREE" as a trade mark whereas the trade mark used by the defendants is "COMFIT ALWAYS". It is no doubt true that the defendants along

with the word "Beltless" have used the words "STAYFREE" on its packing at seven places but the getup, colour scheme and the other essential features are altogether different. In the packing of the plaintiff's there is a picture/figure of a lady which has been shown very prominently. There is no such figure on the packing of the defendants. The packing of the plaintiff's shows the trade origin as that of "Johnsons and Johnsons" whereas that of defendants shows of "Christine Holden .The colour scheme adopted by the plaintiff is that of green and blue whereas the packing of the defendants shows that the base is white with a blue border. The colour scheme of the two wrappers is altogether different. The letter style of the word "STAYFREE" in the two marks is also quite different.

17. The word "STAYFREE" has been used, according to the defendants, to convey a message to the customers that by using the "COMFIT ALWAYS" Napkins, they will stay free of any external support. The counsel has drawn our attention to advertisement in Free Press Journal of 12th Dec. 1985 issue, in which, the prominent trade mark is "COMFIT ALWAYS¹ and there is message for the customer reading "You wouldn't even feel you have worn a sanitary napkin". The defendants also referred to their bill dt. 25th April, 1986, which was filed by plaintiff's in which, while selling the napkins in packets containing the word "STAYFREE" the defendants make the bill of "COMFIT ALWAYS" and not "STAYFREE". The contention is that their trade mark is "COMFIT ALWAYS" and not "STAYFREE". According to the learned counsel the dictionary meaning of the word "STAY" is anything that props or supports or steadies or holds. The contention is that the word "FREE" has often been used in combination with various other words such as, duty, graft, salt, tax, trouble and such like words (American Heritage Dictionary of English Language and Webster II; New Riverside University Dictionary; Collins Cobuild English Language Dictionary ,The argument is that customer is being conveyed a message that she will not be required to use any support if she uses their Napkin. Learned counsel for the defendants also referred to the advertisements of the plaintiffs to show that by use of word "STAYFREE" even the plaintiff's are conveying a message to the customers. In the advertisement of the plaintiff's the figure of a lady is shown and at the bottom it reads "STAYFREE because that is the way you ought to be" (See Eve's Weekly 19-25 April, 1986).

18. The true test is whether the totality of the trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. On totality of circumstances, prima facie, it is difficult for anyone to take the goods of the defendants thinking that they are the goods of the plaintiff's. There is no likelihood of deception or confusion to the ultimate customer, namely, literate or semiliterate ladies. Customer will be able to distinguish two marks. If there is no likelihood of deception or confusion to the ultimate customer the question of the impugned mark enabling the trader to misrepresent the goods of the defendants as those of the plaintiff's does not arise nor does it put a handle into the hands of the traders to create deception or

confusion. The dissimilarities are too many and the only similarity pointed out is that of the word "STAYFREE".

19. On the question of likelihood of deception and confusion, another argument of counsel for the plaintiff's is why the defendants have suddenly started using the word "STAYFREE" on their packings. In this behalf reference is also made to other litigation pending between the parties in Bombay. The said litigation started in the year 1972. The argument of the plaintiff's is that one of their registered trade marks was "CAREFREE". In 1972 the trade mark of the defendants was "COMFIT". In Nov. 1971 defendants started selling their sanitary Napkins with the mark "COMFREE" and adoption of mark "COMFREE" by the defendants was dishonest with a view to encash upon the goodwill of the plaintiff's. The plaintiff's say that "CAREFREE" and "COMFIT" being deceptively similar an action for passing off was brought by the plaintiff's against defendants in Bombay High Court. The defendants gave an undertaking not to use the trade mark "COMFREE". The argument is that the defendants are in the habit of encashing upon the goodwill and reputation of the plaintiff's. They say it is a case of rank dishonesty and, therefore, injunction should issue.

20. Why the defendants have started using "STAYFREE" is answered by them by explaining that prior to 1985 defendants were not manufacturing beltless Napkins and, therefore, there was no question of their using the word "STAYFREE" at that time. Defendants say that if their intentions were dishonest then they would not have waited from 1978 to 1985 to use the words "STAYFREE". According to defendants when they started manufacturing beltless sanitary napkins they thought of conveying a message to the customers that by use of their beltless sanitary napkins the customers would be "STAYFREE" of any external support. According to defendants it is a very appropriate and neat and apt description of the product. For the purposes of temporary injunction, in my opinion, the explanation is satisfactory. About undertaking given in Bombay High Court the answer of the defendants is that the undertaking was given by them of their own free will. They say that ". the order of Bombay High Court dt. 7th April, 1972, a copy of which has been placed on record by them, would show that the application of the plaintiff's for grant of temporary injunction was rejected by the said court. While rejecting their application for -grant of temporary injunction the Bombay High Court came to the conclusion that the plaintiff's have failed to make out a prima facie case for granting interim relief on the grounds of passing off. The Bombay High Court also came to the conclusion that the word "CAREFREE" is a common word having descriptive elements and it requires a long and substantial exclusive use by the plaintiff's in connection with their products to acquire a secondary sense as the trade name of the said goods. The Bombay High Court also came to the conclusion that the purchaser of the goods are well to do and educated English knowing persons and held that there was no warrant for issuing an interim injunction for restraining the defendants. A perusal of the order of the Bombay High Court shows that the defendants are right. If in spite of the aforesaid findings the defendants voluntarily gave any undertaking in

Bombay High Court not to use the trade mark "COMFREE" then this factor cannot be used against the defendants in contending that they are in the habit of imitating the trade mark of the plaintiff's. It cannot be said that the present case is that of rank dishonesty. I am prima facie, convinced with the explanations given by the defendants.

21. In my opinion, the learned single Judge was right in his conclusion that there is no likelihood of confusion or deception and that the two packings are very much different. The balance is to be maintained between the protection of plaintiff's investment and protection of free competition. The balance in my opinion, on a consideration of all facts and circumstances, tilt in favour of the defendants. It cannot be said that defendants are marketing their goods in the packing with the trade mark "STAYFREE". There is no resemblance between the two packings. It cannot be said that the use of the words "STAYFREE" by the defendants is with a view to deceive the ultimate customer. The temporary injunction was rightly refused by the learned single Judge.

22. The learned counsel for the defendants raised various preliminary objections such as about maintainability of the suit; the plaintiff's being not the owners of the trade mark "STAYFREE"; there being no valid licence in favour of plaintiff No. 2 and that the trade mark of the plaintiff's is "Johnsons and Johnsons" and not "STAYFREE". Another argument on which great stress was laid and various judgments and dictionaries were referred was that the word "STAYFREE" is descriptive and not distinctive. Defendants say that the word "STAYFREE" cannot be exclusively appropriated by the plaintiff's. They cannot have a monopoly for use of the word "STAYFREE". It is a common English word, defendants urge.

23. In so far as the last argument about the "STAYFREE" being descriptive, the main emphasis of learned counsel for the defendants is on the judgment of the court of Appeal in McCain International Ltd. v. Country Fair Foods Limited, 1981 RPC 69 for the proposition that one who seeks to adopt and use exclusively as his own a merely descriptive term, the onus is much heavy and task is very difficult. Much reliance was also placed by the defendants on the judgment of Slip-on in Re : Burberrys v. J. C. Cording and Co. Ltd, reported in (1909) 26 RPC 693 for the proposition that to one can claim monopoly rights in the (sic) of a word or name.

24. On the other hand learned counsel for the plaintiff's in order to meet ";the arguments put forth on behalf of the defendants, cited various judgments and in particular emphasis was laid on Reddaway v. Banham (1896 AC 199) (supra) where the word "Camel Hair Belting" received the protection of the court. Learned counsel for the plaintiff's also placed strong reliance on judgment of Chancery Division in the case of Dunlop Rubber Co. Ltd. (1942) 59 RPC 134, where it was held that the word "Trakgrip" was a coined word, hitherto unknown to the English language, and what familiarity it had was due to the applicants' use of it in connection with their own goods. Accordingly it could not be said that it was a word which other traders would be likely, in the ordinary course of their

business to desire to use in connection with such articles. The Assistant Comptroller had refused to allow registration of the mark as in his opinion the word "Trakgrip" was both descriptive and laudatory and it was possible that other traders might legitimately wish to use it in connection with their goods. The said finding was reversed by the Chancery Division and the Assistant Comptroller was directed to proceed with the application for registration. Plaintiffs claim exclusive right to use this word and say that it is not an English dictionary word. In short the argument is that it is a distinctive word within the meaning of S. 9 of the Act. Reference was also made to various dictionaries for the proposition that the word "STAYFREE" is not an ordinary English word. It cannot be said that the word "STAYFREE" is an invented word. The word "STAYFREE", it cannot be doubted is a combination of two English words ,namely, "STAY" and "FREE". Whether it is a coined word or only a dictionary word would be considered during the trial of the suit. I may, however, add here that according to the learned counsel for the defendants the word "STAYFREE" is an ordinary English word like "CAREFREE", "SALTFREE" "TROUBLEFREE" and TAX-FREE etc. The argument of the learned counsel for the defendant is that English is an expanding language. Reference is made to various dictionaries to show as to how these words came into use with the passage of time and how it has become an ordinary English word (See Longman's Dictionary of the English Language, Longman's Dictionary of Contemporary English, Longman-Lax icon-Contemporary English). Defendants say that "STAYFREE" is a colloquial word. I am making reference to these arguments as considerable time was spent by learned counsel for the parties in arguing this question and for the present I will leave the matter here itself without expressing any opinion. In view of the conclusions reached above that there is no likelihood of confusion and deception, in my opinion, it is not necessary to decide these questions which would, of course, be decided during the course of the trial of the suit pending on the original side of the court Accordingly, I express no opinion on the aforesaid questions including the question that the "STAYFREE" is distinctive or descriptive.

25. The result is that I would confirm the order of the learned single Judge and dismiss the appeal leaving the parties to bear their own costs.

Chadha, J.

26. I agree.