

(1994) 05 DEL CK 0003

In the Delhi High Court

Case No : Interim Application No. 9721 of 1993 and Suit No. 2532 of 1993

William Grant and Sons Ltd.

APPELLANT

Vs

McDowell and Compay Ltd.

RESPONDENT

Date of Decision : 27-05-1994

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 23 Rule 3
Copyright Act, 1957 — Section 19(2), 2, 5
Designs Act, 1911 — Section 2(5)
Penal Code, 1860 (IPC) — Section 479
Trade and Merchandise Marks Act, 1958 — Section 15, 2, 2(2), 20

Citation : (1994) 3 AD 65 : (1994) 55 DLT 80 : (1994) 30 DRJ 105

Hon'ble Judges : Mahinder Narain, J

Bench : Single Bench

Advocate : Ashok Sen, S.K. Dholakia, Parveen Anand, Binni Kalra, K. Pratibha, F.S. Nariman, V.P. Singh, A.H. Desai, Rajesh Bhatnagar, Amitabh Marwaha and Ashok Sagar, for the Appellant;

Judgement

Mahinder Narain, J.

(1) The plaintiff William Grant & Sons Ltd. has instituted the suit No.2532 of 1993 in this Court, seeking injunction against defendant McDowell & Co. Ltd. The plaintiff seeks to restrain infringement of copyright in "GLENFIDDICH" label, to prevent passing off and unfair competition, rendition of accounts of profits, delivery up etc. Along with the said suit, application has been filed for interim injunction bearing I.A. No.9721 of 1993.

(2) The facts giving rise to the suit as pleaded in the plaint, are that the plaintiff is a Company, incorporated under the laws of Scotland and having its registered office at The Glenfiddich Distillery, Dufftown, Banff shire Scotland. It is asserted that the plaintiff operates Glenfiddich Distillery, the Balvenie Distillery and Kininvie Distillery, all of which are located in Dufftown, Scotland and the Cirvan Distillery in Girvan in Scotland.

(3) From the pleadings it appears that Mr. Alexander Grant Gordon, who is the Director of the plaintiff Company, has signed, verified the plaint and instituted the suit.

(4) The plaintiff states that Glenfiddich distillery was established by Mr. William Grant in 1887. In the plaint, one of the methods by which the plaintiff makes scotch whisky, has also been set out.

(5) It is asserted that by virtue of The Scotch Whisky Act, 1988, and The Scotch Whisky Order 1990, the scotch whisky is to be, only what is mentioned in the a fore said enactments.

(6) It is asserted in the plaint that the Scotch Whisky are of two kinds, (i) Malt Whisky and (ii) Grain Whisky. The Malt Whisky is made by the Pot Still process and Grain Whisky is made by the Patent Still process. It is asserted that the Malt Whisky is made from malted barley only, while Grain Whisky is made from malted barley together with unmated barley and other cereals. The plaintiff says that it is the producer of pure malt scotch whisky under the trade mark "Glenfiddich".

(7) Paras 13 and 14 of the plaint, as they have bearing on this application need to be reproduced in full. Same read as under:- 13 The plaintiff's Glenfiddich whisky, after it is bottled and labelled, is packed in a black cylindrical container called a tube. The tube is sheathed in black grainy textured paper which forms the base of all the matter appearing on the Glenfiddich label. The shape and design of the said tube is unique and memorable and owes its origin to the plaintiff who is the owner of the copyright therein. Glenfiddichh pure malt whisky is bottled in deep green triangular bottles which, combined with the effect of the tube and the unique. Glenfiddich label, is truly a hallmark of the plaintiff's product. Although the plaintiff does not claim an exclusive right to use the triangular green coloured Glenfiddich bottle, the same is, nonetheless, inseparably associated with the Glenfiddichh pure malt whisky.

(8) The aforesaid pleadings make it clear that the plaintiff's Glenfiddich whisky bottle is labelled. The Glenfiddich whisky bottle can only be labelled by a "label". This pleading also makes it clear that the tube also has all the matter which appears on the Glenfiddich whisky bottle label.

14. The tube of Glenfiddich Single Malt whisky of the plaintiff bears a label with a singularly unique get-up, lay out, colour scheme and arrangement of artistic features. The notable features of the said label are described below: a) An emblem representing two men on either side of a shield like device, bearing three crown devices with the mark Glenfiddich on a scroll atop the said representation and the words "Stand Fast" at the feet of each of the men as aforesaid. This emblem appears in pale gold and black upon the grainy textured black base at the top of the label. This emblem is duly registered in favor of the plaintiff, in the Register of Arms and Bearings in Scotland since May, 1936 and license to use the same was granted to the plaintiff by the Lord Lyon King of

Arms in accordance with the Laws of Arms; b) The device of a stag with antlers in shades of gold and copper appears in the centre towards the upper end of the label. The stag has always been an integral part of the plaintiff's trade dress and has been consistently used by it in relation to its product for decades past; c) The device of thistles in pale gold are seen at the lower end of the said label; d) The words "Single Malt" in gold coloured block letters flank either side of the device of stag as aforesaid; e) The mark Glenfiddich in bold script in white with golden ghost lines appears directly below the device of a stag, followed by the words "Pure Malt" in pale gold with copper coloured ghost lines in relatively smaller lettering in a similar script below the word Glenfiddich and the words "Scotch whisky" in running script with elaborate initials, under these; f) Two identical scrolls coloured deep gold with pale gold borders; outlined by fine black lines, appear on the upper and lower ends of the central label bearing the artistic features described above; g) An oblong device with copper and gold coloured borders, respectively, is represented directly above the upper scroll bearing the words "Special Reserve" in white upon a black background while another oblong device is represented in a similar manner, attached to the lower scroll with the words "Glenfiddich which in Gaelic means Valley of the Deer lies in the heart of the Scottish Highlands"; h) The legend "First distilled on Christmas Day 1887" is carried below the aforesaid label in golden lettering; i) Two ribbon-like devices extend from each end of the scrolls, as described above, and encircle the complete circumference of the Glenfiddich tube. These bear the same colour scheme as the scrolls from which they emanate. The points from which the ribbons emanate from the scrolls are preceded by folds in the scrolls, the visible inner portion whereof is a deep red; j) At the back of the label, more printed matter relating to the product appears between the two gold ribbons running across the width of the tube. A shield-like device bearing three thistles is printed on the centre of the upper ribbon. The same device is repeated on the lid of the Glenfiddich tube; k) Printed matter referring to the source of manufacture of the product appears in black and red lettering upon the scrolls. Apart from this, of course, there are direct references to Scotland on the plaintiff's label.

All of the aforesaid features of the Glenfiddich label, in particular the device of a stag and the thistles Along with heraldic insignia, are typically evocative of Scotland. Thistles, in particular, have been officially recognised to be conclusively indicative of Scottish origin, being the national emblem of Scotland, and their use on products not originating from Scotland has been held to be objectionable. The Glenfiddich label of the plaintiff constitutes an original artistic work within the meaning of Section 2(c) of the Indian Copyright Act, 1957 and is entitled to protection as such under the Indian law by virtue of the membership of both India and the United Kingdom to the Berne Convention and the Universal Copyright Convention (UCC). The Glenfiddich label was first designed in the late 1960s. Over the years, some changes were made in the said label by Mr. David MacKay, in-house together with Mr. David Grant, then Brand Manager and now Director of the plaintiff, to revamp its get-up " for the world market. A design

agency was also commissioned in 1983 by the plaintiff to make certain amendments in the Glenfiddich label and the label in its present form is the result of the said redesigning. Copyright in the artistic work of the Glenfiddich label was duly assigned in favor of the plaintiff by the design agency, Claessens International Ltd. The plaintiff is, thus, the owner of copyright in the said artistic work and is entitled to use or reproduce the same in any material form to the exclusion of all others.

(9) Apart from the claim with respect to the black cylindrical container called tube, the word "GLENFIDDICH" and the "GLENFIDDICH" label, the plaintiff also contends that it is the registered proprietor of the trademark Glenfiddich, Grants and several other marks in India since the year 1946, as also in other parts of the world. The plaintiff asserts that its whisky is considered one of the world leading brand of pure Malt whisky with sales in 180 countries worldwide. It is also asserted that the plaintiff developed a firm association and business with India, which are set out in para 19 of the plaint, and which read as under :- a) The son-in-law of William Grant, the founder of the Glenfiddich Distillery, visited the East during the period 30th October 1909 and 24th January 1910. He visited Port Said, Bombay, Poona, Karachi, Quetta, Lahore, Rawalpindi, Peshawar, Ambala, Agra, Meerut, Delhi, Kanpur, Lucknow, Benares, Calcutta and Rangoon. In the course of time, the plaintiff developed a firm association and business in India. b) The plaintiff signed agreement with several firms in India including: i) D.P. Eduljee & Co., New Commercial Building, Lahore, p73 ii) Pheerozeshah & Co., N?e much & udaipur. iii) Jamsetjee & Co., Cawnpore (now Kanpur); and iv) Bala Prashad & Sons, Lucknow. c) More recently, the plaintiff's whisky bearing the trade mark GLENFID- Dich and the related label has been imported into India by: i) India Tourism Development Corporation (ITDC), 4th Floor, Jeevan Vihar Building, 3, Parliament Street, New Delhi for resale of ITDC's hotels all over India. ii) Ta) Services Co., M/s. Taj Services Ltd., Mandlik House, 3rd Floor, Mandlik Road, Colaba, Bombay 400 039. iii) Hind Traders; iv) Air India; v) Mohan Lall & Co. (Warehouse), Plaza Building (2nd Floor) Connaught Circus, New Delhi 110001 vi) Mohan Brothers, Bajaj Niwas, 712, Linking Road, Khar, Bombay 400052; vii) Cawasji Behramji & Co.; viii) East India Hotels Ltd.; and ix) Embassy Stores, Embassy House, S-28 Electronic Estate, Okhla Phase 2, New Delhi 110020. d) The plaintiff has filed in these proceedings details of the cases of whiskies sold to its Indian customers, according to which details of cases of Glenfiddich sold in India are as follows: Year . Total number of cases of 8.4 litre cases of Glenfiddich 1988. 219 1989 486 1990 821 1991 128 1992 1650 e) More particularly, the plaintiff's Glenfiddich whisky sells in various hotels all over India. By way of example, in the following Bombay hotels; the Sea Rock Sheraton Hotel, Centaur Hotel (Airport), Centaure Hotel (Juhu), Hotel Leela Kempinski, Hotel Ritz, Hotel President, Hotel Taj Mahal, Hotel Holiday Inn etc. f) The plaintiff is also filing documents to show that several cases of its Scotch whisky bearing the trade mark Glenfiddich have been directly sold to Indian customers at least since the year 1946 for redistribution and actual consumption. These customers are hotels,

restaurants, department stores and the details include dates of shipments, customers name and city, the quantity and the price at which the goods were sold; g) The plaintiff has been very active in the Indian sub-continent itself not only in the promotion of sales and advertising but even in organising sports events. For instance, it organized an international Golf Tournament in Sri Lanka in the year 1992 and, closer home, a mountain climbing expedition in India to conquer the Himalayas also in the year 1992; h) The plaintiff's Glenfiddich whisky sales in all the duty-free shops " in India include those at the Indira Gandhi International Airport (New Delhi), Sahar International Airport (Bombay) and Moenambakkam International Airport (Madras). The plaintiff's Glenfiddich malt whisky also sells on Air India flights. To further illustrate the plaintiff's long standing relationship with India, it may be mentioned here that Glenfiddich malt whisky in the carton and the label described earlier, has been sold in India since the year 1978, Approximately 700 cases of Glenfiddich malt whisky are sold per year in India through the various agents named earlier. Thus the plaintiff's association with India is over 83 years old.

(10) That plaintiff asserts that the whisky trade in India is divided Into number os segments, top segments being "Superpremium", in which segment whisky are priced at Rs.400.00 and above.

(11) The plaintiff asserts that the defendant, who is one of the major manufacturers and marketers of whisky in india, announced the launch of a whisky which the p73 defendant claims to be the Single Malt whisky under the name McDowell's Single Malt whisky, which was launched in October or December, 1992. The plaintiff asserts that the McDowell Single Malt whisky introduced by the defendant with the label bearing various features/symbols importing a reference to Scotland and Scotch whisky. It is also packed in a container or tube which is identical to the plaintiff's Glenfiddich tube.

(12) The plaintiff also points out Similarities between the container of the defendant vis a vis the plaintiff's container, and the label of the defendant vis a vis the plaintiff's label in para 23 of the plaint, which reads as under:- (i) The device of a-stag with with antlers in shades of gold and copper; (ii) The device of thistles which, as stated above, is the national symbol of Scotland; f (iii) The device of scrolls appearing above and below the pictorial representations, as stated above, with folds whose inner sides are revealed in red colour; (iv) The words "Single Malt" in bold white lettering are emblazoned across the centre of the said label while the weird McDowell's is depicted on the upper scroll in black lettering; (v) The device of a stag is again repeated in a prominent manner, on the back of the label; (vi) Further, the defendant also reproduces a shield-like device (to simulate a Coat of Arms) on the lid of its container as well as on a ribbon-like device framing the printed matter on the back of the container; and t (vii) A specific reference on its label that the product is distilled true to the centuries old Scotch tradition of Single Malt.

(13) The plaintiff asserts that the defendant's label is a colourable imitation and

substantial reproduction of the plaintiff's Glenfiddich label and that the said action of the defendant is without the plaintiff's permission, consent or license, and in violation of the plaintiff's copyright with respect thereto.

(14) It is also asserted that the use of the black tube by the defendant with the features mentioned in para 24 of the plaint, amounts to a misrepresentation made in the course of trade to prospective customers, which is likely to lead deception and confusion and result in damages to the plaintiff, and hence the defendant's product or business is likely to be passed off as the product or business of the plaintiff.

(15) The plaintiff asserts that the tube and the label adopted by the defendant creates an impression of nexus with the plaintiff's product under the brand name Glenfiddich by visual/external indicia like the packaging and label of McDowell's Single Malt whisky, produced by, the defendant under the description Single Malt. It is also asserted that the Single Malt whisky produced by the defendant is different in taste, colour and smell from the plaintiff's Glenfiddich whisky, and that the difference occurred due to different procedures used by the parties in producing their respective whisky.

(16) According to the plaintiff, the defendant's whisky does not adhere to the standards laid down by law in United Kingdom for the manufacture of Scotch whisky. The defendant's product is a very different product thus Constituting a false trade description when its is referred to as a "Single Malt whisky".

(17) The plaintiff also asserts that in view of the liberalisation of the economic policy of the Government of India, a number of persons who are in the whisky trade, are intending to set up whisky/alcohol trade in India in collaboration with the persons elsewhere in the world, who are in the similar trade.

(18) It is asserted in the plaint that a number of persons who drink whisky in India, are aware of the trade practice in India that Indian whisky is blended with Scotch whisky, and, Therefore, adjusted to the possibility of nexus with the whisky produced in India and Scotch whisky. The plaintiff, Therefore, seeks injunctions mentioned in para 35 of the plaint.

(19) Substantially the same pleas are taken in 1.A.9721 of 1993, as have been taken in the plaint. The reliefs sought in I.A.9721 of 1993 read as under- it is, Therefore, respectfully prayed that during the pendency of the present proceedings, this Hon''ble Court may be pleased to grant an order of temporary injunction restraining the defendant, its officers, servants and agents, from manufacturing, selling, offering for sale, advertising and directly or indirectly dealing in alcoholic beverages under the brand name McDowell's Single Malt whisky in packaging, including bottles, labels and containers, as are a colourable imitation and substantial reproduction of the plaintiff's Glenfiddich label and packaging amounting to an infringement of the plaintiff's copyright therein; and from representing its product by a false trade description and appellations of origin as having any nexus or association with manufacturers of Scotch whisky,

and the plaintiff's Glenfiddich whisky in particular, amounting to acts of unfair competition; and from making misrepresentations to the public and the trade by the use . of false trade description and appellations of origin and from doing any other thing as is likely to lead to passing off ofr the product of the defendant as and for that of the plaintiff's Glenfiddich whisky.

(20) In response to the averments made in the plaint, the defendant pleads that the whisky is made in different parts of the world, and that there are several distinct processes of making whisky, and the whisky made in Scotland is called Scotch whisky. The defendant also asserts that there is a wide range of single malt whiskies. The defendant denies the assertions of the plaintiff regarding improper or other use of any other trade description in connection with the whisky. The defendants denies that the packaging of the defendant amounts to any improper use or trade description or that the packaging has any nexus to scotch whisky. The defendant also denies that the plaintiff is the owner of copyright in black cylindrical container in which the plaintiff sells its whisky. The defendant denies that the Glenfiddich single malt whisky of the plaintiff bears a label with a singularly unique get-up, lay out, colour scheme or arrangement of any of artistic features. The defendant also denies that the Glenfiddichh label of the plaintiff constitutes any original artistic work, or that the plaintiff is entitled to protection, as alleged. The defendant says that many of the features claimed to be distinct by the plaintiff, are really common to the trade. This includes the black tube, the device of a crown, the device of a stag with antlers, the device of thistles or the word single malt or the colour scheme or the device of scroll in coloured border or ribbon like device or the shield like device. The defendant states that the goods of the plaintiff are also sold in square containers. It is denied by the defendant that Glenfiddich is a well known scotch whisky in India. The defendant asserts that the plaintiff does not even claim any across the counter sales in India. It asserts that the plaintiff's product is very expensive, and the plaintiff's products are not purchased by the people for casual consumption who buy their requirements across the counter. The defendant says that the cost of the plaintiff's whisky is about four times of the cost of the defendant's whisky.

(21) The defendant asserts that its "Single Malt" whisky is being sold since October, 1991. The defendant denies that its cylindrical container is identical with the p73 plaintiff's container, and denies that the defendant's label bears any features which are similar to the alleged essential or distinctive feature of the plaintiff's Glenfiddich label. The defendant asserts that the device of thistle is common to the trade. The defendant says that the device of scrolls are also found in various different brands of whisky, (no Indian whisky is specified, and no foreign whisky is specified). It is asserted that the device of scroll is common to the trade. It is also asserted that the shield like device is common to the trade. The defendant asserts that the single malt whisky produced by the defendant is produced according to the scotch tradition. The allegations of the label of the defendant being colourable imitation of the plaintiff's Glenfiddich label are

denied.

(22) The defendant also denies that the defendant's whisky is packed in a deceptively similar trade dress to that of the plaintiff's Glenfiddich, as alleged. It is asserted that there is no likelihood of causing any confusion or deception amongst the consuming public. The defendant states that it has no desire or intention to deceive or confuse the purchasing public, and that there is absolutely no need for the defendant to do so, as the defendant is a well known manufacture of alcohol products in India. The defendant asserts that the plaintiff's product is not available at retail outlets in India, whereas the defendant's product is available, p73 and the defendant's product can never be confused as that of the product of the plaintiff, and both products are being obtained by their respective reputation and the names, and not only on the alleged visual impression of the packaging. The defendant denies that there is likelihood of confusion or deception, as alleged by the plaintiff, or that the use of the name ""McDowvll"s" will aggravate likelihood of such confusion or deception. The defendant denies that it deliberately or otherwise adopted all or any of the symbols or trademark of the plaintiff, as alleged, or at all. The defendant denies that its activities amount to unfair competition, as alleged. The defendant thus seeks dismissal of the suit as being without cause of action,

(23) The case of the plaintiff as set out in the plaint, has been reiterated by the counsel for the plaintiff. Counsel for the plaintiff asserts that the plaintiff is marketing its whisky in bottles that bear the Glenfiddich label after is packed in a black tube, which tube has the label upon it. The label affixed upon the black tube comprises of a number of distinctive features, namely, i) An emblem representing two men on either side of a shield like device, bearing three crown devices with the mark Glenfiddich on a scroll atop the said representation and the words "Stand Fast" at the feet of each of the men as aforesaid .This emblem appears in pale gold and black upon the grainy textured p73blackbasc at the top of the label. This emblem is duly registered in favor of the plaintiff, in the Register of Arms and Bearings in" scotland since May 1936 and license to use the same was granted to the plaintiff by the Lord Lvon King of Arms in accordance with the Laws of Arms; ii) The device of a stag with antlers in shades of gold and copper appears in the centre towards the upper end of the label. The stag has always been an integral part of the plaintiff's trade dress and has been consistently used by it in relation to its product for decades past; iii) The device of thistles in pale gold are seen at the lower end of the said label; iv) The words "Single Malt" in gold coloured block letters flank either side of the device of stag as aforesaid; v) The mark Glenfiddich in bold script in white with golden ghost lines appears directly below the device (if a stag, followed by the words "Pure Malt" in pale gold with copper coloured ghost lines in relatively smaller lettering in a similar script below the word Glenfiddich and the words "Scotch whisky" in running script with elaborate initials, under these; vi) Two identical scrolls coloured deep gold with pale gold borders, outlined by fine blacklines, appear on the upper and lower ends of the central label bearing the artistic features

described above; vii) An oblong device with copper and gold coloured borders, respectively, is represented directly above the upper scroll bearing the words "Special Reserve" in white upon a black background while another oblong device is represented in a similar manner, attached to the lower scroll with the words "Glenfiddich which in Gaelic means "Valley of the Deer" lies in the heart of the Scottish Highlands"; viii) The legend "First distilled on Christmas Day 1887" is carried below the aforesaid label in golden lettering; ix) Two ribbon-like devices extend from each end of the scrolls, as described above, and encircle the complete circumference of the Glenfiddich tube. These bear the same colour scheme as the scrolls from which they emanate. The points from which the ribbons emanate from the scrolls are preceded by folds in the scrolls, the visible inner portion whereof is a deep red; x) At the back of the label, more printed matter relating to the product appears between the two gold ribbons running across the width of the tube. A shield-like device bearing three thistles is printed on the centre of the upper ribbon. The same device is repeated on the lid of the Glenfiddich tube; xi) Printed matter referring to the source of manufacture of the product appears in black and red lettering upon the scrolls. Apart from this, of course, there are direct references to Scotland on the plaintiff's label.

(24) The counsel for the plaintiff asserts that the emblem with the words stand fast is to be found on the bottle cap of Glenfiddich bottle, as also on the neckband of the Glenfiddich whisky bottle. All the other items (ii) to (vii) are to be found in the label affixed on the bottle, and there is a smaller label at the back of the bottle.

(25) As stated above the plaintiff asserts in para 13 that the plaintiff's Glenfiddich whisky after it is bottled and labelled, is packed in a black cylindrical container, called the tube. It is asserted by the plaintiff that the bottle bears the label and the black cylindrical container called the tube, is sheathed in a black grainy textured paper "which forms the base of all matter appearing on the Glenfiddich label.

(26) The said assertion of the plaintiff, Therefore, indicates that the bottle of the plaintiff in which whisky is filled, the label and that the bottle is placed in a tube container which is sheathed in a black grainy textured paper, on which all the matter appearing on the Glenfiddich label also appears.

(27) The plaintiff claims to be the owner of the copyright of the work appearing on the Glenfiddich bottle label.

(28) The plaintiff also claims to be the owner of the Copyright in the "work" on the tube. The plaintiff also asserts that the Glenfiddich Pure Malt whisky

"Is bottled in deep green triangular bottles which, combined with the effect of the tube and the unique Glenfiddich label, is truly a hallmark of the plaintiff's product".

(29) The plaintiff does not claim the exclusive right to use the triangular green

colour bottle, but asserts that the same is nonetheless, inseparably associated with the Glenfiddich pure malt whisky.

(30) During the course of arguments, it has become apparent that there is a difference between the plaintiff's counsel and the defendant's counsel, on what is the label, and in what copyright is being claimed.

(31) The plaintiff asserts that the copyright is claimed in the label affixed upon the green triangular bottle filled with Glenfiddich whisky. The plaintiff asserts that the features of the bottle label are essentially reproduced on the container, which is a tube in which the Glenfiddich whisky bottle is packed. That the tube is sheathed in black grainy textured paper.

(32) Whereas the defendant's counsel asserts that the copyright in the plaint is claimed by the plaintiff in the "label" on the tube in which the green triangular bottle bearing the Glenfiddich label, is packed.

(33) Mr. Sen appearing for the plaintiff, proceeds on the assumption that what the copyrightable matter in the instant case, is the label which is affixed on the bottle, which contains a number of distinctive features, which have been spelt out in the plaint.

(34) One of the questions, Therefore, in issue in this case is what is label.

(35) When I put the question to Mr. Nariman during the course of arguments, his response was to bring to my notice the definition of label given in Black's Law Dictionary, which is reproduced as follows:- Anything appended to a larger writing, as a codicil; a narrow slip of paper or parchment affixed to a deed or writ, in order to hold the appending seal; An affixation to or markings on a manufactured article, giving information as to its nature or quality, or the contents of a package or container, name of the maker etc.

(36) And when the same question was put to Mr. Sen, his response was somewhat different, and according to him, a label is a device which is used by a manufacturer to distinguish his product from the product of others, a label in addition also contains information regarding the nature and quality of the product, the name of the maker etc.

(37) In my view, a label is a device which is affixed by a manufacturer on a product/article and contains material placed upon it by the manufacturer of the goods so as to distinguish his own goods from the goods of the other manufactures ,and contains information regarding the nature and quality of the product, or goods to which the label is appended or affixed.

(38) Mr. Nariman has referred to Xvi Rpc 3 Lever Brothers, Ltd. v. Bedingfield in support of his contention that it cannot be said that the defendant has infringed the label of the plaintiff, despite there being some similarity between the label of the plaintiff and the label of the defendant.

(39) It has to be kept in mind that above case relating to "Sunlight Soap",

decided by the Court of Appeals, was dealing with wrappers, in which cakes/tablets of soap were wrapped. The Court of Appeals apparently made no distinction between a "wrapper" and a "label". To me there is a distinction between a "label" and a "wrapper". What is a label, has been stated by me hereinabove. A label is affixed or appended to the article itself, and stays with the article during the useful life of the article. For example, a label is affixed permanently on a bottle, and as in the instant case, shows a connection in the course of trade with what is contained within the bottle, and the manufacturer of potable liquid in the liquid. This is not to say that label on a bottle containing non-potable liquid is not a label. To my mind, the label on a bottle of insecticides or any other poisonous substance is equally a label. So long as the bottle does not break, or the label is not deliberately removed, the label stays affixed or appended to the bottle.

(40) Similarly, if a label is attached to an article of clothing by being sewn into it, or by any other means that label will continue to be attached to the article of cloth during its useful life. There may be many more examples of a label being affixed or appended to on the article, and I need not give any more.

(41) The wrapper on the other hand, is something in which the article which is being bought and sold, is wrapped, and as soon as the article which has been purchased along with the wrapper in which it is wrapped, is to be used, without removal of the wrapper it is not possible to use the article itself. The instance in the case of soap is very clear. No cake/tablet of soap can be put to use without removing its wrapper. It is, Therefore, not possible for me to equate a wrapper with label, as has been done by the Court of Appeals in Xvi Rpc 3.

(42) Mr. Nariman has probably referred to the aforesaid case for establishing the proposition that despite the two similarities, i.e. a scroll slantingly kept across the wrapper and a space containing written matter on the right hand side of the slanting scroll being common to both in which written matter existed, the Court of Appeals came to the conclusion that despite the similarities there was no infringement.

(43) WHAT" is, however, relevant, is the observations in Xvi Rpc 3, at page 10 line 31, wherein it is said that the "defendant's label as a whole is not a copyright of the plaintiff's label, and is not as a whole a colourable imitation of them, it cannot truly be said that the defendant has infringed the right conferred on the plaintiff by the registration of its mark".

(44) The observations made in this judgment, are clearly based upon the facts of that case and "the law in England. In the facts of the case, the wrappers were found to be quite different as a whole.

(45) It has to be kept in mind that the provisions of the Trade & Merchandise Marks Act, particularly section 2(j), do not include "wrapper" as a mark, whereas a "label" is included as mark. I have already indicated that the two are quite distinct, and the reasons why I think they are quite distinct.

(46) The aforesaid observations regarding wrapper being a mark, indicate that there may be difference in the English statute and the Indian statute regarding the trademarks. Whereas the English statute may have included "wrapper" as part of trade marks, Indian Statute has excluded the "wrapper". For this reason, this authority may not be applicable to the cases which arise in india.

(47) In my view when a manufacturer skillfully blends the factual information, with some features on the label which are intended to distinguish his own product from the products of other manufacturers, and, the blending of the factual information and their distinguishing features is achieved in a manner which combines the aforesaid particulars and features as unified whole, or a representation, then such a representation is a label, which, depending upon the manner in which the various features are harmonized with other of them, may give rise to a claim of the label being "artistically" made and actually being so, and, thus, by itself being copyright-able matter.

(48) It is also contended by Mr. Sen that what is found on the container tube is a substantial reproduction of the plaintiff's label on the bottle, and the variations which are to be found between what is to be found on the label on the bottle of the plaintiff, and what is to be found on the container, are insignificant variations subject to Deminimis rule and the variations between the two would not, in any way, affect the rights of the plaintiff in the label, as affixed on the bottle, and what is to be found on the container tube in which the bottle of the plaintiff is packed, as both belong to the plaintiff.

(49) It is the further case of Mr. Sen that in the pleadings of the defendant there-are no pleadings by the defendant about the differences to be found between the two labels, and, Therefore, oral submissions of Counsel for the defendant with regard thereto should not result this Court in not granting the reliefs sought by the plaintiff.

(50) He also states that any person who has bought the product to the plaintiff that is to say Glenfiddich Single Malt Whisky along with the container, is not likely to be confused by the difference in the "words "Special Reserve" (in the container, and the words "Special Old Reserve" found on the label of tin" bottle. In any event, he states that the words "Special Reserve" are used by the plaintiff only so as to assist a consumer of various products of the plaintiff, i.e. whisky ,of varying years of maturity, whether eight years, or eighteen years, to make his choice and buy what he intends to buy, i.e. whisky of a particular maturity. According to the plaintiff "Special Reserve" or "Special Old Reserve" is a description of 8 years old whisky.

(51) As stated earlier there is another controversy between the parties relating to the claim which has been made by the plaintiff in the suit. According to the counsel for the plaintiff, the plaintiff claims to be the owner of the copyright in the label which is affixed to the bottle. The defendant through Mr. F.S. Nariman, contends that there is no claim to copyright in the label affixed on the bottle. In

order to resolve this controversy, one has to look into paragraphs No.13 and 14 of the plaint, which have been reproduced hereinabove.

(52) Whereas Mr. Nariman emphasises what is stated in para No.13 of the plaint, Mr. Sen on the other hand, relies upon what is stated towards the end of para No.14 of the plaint. According to Mr. Nariman, the words in para No.13 of the plaint, "The plaintiff's Glenfiddich whisky, after it is bottled and labelled, is packed in a black cylindrical container called a tube. The tube is sheathed in black grainy textured paper which forms the base of all the matter appearing on the Glenfiddich label....." indicate that the plaintiff's claim in the copyright is relative to what appears on the container tube. Mr. Sen on the other hand, relies upon the words at the end of para No. 14 of the plaint to the effect, "The GLENFID- Dich label of the plaintiff constitutes an original artistic work within the meaning of Section 2(c) of the Indian Copyright Act, 1957 and is entitled to protection as such under the Indian law....."

(53) In my view, what Mr. Sen says is very clear from pleadings in para No.14 of the plaint. In the early part of para No.14, the distinctive features of the label, which according to the plaintiff, is an artistic work within the meaning of section 2(c) of the Copyright Act, are described before a claim to the copyright in the label on the bottle of Glenfiddich whisky is made in the plaint.

(54) I accept the contention of Mr. Sen that the label is what is affixed on the bottle, and that a substantial reproduction of this is made on the tube container in which the Glenfiddich whisky is packed for sale. What is represented on the tube container, and what is to be seen on the label on the bottle, when compared by putting it side by side, appears to me to be the same except that the scroll on the bottle label is differently designed, keeping in view the shape of the bottle label. The scroll on the tube container is different because of the shape of the tube container. There is some variance between the words on the bottle and the container tube. The differences between the two do not, in my view, in any way whittle down the claim to copyright in the label which is affixed on the bottle. I have to keep in mind the fact that both the bottle label, and what appears on the container tube was got prepared by the plaintiff company, and, Therefore, nothing much would turn upon the differences between the two. The pleadings of the plaintiff mentioned hereinabove in para No.14 of the plaint, are very specific. Copyright is claimed with respect to the label on the bottle. It is not possible for me to accept the contention that what appears on the container tube which is a cylindrical box in which the whisky of the plaintiff is sold, can be termed as a label. The cylindrical box or the tube packaging of the plaintiff's whisky bottle has surface ornament of what is to be found on the bottle label, but it cannot itself be called a label.

(55) It appears to me that the reason why Mr. Nariman has called what appears on the packaging tube container, a label, is because of the words which are used in para No.13 of the plaint. These words are, "The plaintiff's Glenfiddich whisky, after it is bottled and labelled, is packed in a black cylindrical container called a

tube".

(56) On a closer examination of the cylindrical container, it is clear that the cylindrical tube comprises of a white tube which has got two circular metallic disc ends. One circular metallic disc at the bottom of this tube is fixed, and not removable. The top portion of the tube has a metallic disc which is removable, and upon removal of this the bottle inside the tube can be removed from its packing. The words "a black cylindrical container....." appear to be capable of confusion. The words which follow in para No.13, however, clarify. The words which are clarificatory are "the tube is sheathed in black grainy textured paper...." These words indicate that the tube is not black which is correctly stating the reality that the tube is a white cylindrical tube sheathed by a black grainy textured paper. The words "black grainy textured paper which forms the base of all the matter appearing on the Glenfiddich label" indicate to me, that the matter which is to be found on the Glenfiddich bottle label is also to be found on the black grainy textured paper which is used to sheath the white cylindrical tube in which the Glenfiddich bottle is packed.

(57) In myviewparasNo.13and14 read in this way, make it clear that the claim of the plaintiff in the suit is that it has copyright in the label affixed on to the bottle which the plaintiff says, is an artistic work. The artistic work which is entitled to protection by virtue of the provisions of section 2(c) of the Indian Copyright Act, inasmuch as India is a member of the Berne Convention, as also the United Kingdom, and both India and United Kingdom being signatories to the universal copyright convention.

(58) The plaintiff thereafter goes on in para No.14, to State how the label on the bottle came to look like it does now,. to be what it is today. The plaintiff represents that the label in the present form was not what it was in the past, that the labels of yore were altered by in house designer of the plaintiff, as well as professionals called Claessens International Ltd., (who assigned the copyright in the label in favor of the plaintiff for one pound in (runs of one of the documents which arc on record).

(59) Mr. Nariman has also raised an issue before me that the assignment by Claessens International Ltd. is not in accordance with the provisions of the Copyright Act,1957, but in my view, the objections of Mr. Nariman regarding the validity of the assignment are of no significance, inasmuch Claessens International Ltd. are not asserting that they retain copyright in "GLENFIDDICH" label affixed on the bottle of the plaintiff.

(60) In my view for the purposes of the present controversy between the plaintiff and the defendant, it would not be right for me to conclude at this interlocutory stage that there is a cloud on the title to the Glenfiddich bottle label of the plaintiff, in view of the fact that Claessens International Ltd. may have contributed to the development of the label which is presently affixed on the Glenfiddich whisky bottle, containing 8 year old whisky, which is called "Special

Old Reserve" by the plaintiff.

(61) Besides this, Mr. Sen rightly contends that the arguments raised by Mr. Nariman relative to section 92 of the Copyright Act pertaining to assignment are not sound. Mr. Sen contends that looking at the terms of the assignment, as contained in the Deed of Assignment, it is apparent that the assignment by Claessens International Ltd. is total and complete. It has to be kept in view that Cleanssens were the designing agency, and they were only appointed for the purposes of making improvements in the designs of Glenfiddich label, the label in suit, as well as other labels of the plaintiff company, with which we are not concerned in the suit. Looking at the terms of the documents of assignment, bears out his contentions. The assignment relates to the products. The products are defined in the Deed-of Assignment as "merchandise products". One of the merchandise products mentioned is the label of Glenfiddich Special Reserve LABEL. "Work" is also defined in the Deed of Assignment, audit is stated to be accepted designs of labels and shipping cases. "Assignment" is also defined, and according to the Deed of Assignment, the same relates to the work done by Claessens International Ltd., and the work to be done by Claessens International Ltd.

(62) As contended by the plaintiff in the plaint, and as argued by Mr. Sen, the label in suit is not a new one. It has only additions thereto. In view of the definition of the words "work", "product" and "assignment", it is clear that what Claessens International Ltd. have done by assignment is that the additional work done by Cleassens International Ltd. in the accepted label in suit has been assigned. I agree what is stated by Mr. Sen.

(63) It is now necessary to state what the Glenfiddich label that is affixed on the bottle, is. The label of the plaintiff does not have geometrical outline. It is higher than it is wide. It does not have any straight lines. It has curves and projections along with its outer edges/outline. These curves and projections are part of the shape of the label itself. The shape of the label is such that it is slightly wider in the middle, with curves and projections, it thus has a faint suggestion of a barrel-like shape.

(64) This label appears to be black, but it is not really so. It is predominantly in black colour, but it also has a deep green colour along its border, which merges well with the black. On top of the label there is an oval shaped device which has got a twin colour border, one is yellow-golden and the other one is slightly rust-golden colour. These two borders run very close to each other, close enough to merge along their edges. The space in between is used for writing, the description of the whisky that is "Special Old Reserve". Below that is what the plaintiff called, a golden scroll, reverse of which is rust-red colour. The scroll/ribbon has got distinctive borders. Both the edges are slightly lighter golden colour than the main part of the scroll. The scroll is wavy in form, which is in accord with the outer shape of the label. The scroll/ribbon is in wave form which waves in identical form along the two ends on the two sides, this is the form of the "scroll"

on the top part of the label. The curvatures of the ends of the scroll/ribbon apparently dictate the projections in the out line of the label. The scroll/ribbon itself has got space within which there is a design of what appears to be an outline of crescents and crosses in a slightly raised form in the top part of the scroll. In the lower part of the scroll there are raised dots appearing-along its outer side. In between the raised areas of the scroll/ribbon is written the words "DISTILLED And Bottled At (in black colour) The glenfiddich Distillery (in red colour)". The trailing sides of the scroll have got in a raised form slightly larger sized crescent and crosses, and has in addition, in a raised form, representation of thistles. The thistle, according to the plaintiff, is a national symbol of Scotland.

(65) Reference to the dictionary shows that b.otanically "thistle" is "carduus", (which has been used by Homoeopaths to make medicines, which is asserted by the Homoeopaths to be a heart tonic). Perhaps the representation of the thistles on the label, which is repeated a number of times upon it, is a subtle suggestion that the whisky is "good for the heart". Below the top scroll/ribbon is a representation of what the plaintiff calls "a stag" with its antlers projecting into the scroll/ ribbon, its eara perked up, and the neck and the head slightly turned. The representation of the stag is in brown and golden colour, and shows only its back, and slightly nu"rv. (The legs are not visible). By the side of the neek of the stag. are written the words "SINGLE MA1.7". Under the -tag "GLENFIDDICH" is written prominently in white, shadow form, with gold outlines. Below, the words "Pure Malt" are written in raised gold letters with shad on (it rust gold. further below is written in running stvlised from "S Cotch WHISKEY" Around the Words "SCOTCH WHISKY", i.e. by each side of it, is a representation of thistle, and below it is representations of crossed thistles with its leaves, in a raised form, which appears to be a very light silver gold colour, and under the thistles are the words written along raising curvature "product of Scotland". Further below that are two crossed thistles. Further below this, is another ribbon/scroll which is broader than one on the top of the label, containing the words "Distilled &bottled in Scotland by William Grant &. Sons Ltd. The Glenfiddich Distillery Banff shire, Scotland" in Black, and below that the word "Established in 1887" in Red. Below these words is another black space provided for writing the words "THIS Pure Malt Whisky Is Produced By The 5TH Generation Of An Independent Family COMPANY". This black space is surrounded by outline in rust gold and another outline in yellow-gold colour. Both the outer lines are side by side each other.

(66) Glenfiddich label described above, is reproduced below:- Front Label

(67) What I have described above, are the features of the label to be found on the front of bottle of the plaintiff. What's found on the tube container of the plaintiff, is mentioned in para 14 of the plaint, which has been reproduced hereinbefore.

(68) The plaintiff also asserts that it is also owner of the registered trade mark: Glenfiddichh, word per sc in India.

(69) The word Glenfiddich appears prominently not only on the label of the bottle, but also on the paper in which the tube container of the bottle is sheathed. The essential art work on the bottle label is to be found on the art work on the black paper in which the container tube is sheathed. There are some differences in the words used on the container tube, but those differences are of no significance, and do not affect the nature of the label on the bottle. Apparently, as much space was available on the black paper which sheathes the container tube, additional matter appears, and the design of the ribbon/scroll is varied, so as to go around the container tube (instead of the scroll/ribbon curling within the outline of the bottle label).

(70) In my view, great many skills have gone into the making of the bottle label, namely, the skill of painter-artist who has painted the representation of the stag, and the representation of the thistles, and created the form in which the two different sized ribbons/scrolls curl within the outlines of the label and in the creation of spaces in which written material came to be written upon.

(71) In addition, there has been use of the skill of the "calligrapher" in the way in which the written material has been written upon the label, inducting the words "GLENFIDDICH" prominently written, as stated by the plaintiff in white- shadow ghosted from outlined by golden colour lines.

(72) In addition to this, apparently there has been utilised some skill of "engraver" who has created the die for giving raised impression upon the paper of the label: of large number of articles including the thistles, the crescent, the crosses, the dots, the stag and the words Glenfiddich, all in a raised fashion. The overall effect of the composite whole of the label of the bottle is pleasing to my eye, and at least I am of the opinion the same is an artistic work within the meaning of the Copyright Act. As what appears upon the black paper, in which the container tube is sheathed, is also substantially the same, as what appears on the bottle label, in my view, the same is also artistic work, both are entitled to be considered to be artistic work within the meaning of the Copyright Act.

(73) Being artistic work in which copyright is with the plaintiff, whatever original work was done by Claessens International Ltd. with respect to the bottle label, and what appears on the black paper which sheaths the container tube, having been assigned by Claessens International Ltd., the plaintiff is the owner of the copy right in the bottle label, and what appears on the black grainy textured paper in which the container tube is sheathed, and is entitled to protect its copyright in the said artistic work.

(74) Now we have to deal with the label on the bottle of the defendant.

(75) The label which is affixed by the defendant on its bottle, is in black colour. It is also higher than it is wide. It has got two scrolls near the top part of the label. The scroll on the top has a shield like device with the words "McD" written upon it. The scroll with the shield is a conscious variation of the space in which the words "Special Old Reserve" are written. The label of the defendant also does not

have straight lines. It has curves and projections along its outer edges, which are part of the shape of the label itself. In the second scroll from the top, the words "McDowells" are written. Both the scrolls have black borders and the ribbons appear to be .same red shade as in the scrolls of the plaintiff's label. Below the second scroll are the words "Oak Matured" by the side of which appears to be "barley ears". Below that written in shadow form are the words "Single Malt" in white colour, below which are written the words "Whisky". Underneath the word "whisky" is to be found the image of a stag like animal by the side of which are representation of thistles, below which are "barley ears". There is yet another scroll at the bottom part of the label which also has on its underside the same rust red to be found in the label of the plaintiff. On the lower scrolls are written the words, indicating that the whisky is made by the defendant. The stag like animal which the defendant asserts is a "Sambhar" has got antlers with perked-up ears, and is made up of colours of golden, rust brown and black, which are almost identical as the antlered stag as adopted by the plaintiff on its label. The placing of the "Sambhar" in the lower half of the label appears to be a deliberate variation from the placement of the "Stag" by the plaintiff in the upper half of the plaintiff's label. The curves along the side of the scrolls are also identical on both sides, just as curves and the scrolls are identical with each other in the case of the plaintiff's label.

(76) Whereas the scrolls of the plaintiff curve towards the top of the label, the defendant has deliberately reversed the curves, downwards. Just as the word GLENFIDDICH is written in white script sc are the word "SINGLE MALT" written in white script on the defendant's label, whereas the plaintiff writes Glenfiddich in straight line, the defendant has deliberately written the words Single Malt curving upwards in the middle. The defendant's label does not have any raised portions within the scroll, like the plaintiff's label. The label of the defendant is affixed below:- Front Label Back Label

(77) Mr. Sen contends that those who have seen the label of the plaintiff, and the label of the defendant, would find remarkable similarities between the label of the plaintiff and the label of the defendant, which would not have been possissbie unless the defendant had the plaintiff's label either before its eyes or in its memory, and had made colourable variations from the plaintiff's label to avoid charge of slavish copying.

(78) I agree that there is striking similarity in the two labels, inasmuch as both the labels prominently have golden ribbons/scrolls. The defendant having added an additional scroll in place of the space which has been kept by the plaintiff for writing the word "Special Old Reserve". The most prominent words on the label of the defendant, i.e. "Single Malt", have been written in white, which is the name of the whisky, given by the defendant. The plaintiff gives the name to its whisky as Glenfiddich, and that is also written in white .The stag forms the prominent feature of the plaintiff's label, and whereas thistles recurred a number of times in the plaintiff's label, they occurred twice in the defendant's label. He

particularly emphasises that thistle is peculiarly associated with Scotland. In any case, Mr. Sen says that thistle plant is not known to exist in India, and the fact that thistle is used in the label is also an indication to show the effort on the part of the defendant to imitate the features of the plaintiff's label. The defendant has taken the essential feature of the plaintiff's label.

(79) The contention of Mr. Nariman that the label of the plaintiff is a work of "craftsmanship, does not appeal to me at all, inasmuch as I do not see any skill of craftsman involved in the preparation of the label. In my view, the only part which a craftsman may have played in making up the label, is a die maker who has made engraving dies in such a way that some portions of the label have got raised formations, which I have already mentioned herein above. In my view, merely because there are raised formations on the label of the plaintiff, does not make it a work of "artistic craftsman" inasmuch as what one has to see is the visual effect of the label, or appeal to the eye. The appeal to the eye of the plaintiff's bottle label, despite wide variety of matter used in the label, is pleasing to the eye, and is artistic.

(80) The argument that section 2(c) of the Copyright Act applies to the label, that the label must be of "artistic craftsmanship", to my mind, has no merit.

(81) In any case, Mr. Sen has adequately met the "artistic craftsmanship" argument by referring to material, which has dealt with the matter of craftsmanship. According to Mr. Sen, craftsmanship relates to applied arts. Applied arts may relate to needle crafts, cloth stitching, tailoring, furniture or jewellery making, and soon. In the instant case, we are concerned with the printed label affixed on a Single Malt Whisky bottle. It has nothing to do with applied arts, which have been subject matter of the judicial pronouncement in cases 1975 Fsr 455, 1936 Ch. 400 and 1975 Rpc 31. The last of the cases dealing with furniture.

(82) Mr. Sen. also refers to a book written by James Lahore, who also expressed the same view regarding artistic craftsmanship. I am in agreement with what has been contended by Mr. Sen.

(83) In my view, the label of the plaintiff, as I have stated above, is an artistic work. It has got a lot of features, built into it, and despite many features in the label, it still is pleasing to the eye. In my view the defendant's label has striking similarity with the label of the plaintiff, and it appears to me that unless the defendant and its agents who designed the defendant's label, had the label of Glenfiddich bottle label before their eyes, or in their memory, it would not have been possible to prepare the defendant's label of "Single Malt" Whisky in the way it has been done.

(84) The predominant colours used in the plaintiff's label are golden, rust red, white and black.

(85) It is well known that colour photographs use three basic colours, i.e. cyan (a

shade of blue), magenta and yellow. It is equally well known that white light when made to pass through a prism, breaks up into seven colours. These colours have their first alphabets Vibgyor, i.e. violet, indigo, blue, green yellow orange and red.

(86) The seven colours have an extremely large variety of shades and tints. There is no Explanation given by the defendant as to why the defendant adopted the colours, adopted by the plaintiff, namely, black, golden, rust red and white.

(87) There is another matter which needs to be mentioned. Both the parties have referred to me a book, called "Malt Whisky Companion" by Michael Jackson. In this book, a very large number (over 200), if not all, the Malt Whisky labels, and the quality of the respective Single Malt Whiskies are set out. I find it extremely strange that there being over 200 different Single Malt Whiskies mentioned in Michael Jackson's book, the defendant has chosen to give the name of its whisky "Single Malt". In view of Michael Jackson's book, it cannot be doubted that Single Malt Whisky is a kind of whisky. It is not right that any manufacturer in India should try to appropriate a general description and give its whisky the name "Single Malt" when hundreds of Single Malt Whiskies exist, or are distilled, bottled and sold in Scotland.

(88) Besides this, the defendant, in an attempt to show that golden scrolls are common to the trade, has given some coloured representations of some of the labels, which appear to have used scrolls. Of the entire collection, which has been given to me, only one whisky called Glen Moray uses golden scrolls, however the scrolls used by Glen Moray are used differently. Whereas the scrolls used by the plaintiff have curvatures, in wave like form, both at top and bottom of their label, in Glen Moray label, there is one scroll on which Glen Moray is written in a wave form, whereas the scroll giving description of the whisky as Single Highland is given on a golden scroll which is practically in a straight line. In any case, the label of Glen Moray is completely different in effect from the label of GLENFIDDICH. In this state of material placed before me it cannot be that use of golden scrolls on Single Malt Whisky labels, can be said to be common amongst the manufacturers of Single Malt WHISKY.

(89) Despite looking at the labels which are to be found in Michael Jackson's book "Malt Whisky Companions", reprinted in 1992, I have not been able to locate any singlelabel for Single Malt Whisky, which has got the same feature of shape, colour, compose corporation and articles which combine to make up the whole of the label, namely, scrolls/ribbons, stag, thistles, in any other label of Malt Whisky. Yet the defendant has taken all the aforesaid features of the label of the plaintiff, namely, the features of shape (the label is not in straight line, but has got various curves and projections), colour and articles like the "Sambhar" with antlers, scrolls on top and bottom of the label, thistles, the coloring of the stag comprising of golden, brown and black. All this that the defendant has taken, makes one think that the defendant has not done this accidentally, or unknowingly. The same is deliberate. What is deliberate copying, cannot, but be

dishonest with intention of bringing forth similarities between the plaintiff's Glenfiddich Single Malt Whisky and the Single Malt Whisky of the defendant. In my view, Mr. Sen is right when he refers to and relies upon what is stated by Justice Kekewich in 22 Rpc 273, "Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity". The defendant appears to have been conscious of the repute of Glenfiddich as the largest selling Single Malt Whisky in the world, (as asserted by Michael Jackson in "Malt Whisky Companions), so adopted label of the largest selling Single Malt Whisky.

(90) Keeping the aforesaid test in view, with which I am in respectful agreement, I find that the defendant has taken all the essential elements of the plaintiff's Glenfiddich whisky bottle label.

(91) In my view, the defendant has taken the essential features of the plaintiff's Glenfiddich whisky bottle label, and such taking is calculated to injure the reputation of the plaintiff's Glenfiddich Single Malt Whisky, and in fact, such a taking would injure in the reasonably foreseeable future, the good will of the plaintiff in its whisky. The observations contained in 1993 (2) F.S.R. 641 to the aforesaid effect are apt, and applicable to this case, and I am in respectful agreement with the same.

(92) Also apt are the observations contained in the aforesaid judgment at page 673 to the effect that the exclusive reputation (which the plaintiff's Glenfiddich whisky and the associated bottle label enjoys) would be impaired if a similar label is used in connection with a product which is not the same, as the product of the plaintiff's whisky, the impairment being gradual debasement, dilution or erosion of what is distinctive.

(93) Mr. F.S. Nariman for the defendant has repeatedly emphasised that the defendant's product is Single Malt Whisky made by the defendant at Ponda in Goa (India). (This being so, the defendant could have named its whisky as "Ponda", but did not). It is sold at a much lower price than the plaintiff's whisky wherever the same is sold. It does not taste like the plaintiff's Glenfiddich whisky. If this be so anybody who takes the defendant's whisky in India, or elsewhere from out of a bottle to which the label of the defendant, which is objected to by the plaintiff is affixed, would carry it in his mind and memory consciously or unconsciously, and the inevitable result would be that the plaintiff's reputation would be impaired, gradually debased and good-will diluted, and what is distinctive, shall be eroded.

(94) Much emphasis has been laid by Mr. Nariman on the fact that the whisky of the plaintiff is not easily available of the shelf, across the counters at the shops, which sell whisky in India, whereas the defendant's whisky is available there. Mr. Nariman does not dispute that Glenfiddich whisky is sold at duty free shops in India by bottles and in hotels by measured "pegs", the whisky is not sold by bottles like it is sold at the duty free shops). Mr. Nariman has contended that

inasmuch as the plaintiff's whisky is not available in India by virtue of the Government of India Policy, the same cannot possibly have any good-will or reputation in this country, and, Therefore, there can be no passing off by the actions of the defendant, who is not passing off its whisky as the whisky of the plaintiff.

(95) In addition to what I have stated above regarding the gradual impairment and debasement of reputation, dilution and erosion of what is distinctive, what has to be considered in the case of the plaintiff is the trans-border reputation of the plaintiff in its product. Trans-border reputation of the plaintiff, has been, in my view, established sufficiently in this country by means of the fact that the sales of Glenfiddich takes place on duty free shops in India, by the fact that advertise- ment of Glenfiddich whisky arc to be found in various magazines, like the In house magazine of Air India, and other foreign publications which are freely available in india, (some of which have been placed on record of this case), as a result of which, in my view, Glenfiddich whisky has a live reputation in India.

(96) After referring to judgments relating to persons selling their goods internationally all over the world, I have already held in the case of Apple Computer Inc. 1991 (20) DL 319, that a person whose goods have an international reputation can maintain a passing off action in India.

(97) In this case, not only Glenfiddich is carrying on business internationally, even books like Michael Jackson's "Malt Whisky Companion", regard it as the biggest selling Single Malt Whisky in the world. Another book : "The Scotch Whisky Book" by Mark Skip worth ,referred to by the defendant, at page 39, refers to Glenfiddich Whisky by saying "GLENFIDDICH is the world's biggest selling Single Malt Whisky".

(98) In these circumstances, I have come to the conclusion that the plaintiff has international reputation with regard to its Glenfiddich Single Malt Whisky, which it is entitled to protect by instituting a passing off action, by asserting-that no person should injure its reputation. The plaintiff is entitled to say that Glenfiddich is a potable product. It is a liquid. No brand can be put upon the liquid. All that the plaintiff can do, is to label the bottle in which it markets its whisky, and to make sure that its label is distinctive of its product, that its label itself indicates source of the goods, and having done all that, having made the label a distinctive one by incorporating various features which are detailed by me hereinabove. On coming to know of the adoption of the essential features of the plaintiff's label, as has been done by the defendant, the plaintiff is entitled to say that such adoption for a product which the defendant itself admits, does not look like the plaintiff's product, nor does it taste like the plaintiff's product, would injure its reputation in reasonably foreseeable future, if improper use of the label of the defendant is not restrained by an order of injunction.

(99) Keeping in view the nature of the label which is affixed on the plaintiff's bottle has been mentioned by me heretofore, in my view, it is wrong to contend

that the label is an article. It has been contended Mr. Nariman that the Glenfiddich label is an article. The label is an integral part of the bottle. It cannot be sold independently of it.

(100) In my view, it cannot be contended, as has been contended by Mr. Nariman, that the provisions of the Designs Act would apply to this label. Not being an article, as postulated by the Design Act, the definition of design given in the Designs Act, would not apply to the label.

(101) The Trade & Merchandise Marks Act, 1958 deals with trade marks. According to section 20) of the Act, "mark" includes a device, brand, heading, Label, ticket, name, signature, word, letter or numeral or any combination thereof. Section 2(2) of the Act states, "unless the context otherwise requires, any reference - (a) to the use of a mark shall be construed as a reference to the use of a printed or other visual representation of the mark". Reading section 2(i) and 2(2) together, it is clear that printed material like the plaintiff's Label is mark. This being the position, the same cannot be treated as a "design". The label cannot be a design also for the reason that in the Designs Act, 1911, section 2(5) defines "design" as follows: . "design" means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process, or means, whether manual, mechanical or Chemical ,separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, And Does Not Include Any Trade Mark as defined in clause (v) of sub-section (1) of S.2 of the Trade and Merchandise Marks Act, 1958; or property mark as defined in section 479 of the Indian Penal Code."

(102) In the above said definition, there is clear emphasis on the "article", the "finished article" should not be missed. The design under the Designs Act, 1911, relates to article covered by the said definition, and as labels are primarily intended to be used as marks", which marks or trade marks are intended to show a connection during the course of trade between the manufacturer and the goods sold, cannot be made subject matter of the design, postulated by section 2(v) of the Designs Act, 1911.

(103) What I have said above ,is clear from Section 2(v)(i) of the Trade and Merchandise Marks Act which states:

" IN relation to Chapter X (other than Section 8), a registered trade mark or A Mark Used In Relation To Goods For The Purpose Of Indicating Or So As To Indicate A Connection In The Course Of Trade Between The Goods And Some Person Having The Right As Proprietor To Use The MARK."

(104) The label prominently contains upon lower scroll words that the Glenfiddich whisky is of William Grant & Sons. Iam, Therefore, not inclined to accept the contention of Mr. Nariman, that the label is an article covered by the Designs Act.

(105) It follows further that in view of the fact that the plaintiff's label is a mark within the meaning of the Trade & Merchandise Marks Act, Section 15 of the Copyright Act can have no application to the label in question, for the reasons that the same is not an article. The label is permanently affixed on the bottle. It is not sold as an article. Nor is it intended to be sold as an article. The sole purpose of the plaintiff's label is to show that the Glenfiddich whisky which is a Single Malt Whisky, which is "Special Old Reserve", is manufactured by William Grant & Sons Ltd., the plaintiff. In this view of the matter, it cannot be said that because of section 5 of the Copyright Act, the copyright of the plaintiff in the label would cease to be, once more than 50 impressions of the label are made.

(106) In my view the copy right in the label exists in the plaintiff, as nobody else (including Claessens International Ltd., who have assigned the copyright for whatever work they have done on the label, to the plaintiff) claims the copy right in the label of the plaintiff. The plaintiff asserts that it has a copyright in the label. In my view, being an artistic work, the plaintiff has a copyright in the label. I have also been shown in the open Court the original component parts of the label which were drawn up by the artists, engaged by the plaintiff. I have also been shown the transparencies which have been taken of the original artistic work, and I am satisfied that the original work is in possession of the plaintiff, which would be produced by the plaintiff when required by the Court. As the plaintiff is the owner of the copyright, it is entitled to restrain others from infringing the copyright therein by producing colourable imitations of the plaintiff's label.

(107) There is some reference in the pleadings of the plaintiff to the market survey got conducted by the plaintiff. The plaintiff also relies upon the judgment 1983 Fsr 156 at 176, according to which such market surveys are permissible in passing Off actions. In view which I have taken in the matter, I do not think there is any need forms at this interlocutory stage to comment upon the matter regarding usefulness of the market surveys.

(108) Mr. Nariman's contention is that it is essential in the passing off matter also to keep in view the class or person who are going to be misled. According to him, in India the customers of Glenfiddich whisky are the wholesale importers, who buy the whisky by the cases, and not by the labels. It is also his contention that passing off actions are undertaken only for the purposes of preventing confusion. As regards sale of Glenfiddich whisky to persons in India, it may be that the whisky sold in cases, but even on the cases the mark which the plaintiff puts on every label prominently, is the the word "GLENFIDDICH", accompanied by the "stag" picture, "GLENFIDDICH" being a registered mark in India, I am not prepared to say that just because the entirety of the label on the plaintiff's bottle is not reproduced on the packing cases in which the bottles of the plaintiff are packed and sold, the same is either by itself a factor, or amongst other factors, reasons for disallowance of the injunction which is sought by the plaintiff.

(109) Besides this, it is plain that not only the Glenfiddich bottles containing

Glenfiddich whisky, display the label bottle prominently, but also in the black tube container that hold the whisky bottle, the whisky bottle label is substantially reproduced. I have already said that in my view the Glenfiddich bottle label is an artistic label. Again, in my view, the label is not only an artistic label, but also an effective one, a label which attracts the eye.

(110) Like in all passing off actions, Mr. Nariman also relies upon the observations of Lord Diplock in *Erven Warnink B.V. and another v. I.Townend & Sons (Hull) Ltd.* " and another 1980 R.P.C 31, which is in the following terms:- My Lords, *Spalding v. Gamage* and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.

(111) I had occasion to deal with trans-border reputation and observations of Lord J Diplock in a case *Apple Computer Inc. v. Apple Leasing & Industries*, 1992 (1) Arb. L.R.93. After referring to the cases of Irish Courts in *C & A Modes* 1978 Fsr 126, and other cases *Panhard Levassor's* case (1901) 18 Rpc 405; *Poiret v. Jules Poiret Ltd.* (1920) 37 Rpc 177; *Sheraton Corporation* 1916 (4) Rpc 202 and *Globe Elegance* 1974 Rpc 603, I said that the Indian Courts have recognised the existence of trans-border reputation. The trans- border reputation had, particularly, been recognised in the case reported *Kamal Trading Co. & Ors. v. Gillette U.K. Ltd.* (1988) 1 PLR 135.

(112) These cases recognised that the reputation of a trader, trading or carrying on the business in another country, can travel to a country where he had carried no business. The traders trans-border reputation can be on the basis of the extensive advertisements and publicity. Such a trader could obtain an injunction in a Court where he was not trading, to protect his reputation. The Indian Courts also recognise the existence of trans-border reputation, particularly, the Bombay High Court in *Kamal Trading Co. & others v. Gillette U.I. Ltd.*. In the last mentioned- case, the Division Bench expressed the view that good-will or reputation or goods or mark, does not depend upon its availability in the particular country. The Delhi High Court recognised trans-border reputation in an unreported judgment in *Blue Cross & Blue Shield Association v. Blue Cross Health Clinic and others*, Suit No.2458 of 1988, dated 05.09.1989. In the case *Central industrial Alliance Ltd. and another v. Gillette U.K. Ltd.*, Appeal No..368 of 1986, the Division Bench of the Bombay High Court had noted that publicity does not take place merely by advertisement in India. Advertisement in foreign newspapers and magazines, circulated in India, and freely imported in India, are read. Besides this, large number of Indians go abroad temporarily to other

countries, and can have the opportunity to use the goods (goods in question in the case is 7 o'clock safety razor blade), and, in my view, on return of those persons to India, the reputation of the goods used by those who go abroad, will stay in their minds, and the memories of those goods would be revived by advertisements seen in foreign magazines and newspapers which are available in India.

(113) I expressed the view that the goodwill as postulated by the tax laws, is not applicable to the passing off actions. I had agreed with the view of the Ontario Supreme Court in *Orkin Exterminating Co. Inc. v. Pesto Co. of Canada Ltd.* 50 OR 726 regarding the meaning of "goodwill". The observations of the Ontario Supreme Court were as under: Virtually no words have a single fixed meaning, particularly goodwill, and, with respect. I do not think that the meaning appropriate in the *Muller* case is necessarily appropriate in a passing-off case which involves issues of remote territorial use. In this kind of case I think that the main consideration should be the likelihood of confusion with consequential injury to the plaintiff. Generally, where there is such confusion there is goodwill deserving of protection.

(114) The nature of goodwill postulated by passing off action is different. In my view, the difference is not far to seek. All manufacturers of goods, either in due course of their operation or otherwise, get to enjoy a good reputation or suffer a bad reputation vis a vis the consumer. If the goods manufactured by them, and sold by them, perform the purposes which they are intended to perform to the satisfaction of the consumer, and do so consistently over a period of time, the manufacturers come to enjoy a good reputation, and those manufacturers whose manufactured goods do not perform or come up to the expectations of the consumers in due course, come to have a bad reputation.

(115) The same thing would apply with equal force to those persons who are offering services, or running services. Either the services are adequate and come up to the expectation of consumer, or inadequate in which case they do not enjoy a good reputation. The good reputation is the goodwill in passing off actions.

(116) It also needs to be added that when a manufacturer or a seller of goods advertises his product and holds out by advertisements either specifically or by necessary intendment, that the goods would perform a specified task, and they actually do so, good reputation is established, and the reputation is spread more and more by continued advertisements, and continued maintenance good and adequate, standards by the manufacturer who by his own inspection procedures ensures that the goods perform as they are intended to perform.

(117) These reputations, as stated by the Ontario Supreme Court, are not confined to borders. They are trans-border reputation, and agreeing with what was said by the Ontario Supreme Court, I agreed in *Apple Computer* case, 1992 (1) Arb. LR 93 with what was stated by the Ontario Supreme Court, by observing as under:-

(118) I stated in the Apple Computer Inc. case at page 137 as under- expressed regarding the meaning of goodwill in passing off cases. In passing off cases, the main consideration is the likelihood of confusion and consequential injury to the plaintiff, and the need to protect the public from deception, deliberate or otherwise. Where such confusion or deception is prima facie shown to exist, protection should be given by courts to the name or mark or goodwill of the plaintiff. The reason why all traders and manufacturers of goods, and providers of services, wish to protect their name and build up their name is that they want their name or market to have an impact upon anyone who has need their goods or services. That impact may take diverse forms, but one of them would certainly be that a name or mark would recall to the mind of a potential consumer or user of such services, the source from where the goods originate, or the person who provides the services. This is the impact of advertising and publicity by whatever means, including word of mouth, and the build- up of reputation. It would not be right for courts to permit the persons who have spent considerable time, effort, money and energy in building up a name, sufficient to have an impact to lose control over such an impact by improper use of the very same or colourably similar name by another unauthorisedly or even dishonestly.

(119) The Apple Computer case was subject matter of appeal before the Division Bench of this Court, but the said observations were not modified, varied, or set aside. A Special Leave Petition, being SLP No.314Sof1992, was also filed in the Apple Computer Inc. case. In the Supreme Court. where the matter was settled by an application filed under Order 23, Rule 3 of the Code of Civil Procedure, the observations made by me were not modified, varied or set aside under Order 23 Rule 3 CPC ., as they were apparently found to be "lawful".

(120) Nothing has been stated in this case by Mr. Nariman or Mr. Ashok Desai which makes me change my view with regard to what I have set out above.

(121) Both the parties before me have referred to Michael Jackson's book "Malt Whisky Companions". The said book contains Malt Whisky's names, each with different label .It is apparent from the large number of Single Malt Whiskies which are produced in Scotland, that Single Malt Whisky is a type of whisky and Single Malt Whisky is, Therefore, a generic term. In my view, it is not permissible in law for any one in India to adopt a generic term, like the "Single Malt Whisky" and use it as the name of a particular brand of whisky, which that person is producing. It is the case of Mr. Nariman that the defendant has got a registration certificate. The registration certificate produced contains representation of the whole bottle along with the label bearing the name "Single Malt". Such a registration which relates to the design, in my view, cannot possibly result in exclusive appropriation of a generic term, as an exclusive name for a particular whisky.

(122) Mr. Nariman has also referred to and relied upon the case Cadbury - Schweppes Pty. Ltd. v. The Pub Squash Co. Ltd., (1981) 1 Aer 213 = (1981) RPC 429. In my view that case is of no help to the defendant, inasmuch as that case

relates to an advertising campaign ,sought to be adopted/copied. The Court was not inclined to grant the relief which was sought, restraining the defendant from copying the advertising campaign .

(123) In the case Cadbury- Schweppes Pty. Ltd. case, what was being objected to "the theme of their television advertising campaign which was adopted by the defendant and the similarity in the two campaigns .The Privy Council held that:

"IT(passing off) is wide enough to encompass other descriptive material, such as slogans or visual images, which radio, television or newspaper advertising campaigns can lead the market to associate with a plaintiff's product, provided always that such descriptive material has become a part of the goodwill of the product. And the test is whether the product has derived from the advertising a distinctive character which the market recognises. But competition must remain free; and competition is safeguarded by the necessity for the plaintiff to prove that he has built up an "intangible property right" in the advertised description of his product, or, in other words, that he has succeeded by such methods in giving his product a distinctive character accepted by the market. A defendant, however, does no wrong by entering a market created by another and there competing with its creator. The line may be difficult to draw; but, unless it is drawn, competition will be stifled."

(124) The injunction sought by the plaintiff before the trial Judge, restraining the defendant, was denied. The plaintiff was the appellant before the Privy Council, and the plaintiff's appeal before the Privy Council also failed. I do not think, on the facts the h2 I.A.9721/93 judgment in Cadbury - Schweppes Pty. Ltd."s case is applicable to the present case.

(125) Mr. Nariman has also referred to 1989 16 Rpc 3 (Lever brothers. Li). v. bedingfiedl). That case related to the label or wrapper in which the Lever Brothers wrapped their "Sunlight Soap", and the wrapper in which the defendant wrapped their "Red Maid" Soap. The only thing found common by the Court was that "the arrangement of spaces into which the front of the label or wrapper is divided". The Court found that the curved scroll had been copied to some extent by the person employed by the defendant to prepare the label, but the Court, however, held that this was not an infringement on the plaintiff's registered trade mark, as the defendant's label as a whole is not a copy of the plaintiff's label, and is not colourable imitation of it.

(126) What is necessarily to be seen in the case of passing off, is to compare the whole of the plaintiff's label with the whole of the defendant's label. When so compared, in my view, there are common black, red-rust and golden colours, there are common use of scrolls, common use of ghosted letters for the purpose of writing the name of the Whisky, there is common stag/sambhar with antlers, thistles are to be found in both the labels, scrolls being found both on the top and the lower part of both the labels. All these similarities, as a whole, in my view, go to show that the defendant wished to make its label a close

approximation of the label of the plaintiff, as it possibly could. It only made colourable variations in the way the golden scroll curved. In the case of the plaintiff's scrolls. they curve up wards, and, Therefore, the defendant's scrolls curve downwards. This is so far as the top part of the label is concerned. Although the label used by the plaintiff is far more attractive to the eye than the label of the defendant, nonetheless the similarities between the two cannot be missed .

(127) R.J. Reynods Tobacco Company Vs. Indian Tabacco Company Ltd., . a judgment of this High Court, was cited for the proposition that there is no trans-border reputation in case of "NOW" cigarette. In my view, in view of the observations of the Supreme Court of Ontario, which I have reproduced above, and in view of my own observations, at least, tacit approval by the Supreme Court would lead me to say that the said judgment may not have been decided correctly. In any case, I would prefer the view which I have taken in Apple Computer's case, and nothing has been stated in the aforesaid judgment which would persuade me to change the view expressed by me in the Apple Computer's case, and expressed herein.

(128) Mr. Nariman during the course of his arguments, has stated that likelihood of deception is the essence of passing off. In view of what I have stated above, I think that in cases of trans-border reputation, the question of likelihood deception loses its significance in passing off action, and what becomes more important, is whether use of something by the defendant, out of the whole used by the plaintiff, is deceptively similar to what is of the plaintiff that it could lead to erosion of the reputation of the plaintiff, erosion of what is distinctive, especially so in the case of potable products which cannot bear a mark and only their containers can have a label. In case of a potable product like the potable products in the instant case, the Glenfiddich whisky, having admittedly existed prior to coming into the existence of the defendant. The reputation of Glenfiddich which is inseparably linked with the label of Glenfiddich Single Malt Whisky bottle is bound to be eroded by another Single Malt Whisky which bears the label which has very close similarity to the label of the plaintiff.

(129) To my mind, it is of no consequence that the label which is affixed on the Glenfiddich whisky bottle was desired in the year 1990, but the label was apparently, as pleaded, improved upon by Cleassens and since 1990 it existed. The plaintiff had copyright in the unmodified label just as it has the copyright in the modified version of the Glenfiddich label which is the label in the suit. To my mind, the "modified" Glenfiddich label is an artistic work which is equally entitled to protection.

(130) To my mind, the assignment of the modification to the pre-existing GLENFID- Dich label which was done by Cleassens in England, was valid, as far as England was concerned. The defendant in this case, cannot take advantage of the fact that section 19(2) of the Indian Copyright Act, which requires that the nature and extent of assignment must also be specified. It is not the Cleassens

who are complaining about inadequate assignment or incomplete assignment. The defendant, in any case, not being the owner of the copyright in the unmodified label, or in the modified label, cannot complain about the alleged shortcomings, if any, in the assignment made by the Cleassens according to the laws in England. I also do not accept that the assignment of M/s.Cleassens does not accord with section 19(2) of the Copyright Act, for the reasons set out hereinabove.

(131) During the course of arguments Mr. Nariman referred to a unilateral change in the label by the defendant by eliminating the image of Sambhar with antlers and thistles, and changing the colour on the reverse side of the scrolls. In the case which I have to deal with, I am not required to say anything what may happen if different label is used by the defendant. What I have to decide upon is the effect of using the label which is currently being used by the defendant. As I have said above, taken as a whole, the label currently used by the defendant is substantially similar to the label of the Glenfiddich whisky bottle.

(132) Usual consideration in grant of injunction in passing off action is if accounts would be inadequate remedy. In the instant case, accounts will not serve any useful purpose, as it will be very difficult to quantify the loss that will be sustained by continued use of infringing label upon the goods of the defendant.

(133) The second question which is relevant, is the effect of delay. In the instant case, the plaintiff has been vigilant. When the plaintiff became aware of the defendant's proposal to market whisky by calling it a "Single Malt", a notice was given by the plaintiff notifying its intention to take action in passing off if the defendant did not cease and desist, and when the defendant did not comply, actually instituting this suit. For this reason, it cannot be said that either there is delay in institution of the suit, or that there is any kind of acquiescence on the part of the plaintiff in use of the infringing label, which has been used by the defendant. If the nature of the injury which is likely to be caused can be measured in terms of money, then injunction ought not to be granted.. In the instant case, in my view, it would not be possible to assess the quantum of damages which would accrue if the defendant is permitted to use the infringing label upon its goods, and since the defendant has adopted a generic word, as the name of a particular product, it has, to my mind, an intention to foreclose other persons who wish to make Single Malt Whisky, from advertising its product as a Single Malt Whisky, which the defendant cannot be permitted to do, and the appropriate course of action would be to restrain the defendant from manufacturing, marketing and selling whisky which purports to be a Single Malt Whisky by calling it Single Malt Whisky, and restraining the defendant from using the word "Single Malt" Whisky as a name of its whisky because "Single Malt" is a type of whisky, as Single Malt is a generic term; which even the defendant so admits in its written statement (when the defendant says that there are a wide range of Single Malt Whiskies).

(134) In my view, the documents which the plaintiff has filed, especially the

publicity material which shows the extensive advertisements of the Glenfiddich Whisky of the plaintiff, established a connection of the word "GLENFIDDICH" with itself, and also that it has a reputation not only in the word Glenfiddich, which is a registered trade mark even in India, but it has also a copyright in the label in which the word Glenfiddich the name of its whisky, is prominently indicate.

(135) In any case, much the arguments of Mr. Nariman with regard to Glenfiddich not having a reputation, are negated by the fact that two books referred to by both the parties, namely, "Single Malt Whisky companion "by Michael Jackson, and The Scotch Whisky Book by Mark Skip worth ,state in clear terms that the Glenfiddich whisky is the largest selling Single Malt Whisky in the world. It is difficult for me to come to the conclusion that the largest selling whisky in the world would not have any reputation in India, particularly as the defendant admits that Glenfiddich whisky is sold in Indian Duty Free Shops, and is available in Indian Hotels.

(136) Accordingly, I hold that Glenfiddich Whisky of the plaintiff has got a reputation in India, and the plaintiff is entitled to protect that reputation, and to ensure that the reputation is in no way eroded by use of a label which taken as a whole, is very similar to the label which is used by the defendant.

(137) In the facts and circumstances of the case, I am of the view that the plaintiff has made out a prima facie case that it has a world wide reputation in the Glenfiddich whisky, and its label, and that inasmuch as the plaintiff started manufacturing, marketing and selling its whisky all over the World as Glenfiddich whisky much prior to the whisky manufactured by the defendant, and the plaintiff's whisky is recognised as the largest selling Single Malt Whisky in the world, the balance of convenience would be in favor of granting an in function in favor of the plaintiff and against the defendant, so that the defendant is not able to plead that by User of the word "Single Malt" in connection with the goods, and the user of the label in connection with its whisky, it has acquired a reputation, and, Therefore, entitlement to use the name "Single Malt" for its whisky or the label, bearing those words which infringe the copyright in the label of the plaint. As the plaintiff has come to Court at an early stage without any reasonable delay, it is entitled to the injunction which has been sought. I am also of the view that in view of the fact that the goods in the instant case are potable products, and it is not possible to mark a liquid, and it is only the container in which the liquid is held that can be marked with the label, so as to show a connection in the course of trade, which the plaintiff is doing, and has been doing, it would be difficult to quantify the loss which the plaintiff would sustain if the defendant is permitted to continue to manufacture, market and sell the whisky bearing the infringing label.

(138) There is another aspect which is to be seen. The plaintiff can easily adopt another suitable name, devise another label, which is not a colourable variation of the plain-tiff's whisky bottle label. The balance of convenience would be in directing the defendant to change its name and label, rather than asking the plaintiff, who is already marketing the largest selling Single Malt Whisky in the

world under the label in the suit, to devise another label.

(139) For all the aforesaid reasons, I grant an injunction prayed for by the plaintiff, and restrain the defendant, its officers, servants and agents, from manufacturing, selling, offering for sale, advertising and directly or indirectly dealing in alcoholic beverages under the brand name McDowell's "Single Malt" Whisky in packaging, including bottles, labels and containers, that are colourable imitation and substantial reproduction of the plaintiff's Glenfiddich label and further restrain the defendant from packaging its whisky bottles in such a way and in such containers which bear the representations which are substantially the same as the infringing labels used by the defendant on its whisky bottles, and from representing that the Single Malt Whisky made by the defendant at Ponda in Goa, is a type of Scotch Whisky as the same is a false trade description.

(140) The observations made by me herein are only for the dealing with this interim application, and would, in no way, affect the final determination of the controversy after the trial of the suit.

(141) Costs of the application shall abide by the decision of the suit.

(142) I.A.NO-9721 of 1993 is disposed of accordingly.