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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Reserved on: 24th August, 2021
Pronounced on: 2nd March, 2022

+ IA 2821/2021 in CS (COMM) 94/2021

PERNOD RICARD INDIA PRIVATE LIMITED Plaintiff
Through: Mr. Hemant Singh, Ms. Mamta
Rani Jha, Mr. Waseem Shuaib Ahmed and
Mr. Abhijeet Rastogi, Advs.

versus

FROST FALCON DISTILLERIES LIMITED ... Defendant
Through: Mr. Sachin Datta, Sr. Adv. with
Mr. Sidhartha Das, Mr. Gajanand Kirodiwal
and Ms. Prity Sharma, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

% **J U D G M E N T**
02.03.2022

1. This judgment disposes of IA 2821/2021, preferred by the plaintiff, seeking interim injunction against the defendant.

Facts

2. The plaintiff alleges that the defendant's mark "CASINOS PRIDE", the label of the defendant, the design of the bottle in which the defendant sells its product and the package in which the bottle is packed all infringe the plaintiff's registered trademarks.

3. The allegedly infringing product of the defendant, and the

package in which it is packed and sold, are the following:

Product	Package
	

4. Two products of the plaintiff are subject matter of the present proceedings. Both are IMFL. They are “BLENDERS PRIDE” and “IMPERIAL BLUE”. Admittedly, the products of the plaintiff and the defendant belong to the same segment i.e. Indian Made Foreign Miquor (IMFL) and, therefore, cater to the same customer base. They are also, therefore, available from the same outlets.

5. The plaintiff also alleges that the defendant is seeking to pass off its goods as those of the plaintiff or as associated with the plaintiff

and its business.

6. The marks that the plaintiff asserts, in this plaint, may be referred to as (i) the BLENDERS PRIDE marks, and (ii) the IMPERIAL BLUE marks, for convenience.

7. Specifically, the registered trade marks of the plaintiff, which the defendant is alleged to have infringed are the following:

- (i) BLENDERS PRIDE mark - the word mark “BLENDERS PRIDE” registered on 25th March, 1994 and valid till 25th March, 2024, under Class 34 (Wines, Spirits and Liqueurs) and
- (ii) IMPERIAL BLUE marks:

Sl. No.	Trade Mark	Registration No. & Date	Class & Goods Description	Valid till
1		1682732 01.05.2008	33 Whisky	01.05.2008
2		2471714 04.02.2013	33 Alcoholic beverages including whiskies, spirits, brandies, aperitifs, cider and liquerurs'	04.02.2023

3		3327621 03.08.2016	33 Alcoholic beverages (except beers)	03.08.2026
4		3296387 28.06.2016	33 Alcoholic beverages (except beers)	28.06.2026
5		4493973 30.04.2020	33 Alcoholic beverages (except beers)	30.04.2030
6		3263961 19.05.2016	33 Alcoholic beverages (except beers)	19.05.2026

8. The plaintiff asserts that it has been using the “BLENDERS PRIDE” mark since 1995 and the “IMPERIAL BLUE” marks since 1997. As against this, it is an admitted position that the defendant is using the impugned “CASINOS PRIDE” mark only since 2nd August, 2017. Priority of user of the plaintiff is not, therefore, an issue in controversy in the present case.

9. The defendant also applied for registration of the following mark under Class 33:



Registration, as sought by the defendant, has not been granted, as the defendant's application has been opposed by the plaintiff.

10. One of the protestations of the plaintiff, in the present plaint, is that the package, in which the defendant is marketing its product, uses a blue background. This, according to the plaintiff, is a deliberate departure from the mark which the defendant sought to register (which has a black background), so as to achieve proximity between the defendant's mark and the plaintiff's registered trademarks. The defendant, thus alleges the plaintiff, wants to "come as close" to the plaintiff's mark as possible.

11. According to the plaintiff, the mark "BLENDERS PRIDE" was coined and adopted by the plaintiff's predecessors in 1973. It is claimed that the mark was initially registered in favour of Seagram, Canada in the same year, whereafter it passed various hands till, under Deed of Assignment dated 27th June, 2018, the plaintiff succeeded the proprietorship of the mark. In India, it is claimed that, IMFL has been sold by the plaintiff's predecessors since 1995.

12. The plaintiff also claims to have succeeded to proprietorship over the "IMPERIAL BLUE" mark *vide* the Assignment Deed dated

27th June, 2018 already cited supra. IMFL (Whisky), it is claimed, is being sold in India under the “IMPERIAL BLUE” mark since 1997.

13. The defendant has not disputed the proprietorship of the plaintiff over the marks that it seeks to assert.

14. As is customary in such cases, the plaintiff has averred, positively, that the “BLENDERS PRIDE” and “IMPERIAL BLUE” marks have, over a period of time and consequent on continuous and uninterrupted use, become indelibly associated with the plaintiff and have, thus, become source identifiers. Both “BLENDERS PRIDE” as well as “IMPERIAL BLUE” stand recognised as “well-known marks”, within the meaning of Section 2(1)(zg)¹ of the Trade Marks Act, 1999 (“the Trade Marks Act”, hereinafter) by this Court *vide* its decisions in *Austin Nichols & Co. v. Arvind Behl*² (in respect of “BLENDERS PRIDE”) and by the High Court of Madras in *Rhizome Distilleries v. UOI*³ (in respect of “IMPERIAL BLUE”). There can, therefore, be no gainsaying the reputation of the plaintiff, to which this Court, and the High Court of Madras, have already accorded their judicial imprimatur.

15. The plaintiff has provided its sales figures and the expenses incurred by it on promotions and advertisements; however, as the plaintiff’s marks stand recognized, judicially, as “well-known marks”,

¹ (zg) “well known mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

² 2006 (32) PTC 133 (Del)

³ 2016 (65) PTC 132 (Mad)

the reputation and goodwill of the plaintiff stand crystallized and, therefore, there is no need to refer to those figures.

Rival contentions

16. I have heard Mr. Hemant Singh on behalf of the plaintiff and, initially, Mr. Chander Lall and, later, Mr. Sachin Datta, learned Senior Counsel, for the defendant, respectively.

Contentions of the plaintiff

17. Mr. Singh submits that the defendant has, by its label, its bottle, and the package in which the bottle is sold, deliberately infringed the plaintiffs' registered "BLENDERS PRIDE" and "IMPERIAL BLUE" marks.

18. Apropos "BLENDERS PRIDE", Mr. Hemant Singh submits that the mark was a fancifully structured and coined trademark, registered in favour of the predecessor of the plaintiff on 25th March, 1994. There is, therefore, he submits, no dispute regarding priority of user, by the plaintiff, of its marks, vis-à-vis, the impugned "CASINOS PRIDE" mark of the defendant. Mr. Hemant Singh submits that the plaintiff has been using "BLENDERS PRIDE", with "PRIDE" as the distinctive feature thereof, in respect of whisky since 1995. As such, he submits that use of any composite mark by others, with "PRIDE" as the second component of the mark would not only infringe the plaintiffs' "BLENDERS PRIDE" reputation but would also subject the plaintiff to irreparable loss.

19. Mr. Hemant Singh submits that there is, indeed, no compulsion for anyone to use “PRIDE” as part of its registered mark, as, “PRIDE” is not descriptive of alcoholic beverages. The use, by the defendant, of the mark “CASINOS PRIDE” – which, as Mr. Hemant Singh points out, has no etymological meaning, whatsoever, with “PRIDE” as the distinctive part thereof, is clearly with a view to capitalize on the plaintiff’s goodwill and reputation and deceive consumers into mistaking the product of the defendant with that of the plaintiff or into drawing an association between the two.

20. Mr. Hemant Singh also submits that the expressions “BLENDERS PRIDE” and “CASINOS PRIDE” are phonetically similar. He has also questioned the validity of the defendant’s contention that the expression “PRIDE” is common to the alcoholic beverage trade, stating that no sufficient evidence, to that effect, has been placed on record by the defendant.

21. Adverting to the “IMPERIAL BLUE” mark, Mr. Hemant Singh submits that the “IMPERIAL BLUE” IMFL of the plaintiff is sold in a distinctive trade dress which includes the name and other writings on the label in white letters on a blue background with a dome shaped insignia in gold and the name of the product written in two words, one below the other. For ease of reference, the photograph of the bottle of the plaintiff, in which it sells its ‘IMPERIAL BLUE’ IMFL, may be reproduced:

Product	Package
	

These features, which, according to Mr. Hemant Singh, are the “essential features” of the defendants’ registered “IMPERIAL BLUE” marks, have been copied by the defendant in its “CASINOS PRIDE” label as well as affixed on the bottle on which the defendant sells its IMFL and on the package in which the bottle is sold. Mr. Hemant Singh further submits that the defendant’s bottle, along with the label affixed thereon, are also infringing the plaintiff’s “IMPERIAL BLUE” 3D Mark registration separately held in respect of the bottle as well as the label thereon. He points out that the shape of the bottle of the defendant is identical to that of the bottle of the plaintiff, which stands registered as a separate 3 D mark in the plaintiff’s favour. Mr. Hemant Singh has also sought to contend that the plaintiff’s “IMPERIAL

BLUE” registrations – except its 3D Mark registration for the bottle with the label thereon – constitutes a “series of marks” within the meaning of Section 15⁴ of the Trademarks Act, 1999 and that, consequently, the plaintiff is entitled to claim exclusivity over the individual parts of the mark, such as the blue colour, the golden dome shaped design etc.

22. Mr. Hemant Singh submits that the defendant has resorted to an ingenious ruse of copying the essential features of different trademarks of the plaintiff, so as to confuse prospective consumers of IMFL. According to Mr. Hemant Singh, the defendant has copied “PRIDE”, which is the distinctive part of the mark “BLENDERS PRIDE” and the blue colour, the golden dome, the general getup and trade dress of “IMPERIAL BLUE” marks, and by conflating them, devised a label and the packaging which is bound to confuse customers into inferring an association between the defendant’s product and the plaintiff.

23. Mr. Hemant Singh has also claimed copyright infringement. According to him, the distinctive features of the trade dress in which

⁴ 15. **Registration of parts of trade marks and of trade marks as a series.**

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks.

(2) Each such separate trade mark shall satisfy all the conditions applying to and have all the incidents of, an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks in respect of the same or similar goods or services or description of goods or description of services, which, while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statement of the goods or services in relation to which they are respectively used or proposed to be used; or

(b) statement of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour, seeks to register those trade marks, they may be registered as a series in one registration.

the plaintiff sells its “IMPERIAL BLUE” IMFL constitutes an “artistic work” within the meaning of Section 2(c)⁵ of the Copyright Act, 1957 and the plaintiff’s impugned label and packaging an infringing copy thereof within the meaning of Section 2(m)⁶ over which the plaintiff is entitled to protection by Section 51 thereof and the defendant is liable to be enjoined against use of copy right by Section 55⁷.

Contentions of the defendant

24. Answering the submissions of Mr. Hemant Singh, Mr. Sachin Datta, learned Senior Counsel for the defendant submits that the defendant had honestly and *bona fide* conceived and adopted the “CASINOS PRIDE” mark on 25th May, 2016. He submits that the expression “CASINOS PRIDE” is coined and fanciful and that the defendant is entitled to exclusivity in respect thereof. It is further

⁵ (c) “artistic work” means –
(i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;
(ii) a work of architecture; and
(iii) any other work of artistic craftsmanship.

⁶ (m) “infringing copy” means –
(i) in relation to a literary, dramatic, musical or artistic work, a reproduction thereof otherwise than in the form of a cinematographic film;”

⁷ 55. **Civil remedies for infringement of copyright.**

(1) Where copyright in any work has been infringed, the owner of the copyright shall, except as otherwise provided by this Act, be entitled to all such remedies by way of injunction, damages, accounts and otherwise as are or may be conferred by law for the infringement of a right:

Provided that if the defendant proves that at the date of the infringement he was not aware and had no reasonable ground for believing that copyright subsisted in the work, the plaintiff shall not be entitled to any remedy other than an injunction in respect of the infringement and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the court may in the circumstances deem reasonable.

(2) Where, in the case of a literary, dramatic, musical or artistic work, or, subject to the provisions of sub-section (3) of section 13, a cinematograph film or sound recording, a name purporting to be that of the author, or the publisher, as the case may be, of that work, appears on copies of the work as published, or, in the case of an artistic work, appeared on the work when it was made, the person whose name so appears or appeared shall, in any proceeding in respect of infringement of copyright in such work, be presumed, unless the contrary is proved, to be the author or the publisher of the work, as the case may be.

(3) The costs of all parties in any proceedings in respect of the infringement of copyright shall be in the discretion of the court.

submitted that the defendant is openly using the “CASINOS PRIDE” mark since 2nd August, 2017.

25. The defendant, it is submitted, pointed out this fact to the plaintiff in its reply dated 12th December, 2017 filed by way of response to the notice of opposition dated 14th April, 2017 of the plaintiff, while opposing the defendant’s application dated 19th December, 2016 for registration of the “CASINOS PRIDE” mark. It is pointed out that, in the evidence by way of affidavit filed by the defendant before the Registrar of Trademarks in support of its application, the defendant has claimed continuous and extensive use of the “CASINOS PRIDE” mark since 2nd August, 2017. Invoices in support thereof have also been placed on record.

26. Learned Senior Counsel for the defendant has also invoked Section 17 of the Trademarks Act to contend that the plaintiff cannot claim exclusivity in respect of part of its composite mark “BLENTERS PRIDE”. It is sought to be submitted that, in order to overcome this objection, the plaintiff had, in fact, applied on 14th December, 2020 for registration of the mark “PRIDE”, but could not register the mark as an objection was raised by the Registrar of Trademarks on 5th January, 2021 on the ground that the same mark had been earlier registered in respect of similar goods. The present plaint, according to the defendant, is an oblique attempt by the plaintiff to obtain exclusivity in respect of the “PRIDE” mark having failed to obtain registration thereof.

27. Learned Senior Counsel submits that the defendant has not, in any manner, infringed the plaintiff's "BLENDERS PRIDE" trademark. By advertizing to various examples, learned Senior Counsel have sought to contend that the suffix "PRIDE", in the context of alcoholic beverages, has become common to the trade, and is used by several manufacturers. It cannot, therefore, it is submitted, be sought to be contended that "PRIDE" is the dominant part of the plaintiff's "BLENDERS PRIDE" mark.

28. In any event, submits learned Senior Counsel, no exclusivity can be claimed in respect of generic, descriptive, laudatory or common words, unless the word has acquired a secondary meaning in the minds of the consuming public. No evidence of the plaintiff's mark of the "PRIDE" mark having acquired any such secondary meaning is, it is submitted, forthcoming on the record. "PRIDE" is, therefore, submits learned Senior Counsel, *publici juris*, and the plaintiff cannot seek to make out the case of infringement against persons who use "PRIDE" as part of their registered trademark in respect of their alcoholic beverages.

29. Moreover, submits learned Senior Counsel, the label, the getup, the packaging, the shape, the colour combination and the arrangement of features, on the defendant's "CASINOS PRIDE" label are completely distinct and different both from the plaintiff's "BLENDERS PRIDE" as well as "IMPERIAL BLUE" trademarks.

30. The defendant emphatically denies any deceptive similarity between the marks "BLENDERS PRIDE" and "CASINOS PRIDE".

These marks, submits learned Senior Counsel, are not similar phonetically, visually, or otherwise. Nor can it be said that there is any case for idea infringement either.

31. These submissions, submits learned Senior Counsel, apply equally to the plaintiff's allegation of infringement, by the defendant, of its "IMPERIAL BLUE" label. The learned Senior Counsel for the defendant submits that there is no similarity between the "CASINOS PRIDE" label of the defendant and the "IMPERIAL BLUE" label of the plaintiff. The manner in which the words "CASINOS PRIDE" are written on the label of the defendant between diagonal golden lines, the shade of blue used on the labels and the arrangement of the features on the labels, it is submitted, are totally different from those used by the plaintiff on its "IMPERIAL BLUE" label. Purveyors of IMFL, it is submitted, are least likely to get confused between the defendant's and plaintiff's products. In this context, learned Senior Counsel has also highlighted the fact that the plaintiff's products are much more expensive than those of the defendant, so that the customer segments, to which the plaintiff and the defendant cater, are also different.

32. Learned Senior Counsel, addressing the submission of the plaintiff that the defendant has ingeniously infringed both the "BLENDERS PRIDE" and "IMPERIAL BLUE" labels of the plaintiff, submits that the argument has no legs to stand on. It is submitted that no customer would ever find the plaintiff's "BLENDERS PRIDE" product in a label or a packaging, which is in

any manner similar to its “IMPERIAL BLUE” label or packing. As such, learned Senior Counsel submits that the plaintiff cannot seek to make out a case of infringement by combining two marks and alleging that a case of deceptive similarity is made out. Besides, learned Senior Counsel submits that the defendant’s label has sufficient added matter, as would disabuse the possibility of any confusion in the mind of the imbibing public, between the products of the defendant and the plaintiff. Learned Senior Counsel emphatically denies any deceptive similarity between the “IMPERIAL BLUE” label of the plaintiff and the “CASINOS PRIDE” label of the defendant. It is submitted that the only similarity between the two labels is the blue colour and, in all other respects, the labels are different. Even the descriptions on the labels, the manner in which the letters are written and all other features, they submit, are distinct from one other.

Plaintiff’s submissions in rejoinder

33. Arguing in rejoinder, Mr. Hemant Singh reiterates some of the submissions initially advanced by him and further submits that the plea of “PRIDE” being common to the trade would require the defendant to establish sufficient volume of sales of products using “PRIDE”, to the knowledge of the plaintiff, without the plaintiff seeking to challenge such registrants. He draws my attention to the fact that the plaintiff has filed a number of legal proceedings, asserting its rights over the “BLENDERS PRIDE” and “IMPERIAL BLUE” marks. Even otherwise, he submits that the plaintiff, to succeed in an infringement action is not required to show that it has sued every

infringer.

34. Mr. Hemant Singh cites, in his support, the judgements of the Supreme Court in *T.V. Venugopal v. Ushodaya Enterprises Ltd*⁸ and *Heinz Italia v. Dabur India Ltd*⁹ and the judgements of this Court in *B.K. Engineering Co. v. U.B.H.I. Enterprises*¹⁰ and *Ishi Khosla v. Anil Agarwal*¹¹, to contend that, where deception is deliberate, injunction must follow. On the aspect of deceptive similarity, Mr. Hemant Singh cites *Parle Products v. J.P. & Co.*¹², *Kaviraj Pt Durga Dutt Sharma v. Navratna Pharmaceutical Inds*¹³ and *Ruston & Hornby Ltd v. Zamindra Engg Co.*¹⁴ Mr. Singh further submits, relying on *Amritdhara Pharmacy v. Satya Deo Gupta*¹⁵ that, for a person of average intelligence and imperfect recollection, the marks “BLENDERS PRIDE” and “CASINOS PRIDE” would be phonetically and structurally similar. Mr. Singh also relies on the judgement of a Division Bench of the High Court of Madras in *Rhizome Distilleries v. U.O.I.*¹⁶ to contend that, even if the marks are not individually infringing, infringement may exist when the marks are combined. In the present case, he submits that this aspect assumes additional significance as there is no explanation adduced, by the defendant, for use of the mark “CASINOS PRIDE”, in similar letters and on a similar background. On the argument of the defendant that the word “PRIDE” is *publici juris*, Mr. Hemant Singh relies on

⁸ (2011) 4 SCC 85

⁹ 2007 (35) PTC 1 (SC)

¹⁰ AIR 1985 Del 210

¹¹ 2007 (34) PTC 370 (Del)

¹² AIR 1972 SC 1359

¹³ AIR 1965 SC 980

¹⁴ AIR 1970 SC 1649

¹⁵ AIR 1963 SC 449

¹⁶ 2016 (65) PTC 132 (Mad) (DB)

*Himalaya Drug Co. v. S.B.L. Ltd*¹⁷, to contend that such a plea requires positive evidence to be adduced by the defendant. Moreover, he submits, relying on the judgement of the Supreme Court in *Corn Products Refining Co. v. Shangrila Food Products Ltd*¹⁸, that there is a distinction between marks which are commonly found in the register of trademarks and marks which are common to the trade. He reiterates his contention that the defendant has not produced any substantial material to indicate that the mark “PRIDE” is common to the trade. Injurious association, submits Mr. Hemant Singh, exists where the products are available from the same source, even if the defendant’s product may not be mistaken for that of the plaintiff, for which purpose he relies on *Parle Products*¹² and *B.K. Engineering*¹⁰. He further cites *William Grant & Sons Ltd v. McDowell & Co. Ltd*¹⁹ to contend that, if the acts of the defendant dilutes the plaintiffs goodwill in its product, the plaintiff is entitled to relief even if there is no confusion.

35. Learned Senior Counsel for the defendant has also cited various authorities, essentially for the proposition that no exclusivity could be claimed in the mark “PRIDE”, as it is laudatory in nature, and that there is no deceptive similarity between the marks of the plaintiff and the impugned mark of the defendant, to wit, the judgements of the Supreme Court in *J.R. Kapoor v. Micronix India*²⁰, *Khoday Distilleries Ltd v. Scotch Whisky Association*²¹ and the judgements of this Court in *Rhizome Distilleries P Ltd v. Pernod Ricard S.A.*

¹⁷ 2013 (53) PTC 1 (Del) (DB)

¹⁸ AIR 1960 SC 142

¹⁹ 1994 FSR 690

²⁰ 1994 Supp (3) SCC 215

*France*²², *Allied Blenders & Distillers v. Paul P. John*²³, *Roland Corpn v. Sandeep Jain*²⁴, *Delhivery P. Ltd v. Treasure Vase Ventures Pvt Ltd*²⁵, *Schering Corpn v. Alkem Labs*²⁶, *Radico Khaitan Ltd v. Calsberg India Pvt Ltd*²⁷, *Phonepe v. Ezy Services*²⁸, *AstraZeneca UK Ltd v. Orchid Chemicals & Pharmaceuticals Ltd*²⁹ and *S.K. Sachdeva v. Shri Educare Ltd*³⁰.

Analysis

36. The plaintiff has alleged, against the defendant, both infringement of the plaintiff's registered trademarks as well as passing off, by the defendant, of its product as that of the plaintiff.

The legal position

37. Infringement and passing off are, in law, distinct torts, the former being statutory and the latter arising from common law. This distinction finds statutory recognition in Section 27(2) of the Trade Marks Act, which engrafts a disclaimer that nothing in the Trade Marks Act "shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or services provided by another person, or the remedies in respect

²¹ (2008) 10 SCC 723

²² 166 (2010) DLT 12 (DB)

²³ 2008 (38) PTC 568 (Del) (DB)

²⁴ 277 (2021) DLT 677

²⁵ 2020 (84) PTC 179 (Del)

²⁶ 2010 (42) PTC 772 (Del)

²⁷ 2011 (48) PTC 1 (Del)

²⁸ MANU/DE/0775/2021

²⁹ ILR (2007) Del 874

³⁰ (2016) 65 PTC 614 (Del)

thereof.” An action for passing off is, therefore, independent of the Trade Marks Act.

38. Several judicial pronouncements have recognised the distinction between infringement and passing off. In *Satyam Infoway v. Sifynet Solutions Pvt. Ltd*³¹, the Supreme Court noted that an action for passing off is based on the goodwill that the trader has in the trade name, whereas an action for infringement is based on the trader’s proprietary right in the trade name. An action for passing off is intended, as per the said decision, to preserve the reputation of the plaintiff and to safeguard the public against being deceived into believing the goods of one person to be those of another. The *raison d’etre* of passing off is that one cannot carry on one’s business, or deal with one’s goods, so as to make the public believe that the business or goods belong to another. It is, therefore, intended as a means of protection against unfair competition.³² Passing off is, therefore, an action for deceit, which seeks to proceed against one who passes off one’s goods as those of another, whereas an action for infringement is a statutory remedy conferred on the proprietor of a registered trade mark, for vindication of his exclusive right to use the trademark in relation to the goods in respect of which it is registered.³³

39. Though an action based on deceit, fraud is not a necessary element to maintain a successful prosecution for passing off if, otherwise, it is clear that the defendant has imitated or adopted the

³¹ (2004) 6 SCC 145

³² Laxmikant V. Patel v. Chetanbhat Shah & Ors. (2002) 3 SCC 65, (2002) 3 SCC 65

³³ Kaviraj Pt. Durga Dutt (*ibid*); Cadila Health Care Ltd v. Cadila Health Care Ltd, (2001) 5 SCC 73

plaintiff's trademark, in a manner as would confuse the public into believing the goods of the defendant to be those of the plaintiff.³⁴ Passing off, therefore, requires proof of misrepresentation, even if not of intent.³⁵ Though the intent of the defendant is, therefore, not relevant for establishing an allegation of passing off, by the defendant, of its goods or services as those of the plaintiff, the intent may be relevant at the stage of final adjudication, to decide the relief to which the plaintiff would be entitled.³⁶ Passing off may, therefore, be alleged by a claimant who owns sufficient proprietary interest in the goodwill attached to the trade mark or name which is imitated by the defendant, and which is likely to be damaged by the alleged misrepresentation.³⁷ Proof of actual damage is, however, not necessary.³⁸

40. Different judicial authorities have delineated, differently, *albeit* with a large degree of overlap, the ingredients and indicia of passing off. The *troika* of the existence of a *prima facie* case, balance of convenience and irreparable loss, which classically governs grant of injunction apply, equally, to passing off.³⁹ ***Laxmikant V. Patel***³², relying on ***Oertil V. Bowman***⁴⁰, identifies the three determinative issues in adjudicating on a claim of passing off as (i) whether the plaintiff's product had come into existence prior to commencement of user by the defendant, (ii) whether the plaintiff had acquired goodwill in the property by the use of the mark in question and (iii) whether the

³⁴ *Wockhardt Ltd v. Torrent Pharmaceuticals Ltd. and Anr.*, (2018) 18 SCC 346, *Laxmikant V. Patel (ibid)*, *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683

³⁵ *Wockhardt (ibid)*, *Satyam Infoway (ibid)*

³⁶ *Wockhardt (ibid)*, *Satyam Infoway (ibid)*

³⁷ *Khoday Distilleries (ibid)*

³⁸ *Wockhardt (ibid)*, *Satyam Infoway (ibid)*, *S Syed Mohideen (ibid)*

³⁹ *Wockhardt (ibid)*, *Laxmikant V. Patel (ibid)*

⁴⁰ 1957 RPC 388 (CA)

disputed mark or getup had become distinctive of the plaintiff's goods or services. *Satyam Infoway*³¹ identifies the following ingredients of passing off:

- (i) There must be sale, by the defendant, of its goods/services in a manner which is likely to deceive the public into thinking that the goods/services are the plaintiff's.
- (ii) The plaintiff is not required to prove long user to establish reputation. Reputation could be established on the basis of the volume of the plaintiff's sales and the extent of its advertisement.
- (iii) The plaintiff has to establish
 - (a) misrepresentation by the defendant to the public, though it is not necessary to prove *malafide*,
 - (b) likelihood of confusion in the minds of the public, the public being potential customers/users of the goods/services in question, that the goods or services are those of the plaintiff, applying the test of "imperfect recollection of person of ordinary memory",
 - (c) loss, or likelihood of loss, and
 - (d) goodwill, possessed by the plaintiff as a prior user.

*Cadila Health Care*³³ defines passing off as (i) misrepresentation (ii) made by a trader in the course of trade, (iii) to prospective customers or ultimate consumers of goods or services supplied by him, (iv) calculated to injure the business or the goodwill of another (i.e. that such injury is reasonably foreseeable), (v) causing actual damage to the business or goodwill of the plaintiff, or which has the probability of doing so.

41. The Supreme Court held, in *Mahendra & Mahendra Paper Mills v. Mahindra & Mahindra* ⁴¹, that likelihood of confusion or deception is a matter to be determined by the Court, and no witness is entitled to depose in that regard. In examining the likelihood of causing confusion, the judgement held that the Court was required to consider, in conjunction, *inter alia*, (i) the nature of the market, (ii) the class of customers, (iii) the extent of reputation, (iv) the trade channels through which the goods or services were available and (v) existence of connection in the course of trade. In this process, the Court was required to assess the likelihood of deception of confusion by examining (i) the nature of the marks, i.e. whether they are word marks/label marks/composite marks, (ii) the degree of similarity between the competing marks, (iii) the nature of goods, (iv) the similarity in nature, character and performance of the goods of the parties, (v) the class of purchasers, and the degree of care which they would be expected to exercise while purchasing the goods or services and (vi) the mode of purchasing goods and placing orders.⁴²

42. Where a clear case of passing off is found to exist, *Laxmikant V. Patel*³² holds that, ordinarily, *ex parte* injunction is to be granted and a local commissioner appointed.

43. On the aspect of deceptive similarity, too, there is wealth of authority. The onus to prove confusion or deception is on the plaintiff

⁴¹ (2002) 2 SCC 147

⁴² *Mahendra & Mahendra (ibid)*, *Cadila Health Care (ibid)*

so alleging.⁴³ “Confusion” was perhaps most precisely defined by the Supreme Court, in *Cadila Health Care*³³, as meaning the state of mind of a customer who, on seeing a mark, thinks that it differs from the mark on the goods which he has previously bought, but it is doubtful whether the impression is not due to imperfect recollection. Following on this, the ingredients of confusion or deception have been set out in decision after decision. Even so, in *Khoday Distilleries*²¹, *Amritdhara Pharmacy*¹⁵ and *Cadila Health Care*³³, the Supreme Court has cautioned that the tests to be applied would depend on the facts of each case and that precedents, in such matters, are valuable only for the tests enunciated therein, and not on facts.

44. *Khoday Distilleries*²¹ holds that, in assessing deceptive similarity, the look, the sound and the nature of the goods are all relevant considerations. Surrounding circumstances are also, according to the said decision, relevant. The question, in each case, is that of first impression.⁴⁴ This is especially so in the case of phonetic similarity, where the Court must avoid a meticulous comparison of the words, syllable by syllable, and must provide for the effect of careless pronunciation and speech, on the part of the buyer walking into the shop as well as the shop assistant.⁴⁵ The matter has to be examined from the point of view of a person of average intelligence and imperfect recollection, assessing how such a purchaser would react to the trademark, and the association that he would form, and how he

⁴³ Kaviraj Pt Durga Dutt Sharma (*ibid*); *Cadila Health Care* (*ibid*)

⁴⁴ Mahendra & Mahendra (*ibid*), Corn Products (*ibid*), *Cadila Health Care* (*ibid*)

⁴⁵ *Cadila Health Care* (*ibid*), *F. Hoffman La-Roche v. Geoffrey Manners & Co. Pvt. Ltd*, (1969) 2 SCC 716, *Aristoc v. Rysta Ltd*, 62 RPC 65 (HL)

would connect the trademark with the goods which he purchases.⁴⁶ The issue has to be examined by viewing the situation in the course of legitimate use of the latter trademark in a market in which both the marks are assumed to be in use by traders.⁴⁷ The following classic test, as enunciated in the *Pianotist case*⁴⁸, has been approved, many times over, by judicial authorities in this country⁴⁹:

“You must take the two words. You must judge them, both by their look and by their sound. You consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

45. *K. R. Krishna Chettiar v. Shri Ambal & Co*⁵⁰ held that the Court is required to assess whether, if the two marks were used in a normal and fair manner, there was likelihood of confusion or deception. There are no objective standards possible, for the degree of similarity which is likely to cause deception and, in every case, the matter has to be examined from the viewpoint of the purchasers of the goods.⁵¹ The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark.⁵² On the applicability of phonetic and visual tests, to assess deceptive similarity, while *F. Hoffman-La Roche*⁴⁵ and *Cadila Health Care*³³ hold that both tests are required to be applied, *K. R. Krishna Chettiar*⁵⁰, as also *Cadila Health Care*³³

⁴⁶ *Mahendra & Mahendra Paper Mills (ibid)*, *Corn Products Refining Co (ibid)*, *Cadila Health Care (ibid)*

⁴⁷ *Amritdhara Pharmacy (ibid)*, *Cadila Health Care (ibid)*

⁴⁸ *Re. Pianotists Co's Application*, (1906) 23 RPC 774

⁴⁹ *Ref. Cadila Health Care (ibid)*, *Amritdhara Pharmacy (ibid)* and *F. Hoffman-La Roche (ibid)*

⁵⁰ (1969) 2 SCC 131

⁵¹ *Amritdhara Pharmacy (ibid)*, *Cadila Health Care (ibid)*, *Kaviraj Pt Durga Dutt Sharma (ibid)*

itself, hold that ocular similarity would be sufficient to base a finding of possibility of confusion or deception, even if the marks are visually dissimilar.

46. The two most important considerations, while examining the issue of deceptive similarity, have been identified, in *Amritdhara Pharmacy*¹⁵ as being (i) the persons whom the resemblance must be likely to deceive or confuse and (ii) the rules of comparison to be applied. Apart from this decision, the nature of the consumer who would be purchasing the goods, or availing the services, has been held to be a relevant consideration in several judicial pronouncements, including *J.R. Kapoor*²⁰, *Khoday Distilleries*²¹ and *Cadila Health Care*³³.

47. Section 17(1) of the Trade Marks Act confers, on the proprietor of a trademark which consists of several matters, consequent to its registration, the exclusive right to the use of the trademark taken as a whole. Section 17(2) clarifies the position by ordaining that, where a trademark (i) contains any part which is not subject of a separate application by the proprietor for registration as a trademark, or (ii) which is not separately registered by the proprietor as a trademark or (iii) contains any matter which is, to the trade or (iv) contains any matter which is otherwise offered non-distinctive character, the registration of the whole mark would not confer, on its proprietor, any exclusive right in a part of the registered mark. This principle stands reiterated, by the Supreme Court, in *Registrar of Trademarks v.*

⁵² Corn Products Refining Co (*ibid*), Amritdhara Pharmacy (*ibid*), Cadila Health Care (*ibid*)

Ashok Chandra Rakhit ⁵³. That the mark has to be considered as a whole, as a customer would ordinarily not split, into its components while trying to recollect whether he has seen that before, has been held in **Amritdhara Pharmacy**¹⁵ and **Cadila Health Care**³³. **F. Hoffman-La Roche**⁴⁵ holds that the test is whether the totality of the proposed trademark is likely to cause deception/confusion or mistake in the minds of persons accustomed to the existing trademark (the issue before the court in the said case was whether the proposed trademark deserved to be registered or not). **Amritdhara Pharmacy**¹⁵ and **Cadila Health Care**³³ also hold that the common part of words forming competing marks would not be decisive and that overall similarity of the composite words is required to be seen, having regard to the circumstances that the marks are on like goods of similar description.

48. The principle that exclusivity cannot be claimed over part of a composite mark (known, otherwise, as the “anti-dissection rule”) is, however, subjected to the exception that exclusivity can be claimed over a part of a composite mark, if that part is shown to be the dominant part of the mark. The “anti-dissection rule” is, therefore, subject to the “dominant part” test. The decision most often cited for this proposition, and which has been followed in several subsequent judgements, is the Division Bench pronouncement of this Court in **South India Beverages v. General Mills Marketing Inc.** ⁵⁴ .

49. Section 9⁵⁵ of the Trade Marks Act postulates absolute grounds

⁵³ AIR 1955 SC 558

⁵⁴ 2014 SCC OnLine Del 1953

⁵⁵ 9. Absolute grounds for refusal of registration –
(1) The trade marks –

on which an application for registration of a trade mark can be refused. Thus, marks which are not distinctive, which are common to the trade, or which are purely descriptive of the goods or services in respect of which they are used, cannot be registered. The proviso to section 9(1), however, engrafts an exception to this principle, by permitting registration of marks which have acquired a distinctive character owing to longevity of use, or which are “well-known trademarks” within the meaning of Section 2(1)(zg) of the Trade Marks Act. Thus, it was held, in *J.R. Kapoor*²⁰ that no exclusivity can be claimed over a descriptive mark, or even over a descriptive part of a mark. The Supreme Court in *F. Hoffman-La Roche*⁴⁵ and this Court in *Rhizome Distilleries*²² held, similarly, that no exclusivity could be claimed over laudatory, generic or common words. The effect of the proviso to Section 9(1) was, however, recognised by the judgement of the Division Bench of this Court in *Marico Ltd. v. Agro*

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- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
 - (b) which consist exclusively of mass or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the type of production of the goods or rendering of the service or other characteristics of the goods or service;
 - (c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, shall not be registered:

PROVIDED that a trademark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trademark.

- (2) A mark shall not be registered as a trademark if –
 - (a) it is of such a nature as to deceive the public or cause confusion;
 - (b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
 - (c) it comprises all contains scandalous or obscene matter;
 - (d) each use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.
- (3) A mark shall not be registered as a trademark it consists exclusively of –
 - (a) the shape of goods which results from the nature of the goods themselves; or
 - (b) the shape of goods which is necessary to obtain a technical result; or
 - (c) the shape which gives substantial value to the goods.

Explanation: For the purposes of this section, the nature of goods or services in relation to which the trademark is used or proposed to be used shall not be a ground for refusal of registration."

*Tech Foods Ltd.*⁵⁶, which held that a descriptive mark could also be registered if it had acquired a secondary meaning. Even so, the decision cautions courts to lean against treating a descriptive mark as distinctive, unless the mark had several years' longevity of usage, and was identified with one and one person alone.

50. The following judgements would serve to illustrate the practical applicability of the above principles:

(i) In *Laxmikant V. Patel*³², the plaintiff was running a colour studio under the name 'Muktajivan Colour Studio'. The defendant started a colour studio, a little distance away, using the same name 'Muktajivan'. The business of the plaintiff and defendant were identical. Intent to pass off the defendant's business as that of the plaintiff was, it was held, apparent. The argument that the defendant was unaware of the plaintiff's business was held to be irrelevant, as the case was clearly one of passing off. Injunction was, therefore, granted.

(ii) 'Sify' and 'Siffy' were held to be phonetically and visually similar, so that the mark 'Siffynet' was held to infringe the plaintiff's mark 'Sify'. The mere addition of the suffix 'net' after 'Siffy' would, it was held, make no difference.⁵⁷

(iii) In the case of the marks 'Gluvida' and 'Glucovita', it was held that there was likelihood of confusion, as the marks were

⁵⁶ 2010 (44) PTC 736 (Del)

⁵⁷ Satyam Infoway (*ibid*)

identical except for the single syllable ‘co’ between ‘Glu’ and ‘vita’ in the latter. The addition of this syllable, it was held, was insufficient to enable buyers to distinguish between the marks. Additionally, it was held that the case was one of idea infringement, as both marks conveyed the idea of glucose and vitamins, and their health benefits.⁵⁸

(iv) ‘Amritdhara’ and ‘Lakshmandhara’ were held to be deceptively similar, as both were used in connection with medicinal preparations, and, given their overall structural and phonetic similarity, consumers, who could be either illiterate or illiterate, were likely to be confused.⁵⁹

(v) In *K.R. Krishna Chettiar*⁵⁰, the Supreme Court was concerned with the use of the marks ‘Sri Ambal’ and ‘Sri Andal’, Andal and Ambal both being goddesses worshipped in the south of India. The marks were visually distinct, but were used in the context of the same product; (ironically), snuff. The Supreme Court held that there was likelihood of deception, as (a) the suffix ‘Sri’, in the two marks constituted the subsidiary part thereof, with the distinctive parts being ‘Ambal’ and ‘Andal’, (b) the marks were phonetically strikingly similar, (c) in such circumstances, visual distinction or difference, though it existed, was irrelevant, as the essential features of the marks were deceptively similar and (d) customers were unlikely, on seeing the marks, to recollect the difference between the two

⁵⁸ *Corn Products Refining Co (ibid)*

⁵⁹ *Amritdhara Pharmacy (ibid)*

deities Ambal and Andal.

(vi) In *F. Hoffman-La Roche*⁴⁵, however, the Supreme Court held that as the marks ‘Dropovit’ and ‘Protovit’ were used in the context of prescription drugs, there was little chance of confusion between them, as the drugs would be sold on prescription and the customer would also be on his guard.

(vii) ‘Mahendra & Mahendra’ was held, in *Mahendra & Mahendra Paper Mills*⁴¹, to be deceptively similar to ‘Mahindra & Mahindra’, despite dissimilarity in the goods in respect of which the marks were used, on the ground that, owing to extensive usage, the latter mark had acquired distinctiveness and a secondary meaning, and was exclusively associated with the appellant before the Supreme Court. Use of the former mark was, therefore, it was held, liable to dilute the goodwill in the latter. Injunction was, therefore, affirmed.

(viii) In *Khoday Distilleries*²¹, it was held that the mark ‘Peter Scot’, though not used in the context of Scotch whisky, was entitled to registration, as buyers of Scotch whisky were educated and niche, and would not be likely to be confused into believing that ‘Peter Scot’ related to a brand of Scotch whisky. It may be noted, however, that this was not a case of alleged infringement, but was in the nature of an action by the Scotch Whisky Association, opposing the registration of the mark ‘Peter Scot’ on the ground that the market could confuse customers into believing that the product was Scotch whisky.

(ix) The discerning nature of imbibers of alcoholic beverages (in that case vodka) was also held, by the Division Bench of this Court in *Diageo North America v. Shiva Distilleries*.⁶⁰, to obviate any possibility of confusion, by customers, between the marks ‘Smirnoff’ and ‘Brisnoff’. Besides, the marks were also found not to be phonetically similar.

(x) In *Nandhini Deluxe v. Karnataka Co-operative Milk Producers Federation Ltd.*⁶¹, the Supreme Court held that the use of the mark ‘Nandhini’, for restaurants, meat, fish, poultry etc., did not infringe the existing mark ‘Nandini’, which was used for milk, despite the phonetic similarity between the two marks, as (a) the services/goods in respect of which the marks were used were different, (b) both were generic words, one representing a cow and the other the name of a goddess, (c) the claim for registration for milk, in respect of the mark ‘Nandhini’, had been given up and (d) the marks were visually completely dissimilar.

(xi) ‘Micronix’ was held, in *J.R. Kapoor*²⁰ not to infringe ‘Microtel’, as (a) the logos were visually similar, (b) the suffix ‘micro’ was generic and descriptive of the microchip technology used in the products, over which no exclusivity could be claimed, (c) consumers of such products were discerning and would be able to distinguish between them and (d) if one were to ignore the suffix ‘micro’, the remainder of the

⁶⁰ 143 (2007) DLT 321

⁶¹ (2018) 9 SCC 983

two marks, i.e. ‘nix’ and ‘tel’ were dissimilar both phonetically and otherwise.

51. It is apparent, from a reading of the Trade Marks Act, that *actus reus*, and not *mens rea* alone, is necessary to constitute a tort of infringement. Equally does this principle apply to passing off. Deceptive – or, at the very least, confusing – similarity is the *sine qua non* both for infringement and passing off. *Absent* confusion or deception, there can, quite obviously, be neither infringement nor passing off.

52. Nonetheless, two important principles, which do not emanate directly from the Trade Marks Act but are obviously enunciated in furtherance of its objectives and to ensure its proper implementation, have evolved over a period of time. These are that (i) where there is clear imitation with an intent to deceive, the Court must not bend backwards to presume that the intent is not successful, and (ii) where there is intent to deceive, the Court must pay greater attention to the similarities between the competing marks, and avoid searching, instead, for dissimilarities. The former owes itself to the exhortation of Lord Lindley, LJ in *Slazenger & Sons v. Feltham & Co.*⁶² and the latter to the words of Justice Kekewich in *Munday v. Carey*⁶³.

53. Lindley, LJ, observed, in *Slazenger*⁶², thus:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the

⁶² (1889) 6 RPC 531

⁶³ (1905) R.P.C. 273

imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?"

54. Kekewich, J. spoke thus, in *Munday*⁶³:

"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."

55. Suffice it to state that both these principles have been applied by this Court in a plethora of judgements, with which I do not deem it necessary to burden this decision.

Applying the law

Infringement *qua* BLENDERS PRIDE mark

56. Applying the above legal principles, first, to the contention of the plaintiff that the defendant's mark 'CASINOS PRIDE' infringes the plaintiff's 'BLENDERS PRIDE' registered word mark, there is substance in the contention of learned Senior Counsel for the defendant that the plaintiff cannot claim exclusivity over the 'PRIDE' part of the mark. 'PRIDE', etymologically, merely denotes the quality of the product, especially when used in context with the preceding expression 'BLENDERS'. It is, therefore, *prima facie* laudatory in nature, apparently intended to signify the pride that the blenders would have in their product. That apart, it is a word of common usage, and cannot be treated as distinctive, or as being capable of distinguishing

the product of the plaintiff from that of any other manufacturer of whisky.

57. That being so, any claim for exclusivity over the ‘PRIDE’ part of the ‘BLENDERS PRIDE’ marks would be hit by Section 17(1) as well as 17(2)(b) of the Trade Marks Act. The right of the plaintiff, under Section 17(1) would be to the ‘BLENDERS PRIDE’ mark *as a whole*. Any claim to exclusivity over the ‘PRIDE’ part of the mark would be hit by Section 17(2)(b), as it is not distinctive in nature.

58. The law, as contained in the judicial authorities cited *supra*, permits a departure from this principle only where the part of the mark, in respect of which exclusivity is being claimed, is the dominant part of the mark. Though Mr. Hemant Singh has sought to contend that ‘PRIDE’ does constitute the dominant part of the ‘BLENDERS PRIDE’ mark, the contention is not easy to accept. The plaintiff has not placed any material on record which could lead to a *prima facie* conclusion that, over a period of time, the public has indelibly come to associate the ‘PRIDE’ suffix with the plaintiff’s product. The test of discerning the dominant part in a mark is, essentially, a ‘plain glance’ test. At a plain glance, if one part of the mark stands out over the others, it would constitute the dominant part of the mark. That, again, has to be assessed from the perspective of the man in the street, who intends to purchase the product, or avail the service. Else, if one part of the composite mark has, by dint of longevity of usage, become identified with the plaintiff, it could be treated as the dominant part of the mark. To apply the ‘dominant part’ test and, thereby, overcome

the Section 17 proscription against claiming exclusivity over a part of a registered mark, the Court must be able, definitively, to come to a conclusion that, in the perception of the customer of the goods, or the person availing the service, one part of the mark would stand out from the rest. Having said that, psychoanalysis is not the virtue of any judge, and the matter must, ultimately, rest with the dispassionate appreciation of the judge herself, or himself.

59. ‘PRIDE’ being a plainly generic, commonplace and laudatory expression in the ‘BLENDERS PRIDE’ mark, one would be inclined, rather, to treat the initial the ‘BLENDERS’ part of the plaintiff’s mark as the dominant part thereof, if at all. I say “if at all” because it is also apparent that, even as a whole, ‘BLENDERS PRIDE’ is purely descriptive of the plaintiff’s product, which is blended whisky.

60. For this reason, I am also unable to accept the submission, of Mr Hemant Singh, that the only purpose for anyone to use ‘PRIDE’ as a part of her, or his, mark, in respect of whisky, can be to imitate the plaintiff, and capitalize on the plaintiff’s goodwill. ‘PRIDE’ being a purely laudatory expression, the desire of any manufacturer, of any product, to use ‘PRIDE’ as a part of the trade name of the product is perfectly understandable, and the plaintiff just happens, in my opinion, to be one such manufacturer. It is clearly not open to the plaintiff to arrogate, to itself, all rights to use ‘PRIDE’ as a part of its brand name, qua whisky or otherwise.

61. Any attempt to claim exclusivity in respect of the ‘PRIDE’ part

of the plaintiff's 'BLENDERS PRIDE' mark, and allege infringement on the ground that another manufacturer is using a mark including 'PRIDE' as a part thereof, must necessarily fail.

62. Applying the *J.R. Kapoor*²⁰ test, once the common 'PRIDE' part of the plaintiff's and defendant's mark is ignored, the remaining part of the marks are totally dissimilar. It is obvious that there is no phonetic, visual or other similarity, between the 'BLENDERS' and 'CASINOS' parts of the plaintiffs and the defendant's marks. No case of idea infringement can, either, be said to exist. One does not blend in a casino, and blenders don't play dice.

63. Visually, too, there is no similarity in the 'BLENDERS PRIDE' device mark of the plaintiff and the 'CASINOS PRIDE' device mark of the defendant. This is obvious when the marks are viewed plainly. Indeed, Mr. Hemant Singh did not even seek to argue device mark infringement, insofar as the defendant's 'CASINOS PRIDE' mark was concerned, when viewed *vis-à-vis* the plaintiffs 'BLENDERS PRIDE' mark. The plea of infringement, by the defendant's mark, of the plaintiffs 'BLENDERS PRIDE' mark was *vis-à-vis* the plaintiffs 'BLENDERS PRIDE' word mark, and not *vis-à-vis* the plaintiffs 'BLENDERS PRIDE' device mark.

64. I am unable to convince myself that any case of infringement, by the defendant's 'CASINOS PRIDE' mark, of the plaintiffs 'BLENDERS PRIDE' mark, can be said to exist.

Infringement *qua* IMPERIAL BLUE marks

65. Even less convincing is the contention of Mr. Hemant Singh that the defendant's 'CASINOS PRIDE' bottle, label or packaging infringes the plaintiffs 'IMPERIAL BLUE' registered marks.

66. The plaintiff does not possess any registration in respect of the colours used in its 'IMPERIAL BLUE' mark, or in any individual part of the design, including the dome shape. "Mark" is defined, in Section 2 (m) of the Trade Marks Act as including "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof". It was open, therefore, to the plaintiff, to seek registration in respect of the combination of colours used in its label, or for the shape of its bottle. It has not done so. What it has obtained are registrations of the label in full, and the labelled bottle, as individual device marks. Any claim to exclusivity in respect of a part of such device marks may, therefore, again infract Section 17(2), as well as the law regarding 'anti-dissection', as there is precious little for the Court to hold, even *prima facie*, that the individual elements of the plaintiffs registered marks, such as the blue colour, the golden dome, or the arrangement of letters on the label, or even the shape of the bottle, have acquired secondary meaning over a period of time, or have become indelibly associated with the plaintiffs 'IMPERIAL BLUE' whisky.

67. One has, therefore, in examining the claim of infringement, by

the defendant's 'CASINOS PRIDE' mark, of the plaintiffs 'IMPERIAL BLUE' registered marks, to examine the marks as a whole, and cannot afford to concentrate on any individual feature of the plaintiff's mark, such as the blue colour or the golden dome shaped design, unless a *prima facie* view could be taken that the individual parts have indelibly come to be associated with the plaintiff's product.

68. Viewed thus, it cannot be said, *prima facie*, that the defendant's mark infringes the plaintiffs. For one, the name of the product, which figures prominently on the two labels, are entirely different, with the plaintiffs being 'IMPERIAL BLUE' and the defendants 'CASINOS PRIDE'. The name figures prominently on the label, and is by itself sufficient to hold that the labels of the plaintiff and the defendant are clearly distinguishable from one another. Besides, the arrangement of letters and overall appearance of the defendant's mark can also not be said to be deceptively similar to that of the plaintiff, especially where the names of the products are thus completely dissimilar. Viewed purely as rival trademarks, I am unable, *prima facie*, to hold that the defendants 'CASINOS PRIDE' infringes any of the plaintiffs 'IMPERIAL BLUE' marks.

69. Mr. Hemant Singh seeks to contend that the defendant's "CASINOS PRIDE" label copies the essential features of the plaintiff's "IMPERIAL BLUE" label. I am unable to accept the contention. The most "essential" feature in any label would be the name of the product. There is no similarity, whatsoever, between the

names, “IMPERIAL BLUE” and “CASINOS PRIDE”. Had the essential features of the label, “IMPERIAL BLUE” label been copied or duplicated in the “CASINOS PRIDE” label, so as to outweigh the differences, the distinction between “IMPERIAL BLUE” and “CASINOS PRIDE” might have ceded place. That, however, is not so. Barring the fact that the background of the “CASINOS PRIDE” mark is blue, and a thin golden dome shaped border is also present on the “CASINOS PRIDE” label, no other features of similarity rest between the labels. Usage, by the defendant of white lettering cannot be regarded, in my view, as copying of an “essential” feature of the plaintiff’s “IMPERIAL BLUE” mark. Be it noted, at the cost of repetition, that the plaintiff does not hold any separate trademark registration either regarding the blue colour or regarding the golden dome shaped border.

70. The claim, of the plaintiff, of infringement, by the defendant’s ‘CASINOS PRIDE’ mark, of the plaintiffs registered ‘BLENDERS PRIDE’ or ‘IMPERIAL BLUE’ marks cannot, therefore, in my view, *prima facie* sustain.

71. Which brings us to the issue of passing off.

72. Passing off, as noticed hereinabove, is a tort independent of the Trade Marks Act. It does not owe its identity to statute. It is essentially predicated on the prohibition, of any person, to pass off his goods or services as those of another. It is not, therefore, conditioned or corseted by any of the controls which exist in the Trade Marks Act

with respect to infringement. The Court is not required, therefore, while examining the claim of passing off, to feel itself bound by the specific ingredients of the tort of infringement, as statutorily contained in the Trade Marks Act.

73. A person is not permitted, in law, to pass off his goods, or services, as those of another. If the manner in which the person is marketing his product, especially the label or mark used by the person concerned, indicates an attempt to pass off its goods as those of another, a *prima facie* case of passing off exists. Though conclusive proof of *mens rea*, or *mala fide*, is not essential for succeeding in an action for passing off, a possibility of the defendants goods being regarded, by a customer of average intelligence and imperfect recollection, as emanating from the plaintiff's stable, must be found to exist. At the Order XXXIX stage, this finding, obviously, need only be *prima facie*.

74. Infringement is a mark specific tort, whereas passing off is product specific. Relief in an action for infringement is, therefore, aimed at protecting the mark whereas relief in an action for passing off protects the product and the goodwill and reputation commanded by the product. The comparison in an infringement case is, therefore, mark to mark, whereas the comparison, in a case of passing off, is, product to product. So long as sufficient factors are found to exist, as would indicate that the defendant seeks to pass off its product as that of the plaintiff, the tort of passing off stands committed. This act of passing off may be by use of a single mark of the plaintiff, a

combination of the plaintiff's marks, copying of the plaintiff's distinctive trade dress, or by any other means. For this reason, while it is not open, in an action for infringement, to allege that one mark infringes two marks, or vice-versa, it is always open to a plaintiff to show that, by combining distinctive features of different marks of its goods, the defendant is seeking to create an overall picture of association between the products of the defendant and the plaintiff so as to persuade a person of average intelligence and imperfect recollection to believe that the defendants' product emanates from the plaintiff.

75. When, with this legal position in mind, one views the defendants 'CASINOS PRIDE' label, the manner in which it is employed, and the manner in which the product is sold, it does appear, *prima facie*, that the defendant is seeking to create an association, in the mind of a customer of its product, with the plaintiff. The coincidences are just too many. The defendant has used the mark 'CASINOS PRIDE' while, incidentally, the mark of the plaintiff is 'BLENDERS PRIDE'. Again incidentally, the mark is used in the form of white colours on a blue background, similar to the colour combination in which the plaintiff packages and markets its IMPERIAL BLUE' whisky. Again, incidentally, the defendant's product also contains a golden dome shaped design, which is present on the plaintiff's label. The shape of the defendant's bottle is identical to that of the plaintiff. Though, viewed individually, these likenesses may not suffice to justify a conclusion even *prima facie* of infringement, by the defendant's 'CASINOS PRIDE' marks, as used

by it, infringes the plaintiff's 'BLENDERS PRIDE' or 'IMPERIAL BLUE' marks, the defendant has, as Mr. Hemant Singh correctly puts it, ingeniously combined features of the 'BLENDERS PRIDE' and 'IMPERIAL BLUE' marks of the plaintiff to create an overall label and packaging which, in the mind of a customer of average intelligence and imperfect recollection, who has earlier in point of time purchased the plaintiffs 'BLENDERS PRIDE' and 'IMPERIAL BLUE' beverages, and is aware thereof, is perilously likely to invite an inference of association between the defendant's product and of the plaintiff. Applying *Munday*⁶³, in view of the apparent dishonest intent of the defendant, the similarities between the defendant's and the plaintiff's labels would have to be accorded precedence over the dissimilarities. The intent of the defendant, therefore, to pass off its 'CASINOS PRIDE' whisky as that of the plaintiff appears, *prima facie*, to be apparent.

76. "CASINOS PRIDE" may not, therefore, infringe "BLENDERS PRIDE" within the meaning of Section 29 of the Trade Marks Act, *inter alia* because of the proscription contained in Section 17. The "CASINOS PRIDE" label, even as affixed on the bottle, may not, similarly, infringe the "IMPERIAL BLUE" marks of the plaintiff, again for want of imitation of a sufficient number of prominent essential features. The superimposition of the "CASINOS PRIDE" label on a trade dress which has the possibility of bringing to mind the plaintiff and its products, however, betokens an apparent intent to making the unwary customer believe that "CASINOS PRIDE" is perhaps a cheaper product from the plaintiff's brewery. Once such

intent is thus apparent, following the principle enunciated in *Slazenger*⁶², the Court would presume that the intention of creating, in the mind of the customer of average intelligence and imperfect recollection, the impression of an association between the Defendant's product and the plaintiff, or that the "CASINOS PRIDE" whisky is also manufactured by the plaintiff, is successful.

77. I am, therefore, *prima facie* of the view that a case of passing off, by the defendant, of its product as that of the plaintiff does exist, on the facts before the Court.

Conclusion

78. An interlocutory injunction, in terms of the relief sought in this application, shall, therefore, issue. The defendant, its directors, partners as the case may be, assignees in business, sister concerns, associates, agents, dealers, distributors, stockists are restrained from manufacturing, marketing, selling or exporting the IMFL manufactured by it under the impugned "CASINOS PRIDE" marks, reproduced in para 3 of this judgment, pending disposal of the suit.

79. The application is allowed accordingly.

C. HARI SHANKAR, J.

MARCH 2nd, 2022
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