
(2010) 02 DEL CK 0070

In the Delhi High Court

Case No : CS (OS) No. 246 of 2004

Rich Products Corporation and Another

APPELLANT

Vs

Indo Nippon Food Ltd.

RESPONDENT

Date of Decision : 19-02-2010

Acts Referred:

Trade Marks Act, 1999 — Section 29(6), 29(7), 29(8), 29(9)

Citation : (2010) 2 ILR Delhi 663 : (2010) 42 PTC 660

Hon'ble Judges : Rajiv Shakdher, J

Bench : Single Bench

Advocate : Ajay K Gupta, Brijesh and V. Mohini, for the Appellant; S.K. Bansal, Ranjit Kumar Rana and Anand Vikas Mishra, for the Respondent

Judgement

Rajiv Shakdher, J.—The plaintiffs have instituted the present suit seeking various reliefs against the defendant, however, at its core is the relief of permanent injunction sought by it, whereby it seeks to prevent the defendant from using the word mark "WHIP TOPPING" as part of its trade mark/label "BELLS WHIP TOPPING". The reason in nut shell is; the plaintiffs' belief that the impugned mark masquerades the plaintiffs' registered mark "RICH'S WHIP TOPPING". Thus in legal terminology the impugned mark, which is, "BELLS WHIP TOPPING" is deceptively similar to the plaintiff's registered trade mark "RICH'S WHIP TOPPING". A perpetual injunction has also been sought against the defendant to prevent passing off or infringement of copyright in so far as trade dress, packaging and instructions are concerned, which according to the plaintiffs, are identical and/or similar to its own product. Consequential orders in the form of preliminary decree to render accounts, as also final decree for payment of money found due and payable, and of rendition of accounts is sought as well. Finally, a decree for delivering to the plaintiffs custody of all such products, packing material, boxes, cartons, labels, containers e.t.c, which bear the infringing mark "WHIP TOPPING" or the impugned trade dress or get up, is also prayed for.

2. The plaintiffs' application being IA No. 1607/2004 under Order 39 Rule 1 & 2

of Code of Civil Procedure, 1908 (hereinafter referred to as "CPC") was dismissed by a single Judge of this Court vide order dated 03.07.2007. Being aggrieved, the plaintiffs had carried the matter in appeal to the Division Bench. The Division Bench by an order dated 10.09.2008 passed in FAO(OS) No. 355/2007 disposed of the appeal with a direction, based on submissions of counsels for both parties, that the suit be put up for disposal by resorting to methodology of filing affidavit of evidence sans cross-examination. Accordingly, the court by its order dated 10.11.2008 framed the following issues:

(i) Whether the plaintiff is the proprietor of the Trademark "RICH'S WHIP TOPPING " in relation to its goods as mentioned in the plaint both under the statutory as well as under the common law ? OPP

(ii) Whether the plaintiff No. 1 has acquired distinctive goodwill and reputation and secondary meaning in respect of the trademark "RICH'S WHIP TOPPING" by virtue of its prior, long and continuous user as alleged? OPP

(iii) Whether the trademark "RICH'S WHIP TOPPING" is a trademark possessing transborder reputation? OPP

(iv) Whether the registered trademark of the plaintiff "RICH'S WHIP TOPPING" is deceptively similar to the trademark of the defendants, "BELLS WHIP TOPPING" and amounts to infringement, and passing off the plaintiff's impugned product? OPP

(v) Whether the defendant's packaging is confusingly similar to the tradedressing of the plaintiffs "packaging" OPP

(vi) Whether the plaintiff is entitled to damages against the defendants and if so, in what sum? OPP

(vii) Whether the trademark of the plaintiff is not a coined word? OPD

(viii) Whether the trademark of the plaintiff is a descriptive trademark? OPD

(ix) Whether the trademark of the plaintiff is a common dictionary word and that the same is common in use? OPD

(x) Whether the trademark of the plaintiff is generic in nature? OPD

(xi) Whether the plaintiff is guilty of concealment of the fact that its registered trademark is subject to a disclaimer and the effect thereof? OPD

(xii) Whether the suit instituted by the plaintiff is barred on account of delay and laches and acquiescence on the part of the plaintiff? OPD

(xiii) Relief

3. Following the procedure laid down by the Division Bench, affidavits of witnesses was filed by both parties. This exercise was completed on 19.08.2009; whereupon was listed in the category of finals for hearing, and accordingly, heard

on the basis of evidence placed on record.

4. The case set up by the plaintiffs, both in the plaint and the affidavit of evidence filed by their witnesses in support of averments made therein, is as follows:

4.1 The plaintiff No. 1 is a company incorporated in the USA in the State of Delaware. plaintiff No. 1 has its genesis in a family business which commenced in 1945. Mr Robert E. Rich who is the progenitor of plaintiff No. 1, in a manner of speaking, responsible for the discovery of vegetable based whipped cream, made from soya bean. The research carried out under aegis of Robert E. Rich, led to the discovery that soya bean substance could be frozen, thawed and whipped. Thus came into existence, what the plaintiffs claim a miracle cream made from soya bean; a wholly "non-dairy" product.

4.2 The plaintiffs called the miracle cream RICH'S WHIP TOPPING. Being a non-dairy topping it spawned various non-dairy products including Rich's Bettercreme Icing and Filling, Rich's on Top non-dairy dessert, frozen eclairs and cream puffs, coffee Rich; which incidentally is claimed as the first frozen non-dairy creamer.

4.3 The plaintiffs it appears discovered another new product by the name of "Freeze Flo". It is claimed that this is an all-natural process for soft foods, so that they remain soft while frozen, and hence can be served straight from the freezer. The plaintiffs claim that because of its expertise in manufacture and sale of frozen foods, non-dairy and baking products including frozen sea-foods specialties, soup bases, gravy mixes and powdered coffee, it has mustered an annual sales exceeding U.S. Dollars 1.7 billion, comprising of 2300 products which are available in more than 75 countries including, Australia, Belgium, Canada, Colombia, China, Holland, Israel, Italy, Japan, Mexico, South Africa, Thailand, United Kingdom, Vietnam and of course India.

4.4 plaintiff No. 2, i.e., Rich Graviss Products Pvt. Ltd. was incorporated on 16.08.1994 as a result of a joint venture initiated by plaintiff No. 1; for an avowed purpose of manufacturing products under the trademark of plaintiff No. 1, based on the technical know-how provided by the plaintiff No. 1. In lieu thereof, plaintiff No. 2 pays royalty to plaintiff No. 1.

5. The plaintiffs, in so far as the present dispute is concerned, have more specifically averred that in India "RICH'S WHIP TOPPFNG" was duly registered w.e.f. 13.11.1991, in class 30 specifically for non-dairy topping, icing, filling, and generally for other goods in class 30. Presently, though its renewal is pending consideration before the Registrar of Trade Mark in India. Furthermore, the registration is subject to a disclaimer with respect to the letter "S" and word "Topping". It is further averred that "RICH'S WHIP TOPPING", has enjoyed brisk and consistent sale in countries all over the world, since 1945. In particular, in India the sales have increased exponentially from a figure of approximately Rs 2. Icrores in the year 1997-98, to 15.6 crores in the year 2002-03. It is averred

that the plaintiff No. 1 also maintains two websites being www.richs.com and www.whiptopping.com.

5.1 As a matter of fact the plaintiffs have stated that the trademark "RICH'S WHIP TOPPING" as also "WHIP TOPPING" are registered in several countries of the world such as USA, New Zealand, Australia, Germany, Italy, Spain, Switzerland, Malaysia, Singapore, Hong Kong, Thailand, Philippines, Vietnam, Pakistan and Taiwan. It is also averred that the trademark "WHIP TOPPING" in class 29 has been registered vide registration certificate dated 28.03.2007, which is operative w.e.f 27.06.2005.

5.2 It is further averred that the plaintiffs became aware only in April, 2003, that the defendant, was selling its product under the infringing mark "WHIP TOPPING", in packaging carrying an identical trade dress with similar user instructions.

5.3 The plaintiffs being aggrieved issued a cease and desist notice dated 23.04.2003 to the defendant. The defendant, however, refuted the plaintiffs contention vide their reply dated 13.05.2003. The defendant thereupon, filed a suit in the Distt. Court at Tis Hazari being suit No. 53/2003, which, I am informed, stands withdrawn in view of the fact that parties realized that the legal validity of their respective stands would really get determined in the present proceedings.

6. In the background of the aforesaid averments, as stated above, the plaintiffs have led evidence in support of the same by filing affidavits of eight witnesses. Briefly, each of the witnesses have stated as follows:

6.1 Mr Jill K. Bond (PW1) has adverted with respect to: the worldwide market reputation of its trademark "RICH'S WHIP TOPPING"; which is an invention made under aegis of its founder Robert E. Rich in the year 1945; the trade mark "WHIP TOPPING" is registered in USA and Taiwan, in the form of proof exhibits PW1/5 and PW1/6 are cited; and lastly, the trademark "RICH'S WHIP TOPPING" is registered in USA, Pakistan, Thailand and Malaysia; reliance in this regard is placed on exhibits PW1/7 and PW1/12.

6.2 In particular, PW1 has deposed with respect to the trademark "RICH'S WHIP TOPPING" being registered in India w.e.f. 13.11.1991 with a disclaimer with regard to the letter "S" and the word "Topping" in class 30 in respect of non-dairy toppings, icing, fillings and all other goods falling under class 30. PW1 has also deposed that the same trademark has been registered in class 29 with respect to: meat; fish; poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; fruit sauces; eggs, milk and milk products; edible oils and fats. PW1 has also alluded to the fact that because of tremendous goodwill and reputation acquired by its trademark "RICH'S WHIP TOPPING" and the distinctive packaging adopted for its products in the form of a unique trade dress composed of red, blue and white colours it has, over the years, acquired immense brand value.

6.3 It is also claimed by PW1 that the said trademark "WHIP TOPPING" and "RICH'S WHIP TOPPING" has been extensively promoted by the plaintiffs in all forms of media including the internet. In this regard reliance is placed on various forms of promotional material being exhibits PW1/15 to PW1/27. A reference is also made by PW1 to its domain name www.whiptopping.com which is claimed to be a popular website; extensively visited by consumers and associates of plaintiffs all over the world.

6.4 PW1 has adverted to the effect that the defendant by using a deceptively similar mark and/or packaging, to that of the plaintiffs, is in fact riding on the plaintiffs' goodwill and reputation. It is thus claimed that the defendant's action amount to, not only an infringement of the plaintiffs' trademark, but also amount to, committing a tort of passing off. PW1 has also proved the cease and desist notice dated 23.04.2003 (Ex. P3) issued to the defendant in that regard, as also the reply of the defendant dated 13.05.2003 (Ex. P4). PW1 has also proved the power of attorney dated 23.10.2003 and 01.03.2004 (Exs. PW1/28 & PW1/29) respectively.

7. Ms Betty Fye (PW2) who is the International Finance Manager of plaintiff No. 1, has supported the case of the plaintiff by seeking to prove the international sale figure of plaintiff non 1 between 2000-2003. In this regard she has proved Ex. PW2/1 and Ex. PW2/2. There is also a reference to random sales invoices of Whip Topping/Rich's Whip Topping. In this regard invoices being Ex. PW2/3 to PW2/9 have been proved. PW2 has also deposed that plaintiffs maintain two websites being www.richs.com and www.whiptopping.com wherein it is claimed that information is available with regard to plaintiffs' product including product marketed under trademark "whip topping"/ "rich's whip topping".

8. Mr Priyakant Himatlal Shah (PW3), who is a consultant with plaintiff No. 2, has adverted to the effect that plaintiff No. 2 was incorporated on 16.08.1994 for manufacturing products, chiefly "dairy-free topping" under the trademark of plaintiff No. 1 as per technical know-how supplied by plaintiff No. 1. For this purpose PW3 has stated that royalty is paid to plaintiff No. 1. PW3 has also alluded to the fact that plaintiff No. 2 is involved in production of non-dairy topping which is ultimately sold to bakers, confectioners, food service outlets, five-star hotels etc. PW3 has also deposed that defendant's trade mark "BELLS WHIP TOPPING" is similar to plaintiff No. 1 trademark "WHIP TOPPING" which forms part of the registered trademark of plaintiff No. 1 in India. PW3 has further stated that "WHIP TOPPING" on its own is registered in countries such as USA, Italy, France, Saudi Arabia, China etc.

9. Mr Pankaj Jain (PW4), who is the National Culinary Manager of plaintiff No. 2 has proved exhibit PW4/2 in order to establish its product under the trademark "RICH'S WHIP TOPPING" extensive advertisement carried out in India. To be noted these advertisements carried out in various newspapers are primarily pertaining to 2004 and 2007, that is, post institution of the suit.

10. Mr Sandesha S Laad (PW5), who is the senior Manager (Finance) of plaintiff No. 2, deposed that he had been associated with plaintiff No. 2 since April, 2009. He proved the fact that plaintiff No. 2 has paid royalty to plaintiff No. 1 in consideration of use of technical know-how supplied by plaintiff No. 1. In this regard PW5 has proved the audited balance sheets and profit & Loss accounts for the year 1999-2000, 2002-2003 and 2003-2004. PW5 has specifically adverted to the fact that in so far as India is concerned the sales of "RICH'S WHIP TOPPING" has increased from Rs 49.85 lacs (approximately) to Rs 19 crores in the year 2003-04. In this regard reliance is placed on the volume and revenue statement of plaintiff No. 2 (Ex. PW5/4) as also on the audited balance sheets and profit & loss accounts for the year 1999-2000, 2002-2003 and 2003-2004 being exhibits PW5/5, PW5/6 & PW5/7 respectively. In order to demonstrate the increase in profit from Rs 122.25 lacs in the financial year ending 2000 to Rs 545 lacs in the year ending 2003, reliance is placed on Exhibits PW5/8, PW5/9 and PW5/10. PW5 has also proved the sales in India for the years 1996-97, 2001-02. Randomly selected original invoices for the periods 1999 to 2005 were also proved. Reliance in this regard is placed on exhibits PW5/11 to PW5/17.

11. Mr V. Seetharaman (PW6) has deposed that based on the Power of Attorneys (Ex. PW3/1 and PW1/29) he has signed and verified the plaint on behalf of plaintiff No. 1 and 2 in his capacity as the constituted attorney.

12. Mr Prithvi Raj Chaudhary (PW7), who is a partner in M/s Modern Marketing Company has adverted to the effect that his firm had been distributing the product manufactured by plaintiff No. 2 under the trademark "RICH'S WHIP TOPPING" since 1997. PW7 has deposed that once he purchased the product from plaintiff No. 2 he would supply them to hotels, bakeries, confectioneries, such as Oberoi Group, Taj Flight Kitchen, ITC Group, Surya Crowne Plaza, Nirula's etc. in Delhi. He has testified that the quality of the product under the brand of "RICH'S WHIP TOPPING" is very good and is in great demand. He has specifically adverted to the fact that selling the product under the brand name of "BELLS WHIP TOPPFNG" had created confusion, in as much as, he verily believed that plaintiff No. 2 had adopted another trademark by the name of "BELLS WHIP TOPPFNG".

13. Mr Shikhil Nagpal (PW8), who is the Operational Manager of Everbake Bakers Pvt. Ltd, has deposed that they had been in the business since the year 2000. He has also testified that the plaintiffs trademark "RICH'S WHIP TOPPING" along with its trade dress comprising of red, blue and white packaging is "easily recognizable and eye catching". He further stated that "RICH'S WHIP TOPPFNG" is used as a substitute to fresh dairy cream as it has greater shelf life and is easier to manage.

14. The defendant, on the other hand, has emphatically refuted the plaintiffs' claim of proprietary rights in trademark "RICH'S WHIP TOPPFNG" and "WHIP TOPPFNG" the trade dress comprising of red, blue and white colour the packaging, the domain name www.whiptopping.com, and lastly, in the use of the

expression of "whip topping" either by itself or in combination with other marks or as suffix or even as prefix. The defendant's stand is that they have been using the expression "BELLS WHIP TOPPFNG" honestly and openly in the course of their trade since 1995. It is averred, over the years the defendant has built for itself a valuable reputation and goodwill in trademark/label. Resultantly, the defendant, it is stated, has achieved a turnover of Rs 1.75 crores in the financial year 2002-2003. The defendant also claims that it maintains the highest standard of quality and control; and towards this end have invested a large sum of money in research and development. It claims to be in possession of fully equipped laboratory with qualified chemists and microbiologists. It claims that continuous research and development activities have been undertaken in respect of its new products like whippable dairy cream and Ultra Heat Treated Desserts, Custards and Sauces etc. It is averred that research in these areas has been carried out in association with world renowned companies like G.C. Hann & Co., Germany, Danisco Culator, Denmark, Orana A/S, Denmark, Stock Germany etc. It is also claimed that defendant has the state-of-the-art manufacturing and packaging machines. It claims to cater to renowned multi-national companies such as Britannia Industries Ltd., Perfetti India Ltd, Candica (India) Ltd., Nirulas" Hotels, Sugar & Spice Restaurants, Taj Sata Air Catering Ltd, Hyatt Regency Hotel etc.

14.1 In defence of its right to use the mark "BELLS WHIP TOPPING" the defendant has stated that the plaintiffs' mark is generic in nature and has no trademark significance. It is further averred that, in any event, the plaintiffs trademark, which is registered as one composite whole is, "RICH'S WHIP TOPPING" with a disclaimer in so far as letter "S" and the word "Topping" is concerned; therefore, there can be no infringement much less a commission of tort of passing off by the defendant in using the trade mark "BELLS WHIP TOPPING". This, according to the defendant, is more so in view of the fact that "WHIP TOPPING" is a descriptive expression which alludes to the character and quality of the product itself and hence, cannot be protected till it can be demonstrated that it has acquired a "secondary meaning". The defendant has further averred that the product in issue is "WHIP TOPPING" and it cannot be described in any other manner except by using that expression and especially when it is a manufacturer of the said product. It is the defendant's stand that the said word/expression "WHIP TOPPING" is commonly used in the trade world over. According to the defendant "WHIP TOPPING" is an imitation dairy product which is commonly used in making desserts, baked and frozen products by various manufacturers all over the world, and hence is "publici juris". In this regard example of other manufacturers, which have used the word mark "whip topping" in respect of their products, have been referred to in the written statement. For the sake of convenience they are extracted herein below:

S.No.

Name of the Company

Product

1

Lego Foods Co. Ltd.

Lego non-dairy Whip Topping

2

Kraft Foods

Cool Whip Whipped Topping

3

Flavor Right Foods, Columbus, Ohio 43216, USA

Flavor Right Premium ready to whip Topping

4

Elgin Dairy Foods, Inc. Chicago, Illinois, USA

1) Elgin NP Whip Topping

2) Elgin's Indenium Whip Topping.

3) Elgin's ready-to-whip D-lux Whip Topping

5

Morningstar Foods Inc., USA

1) Frozen Whipped Toppings

2) Dairy Fresh Aerosol Whipped Toppings.

6

Hanan Products Co. Inc.

Hanan's Whip Topping

14.2 According to the defendant the words "Whip Topping" are neither distinctive nor invented being part of common usage in trade, they cannot be protected. The defendant has refuted the charge of infringement and passing off as it has claims the use of the word/expression "Whip Topping" in conjunction with "BELLS" has over the years had distinctiveness associated with the products manufactured by the defendant. The packaging and the presentation of the colour scheme also being different both visually and in presentation, there is no deception or confusion as alleged or at all in the defendant's use of the expression "BELLS WHIP TOPPING" along with its own trade dress. The defendant claims the use of the expression "whip topping" is bonafide as it describes the character and quality of the goods which are manufactured by it

and hence, protected by the provisions of Section 35 of the Trade Marks Act, 1999 (hereinafter referred to as "Trade Marks Act 1999").

SUBMISSIONS OF COUNSELS

15. Mr A.K. Gupta, learned senior counsel, who appeared for the plaintiff, elaborated on the challenge laid to the defendant's mark in the pleadings by adverting to the following actions of the defendant which according to him trench upon both the statutory as well as common law right of the plaintiff.:

(i) first, the use of words/expression "WHIP TOPPING" in the defendant's mark resulted in the infringement of the plaintiff's mark "RICH'S WHIP TOPPING";

(ii) second, the adoption by the defendant of a similar packaging /trade dress;

(iii) third, the infringement of copyright in the instructions accompanying the product; and,

(iv) lastly, commission of tort of passing off by the defendant.

16. In support of his charge Mr Gupta made the following submissions:

(i) Notwithstanding the fact that at the time of registration of the plaintiff's trademark "RICH'S WHIP TOPPING" a disclaimer was entered with respect to the letter "S" and the word "Topping"; the defendant's mark "BELLS WHIP TOPPING", (which is unregistered) is; deceptively similar to the plaintiff's registered trademark,

(ii) plaintiff No. 1 as far back as on 1945 was responsible for inventing a "non-dairy" product which is capable of being whipped into foam for use in desserts, salads and confectionaries items e.t.c, which resulted in the product acquiring the name "whip topping". In short it is the invention in which plaintiff No. 1 has legal rights.

(iii) In the country of its invention, i.e., U.S.A. "Whip Topping" is registered with the plaintiff's name.

(iii) In India, the plaintiff's registration of the mark "RICH'S WHIP TOPPING" dates back 13.11.1991, and thus carries with it a superior right qua the defendant by virtue of prior user.

(iv) On discovering the defendant's use of the infringing mark in April, 2003, a notice was issued on 23.04.2003, which, as indicated above, was replied by the defendant vide its reply dated 13.05.2003. The defendant instituted a suit only thereafter in the Distt. Court being suit No. 53/2004 in March, 2004. This was followed by the defendant making an application for registration of its mark only on 29.05.2003. In the defendant's application user is claimed from 1995.

(iv) The plaintiff has rights both in the composite as well as a part of the trade mark, i.e., in both "RICH'S WHIP TOPPING" as well as in "WHIP TOPPING". The defendant's use of the infringing mark is violative of the plaintiff's proprietary

right in a registered mark; a violation which squarely falls within the ambit of Section 29(2)(b) or in the very least in Section 29(2)(c) of the Trade Marks Act, 1999 (in short the "Trade Marks Act").

17. Mr Gupta, in order to buttress his submissions, relied upon the following judgment in order to draw my attention to the test adopted by courts in determining what would constitute a deceptively similar mark or trade dress. Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., ; Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, ; Lever v. Goodwin 1887 (4) RPC 492; Spalding (AG) & Bros, v. AW Gawage (1915) 32 RPC 273 and Parker-Knoll Limited v. Knoll International Limited 1962 RPC 243.

17.1 In support of his submission that the definition of "trade mark" given u/s 2(1)(m) to 2(1)(zb) in the Trade Marks Act would bring within its ambit even colour combinations/ trade dress, the following judgments are cited: Smith Kline & French Laboratories Ltd v. Sterling-Winthrop Group Ltd (HL) 1976 RPC 511; Colgate Palmolive Company and Another Vs. Anchor Health and Beauty Care Pvt. Ltd.,

17.2. In support of his submission that the disclaimer of the letter "S" and the word "Topping" would not take away its right to sue for tort of passing off committed by the defendant, reliance was placed on the judgment of the Supreme Court in The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd., , and the judgment of this Court, in the case of Cadbury India Limited and Others Vs. Neeraj Food Products, .

18. Mr Gupta further contended that the registration of mark, "Rich's Whip Topping" constituted a prima facie evidence of its validity, and since the plaintiff was the first one to obtains its registration it ought to be protected against the infringing mark adopted by the defendant. For this purpose reliance was placed on provisions of Section 31 of the Trade Marks Act and the judgment of Bombay High court in the case of Consolidated Foods Corporation Vs. Brandon and Company Private Ltd., .

19. It was further contended that the plaintiffs mark was a "well-known" mark in India and in accordance with the provisions of Section 11 of the Trade Marks Act there was every likelihood of defendant's mark being refused registration.

20. In particular, the learned Counsel submitted that the defence u/s 35 of the Trade Mark was not available to the defendant for the reason that it protects word marks which describe the character and quality of goods, that is, are used in adjective sense. In the instant case, the learned Counsel submitted that the word mark "whip topping" comprises of two words whip and topping, both of which are nouns.

21. It was contended that trademark "WHIP TOPPING" is not descriptive since it relate to a non-dairy product. The learned Counsel went on to submit that the word "whip" is essentially used and confined to cream (dairy based product) or

egg (poultry product). It was submitted that for the first time, after the extensive research and development, plaintiff No. 1 had discovered the product in issue, which was made out of a non-dairy substance, i.e., soya bean and hence, both the product as well as the name are associated with the plaintiff. The learned Counsel relied upon Section 36 of the Trade Marks Act to buttress his submission that there is no absolute bar to registration of a descriptive trademark. It was contended that as a matter of fact, registration of descriptive trademark is saved under the provisions of Section 36 of the Trade Marks Act, provided: it is not shown that after the registration of the trademark third parties have been using the descriptive mark in a manner that it has become well-known and its use is widely established.

21.1 With particular reference to the defendant it was submitted that even though the defendant had averred that it has been using the infringing mark since 1995 and, had referred to sales figures of Rs 1.7 crores achieved in 2002-03; no evidence with respect to the same has been supplied. There is also, according to the learned Counsel for the plaintiff, no evidence of use by any third party of the trademark within the country. In sum and substance it is submitted that even if it is assumed without admitting that plaintiff mark is descriptive the same is protected and/or saved under the provisions of Section 36 of the Trade Marks Act.

22. It was contended that the defendant's use of the infringing mark either in 1995 or anytime thereafter is neither bonafide nor honest and in any event concurrent use of a mark similar to that of the plaintiff cannot be deemed as honest. A mark, according to Mr Gupta, can have only one proprietor. Reliance in this regard was placed on the judgment of the Supreme court in the case of Power Control Appliances and Others Vs. Sumeet Machines Pvt. Ltd., .

23. The claim of the plaintiff to the copyright in the instructions was based on the provisions of Section 70 of the Copy Right Act, 1957 (hereinafter referred to as "Copyright Act").

24. Mr Gupta concluded by submitting that the suit be decreed in terms of the prayers made in the suit.

15. Mr. S.K. Bansal, on the other hand, refuted the submissions made by the learned Counsel for the plaintiffs and supported the defendant's stand taken in the pleadings by taking recourse to the following arguments: The word or mark "whip topping" is generic as it describes the product. For this purpose reliance is placed on the plaintiffs' own affidavit of evidence and documents where "whip topping" has been described as a product. It was submitted by Mr Bansal that no trademark right can exist or can be acquired in relation to a product if it cannot be described in any other manner, even though, it has acquired secondary significance through use and publicity. In the alternative it was submitted that the mark "whip topping" is descriptive as it is used to describe the product and does not, therefore, have any trademark significance. The mark "whip topping"

is publici juris as it is commonly used in the trade pertaining to non-dairy products. It was contended that the mark "RICH'S WHIP TOPPING" has been registered consciously subject to disclaimer, and that it can be protected only in its composite form, and not when "whip toping" is independently used in conjunction with a prefix or suffix. It was further submitted that a descriptive trademark could be protected only on proof of secondary significance. The standard of proof with regard to which is of a high order and/or nature, and in ascertaining similarity in respect of descriptive trademarks even small differences in the rival and competing product are enough to obviate the charge of similarity. It was submitted that ordinarily descriptive marks are not protected as trademarks as everyone has a right to use such trademarks, and that it would embarrass the trade or industry if only one manufacturer were to monopolise the use of such descriptive mark. Furthermore, protection of such descriptive mark has the tendency to deplete the use of ordinary and commonly used expressions to describe a product. In order to buttress his submissions the learned Counsel submitted that even in the case of invented products, which are patented; on the expiry of the patent the name and description given to the product is not permitted to be used as a trademark.

25.1 Mr Bansal submitted that the plaintiff itself has been using the expression "whip topping" in a generic and/or descriptive manner. The learned Counsel has cited examples where "whip topping" has been used conjointly with the word "Rich's" and also disjunctively. Mr Bansal contended that a close perusal of the trademark on the packaging would show that Rich's, which is Rich with an apostrophe "s" is shown prominently along with the expression "WHIP TOPPING" to signify that "WHIP TOPPING" which is the product is manufactured by and hence, originates from Rich, which is, in a sense the trademark. To support his submission he cited the example of Rich's Bettercream, icing and filling. A reference has also been made to the registration certificate issued on 28.03.2007 operative w.e.f 26.06.2005 vide registration No. 1366892 in class 30.

26. Mr Bansal contended that the expression "WHIP TOPPFNG" is common to trade and hence, publici juris. It has been used world over by various companies and businesses. In this regard examples of Logo, Kraft, Flavor Right, Eligin Dairy, Momingstar Foods, Hanan Foods etc. were referred to. Mr Bansal contended that the product by itself cannot be the trademark and in this regard laid stress on the distinction between the definition of a "mark" provided in Section 2(1)(m) and "trademark" contained in Section 2(1)(zb). He submitted that the word "mark" is consciously defined in the Trade Marks Act in wide terms, and has innumerable possibilities on account of the inclusive nature of the definition. In contradistinction, he submitted, the definition of "trademark" is narrow being confined to those marks which are used in relation to goods for the purpose of indicating and identifying the source and the origin of goods.

27. According to Mr Bansal the remedy of infringement is a statutory remedy, which is controlled and limited by the provisions of the statute and based on the

mark found in on the register of trademark authority. Reliance in this regard was placed on the provisions of Section 2(1)(w) of the Trade Marks Act. Mr Bansal went on to contend that infringement is subject to statutory conditions as contained in Section 27, 28(2), 30, 35 and 37 of the Trade Marks Act. Mr Bansal further contended that the rights conferred by registration of mark are subject to the conditions and limitations attached to the registered mark, in the present case the disclaimers in respect of the letter "s" and the expression "Topping". Mr Bansal referred, in particular, to the provisions of Section 30, 35 and 37 of the Trade Marks Act to demonstrate the situation in which a charge of infringement cannot attach to the defendant. He submitted that Section 31 of the Trade Marks Act only raised a prima facie presumption in favour of a registered mark which is subject to rebuttal. Therefore, in an infringement action a court can determine the validity of a registered mark which need not be left to be ascertained or enquired into, in a rectification proceeding. It was contended that there was no deceptive similarity as alleged or at all between the impugned trade mark and that of the plaintiff in the usage of the impugned mark by the defendant. For this purpose he referred to the essential features of trademarks of both the plaintiff and that of the defendant. It was pointed out: firstly, the main feature in rival marks was Rich's and Bell's; and secondly, the art work was different and since, the art work was different the accumulative effect was that they represented different trade origins. It was his contention that "RICH'S WHIP TOPPING" is a combination of different words as is "BELLS WHIP TOPPING" which signify different origin of the goods, that is, "whip topping". According to Mr Bansal there was no likelihood of confusion. The reason being, the consumers of the goods in issue are urban and well-educated; the trademark/labels are different and not similar; no instances of confusion is cited despite the fact that the defendant has been in business since 1995; the plaintiff has not acquired any distinctiveness in respect of the expression "WHIP TOPPING"; the plaintiff has accepted disclaimers in India as well as any other jurisdictions across the world; and lastly, no documents have been filed by the plaintiff to demonstrate substantial worldwide user of the word mark "whip topping" as a trademark.

28. In sum and substance it was contended that there is no confusion, much less deception employed, and hence both the charge of infringement as well as passing off ought to fail.

29. As regards the plaintiffs claim with respect to copyright in the trade dress and the art work, Mr Bansal submitted that there are no pleadings which would establish the right and authorship or originality in the trade dress or the art work; there is only a bald averment with respect to plaintiffs' claim of the copyright in the trade dress and the artistic work. The plaintiff has no right in the colours red, blue and white; the trade dress of the plaintiff is undoubtedly different from that of the defendant. Similar submissions were also made vis-a-vis the instructions on the labels used by the plaintiff.

30. Based on the aforesaid submissions Mr Bansal has submitted that there is no

cause of action which one could say had arisen in favour of the plaintiff in order to enable it to maintain a suit either for infringement of its trademark or violation of copyright or even in respect of tort of passing off.

30.1 In support of his submissions the learned Counsel relied upon the following: Oxford English Referenc Dictionary, 2nd Edition, Revised; Mc Carthy on Trade Marks, Generic Terms; CES Publishing Corporation v. St. Regis Publication Inc. 531F2d 11,188 U.S.P.Q 612; Abercrombie and Fitch Co. v. Hunting World, Incorporated 1976 WL152702(CA.2(N.Y)), 189U.S.P.Q. 759; Bharat Enterprises (India) v. C. Lall Gopi Industrial Enterprises and Ors. 1999 PTC (19) 598; AIR 1938 143 (Privy Council) ; Mc Cain International Ltd. v. Country Fair Foods Ltd. and Anr. 1981 RPC 69; Beer Nuts, Inc. v. King Nut Company, Federal Reporter, 2nd Series; James v. Souby 1886 Chancery Division 392; Halsbury's Laws of England, Vol.9, 4th Edition; J.R. Kapoor Vs. Micronix India, ; SBL Ltd. v. Himalaya Drug Company 1997 PTC (17) (DB); Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co., ; Competition Review (P) Ltd. v. N.N. Ohja 1996 PTC (16) Del 124.

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31. I have heard the learned Counsel for the parties and considered the evidence on record. In my view the sum and substance of the dispute is the plaintiffs' claim of proprietary rights in not only its registered trademark "RICH'S WHIP TOPPING" but also in a part of its mark, i.e., "WHIP TOPPING". In addition the plaintiff claims of proprietary rights in trade dress/packaging, which according to it, consists of a unique colour combination of the colours red, blue and white as also in the "instructions for use" set out in the packaging for the product. In order to decide the aforesaid issues, which, according to me are the heart of the matter, let me first advert to the facts which are not in dispute:

(i) The plaintiffs' registration of its trademark "RICH'S WHIP TOPPING" in class 30 was obtained specifically, in respect of non-dairy toppings, icing, fillings, and generally, in connection with all other goods in class 30;

(ii) the registration certification referred to in (i) above was issued vide certificate dated 13.06.2003 which relates back to the date of the application, i.e., 13.11.1991;

(iii) the registration referred to in (i) above came with a disclaimer. The disclaimers made is with respect to the letter "S" and the word "topping";

(iv) the plaintiff has applied for renewal of registration mentioned in (i) above which is pending consideration with the Trade Mark Authority;

(v) the plaintiff has also in its possession a registration certificate dated 28.03.2007, once again issued with respect to the trademark "RICH'S WHIP TOPPING" which is operative from 27.06.2005, in respect of goods in class 29, i.e., meat, fish, poultry and game; meat extracts preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces; eggs, milk and milk products;

edible oils and fats, included in class 29;

(vi) the United States Patent and Trade Mark Office has registered the word mark "Whip Topping" with a disclaimer entered by the owner, (i.e., the plaintiff No. 1) in respect of its exclusive right to use "topping"; and

(iv) lastly, the certificate issued by New Zealand company's office, w.e.f 12.11.1991 which is valid till 12.11.2010, in respect of mark and device and the descriptor "RICH'S WHIP TOPPING" is subject to the limitation that registration of the said mark shall not give plaintiff No. 1 the exclusive right to use the word "Whip Topping". (See document at page 14 of the defendant's compilation)

32. The position, therefore, in so far as India is concerned is that, the plaintiffs have disclaimed their rights on letter "S" and word "Topping" which, in sum and substance, denudes any practicable efficacy in the trademark "Whip Topping" (assuming it is one).

32.1 The plaintiffs, however, claim that the registration of its mark "RICH'S WHIP TOPPING" has resulted in conferment of statutory rights against the infringement of its mark as well as common law rights, de hors the registration, in each and every part of its registered mark.

32.2 To analyse this submission it may be relevant to refer to certain provisions of Trade Marks Act. The word "mark" has been defined in Section 2(1)(m) of Trade Marks Act. The definition is inclusive. It brings within its ambit a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. As against this, the word "trademark" which is defined in Section 2(1)(zb), broadly has the following indices.

(i) It is capable of a graphical representation.

(ii) It distinguishes goods or services of one person from those of the other.

(iii) Such graphical representation could also include the shape of goods, their packaging and combination of colours. In other words it brings within its ambit a trade dress.

32.3 Section 2(1)(h) defines what is a deceptively similar mark. A mark is deemed to be deceptively similar to another mark if it so nearly resembles that other mark, that it is likely to deceive or cause confusion. A registered trademark is defined in Section 2(1)(w) as one which is actually on the register and remains in force.

32.4 Section 17 of the Trade Marks Act confers on the proprietor of a registered trade mark which consists of several matters, exclusive right to use the trade mark when taken as a "whole". Sub-section (2) of Section 17 makes it clear that notwithstanding anything contained in Sub-section (1) of Section 17; where a trade mark contains (a) any part which is not the subject matter of a separate application by the proprietor for the registration of a trade mark; or (b) which is

not separately registered by the proprietor as a trade mark; or (c) which contains any matter which is common to the trade or is otherwise of a non-distinctiveness character - the registration of the mark shall not confer any exclusive right in respect of the matter which forms only a "part" of the "whole" of the trade mark, which is registered.

32.5 Sub-section (2) of Section 27 of the Trade Marks Act preserves a right in a person who is a proprietor of a mark to bring an action for passing off as well.

32.6 The rights conferred by registration of a mark are encapsulated in Section 28 of the Trade Marks Act. Section 28 provides that subject to other provisions of the Trade Marks Act the registration of the mark shall confer on the owner exclusive right of use of the trademark in relation to the goods or services in respect of which the mark is registered, and consequently enable a registered proprietor to obtain necessary relief in the event of infringement of his trademark, in the manner provided in the Act. This is subject to the mark being a valid. The validity of the mark in an action for infringement can be enquired into either by the court or the statutory authority depending on where and at which stage the action is pending. [See *Lowenbrau AG and Another Vs. Jagpin Breweries Ltd. and Another*,]. The right to exclusive use of a registered mark conferred upon the owner of such a mark is subject to conditions and limitations to which the registration is subjected to. In the context of the present case in my view Sub-section (2) of Section 28 of the Trade Marks Act would bring within its ambit any disclaimers which are set out at the time of registration of the mark.

32.7 Section 29 of Trade Marks Act sets out as to what would constitute an infringement of a trade mark. Sub-sections (2) and (4) of Section 29 of Trade Marks Act provide for various permutation and combinations which constitute an infringement. Between Clauses (a) to (c) of Sub-section 2 of Section 29 various situations are covered: First, where rival trade marks are identical and the goods and services are also similar. Second, where rivals trade marks are similar, and goods and services are identical or similar. And third, where not only the rival trade marks are identical but the goods and services are identical. Sub-section (4) of Section 29 on the other hand covers a situation where rival trade marks are identical but goods and services are dissimilar. Even in such a situation an infringement occurs provided additional condition provided in Clause (c) of Sub-section (4) is fulfilled, which is, that the registered mark has a reputation in India and the use of the mark without due cause would tantamount to taking "unfair advantage" or, would be detrimental to the distinctive character or repute of the registered trade mark. Sub-section (5) of Section 29 of the Trade Marks Act also brings within its ambit an infringement of the kind where a registered mark is used by a person as a trade name or a part of the trade name or as a name of one's business concern or part of the name of one's business concern dealing in goods or services in relation to which the trade mark is registered. Sub-section (6) to (9) of Section 29 of Trade Marks Act sets out as to what would constitute "use" of a registered trademark for it to be termed as infringement of a

registered mark within the meaning of the Trade Marks Act.

32.8 Section 30 of the Trade Marks Act provides that nothing in Section 29 of the Trade Marks Act shall be construed as preventing the "use" of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided: (a) the use is in accordance with honest practices in industrial or commercial matters; (b) it is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark. Sub-section (2) (a) and (b) of Section 30 specifically adverts to situation where a registered trade mark is not infringed.

32.9 Section 31 of the Trade Marks Act provides that registration of a mark usually shall constitute a prima facie evidence of its validity. Sub-section (2) of Section 31, however, makes it clear that the validity of a registered trade mark shall not be challenged on the ground that it was not registrable trade mark u/s 9 except on evidence of distinctiveness and that such evidence was not submitted to the Registrar before the registration.

32.10 Section 33 of the Trade Marks Act gives statutory recognition to the defence of acquiescence where an owner of a registered trade mark allowed continuous user of a rival mark for a period of five years.

32.11 Similarly, Section 34 of the Trade Marks Act saves the right of an owner of a trade mark which is identical with or nearly resembling the registered trade mark provided: the said person had continuously used the trade mark from a date prior to the use or to the date of registration of the first mentioned trade mark, whichever is earlier in relation to the goods and services in issue.

32.12 Section 35 of the Trade Marks Act gives statutory protection (against interference by a proprietor or a registered user of a trade mark) to persons who make bonafide use of a registered mark as its own name or place of his business or of the name or name of the place of business of his predecessor in business or is used in a bonafide manner to describe the character or quality of his goods or services.

32.13 Section 36 of the Trade Marks Act saves the use of a name or description of an article as a trade mark or as a part of a trade mark only till such time it is proved that after the date of registration there has been a "well known" and "established" use of the said word as the name or description of the article or substance or service, not being used in relation to goods and services of the proprietor or registered user of the mark; or that article or substance was formerly manufactured under a patent in respect of which a period of two years or more has expired since the cessation of the patent, and that the word is the only practicable name or description of the article or substance.

33. A conjoint and harmonious reading of the aforesaid provisions of the Trade Marks Act is indicative of the following broad scheme of the Trade Marks Act;

(i) Statutory rights and remedies with respect to an action for infringement of a

registered trade mark are governed strictly by the provisions of the Trade Marks Act.

(ii) Notwithstanding the rights and remedies provided under the Trade Marks Act, the Act itself saves common law right of passing off. [See Sub-section (2) of Section 27].

(iii) The rights conferred on a proprietor of a registered trade mark even though exclusive in nature, are however, subject to the conditions and limitations set out at the time of registration.

(iv) A trade mark registration confers on the proprietor exclusive right to use the trade mark as a "whole".

(v) There is no exclusivity conferred on the registered proprietor if he chooses to use only "part" of the whole of such registered mark and such "part" is neither a subject matter of the separate application for registration filed with Registrar of Trade Marks nor is it registered separately.

(vi) A registered proprietor may be able to protect a "part" of a registered trade mark if he is able to show it is not common to trade or that it has obtained a "distinctive character".

(vii) The presumption of validity of a registered mark u/s 31 of the Trade Marks Act (eventhough rebuttable) applies to "whole" or entirety of mark. The presumption of validity does not ipso facto get attracted to a part of the registered mark.

(viii) If a mark is registered it matters little whether the infringing mark is relatable to the goods in issue once it is held to be identical or deceptively similar to the registered mark, as long as the registered mark has acquired a reputation in India and the use of the infringing mark is made by the infringer without due cause only to take "unfair advantage" and/or in a manner which results in detriment to the distinctive character or repute of the registered trade mark.

(ix) The defendant, can resort to the defence of honest use in accordance with the practices of the industry or commercial trade as long as the use is not such which takes either unfair advantage or is detrimental to the distinctive character or repute of the registered mark.

(x) A registered mark is not infringed where the use of the registered mark is only to indicate the kind, quality, quantity, value, intended purpose or geographical origin or even the time of production of goods and services.

(xi) A defendant can also adopt the defence of a prior continuous user from a date prior to the use or registration of the registered mark.

(xii) The defendant is also not prevented from using the registered mark provided it is used in a bonafide manner by a person as his own name, place of business or as a name or place of business of his predecessors in business; or

the registered mark is used genuinely to describe the character and quality of the goods.

(xiii) Lastly, if a registered mark contains within it words, which is, a name or description of an article or substance or services then the right in it ceases the moment the use becomes "well known" and "established". It is important to note that the test of "well known" and "established" use as provided in Section 36 of the Trade Marks Act in respect of a name or description of an article, which forms part of a trade mark, is not confined to the use in the country or by the defendant in a given case.

34. It is now well-settled that in determining whether or not an infringing mark is deceptively or confusingly similar to a registered mark the courts usually follow the following parameters:

(i) they look for similarities rather than dissimilarity, [see Cadila Healthcare (supra)]

(ii) the similarities are not judged by keeping the registered and the infringing mark alongside [see Parle Products (supra)]

(iii) the test of fading memory of a consumer is applied. (iv) in the absence of cogent evidence the presiding officer, i.e., the Judge may resort to an ocular test with regard to the similarities in the registered trade mark and the infringing mark.

35. In the instant case it is quite evident that the plaintiff has a registration in his favour in respect of mark "RICH'S WHIP TOPPING" and not "WHIP TOPPING". This is a position which obtains even in other jurisdictions such as the USA and New Zealand, a fact which is evident from the documents referred to above. The registration in India of the trade mark "RICH'S WHIP TOPPING" is also subject to disclaimer of the letter "S" and the word "Topping". There is definitely no registration in favour of the plaintiff with respect to the trade dress which is based on the use of red, blue and white colours. Similarly, while the plaintiffs have statutory rights in the entire trade mark "RICH'S WHIP TOPPING" it certainly does not have statutory right in a part of the trade mark, that is, "WHIP TOPPING" unless it is able to demonstrate that it is not common to trade or has attained a distinctive character.

35.1 In my view, in order to come to a conclusion whether or not a given mark achieved distinctiveness the evidence placed on record will have to be appraised keeping the following in mind:- First, does the mark remind the consumer of the trade origin. In other words, does the trade origin get related to the propounder of the mark and none other. Second, has the mark acquired "sufficiently distinctive character that the mark has become a trade mark". The use of a mark does not automatically translate into distinctiveness. [See Shredded Wheat Co. Ltd v. Kelloggs of Great Britain Ltd. (1940) 57 RPC137 & British Sugar PLC v. James Robertson and Sons Ltd. 1996 RPC 281].

35.2 Evidence on record placed by plaintiffs does not lead to such a conclusion. There is no evidence of consumers on record which would suggest that use of the words "WHIP TOPPING" brings to mind the product manufactured by the plaintiffs. PW7 who is the distributor of plaintiff No. 2 has laconically stated that the infringing mark has created confusion. Being a distributor of plaintiff No. 2 his evidence cannot be given much weight. Similarly, PW8 has extolled the virtues of the plaintiffs product as having a greater shelf life, and the fact that the trade dress of the plaintiffs' packaging is "eye catching" and easily recognizable. There is no pointed evidence on the distinctiveness of word mark "WHIP TOPPING". There is no evidence say in the form of a consumer survey; I must add here that even the purity of such evidence will depend upon the kind of samples drawn and the questions asked of consumers. In such a situation, I am not persuaded to hold that the defendant in using the trade mark "BELLS WHIP TOPPING" has infringed the registered mark, which is "RICH'S WHIP TOPPING". The suffix "BELLS" by itself, even if one were to apply the test of the fading memory of a consumer, does not persuade me to hold that there is any similarity, much less an identity, with the plaintiffs' registered trade mark, which is "RICH'S WHIP TOPPING". Therefore, in one sense it is not necessary in the instant case for the defendant, in my view, to bring its case under the provisions of Section 30, 35 or 36 of the Trade Marks Act.

36. Since lengthy submissions were made by both sides with respect to whether or not "WHIP TOPPING" is a generic and/or a descriptive expression, it may be necessary to briefly touch upon this aspect of the matter. The word "generic" ordinarily would mean that which has character of or belongs to a genus or class (see New Shorter Oxford English Dictionary, Edition 1993 at page 1074); whereas the word "descriptive" would mean that which seeks to describe, characterized by description, consist of or concern with description or observable things or qualities (see New Shorter Oxford English Dictionary, Edition 1993 at page 644). Whether a word or expression is "generic" or "descriptive" or both is dependent on the facts and circumstances arising in a particular case. It is quite possible that a word or expression which is "generic", i.e., which refers to a genus or a class is also descriptive as the word by itself characterize the qualities of the product. The line dividing the two in certain cases may get blurred. The word "whip" by itself means, in the context of the present case, a light fluffy desert made with whipped cream or beaten eggs (see New Shorter Oxford English Dictionary, Edition 1993 at page 3670), while the word "topping" means a top layer or garnish put on food (see New Shorter Oxford English Dictionary, Edition 1993 at page 3342). Similarly, the word "cream" means part of liquid that gathers at the top; froth etc. or a liquid rich in droplets or particles of the dispersed phase that forms a separate (especially upper) layer in an emulsion or suspension when it is allowed to stand or is centrifuged (see New Shorter Oxford English Dictionary, Edition 1993 at page 543). The words "Whip Topping", when juxtaposed would, in my view, be representative of toppings or garnishes for food items which have cream like quality. Therefore, it is, in my opinion, both

"generic" as well as "descriptive" of the product. The submission of Mr Gupta that the words "WHIP TOPPING" is distinctive because it relates to a non-dairy product is not substantiated by any evidence on record which would demonstrate that the words "WHIP TOPPING" are associated only with a cream which is not dairy based.

37. It is not disputed by the learned Counsel for the defendant, as it cannot be, that descriptive words and expression can be registered. Even if they are not registered they can be protected, provided it has attained secondary distinctive meaning by its extensive use and publicity. In other words use is a question of degree. What one needs to ask oneself is whether the descriptive mark has become the trade mark. The defendant can ward off a challenge in respect of a mark in which the plaintiff claims proprietorship rights and seeks to enforce his rights whether on the basis of the registration or otherwise; on the ground that the trade mark is a descriptive word or consists of words which are descriptive of the character and quality of the product as long as the use is bonafide or that the descriptive word is well known or used extensively by third parties.

38. The plaintiff, in order to demonstrate that "WHIP TOPPING" has attained secondary distinctive meaning, has relied upon the affidavits of PW1 to PW4. The plaintiffs' witnesses attempted to prove the extensive promotion of its trade mark "RICH'S WHIP TOPPING" through indices such as the world wide turnover of its product, which included the sales in India, the amount spent on promotional material and the extensive publicity received over the years in newspapers and journals both in India and abroad. I have already observed hereinabove the use of the mark by itself does not translate into distinctiveness. The distinctiveness should be of an order which displaces the "primary descriptive meaning" of the word. The evidence placed before me falls well short of this standard. Assuming that one were to accept the evidence produced as an indicator of the fact that words "WHIP TOPPING", which is part of the plaintiffs' trade mark "RICH'S WHIP TOPPING", has attained secondary distinctive meaning, the very fact in at least in two jurisdictions i.e., the USA and the New Zealand the plaintiffs' mark "RICH'S WHIP TOPPING" has been registered with limitation. While the U.S. registration excludes use of the word "Topping"; the New Zealand company office has excluded the use of the words "WHIP TOPPING". Even in India the plaintiffs have of their own accord disclaimed their right to the letter "S" and the word "Topping". In these circumstances, I am not persuaded to hold that the use of the words "WHIP TOPPING" by the defendant in its trade mark "BELLS WHIP TOPPING" would infringe either the statutory rights vested in the plaintiffs' registered trade mark "RICH'S WHIP TOPPING", or even constitute violation of any common law rights that the plaintiffs would have in its mark "RICH'S WHIP TOPPING" for the reasons given herein below. In the context of what is said by me above, there is therefore also no necessity for me to deal with the submission that the defence of "character" and "quality" referred to in Section 35 of the Trade Marks Act are used in the adjectival sense, though I have doubts about the tenability of this argument. The example most commonly

used, which comes to my mind, is that of a "soap". Can "soap" be used by itself as a mark? The answer in my opinion is clearly in the negative since it describes the product; however, it nevertheless is a noun.

39. Consequently, this brings me to the submission of the plaintiffs that the defendant's use of the infringed mark constitutes passing off. In this connection, let me reiterate the well known parameters of what constitutes passing off. Passing off as is ubiquitously held in most jurisdictions subject to usual turn of phrase or change of phraseology, a tort of false representation, whether intentional or unintentional whereby, one person attempts to sell his goods or services as those manufactured or rendered by another which is "calculated" to damage the goodwill of that other person. Thus, the necessary ingredients which a plaintiff in an action of passing off is required to prove, is the:

- (i) employment of deception. Mere confusion will not suffice;
- (ii) intent is not a necessary as long as the unwary consumer is deceived; and
- (iii) the act of the tort should injure the goodwill not just his reputation.

The cause of action for passing off are premised on the "classical trinity" form or the extended form. A "classical form" of passing off is one where a person seeks to trade his goods as those originating from another; thus injuring such person's individual business and goodwill. Extended form of passing off is one where court's seek to protect "shared goodwill" accruing in favour of a class of traders; for example, on account of geographical connotations, [see J. Bollinger SA v. Costa Brava Wine Co. Ltd. (1960) R.P.C 16 (in short the "Champagne case"), Vine Products Ltd v. Mackenzie & Co. Ltd. (1969) R.P.C 1 (in short the "Sherry case"), Erven Warnink v. J. Townend & Sons (1980) R.P.C 31 (HL) (in short the "Advocaat case") and Reckitt Colman Products Ltd v. Borden (1990) R.P.C 341 H.L.]

39.1 In my view, the defendant cannot be said to have committed the tort of passing off if the test set out above are applied to the facts obtaining in the instant case. The defendant's trade mark "BELLS WHIP TOPPING" when looked at in the setting in which the mark is affixed, which has a picture of a cake on the cover, leaves no doubt in my mind that there is not even a slightest attempt to deceive by the defendant. The defendant on the packaging has prominently alluded to the fact that the product is being sold by it as "Bell's" non-dairy "Whip Topping". Therefore, merely because it uses on its packaging a colour scheme comprising of red, blue and white colours would not, to my mind, be sufficient to constitute a tort of passing off

40. As regards the similarity in the handling instructions and the directions for use of the product, which form part of the packaging, I tend to agree with the learned Counsel for the defendant that the plaintiffs have not placed any evidence on record to show that it has a copyright in the said handling instructions/directions for use of the product. Though the instructions and the

directions may have an element of similarity, unless the plaintiff is able to adduce evidence to support its claim, which, as stated above, it did not produce i.e., it is the originator of those instructions; it cannot seek any rights in respect of the same.

41. Let me also deal with some of the other submissions made on behalf of the plaintiffs. The argument of Mr Gupta that the sales shown by the defendant is only Rs 1.7 crores, that too, in the year 2002-03 which is not supported by requisite evidence, cannot in my view enure to the benefit of the plaintiffs at the final stage because the onus of proof with respect to distinctiveness of the mark lay on the plaintiff, which in my opinion, it has not been able to discharge.

41.1 The other submission of Mr Gupta that the defendant shall not be able to obtain registration of its mark in view of the provisions of Section 11 of the Trade Marks Act is also predicated on a finding that the plaintiffs' mark is "well-known" in the trade. Priority of use alone shall not suffice for the purposes of Section 11 of the Trade Marks Act, given the facts and circumstances of this case, and my observations made hereinabove on "distinctiveness" achieved by the plaintiffs' mark.

41.2 On the issue of validity of presumption arising u/s 31 of the Trade Marks Act in favour of the plaintiffs in view of its mark having been registered has already been answered by me while examining the scheme of the Trade Marks Act. This submission does not need any further elaboration.

42. In view of the observations above, my answers to the issues framed are as follows:

(i) In so far as issue No. 1 is concerned my opinion is as follows: While it cannot be denied that the plaintiff has a proprietary right in the trade mark "RICH'S WHIP TOPPING" in relation to goods referred to in the plaint. And these rights obtain both with respect to those conferred upon the plaintiff under the Trade Marks Act as well as under common law. The rights of the plaintiffs do not extend to a part of the trade mark, i.e., "WHIP TOPPING". Rights in the entire or "whole" does not necessarily translate into a right in a "part" of the trade mark - as in this case. The issue is answered accordingly.

(ii) As regards issue Nos. 2 and 3 are concerned the plaintiff has not been able to discharge its onus with respect to trade mark " RICH'S WHIP TOPPING" with obvious emphasis on "WHIP TOPPING" has acquired secondary distinctive meaning and, therefore, transborder reputation. The plaintiffs on their own accord having accepted the limitation both in USA and New Zealand with respect to the exclusive right to use the word "TOPPING" and "WHIP TOPPING" - both of which form part of its registered trade mark "RICH'S WHIP TOPPING". Similarly, in India the plaintiff has accepted disclaimer in respect of letter "S" and the word "Topping" once again as part of its trade mark "RICH'S WHIP TOPPING". Consequently, both the issues are found against the plaintiffs.

(iii) Issue Nos. 4 & 5 are answered against the plaintiff and in favour of the defendant in as much as neither the defendant's mark "BELLS WHIP TOPPING" nor the defendant's packaging and/or trade dress is deceptively or confusingly similar to the plaintiffs trade mark "RICH'S WHIP TOPPING" or its packaging or even its trade dress.

(iv) Issue Nos. 7 to 10 are also answered in favour of the defendant and against the plaintiffs. The word "WHIP TOPPING" which forms a part of the plaintiffs mark are not a coined words but are both generic and descriptive of the product. The words have not acquired a secondary meaning.

(v) In view of the observations above, the issue No. 6 is also answered against the plaintiff. The plaintiffs are hence not entitled to any damages as claimed or at all. (vi) In so far as issue No. 11 and 12 are concerned, I am of the view that both these issues have to be found in favour of the plaintiff. The plaintiff is not guilty of concealment in view of the fact that the document pertaining to disclaimer of letter "S" and the word "Topping" had been filed. Even though it is conceded, and I must say, quite fairly by the learned senior counsel for the plaintiff that the pleadings do not allude to the aspect of the disclaimer, this, in my view, may have been oversight, which cannot be termed as an act of concealment. In any event, as submitted by Mr Gupta, this cannot determine the outcome of the proceeding in the final analysis. Since, in any event, every issue has been determined on merits this issue has really been relegated to the background. Accordingly, I find the issue in favour of the plaintiff and against the defendant.

(vi) As regards whether the suit is barred on account of delay and laches and acquiescence, I am of the view that the said issue has to be once again found in favour of the plaintiff and against the defendant. The reason for the same being that there is nothing put on record by way of evidence by the defendant to suggest that the plaintiffs' assertion, that it came to know of the defendant's use of, what it claims as infringing mark, i.e., "BELLS WHIP TOPPING", only in April, 2003 as false. The plaintiffs' alacrity from then on is documented in the cease and desist notice dated 23.04.2003 (Ex.P3) issued to the defendant. The reply to the said notice was received by the plaintiff undisputedly on 13.05.2003 (Ex D4). The instant suit was filed in March, 2004. Therefore, while there may have been some delay, and perhaps some degree of laches in not coming to the court at the earliest, it most certainly is not a case of acquiescence. It would also perhaps be useful to cull out the distinction between acquiescence and laches. See Bihar Tubes Ltd v. Garg Ispat Ltd. CS(OS) No. 1633/2009 dated 26.10.2009.

13. ...Acquiescence to my mind, would mean conscious acceptance of an inimical state of affairs. The meaning of the word "acquiescence" would perhaps also depend on the context in which it is used. In the present context, amongst various meanings ascribed to the word, the closest would be the following given in Corpus Juris Secundum Volume I & Black's Law Dictionary, Sixth (6f) Edition.

Corpus Juris Secundum Volume I at Pages 915-916

"Acquiescence-the word, it has been said, implies acceptance or approval, active assent, active consent, assent, assent or consent, consent, also knowledge, and power to contract. "

Black's Law Dictionary , Sixth (6) Edition at Page 24

Acquiescence - conduct recognizing the existence of a transaction, and intended, in some extent atleast, to carry the transaction, or permit it to be carried, into effect.

13.1 It would also perhaps be useful to cull out the distinction between acquiescence and laches as stated in the Black's Law Dictionary (6f Edition at page 24).

Acquiescence and laches are cognate but not equivalent terms. The former is a submission to, or resting satisfied with, an existing state of things, while laches implies a neglect to do that which the party ought to do for his own benefit or protection. Hence laches may be evidence of acquiescence. Laches imports a merely a passive assent, while acquiescence implies active assent. In re Wilbur's Estate, 334 Pa. 45, 5 A.2d 325, 331. "Acquiescence" relates to inaction during performance of an act while "laches" relates to delay after act is done.

Accordingly, this issue is found in favour of the plaintiff and against the defendant.

43. In view of the discussions above, I am of the opinion that the prayers sought in the suit deserves to be rejected. The suit is dismissed. It is ordered accordingly.