
(1999) 11 DEL CK 0123

In the Delhi High Court

Case No : IA No. 94450 of 1996 in Suit No. 2515 of 1996

Smithkline Beecham Plc. and Others

APPELLANT

Vs

Hindustan Lever Limited and Others

RESPONDENT

Date of Decision : 26-11-1999

Acts Referred:

Designs Act, 2000 — Section 2(5)

Trade and Merchandise Marks Act, 1958 — Section 27, 27(2)

Citation : (2000) 52 DRJ 55

Hon'ble Judges : Dr. M.K. Sharma, J

Bench : Single Bench

Advocate : Arun Jaitley, Michael Fyash, of, P.N. Sewak and Naveen Chawla, for the Appellant; Ashok Desai, V.P. Singh, Praveen Anand and Hemant Singh, for the Respondent

Final Decision : Dismissed

Judgement

M.K. Sharma, J.—The plaintiffs instituted a suit in this court praying for a decree of declaration that the plaintiffs are exclusive owners and proprietors of the tooth brush designs "ACQUA FLEX" and "ACQUAFRESH FLEX N" DIRECT" having foreign registrations. In the suit a decree for permanent injunction was also sought for preventing infringement of the tooth brush design registration of the plaintiffs by restraining defendants, their partners, servants and agents from manufacturing, selling or offering for sale tooth brushes bearing same designs which are identical with or deceptively similar to the tooth brush of the plaintiffs and also from restraining the defendants 1 & 2 jointly and severally from passing off their business and goods as those of the plaintiffs and also for payment of damages for a sum of Rs.5,05,000/-. Along with the aforesaid suit an application for temporary injunction was also filed seeking for an injunction restraining the defendants from making infringement to the said tooth brush design and from manufacturing, selling or offering for sale tooth brushes having designs which are identical with or deceptively similar to that of the plaintiffs.

2. It is the case of the plaintiffs that the plaintiff No. 1 through its own efforts and through the efforts of its subsidiary companies developed the design of a tooth brush consisting of a distinctive aesthetic handle and head shape, a connecting portion with S-shaped (zig-zag) folds between the Head (carrying the "bristles") and the Handle for which the plaintiffs obtained foreign registrations. It was further stated that the plaintiffs No. 1 & 2 had entered into an Intellectual Property Right Agreement dated 3.6.1996 whereunder the plaintiff No. 1 appointed the plaintiff No. 2 as its distributor to sell and distribute throughout India including the Territory of Delhi tooth brushes manufactured as per the foreign and/or Indian registered design of plaintiffs No. 1 and/or 3.

3. It is alleged that the traders including defendant No. 1 who happened to go abroad, came across the aquafresh tooth brush of the plaintiffs or otherwise acquired knowledge about its distinctive design, and after making applications in India for registration of the said tooth brush design of the plaintiffs in their own name and the said applications for registration of design filed by defendant No.2 were accepted and were granted registration without making proper investigation and search of Designs Register for existing registered designs and publications. In the light if the aforesaid statements the plaintiffs sought for a decree for declaration and for permanent injunction as delineated above and also sought for a temporary injunction.

4. The defendants entered appearance and contested the suit for filing written statements as also replies to the application seeking for temporary injunction. The aforesaid application seeking for temporary injunction was pressed before me, on which I heard Mr. Michael Fyash and Mr. Arun Jaitley, appearing for the plaintiffs and Mr. Ashok Desai and Mr. V.P. Singh appearing for defendants No. 1 & 2 respectively. I propose to dispose of the said application by this order.

5. It was argued on behalf of the plaintiffs that the plaintiffs manufactured and marketed two tooth brushes which are known and marketed as "AGQUA FLEX" and "AQUAFRESH FLEX N" DIRECT" which comprise of distinctive aesthetic handle and head shape, a connecting portion with "S" shaped (zig-zag) folds between the head carrying bristles and the handle. It is the specific case of the plaintiffs that the "S" shaped region is primarily aesthetic and also serves the function of modifying flexibility of the connecting portion. The plaintiffs have pleaded that the aforesaid designs of the plaintiffs have foreign registration, for they have obtained registration in respect of the said design in Great Britain and other countries and also applied for registration of the said design in India and that the said tooth brush marketed under the trade name "FLEX" was duly registered in favor of plaintiff No. 3 under design registration No. 166434 dated October 27, 1993 and the tooth brush marketed by the plaintiffs under the name "FLEX N" DIRECT" was also registered in favor of plaintiff No. 1 under design registration No. 167936. The design "FLEX N" DIRECT" marketed by the plaintiffs forming the subject matter of Indian design registration No.166434 essentially comprises a Head which carries the "bristles", a connecting portion with an

attractive and aesthetic handle and the S-shaped (zig-zag) folds between the head and the handle.

6. In the plaint it was also the case of the plaintiff that by manufacturing and marketing similar tooth brushes the defendants have infringed the registered design of the plaintiffs so far "FLEX N" DIRECT" is concerned whereas the defendants particularly the defendant No.2 was passing off their business and goods as those of the plaintiff by manufacturing, selling and offering for sale tooth brush bearing design which is identical with or deceptively similar to the tooth brush design of the plaintiffs manufactured and marketed under the name "ACQUA FLEX".

7. During the course of arguments however, it was revealed that the design of "ACQUA FLEX N" DIRECT" was previously published in India and Therefore, the case of infringement in respect of the said tooth brush was given up by the plaintiffs, when Mr. Michael Fyash, counsel for the plaintiffs submitted that in view of the evidence placed on record by the defendants that the said design was previously published in India the plaintiffs have no case for infringement. Mr. Jaitley however, appearing for the plaintiffs submitted that still the plaintiffs could continue the proceedings as against the defendants particularly the defendant No. 1 on the ground of passing off. So far the design of the tooth brush with the name "ACQUA FLEX" is concerned no case of infringement was made out in the plaint and the only plea taken up by the plaintiffs was that the defendants, particularly the defendant No.2 has been passing off their business and goods as those of the plaintiffs" by manufacturing, selling and offering for sale tooth brushes bearing design which is identical with or deceptively similar to the tooth brush design being manufactured and marketed by the plaintiffs under the name "FLEX".

8. Mr. Ashok Desai, appearing for defendant No. 1 submitted that there is no concept of passing off under the design law and in fact in the interim injunction application no relief was sought for by the plaintiffs for passing off. He also submitted that there could be no monopolies in respect of a matter relating to design or patent. He submitted that the design in question with S-shaped zig-zag folds, angular neck and curved handle was a pure and simple functional feature and Therefore, no novelty could be claimed in respect of the same. He also drew my attention to the submission of Mr. Michael Fyash during the course of his arguments stating that the action of passing off is confined only to "OZETTE" which is alleged to be deceptively similar to that of the tooth brush "FLEX" only and not to "PEPSODENT manufactured and marketed by defendant No. 1. He also submitted that S-shaped feature in FLEX N" DIRECT is merely functional in nature and Therefore is incapable of any protection in view of the provisions contained in the Designs Act. He further submitted that not only action of passing off is not applicable to a case of design but even assuming that such an action lies even under the Designs Act no case for such action is made out and proved in the present case. He also submitted that none of the three conditions

for grant of an injunction is made out by the plaintiffs and Therefore, no injunction could be granted.

9. Mr. V.P. Singh appearing for defendant No.2 submitted that the defendants are registered proprietors of "PEPSODENT POPULAR" and "OZETTE" respectively and Therefore, the statutory right acquired by defendants by virtue of the aforesaid registration cannot be enjoined under common law principles. He also submitted that the ingredients of making out a case and proving passing off are not made out in the present case, for no evidence of deception and confusion has been led by the plaintiffs. He also submitted that the plaintiff has to establish existence of monopoly and proprietary right on the date of commencement of infringing activity by the defendants. But the same is totally absent in the present case as the defendant No.2 has been using the design in question since 1991 whereas the evidence of use of the tooth brush "ACQUAFRESH FLEX" has been produced only from the year 1993. He also submitted that there cannot be a proprietary right in admittedly utilitarian features such as "S" bend flexible neck the same being exclusively functional only.

10. In the light of the aforesaid submissions of the counsel appearing for the parties and the documents placed on record several questions arise for my consideration which are dealt with and discussed by me hereinafter giving my reasons therefore.

11. The present case has been initiated by the plaintiffs seeking for interlocutory relief in an action for infringement of a registered design by plaintiff No. 1 and for passing off. It is alleged that by manufacturing and selling PEPSODENT POPULAR by the defendant No. 1 they have infringed the registered design of the plaintiff and whereas by manufacturing and selling OZETTE by defendant No.2 they have passed off their goods as that of the plaintiffs. plaintiff No.2 sold a tooth brush in India called ACQUAFRESH FLEX. The plaintiff No. 1 manufactured another tooth brush namely ACOUAFRESH FLEX N" DIRECT but the same was not sold in India at the time of institution of the aforesaid proceedings, but during the pendency of the suit they have entered the Indian market and started selling the said goods from the year 1999. The plaintiffs specifically stated that there is an infringement by defendant No. 1 by manufacturing and selling PEPSODENT POPULAR tooth brush. Subsequently however, and during the pendency of the present proceedings in this court it was discovered that the plaintiffs have advertised their product namely ACOUAFRESH FLEX N" DIRECT and that the said produce was prior published in India and accordingly the action for infringement was admittedly not maintainable in relation to the aforesaid product namely -ACOUAFRESH FLEX N" DIRECT. The plaintiffs Therefore, during the course of their arguments sought to give up the allegation of action for infringement in respect of ACQUAFRESH FLEX N" DIRECT as against defendant No. 1 but sought to maintain the action of passing off in respect of the said tooth brush also. It is reiterated here that so far the tooth brush OZETTE manufactured and sold by defendant No. 2 is concerned the action alleged is only for passing off

and not for infringement. Thus initially in the plaint interlocutory order was sought for an action for infringement of registered design pertaining to "S" bend only. Counsel for the defendant No. 1, Therefore, took up a plea that the plaintiffs are bound by their admissions. It was contended that the statement made by a counsel for a party at or during the hearing of the case amounts to admission. Since in the present case there was an admission made by the plaintiffs through their counsel stating that the action for passing off is confined only to OZETTE, the counsel submitted that the plaintiffs should not be allowed to make out a case of possibility of confusion and deception allegedly taking place between the two products. In support of this contention Mr. Desai appearing for defendant No. 1 relied upon the decisions in the Veeramma Vs. Appayya and Another

Mr. Jaitley however, appearing for the plaintiffs submitted that the clients or the parties should not suffer for an inadvertent admission on the part of a counsel and that if a case for passing off is made out on the basis of the records the plaintiff could still seek for interlocutory relief in respect of such action as well although at one stage the same was sought to be given up. Without entering into the controversy as to whether the statement of the counsel for a party would amount to an admission or not I thought it fit to look into the pleadings of the parties in order to scrutinise the said aspect and to ascertain as to whether a case of passing off has been made out by the plaintiffs so far ACQUAFRESH FLEX N" DIRECT is concerned. In order to prima facie prove a cause of action for passing off certain pre-conditions are to be fulfilled. The first ingredient to be prima facie pleaded and proved is goodwill, whereas the second aspect to be proved is misrepresentation and the third such aspect that is to be proved is the fact that such misrepresentation has led to sufferance of damages. The plaintiffs have to prove that the defendant has been using or is using in connection with his own goods a name, mark, sign, or get up which has become distinctive with the plaintiffs. He also has to prove in addition that the defendants' use of the said feature was calculated or likely to deceive, which has resulted into injury actually to the goodwill of the plaintiff. Since passing off action is based on deception and misrepresentation there has to be enough pleadings in the plaint to indicate that there was in fact deception, confusion and misrepresentation. On careful consideration of the pleadings of the plaintiffs in the suit I find no such pleading either in the plaint or in the application under Order 39 Rules 1 & 2 which could lead to an inference that so far ACQUAFRESH FLEX N" DIRECT is concerned the defendant No. 1 prima facie has in any manner caused misrepresentation or deception while manufacturing and selling PEPSODENT POPULAR or that there was any confusion created by the sale of such products by defendant No. 1.

12. It is settled law that unless a plea is corroborated by pleadings no such plea could be allowed to be taken up for the purpose of deciding an action unless enough material to prove and establish the charge have been placed on record. The action of passing off is an action for misrepresentation and/or deceit and in

order to prove such charges strong and cogent material shall have to be available no record and in absence of the same the court would decline to investigate on the charges. Besides, it is an admitted position that when the aforesaid proceedings were instituted in this court ACQUAFRESH FLEX N" DIRECT was not sold in the Indian Market at all. Admittedly, the product was prior published in India in Dental Journals. Since the produce was not available in the Indian Market having not been marketed and sold in the Indian Market by the plaintiffs there was no scope for contending that the said product had already achieved a goodwill in India. Pleadings to prove creation of a goodwill and reputation in India for the tooth-brush "ACQUAFRESH FLEX N" DIRECT" are absent. In my considered opinion, Therefore, the plaintiffs have failed to make out a prima facie case to prove and establish either a case of action for infringement or a passing off action in respect of its product with the name "ACQUAFRESH FLEX N" DIRECT".

13. Having arrived at the aforesaid finding it would thus be necessary during these proceedings to scrutinies and ascertain as to whether the plaintiffs have been able to prima facie show that there has been passing off by get up in relation to the OZETTE tooth brush having regard to the FLEX medal of the plaintiffs. At this stage it would also be necessary to deal with the contention of the counsel appearing for the defendants that no action for passing off could lie or be entertained in respect of a matter relating to design. According to the defendants the design law frowns upon monopolies as it is in public interest that inventions and improvements enter the public domain and are freely available for public use and Therefore in such a situation public interest supersedes the individual interest of a person claiming ownership over intellectual property. In support of the contention, the counsel for the respondent relied upon the decision of this court in Tobu Enterprises Pvt. Ltd. v. Megha Enterprises; reported in 1983 PTC 359. Relying on the said decision of this court learned counsel submitted that the definition of design as given u/s 2(5) of the Designs Act having excluded the trade mark from its purview, the remedy against passing off is specifically excluded under the Act as there is no section similar to that of Section 27 of the Trade and Merchandise Marks Act, 1958. The aforesaid submission was considered by me after taking notice of the provisions of the Designs Act as also the decisions relied upon in respect of the said contention by the counsel appearing for the parties.

Rights under the registered design are set out in the Designs Act itself whereas the law of passing off is carved out under the Common Law Rights and Therefore, both the rights are distinct and different. The contention of the counsel appearing for the respondents that there can be no monopoly in respect of a design is also without any merit for the provisions of the Design Act itself provide for having monopoly over such a design for a statutory period. Only after expiry of the aforesaid statutory period inventions and improvements go into the public domain and could be made freely available for public use but till then the inventor or the registered owner of the design have a monopoly over the said

design in terms of the provisions of the Design Act. The Plea that concept of passing off cannot be made applicable to a case of design is also equally without merit. As delineated above, the registered design and Common Law rights are distinct and different rights arising from two different situations. Infringement right accrues on the basis of the provisions of the Design Act whereas the passing off rights accrue on the basis of Common Law rights. It is true that there is no similar section to that of section 27 of the Trade and Merchandise Marks Act in the Design Act. Section 27(2) of the Trade and Merchandise Marks Act gives a statutory recognition to the passing off rights making the said rights a statutory right as well but that does not mean that in absence of a similar provision to that of the provisions of Section 27 in the Trade and Merchandise Marks Act the right of passing off would not be available to a case of design. If such a right is available to someone under the Common Law rights that could well be enforced even though the same is not statutorily recognised under a Statute. In this connection reference may be made to a subsequent decision of this court in *Tobu Enterprises (P) Ltd. Vs. Joginder Metal Works and Another*, . I am, Therefore, inclined to hold that passing off action is also available to case of design and such right could be enforced provided the same is available in accordance with law even in a case of design, for otherwise a latitude would be given to a manufacturer to misrepresent and to deceive unwary customers by manufacturing and selling its products as that of products of some other manufacturer or seller. Such course would also allow unscrupulous manufacturer or dealer to take recourse to confusing the unwary customer/public to purchase some goods which it was unwilling to purchase but being deceived and/or confused proceeded to purchase the same believing it to be products and goods manufactured and sold by the actual manufacturer or dealer.

14. It is next to be scrutinised and ascertained as to whether the defendants have in any manner passed off his OZETTE tooth brush as that of the tooth brush of the plaintiffs namely - "ACQUAFRESH FLEX". In order to succeed for proving the prima facie case of passing off action against the defendants the plaintiffs shall have to prima facie show that goodwill was created by the plaintiffs in respect of ACQUAFRESH FLEX tooth brush and that the defendants have misrepresented by using the features which were calculated or likely to deceive the general customers and that such action had resulted in injury actual or probable to the goodwill of the plaintiffs. Therefore, one of the questions which needs consideration is whether "S" shape in the tooth brush could be taken as an indication of the source or origin and that the plaintiffs have acquired a reputation in the aforesaid features by the use of which the defendants calculated or sought to deceive resulting into injury to the goodwill of the plaintiffs. It would also be necessary to examine whether the use of the goods with the design or a substantially similar design by the defendants has caused or is likely to cause confusion by leading the public to mistake the defendant's goods for those of the plaintiff or to associate them with it. It would also be necessary to take notice of the fact that the whole get-up of the article i.e. the

shape of the packet, the colour, the printing and the whole product would have to be taken into consideration, apart from looking at the distinctive features in order to ascertain whether the goods of the defendants were calculated to deceive the general public.

15. Before discussing the aforesaid factors it would be relevant at the first instance to ascertain whether "S" shaped feature is functional or aesthetic, for if the said feature is held to be functional in nature the same would be incapable of any protection, for no passing off action would lie for a design if the feature is held to be merely functional features. The contention of the defendants during the course of arguments was that the purpose and advantage of the design is that a certain flexibility is attained through the extensive pliability of the handle connected thereby enabling better access of the bristle to the inner surface of the tooth. If it is held to be so then the aforesaid feature would be deemed to be functional only inasmuch as only non-functional and non-utilitarian features are capable of being exclusively monopolised by anyone.

16. I have given my anxious and thoughtful consideration to the plea taken up by the defendants and refuted by the plaintiffs who submitted that the dominant featured the "S" shape was aesthetic feature. Although to some extent the said feature could be said to be aesthetic but the court is to look into the dominant purpose for deciding as to whether the features are functional or utilitarian or not. The parties have placed on record certain documentary evidence including the advertisements given by the plaintiffs in various magazines and newspapers. In the said magazines and newspapers this feature has been described by the plaintiffs themselves as lending flexibility to the neck portion of the tooth brush. Even in paragraph 9 of the plaint the aforesaid feature has been described by the plaintiffs as "S" shaped folds being resilient lending flexibility between the head the handle. The S-shaped region serves the function of modifying flexibility to the connected portion. Swiss patent granted in 1932, which document is placed on record, indicates that plaintiffs claim that the purpose and advantage of the design is that a certain flexibility of the whole tooth brush and/or of the brush head is attained through the extensive pliability of the handle connecting part in the handling and moreover also a better access of the bristle rim to the inner surface of the tooth is made possible than normally. U.S. Patent dated 1.10.1991 also describes "resiliently flexible portion and a head carrying portion, the resiliently flexible portion conspiring atleast one transverse V shaped fold formed integrally with the remainder of the handle". Some of the documents placed on record including advertisements in the TV particularly the advertisement of TV lest highlight the functional feature of the tooth brush and not the aesthetic aspect. It could thus be deduced that the purpose and advantage of the aforesaid design is basically to lend a certain flexibility to the neck portion of the tooth brush, so as to provide extensive pliability of the handle thereby enabling better access of the bristle to the inner surface of the tooth. Thus the said feature has dominant and primarily functional feature, although there could be an aesthetic feature with the zig-zag bend which seeks to give an

aesthetic view to the user. But still the dominant purpose of the feature is functional and utilitarian and that is how advertisements were also brought out in the advertisements published and Therefore, no passing off action could be available in respect of a design under the common law.

The plaintiffs have also not been able to place on record enough evidence to prima facie prove and establish that the appearance of the article to which the design is applied is in some way outstanding and peculiar and that owing to considerable use that appearance has come to be associated in the minds of the relevant trade and public with its goods and Therefore, to be distinctive of them. Even otherwise when the entire get-up of the article i.e. the tooth brush, the trade mark, shape, blister packing, colour combination of both the products and the packings, the front/logo script of the trade mark, the arrangement and features on the packaging, and the price are dissimilar in both the tooth brushes i.e. of the defendant No. 2 and plaintiff and if there is such vital point of dissimilarity between the two brushes there can be no passing off action against the defendants. The difference in the over-all appearance of the tooth brush and the added matter on the tooth brush packaging of defendant No. 2 is enough to negate the possibility of any confusion taking place.

17. The plaintiffs have also not placed on record any evidence of any use, reputation or goodwill in the "S" bend feature of the plaintiffs tooth brush "FLEX" even internationally prior to launch in India i.e. in June, 1996. They have not even placed a single advertisement published in India or invoice prior to 1996 to show and indicate that there is subsistence of any goodwill in this country. In absence of any evidence of goodwill or any reputation it cannot be presumed that the plaintiffs achieved a trans-border reputation prior to the filing of the suit in respect of their tooth brush, no injunction could be granted in favor of the plaintiff even in respect of OZETTE manufactured and marketed by the defendants vis-a-vis ACQUAFRESH FLEX. In the case of Whirlpool reported in 1996 PTC 415 there was voluminous evidence produced which were circulated in India for several years and the goods were sold to Embassies and in the context of such evidence this court held that the said product achieved trans-border reputation. No such evidence has been placed in the present case at least prior to 1996 and even whatever evidence has been placed on record after 1996 the same does not establish that the plaintiffs achieved a trans-border reputation. In order to prove trans-border goodwill and reputation the plaintiffs have relied upon materials published in the dental journal which admittedly has very restricted circulation. Mere publication of such advertisement and materials in dental journal cannot and would not establish a trans-border reputation. Such reputation, if any, was confined to a particular class of people i.e. the persons subscribing to the said specialised journals and cannot be said to be extended to the general consumers. It could not be shown that any advertisement was made by the plaintiffs prior to 1996 in any journal or magazine having wide circulation. In absence of same it is not possible to hold that the tooth brush of the plaintiff acquired any trans-border reputation and goodwill.

18. Considering the entire facts and circumstances of the case and also the three factors which are acquired to be considered for granting a temporary injunction I am of the considered opinion that the plaintiffs have failed to make out any case for grant of ad interim injunction and accordingly, the application stands dismissed.

It is however, made clear that all views and opinions expressed herein are my tentative and prima facie opinions and conclusions for the purpose of deciding the injunction application and shall not be treated as any final opinion on the merit of the dispute.