(1998) 05 MAD CK 0001

In the Madras High Court

Case No : C.S. No. 204 of 1998, Original Application No. 144 of 1998 and Application No. 1210 of 1998

Parle Products Limited APPELLANT

Vs

Bakemans Industries Limited, A-5/B-1, Mohan Co-op. Indl. Estate Badarpur, New Delhi - 110 044 RESPONDENT

Date of Decision : 29-05-1998

Acts Referred:
Trade and Merchandise Marks Act, 1958 — Section 120, 32, 46, 56

Citation : (1998) 05 MAD CK 0001

Hon'ble Judges : B. Akbar Basha Khadiri, J

Bench : Single Bench

Advocate : V. Nataraj and S. Raghunathan, for the Respondent

Judgement

B. Akbar Basha Khadiri, J.—Both the applications have arisen in this way :-The applicant in O. Application No. 144 of 1998 is engaged in

manufacturing and marketing of biscuits and sweets. The applicant is the registered proprietor of the trade mark GLUCO in respect of biscuits.

The trade mark GLUCO was conceived about fifty years ago and was registered on 10.2.1949 under the Trade and Merchandise Marks Act,

bearing No. 137633. Due to continuous and exclusive usage the trade mark GLUCO has become distinctive and exclusively identified with the

applicant''s biscuits. The applicant''s turnover exceeds several crores of rupees and the applicant had been spending huge amounts on

advertisements. Recently, the applicant came to know that the respondent is selling biscuits under the mark GLUCO GOLD. The two words

''GLUCO"" and ''GOLD'' combined together to form another word ""GLUCOGOLD"", which does not have any meaning. This is an attempt by the respondent to indirectly infringe the statutory restraint upon it. When public see the trade mark GLUCOGOLD, they would tend to think that the

said product is also that of the applicant. The respondent is deliberately adopting the word ''GLUCOGOLD'' to cash in on the wide reputation

enjoyed by the applicant in respect of its trade mark GLUCO and to deceive the people that the product emanates from the applicant. There had

been exchange of the letters between the applicant and the respondent in this regard which culminated in holding a meeting between the Chief

Executives of the applicant and the respondent on 20th November 1997 at the applicant''s office in Mumbai. At the meeting, the respondent''s

executive offered to (1) keep the brand name GLUCOGOLD as one word without any dissection; (2) refrain from prominent use of the word

GLUCO in the present or in future by changing the size, the word GOLD to make the same deceptive; and (3) change the jingle advertised on

Television by restraining the use of the word ''G'' by way of reference either remotely or through passing off of the same. The proposal was

reduced into writing and referred to the applicant''s management for consideration. But the same was not approved by the management and the

respondent was directed by letter dated 04.12.1997 to discontinue the use of the word GLUCOGOLD. But the respondent continues to sell the

biscuits under the infringing mark GLUCOGOLD in Madras and is also advertising its biscuits through Television Networks, dailies and periodicals

circulated all over India. The respondent''s action is causing irreparable loss and hardship to the applicant, which cannot be adequately

compensated. Hence, the applicant has filed the main suit and also the application in O. Application. No. 144 of 1998 for order of ad-interim

injunction restraining the respondent from manufacturing, marketing, distributing or selling biscuits under the mark GLUCOGOLD or any other

mark deceptively similar to the applicant''s registered trade mark GLUCO. The respondent countered the case of the applicant contending that it is

manufacturing biscuits for the past twenty years under the registered trade Mark BAKEMANS and has a distinctive Chef Device as its logo. In or

about August 1997, the respondent adopted the trade Mark GLUCOGOLD. The mark is coined by combination of ''GLUCO"" which is defined

in the Websters Collegiate Dictionary as (1) Glucose and (2) related to or containing Glucose and ''GOLD'' which traditionally stands as a mark of purity. The applicant has registered a generic term as its trade mark, the respondent has filed application u/s 32 and 46 r/w Section 56 of the Trade

and Merchandise Marks Act for removal of the applicant''s registration. The applicant has given up the use of the registered mark GLUCO for

more than twenty years and is now selling its products under the trade mark PARLE-G The trade marks are to be compared as a whole, and

taken as a whole the trade marks of the applicant and the respondent, the colour scheme, get-up and layout of the applicant and respondent''s

marks are dissimilar different and distinctive. The applicant''s biscuits are rectangular in shape and the respondent''s biscuits are round in shape.

There is no likelihood of causing confusion and deception amongst the trade and public.

2. Further, the applicant has not come with clean hands to seek the equitable relief of injunction. The applicant has failed to disclose (1) that the

respondent had filed application with the Registrar of Trade Marks. Bombay; to expunge the entry relating to the applicant''s registration; (2) the

respondent has filed a suit on the file of the Additional District Judge. Patiala against the applicant for declaration u/s 120 of the Trade and

Merchandise Marks Act and obtained an injunction against the threat of infringement of the trade mark. The respondent had also contended that

while it has filed caveats in the High Courts at Bombay. Chandigarh and Delhi, the applicant has deliberately chosen to file the suit at Madras, so

that the respondent did not get a chance to defend the plea for grant of ex parte ad-interim injunction. According to the respondent, the balance of

convenience is in favour of the respondent and the application is therefore to be dismissed. The applicant and the respondent filed further reply

affidavits and additional counter affidavits to explain and elucidate their respective pleas

3. The respondent in O.A. No. 144 of 1998 has filed Application No. 1210 of 1998 for vacation of the ad interim injunction granted raising the

same contentions raised in the counter mutatis mutandis. The applicant opposed this application on the same pleas mutatis mutandis raised in its

affidavits.

4. Heard both the sides The applicant and the respondent are admittedly engaged in identical trade, that is, manufacture of biscuits The applicant

has registered the word GLUCO as its trade mark on 10.02.1949. It is admitted that the respondent is manufacturing and selling the biscuits under

the trade mark GLUCOGOLD. The applicant alleges that such usage amounts to infringement of its registered trade mark. According to the

applicant, GLUCO is a word and the mark coined exclusively by the applicant to distinguish his biscuits. But the respondent contends that

GLUCO is a generic word, descriptive of the usage of Glucose in the product, it has no inherent distinctiveness or secondary meaning. This is a

common English word found in the Dictionary, over which none can claim monopoly and the word has become public juris.

5. To stress his points, the learned counsel for the respondent referred to the following decisions:- In Perry Davis v. Harbord (7 R.P.C. 336 (H.L.)

it has been held that the usage of the word Pain Killer'' in medicinal preparation was not a distinctive mark, but was merely descriptive of a quality

of the goods and did not distinguish the goods as the plaintiffs.

6. In Geep Flashlight Industries Ltd. Vs. The Registrar of Trade Marks, Government of India, Trade Marks Registery, New Delhi, the applicant in

that case wanted to register ''Janta'' as trade mark for its electric torches. It has been held that the word ''Janta'' has a dictionary meaning as

people"" and although the applicant had proved that its torches bearing the name ''Janta'' had acquired considerable reputation in the market, still it

was not capable of distinguishing the applicant''s goods, but had a direct reference to the character or quality of the goods.

7. In S.B.L. Ltd. v. Himalaya Drug Co. (1997 (1) Delhi 803) Law Times , when a dispute arose whether ''Liv. 52'' is similar to or deceptive with

''Liv-T'', it has been pointed out that ''Liv'' is an abbreviation of Liver - an organ of the human body as a constituent of names of

medicinal/pharmaceutical preparations with some prefix or suffix -mostly suffixes meant for treatment of ailments or diseases associated with liver,

and thus ''Liv'' has become a generic term and public juris. It has also been observed that the two rival marks ''Liv 52'' and ''Liv-T'' contain a

common feature ''Liv'' which is not only descriptive but also public juris, and that a customer will tend to ignore the common feature and will pay

more attention to uncommon features, i.e.. 52 and T. It has also been pointed that the two do not have phonetic similarity as to make it objectionable.

8. In The Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd. (55 R.P.C. 125), the Canadian Shredded Wheat Co. registered the

words ''Shredded Wheat'' as trade mark in respect of biscuits and crackers in 1928 and registered it as trade mark for cereal foods in 1929. In

1934, the Kellogg Company began to sell in Canada biscuits of shredded wheat made by the same process. The biscuits were of the same shape,

but smaller in size and the cartons in which they were sold were quite different from those of the Canadian Company. In an action for infringement

of passing off brought by the Canadian Company, it was held by the Canadian Court that the words ""Shredded Wheat'' were descriptive of the

goods and had not acquired a secondary meaning. In The Shredded Wheat Co. Ltd. v. Kellogg Co. of Great Britain Ltd. (1940) 57 R.P.C. 137

H.L.), the English Court also came to the same conclusion..

9. With reference to the specific facts of the instant case, the learned Counsel for the respondent referred to the affidavit filed by Mr. Ravinder Pal

Singh, attorney of the respondent and documents in Annexures ''D'' to ''F'' filed along with the affidavit and submitted that at the initial stage, the

applicant''s predecessors desired to register the trade mark GLUCO for biscuits and confectioneries, but such registration was opposed by M/s. C

& E Morton (India) Ltd. on the ground that they had been manufacturing and selling confectioneries, especially Toffee under the name ''Gluco

Toffee'' and Tablets under the name ''Morton Gluco Tablets''; the word ""GLUCO"" indicates that glucose has been used in the preparation of their

articles and GLUCO cannot be registered without any distinctiveness thereof. The predecessors in title of the applicants had considered the

objections and restricted the registration to the Biscuits only. The learned Counsel submits that lack of distinctiveness in relation to confectionaries

equally hold good for biscuits also.

10. The learned Counsel also referred to a judicial pronouncement of the Apex Court in this regard. In Corn Products Refining Co. Vs. Shangrila

Food Products Ltd., Their Lordships have referred to ''Glucose biscuits'', '' Gluco biscuits'' and ''Glucoa Lactine biscuits'' and observed that ''they

are ordinary dictionary words in which no one has any right, and that they are really not marks with a common element or elements.

11. The learned Counsel for the applicant submitted that only one ''Gluco'' is mentioned in the judgment which is the Gluco Biscuits manufactured

by the applicant. Be it so. The observation that ''Gluco'' is an ordinary word in which no one has any right has not been assailed. Further, the

respondent has produced sample biscuit pockets and filed additional affidavit to show that at least two other manufacturers of biscuits used the

word ''GLUCO"" for their biscuits. Though the learned Counsel refers to the products of M/s. Surya Food and Agro Industries Pvt. Ltd. and

Kwalily'' Biscuits Limited, a perusal of the typed set of papers would show that Kwaliry Biscuits Limited is manufacturing ''Glucos Biscuits'', and

the typed set would reveal that M/s. Surya Food & Agro Pvt. Ltd. is manufacturing '' Gluco-V Biscuits and a Manufacturer known as Sudha is

manufacturing Gluco Bicol. It is thus evident that several biscuits manufacturers use the word GLUCO to indicate that Glucose is an ingredient in

the biscuits. I accept the contention of the learned Counsel for the respondent and hold that GLUCO is a generic word descriptive of use of

Glucose in the product. The applicant''s action, in the language of Fry. Lord Justice in the case of In Re :Dunn (1888)-6- RPC 379), is a struggle

to enclose and to appropriate as private property certain little strips of the great open common of the English Language.

12. Nextly, it is argued by the learned Counsel for the applicant that in the case of the registered trade mark, the statutory protection is absolute in

the sense that once a mark is shown to offend, the user cannot escape by showing something outside the mark itself On the other hand, the learned

Counsel for the respondent submitted that if the offending mark is identical to the plaintiffs mark, no further question would arise, but if the

offending mark is deceptively similar to the plaintiff''s mark, the test is the same as in an action for passing off, the court must ask the question

whether there is likelihood of deception and confusion.

13. In view of my earlier finding that the mark ''GLUCO'' was in vogue before the applicant could register it, it cannot be considered as a word or

mark invented by the applicant, because already M/s. G & E Morton was using the same for their confectionaries. The mark is not a distinctive

mark, but only a descriptive mark which according to the Apex Court (A.I.R. 1960 S.C. 142.) no one has am right over the same. The mark is in usage in the trade by other biscuit manufacturers also The word or mark which was originally a trade mark has subsequently become public juris.

Therefore, the question whether there is infringement of trade mark need not be gone into. Yet considering the act that both she Counsel have

advanced arguments m extension and the catena of the decisions cited by them in fairness, this aspect also requires consideration.

14. The respective contentions of the learned Counsel goes to the root of the matter whether same mark is used or a similar mark is used. When a

same mark is used in a sense the public is deceived into purchasing the respondents goods on the belief that they are applicants goods, so a

registered trade mark is a causality, it is the duty of the Court to protect the trade mark. Therefore, no further question would arise in such a case.

In case of similar mark, a duty is cast upon the Court to compare both the marks to find out if the offending mark is deceptively similar to the

applicant''s mark and to ask the question whether there is likelihood of deception or confusion. In deciding the question, the Judge is the final

authority. The Judge must approach the question from the point of view of a man of average intelligence and imperfect recollection.

15. The learned Counsel for the applicant submitted that the need for comparison does not at all arise in this case, because the respondent is using

the same mark ''GLUCO"" with an appendage ""Gold"" as suffix was of no consequence. The learned Counsel cited the decision reported in Ruston

and Hornsby Ltd. Vs. The Zamindara Engineering Co., . wherein Their Lordships held that the defendant''s using words ''Rustam India'' for its

diesel engines infringed plaintiff''s trade mark ''Ruston'' for diesel engines and the suffix ''India'' to ''Rustam'' was not a sufficient warning to the

purchaser to distinguish the goods and the word ''India'' was of no consequence.

16. Reliance is placed by the learned Counsel for the respondent also to refer to the Yardstick to be adopted in case of infringement of exact mark

and a mark similar to it.

17. In the instant case, neither the applicant nor the respondent is using the mark ''GLUCO'' on a stand alone basis to apply the ''same mark''

yardstick. The applicant is using the mark with a prefix - Parle-G Gluco- and the respondent with a suffix - Glucogold'' -. Therefore, the yardstick

for similar mark has to be applied. Both the products are packed with wrappers.

Therefore, the colour, get-up and lettering ought to be compared

to find out similarities or the dissimilarities.

18. The applicant biscuits are wrapped in white wax paper with thick yellow vertical stripes making an appearance of alternate white and yellow

stripes. There is a red rectangle in which ''Parle-G'' is printed in the wax paper colour. To the right of the rectangle, there is a white rectangle space

where the names other popular parle products are printed.

19. Beneath the rectangle, there is a long red band in which ''Parle-G'' is found in the wax paper colour in big letters printed horizontally and at

both the ends of this red band within the red band ''Parle-G'' is printed in small letters, vertically. There is a picture of a child with open hands. The

picture is considerably big in size. Above the red band, there is a blue trapezium within which ''Parle'' is printed in capital letters in wax paper

colour. Beneath the red band ''GLUCO'' is printed in red colour with blue border accompanied by the ''biscuits'' printed in bold letters in blue

colour. Beneath the print Gluco Biscuits, there is a blue wavy stripex in which ''the tastier energy food'' found printed in white colour letters.

20. Below the red band, there is another rectangle similar in shape to the-rectangle above the red band. In this rectangle also ''Parle-G'' in printed

in wax colour. To the right of the: rectangle, again there is white rectangle space where the other popular parle brands are mentioned.

21. Beneath these characters the ingredients of the biscuits are printed in small bold letters in black colour, beneath which there is a yellow

rectangle with a red border in which ''Parle-G'' Gluco Biscuits ''is printed in black colour, below which the net weight, month of packing and price

of the biscuit are given. The net weight of the packet is 100 Gram and the price is Rs. 4/. To the left of this character, the address and other details

of the manufacturer are printed in black colour. In the applicant''s packet ''Parle-G'' is given prominence than ''Gluco''.

22. The respondent''s wrapper is gold colour laminated paper with mild yellow lines. There are three elongated oval shaped red broad horizontal

stripes, placed one beneath the other. The stripes have a turbid whitish yellow border. The middle stripe carries the picture of a boy and a girl upto

their burst and ''Gluco Gold'' is printed in turbid whitish yellow colour over which the trade mark ''Bakeman''s'' is printed in black colour in an artistic design with the outline of a chef and two semi circular lines. On either side of this stripe Bakeman''s design is printed in black whitish yellow

background. Over the red middle stripe, the Bankeman''s trade mark in black and ''Glucogold'' is printed in bold letters, beneath which the

ingredients of the biscuits are given with a last line in bold letter ""contains added flavours"". The bottom red shape has also Bakeman''s trade mark

and a GLUCOGOLD and other details regarding packing, weight, price, address, etc are printed in turbid whitish yellow colour. The net weight of

the packet is 100 gram and the price is Rs. 5/.

23. The respondent''s biscuits are circular and the packet is therefore cylindrical. There is absolutely no similarity between the packets. The

dissimilarities are so glaring and flagrant and that even a child could not get confused or mistake one product for the other. Any person with

average intelligence and imperfect recollection, or even a gullible child will not get deceived into purchasing one product for the oilier.

24. The learned Counsel for the applicant cited the following decisions to stress that notwithstanding that each mark contains other matter which

distinguishes one from the other, the Courts have held that there had been infringement of a trade mark:- Ruston and Hornsby Ltd. Vs. The

Zamindara Engineering Co., K.R. Chinnikrishna Chetty Vs. K. Venkatesa Mudaliar and Another, : Shree Ambal - Radha Shree Andal; American

Home Products Corpn. Wyeth Lab. Ltd v. Lupin Lab. Ltd. (1996 PTC (16) Bombay); Rolac-Toralac; the judgment of this Court in Ciba Geigy

Ltd. & another v. Crosslands Research Laboratories Ltd. (O.S.A. No. 51 of 1995) Emulgel Emugel;

25. The learned Counsel for the respondent cited the following authorities where after comparision, the Courts have held that there was no

likelihood of deception or confusion:-Mount Mettur Pharmaceuticals Ltd. v. Ortha Pharmaceuticals Corporation (A.I.R. 1975 Mad 74 : 87 L.W.

97) Utogynol - Orthogynol; Indo -- Pharma Pharmaceutical Works Pvt. Ltd. v. Farben Fabriken Bayer A.G. (1975 RPC 545) Lumindon -

Luminol; Solavoid Trade marl, (1977 R.P.C. PC (Trade Mark Trade Manic and Passing off case compilation by P. Narayanan in 2nd Edition

case No. 1320 at Page 1412) Selavoid Polaroid; Helena Rubinstein Ltd.''s case (1960 RPC 229) Skin Dew - Skin Deep, Friciking T.M. (1973

RPC 739) Frigking - Thermokittg. The Coca Cola Company of Canada Ltd v. Pepsi Cola Company of Canada Limited (1942 59 RPC 127),

Pepsi Cola Coca Cola; Square D. Biotech Limited v. Plasmon Dietetichi Alimentary Spa and two others (C.S. No. 132 of 1996 of this Court)

Glucon D - Glucosdin; The Anglo Thai Corporation Ltd. v. Mahendra Kumar Maneklal Shah and others (1977)-2- IPLR 57) Gripewater case;

S.B.L. Ltd. v. The Himalaya Drug Company (1997 (1) DLP 803) LIV 52-LIV T; J.R. Kapoor v. Micronix India (1994 PTC 260) Microtel--

Micronix All the decisions have no application to the facts of this instant case in that there had been some tinge of similarity between the marks

either visually or phonetically. In the instant case, the packets containing the applicant''s products and the respondent''s products are so dissimilar

and that none will get cheated either visually or phonetically.

26. Lastly, we come to the aspect of the balance of convenience. It is argued by the learned counsel for the applicant that the applicant is spending

huge amounts towards advertisements and the turnover of the applicant is running to crores; if the respondent is allowed to use the trade name of

the applicant, the applicant will be put to grave and irreparable loss which cannot be adequately compensated. On the other hand the learned

Counsel for the respondent submitted that the respondent has employed large number of workers and spending crores in promoting its biscuits. If

the respondent is injuncted from manufacturing its product, it would not only upset the respondent, but also the future of the labourers leading to

chaos

27. It should be pointed that balance of convenience would become relevant for consideration in the case where the scales are even. If the balance

is already tilted, the question of consideration of balance'' of convenience would not arise for consideration. In the instant case, the respondent

admits that it is manufacturing different varieties of biscuits like Bakeman''s Yums, Bakeman''s Elaichi, Cream, Bakeman''s English Marie and

Bakeman''s Coconut Cookies. Bakeman''s Glucose Biscuits, Bakeman''s Glucose plus, Bakeman''s Orange Cream Biscuits. Therefore, injuncting

the respondent from manufacturing one product would not lead to the closure of the factory itself. Yet in the instant case, the balance of

convenience does not lie in favour of the applicant. Due to the injunction order, the respondent has not been able to carry on manufacture of

Glucogold biscuits. Had there been no injunction, the defendant/respondent''s business would have multiplied and in the event of dismissal of the

suit, the loss suffered by the respondent/defendant cannot be ascertained. On the contrary, if no injunction is granted and the suit is ultimately

decreed the loss suffered by the applicant/plaintiff can be ascertained and he can be adequately compensated. In the result, Application No. 1210

of 1998 is allowed. O.A. No. 144 of 1998 is dismissed. Ad-interim injunction granted is vacated. Parties to bear their respective costs.