

\$~J-1

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

Judgement reserved on **26.08.2020**
Judgement pronounced on **27.11.2020**

I.A. No. 6865/2020

in

+ **CS(COMM) 319/2020**

RB HEALTH (US) LLC AND ANR.Plaintiffs

Through Mr. Chander M. Lall, Senior
Advocate with Mr. Jawahar Lai
and Ms. Nancy Roy, Advocates.

versus

DABUR INDIA LTD.Defendant

Through Mr. Hemant Singh, Ms. Mamta
Jha, Mr. Manish Kumar Mishra
and Ms. Akansha Singh,
Advocates.

CORAM:

HON'BLE MR. JUSTICE RAJIV SHAKDHER

RAJIV SHAKDHER, J.:

TABLE OF CONTENTS

Preface.....	2
Background facts	3
Submissions on behalf of the plaintiffs.....	5
Infringement of design registrations obtained by the plaintiffs	6
Passing off.....	7
Submissions on behalf of Dabur: -.....	9
Reply to the charge of passing off.....	11
Analysis and reasons.....	14
Passing off.....	18
Conclusion	24

I.A. No. 6865/2020

Preface: -

1. The plaintiffs before me are seeking an injunction against the defendant from manufacturing, importing, marketing, advertising, promoting, selling and/or using plaintiff no. 1/RB Health (US) LLC's registered design i.e. design no. 271671, falling in class 28-02, in relation to a soap bar [hereafter referred to as the "subject design registration"].

1.1. There is the usual extrapolation of this prayer, which is, that an injunction is sought against the defendant in making use of any other design that combines RB Health (US) LLC's registered design in connection with the aforementioned activities.

1.2. Besides this, the plaintiffs also seek an injunction against the use of their tagline "be 100 % sure" and/or *qua* the trade dress/packaging as also the colour of the soap bar manufactured and/or sold by the defendant.

1.3. Along with the aforementioned reliefs, consequential reliefs for surrendering offending material, such as advertising leaflets, labels, pamphlets, etcetera and stock bearing the subject design registration, whether packed or unpacked, are also sought.

1.4. Before I proceed further, I may indicate that plaintiff no. 1/RB Health (US) LLC would, hereafter, be referred to as "RB (US)". Likewise, plaintiff no. 2/Reckitt Benckiser (India) Pvt. Ltd. would be referred to as "RB (India)" while the defendant/Dabur India Limited would be referred to as "Dabur". Collectively, though, wherever the context requires, RB (US) and RB (India) will be referred to as plaintiffs.

2. These interim reliefs are sought in aid of the suit, in which, a panoply of final reliefs are sought such as permanent injunction, rendition of accounts, damages, as also the relief for delivering up the offending goods.

2.1. However, what is at the heart of the matter, at least at this stage, are two aspects.

- i. First, as to whether or not Dabur has raised a credible challenge to the validity of the RB (US)'s registered design?
- ii. Second, as to whether Dabur, in using the offending trade dress, which includes the taglines, the colour of the packaging, the colour of the soap bar etcetera, has attempted to pass off the goods manufactured by it as those originating from the plaintiffs' stables, so to speak?

Background facts: -

3. Before I deal with the legal nitty-gritties, the following broad facts need to be noticed.

- i. RB (US) and RB (India) claim to be part of a multi-national going by the name Reckitt Benckiser PLC. It is averred that as a group they are into manufacture and sale of health and hygiene products which are sold under well-known brands such as "Dettol", "Harpic", "Lizol". While RB (US) is a company registered under the laws of State of Delaware, USA and, as indicated above, is the owner of the subject design registration, the authority to use the same, it is stated, has been vested in RB (India).
- ii. It is claimed that RB (India) is also *inter alia* in the business of manufacturing health care, home care and hygiene products. It is also averred that RB (India), amongst other products, manufactures Dettol soap bar.
- iii. Although, there is a reference to several registered designs, there are two sets of registrations which are relevant for the purpose of this case. The first set of registrations, which are relevant, are the design registrations for soap bar bearing numbers 229435 and 229436 falling

in class 28-02. These registrations, it is claimed, were obtained by the plaintiffs' group company on 21.05.2010, having a reciprocity date of 23.11.2009. The second design registration, which is relevant, is the subject registration which was obtained, as adverted to hereinabove, by RB (US) on 24.04.2015. The subject design registration [i.e. 271671] has a reciprocity date of 04.11.2014 and, as noticed above, falls in class 28-02.

4. Intermingled with these facts, are assertions by the plaintiffs, that the Dettol antiseptic liquid was first marketed in United Kingdom in 1933. The attempt, perhaps, is to link the liquid soap with the soap bar. It is also asserted that the sword device was adopted by the plaintiffs, insofar as India was concerned, in 1999-2000.

4.1. There is also an assertion to the effect that the plaintiffs adopted the tagline "be 100% sure" in 2003 and, likewise, the other tagline i.e. "everyday protection against wide range of unseen germs" in 2010. It is also averred by the plaintiffs that they adopted and started using the packaging for their soap product which contains an overlapping plus sign in 2010. There is also a reference to the fact that in 2014 the plaintiffs commenced the use of another tagline i.e. "protection from 100 illness causing germs".

4.2. It appears that the purpose behind making a reference in the plaint to the dates when the aforementioned taglines and packaging were adopted is to bolster their claim that Dabur is guilty of committing the tort of passing off.

5. It is in this background that the plaintiffs have approached this Court with the instant action and sought interim reliefs given the fact that Dabur has introduced a soap bar with the "offending shape and configuration", under the brand name "SANITIZE", on 30.07.2020.

5.1. The suit came up for hearing before the Court for the first time on 14.08.2020 when Mr. Hemant Singh entered appearance on behalf of Dabur. The plaintiffs were represented by Mr. Chander M. Lall, senior advocate. On that date, one of the issues which came to fore was whether or not there were known designs in public domain which were similar to the subject design registration.

5.2. Mr. Hemant Singh had, on that date, screen-shared the following two design registrations concerning Hindustan Unilever Limited [HUL].

S. No.	Design Registration Number	Class
1.	233189	28-02
2.	233190	28-02

5.3. Given the fact that Mr. Hemant Singh had alluded to the possibility of other known designs being in public domain [i.e. published] which were, according to him, similar to the subject design registration, a direction was issued to the Controller of Design to furnish certified/uncertified copies of such design registrations, if an application, in that behalf, was moved by either party. Besides the aforesaid direction, the usual directions of issuing summons in the suit and notice in the captioned application were also issued.

5.4. Thus, having regard to the urgency expressed by the plaintiffs, Dabur filed a short affidavit-in-reply to the captioned application.

5.5. The arguments in the captioned application were heard, thereafter, on various dates and the judgement was finally reserved on 26.08.2020.

Submissions on behalf of the plaintiffs: -

6. On behalf of the plaintiffs, Mr. Lall made the following broad submissions under the following two heads.

Infringement of design registrations obtained by the plaintiffs: -

- i. A comparison of the subject design registration and the Dabur's product (i.e. the soap bar) would show that Dabur's soap bar, if not identically shaped and configured, as the subject design registration, is an obvious and fraudulent imitation of the same. Consequently, Dabur is guilty of infringement or, more bluntly put, piracy, as envisaged under Section 22 of The Design Act, 2000 [in short "Designs Act"].
- ii. Once a *prima facie* case of infringement is established, ordinarily, an injunction should follow. The rationale being that design rights have a limited statutory timespan of 15 years. [See: *Telemecanique & Contols (I) Ltd. vs. Schneider Electric Industries SA*, 2002 (24) PTC 632 (Del)]
- iii. The stand of Dabur that the subject design registration is not significantly distinguishable from the known design or combination of known designs, as the plaintiffs are the owner of the 2009 design is flawed. [See: Section 6(4)(b) of the Designs Act.] This provision permits similar designs to be registered *albeit* by the same proprietor. Thus, the subject design registration cannot be invalidated only because it has features which are common with the 2009 design. The fact that RB (US) and RB (India) are part of the Reckitt Benkiser group of companies is sufficient to fulfil the requirement of common proprietor as provided in Section 6(4) of the Designs Act.
- iv. Dabur's reliance on the 2010 design registrations of HUL is futile for two reasons.
 - a) First, these designs were registered after the plaintiffs had obtained the 2009 design registration.
 - b) Second, the HUL registration of 2010 claim rights only in the colour or combination of colours applied to its product and not in its shape and configuration.

v. Dabur's reliance on third-party registrations made outside India prior to 2009 cannot help its cause for the following reasons:

- a) Firstly, the designs registrations relied upon are not similar to the 2009 design or the subject design registration of the plaintiffs.
- b) Secondly, the registrations made outside the country is not a ground available under Section 19 (1) (a) of the Designs Act for invalidating a design registered in India.
- c) Thirdly, the design registrations relied upon do not constitute prior publication.
- d) Lastly, there has been neither any publication nor has any evidence of publication made prior to 2009 been placed on record. [See: *Reckitt Benkiser India Ltd. vs. Wyeth Ltd.*, 2013 SCC OnLine Del 1096]

A. In support of this submission, it was argued that World Intellectual Property Organisation [WIPO] search report filed by Dabur does not disclose when the said organisation published the searches placed on record by Dabur along with its affidavit-in-reply. Countries publish only one view of the design registration for the purposes of search being carried out by the public at large which does not assist in reaching a conclusion as to whether or not that particular design is similar to any other design.

Passing off: -

7. The fact that Dabur is seeking to pass off its product as that of the plaintiffs' is evident from the following features which are exclusively associated with the plaintiffs' product. Dabur has, thus, committed a tort of passing off by slavishly adopting these features.

- i. Predominance of green colour packaging and label with elements of white colour.
- ii. The colour of the two soap bars which is orange.
- iii. The shape, contour and configuration of the soap bars.
- iv. The endorsement of the following taglines: “Be 100% Sure”; “Everyday protection against a wide range of germs”; “Germ protection for the whole family”; and “protection from 100 illness causing germs”.
- v. The sword device.
- vi. Distinctive smell.
- vii. The overlapping plus design both on the product and the packaging.

7.1. While one or more features which are associated with the plaintiffs’ product, if copied, may not amount to passing off, the usage of all features referred to hereinabove does establish dishonesty and deceit. The idea is to cause confusion in the mind of the consumer. [See: *N. Ranga Rao & Sons vs. Anil Garg*, 2005 SCC OnLine Del 1293]

7.2. It is obligatory on the part of a second comer to dress its product in a manner that steers clear of the charge that there is likelihood of confusion.

7.3. The assertion of Dabur that the taglines used by the plaintiffs being descriptive are not protected is erroneous. [See: *P&G Manufacturing Co. vs. Anchor Health and Beauty Care Pvt. Ltd.*, 2013 Indlaw DEL 1931; and *Ishi Khosla vs. Anil Aggarwal & Anr.*, 2007 (34) PTC 370]. This is de hors the submission that the taglines used by the plaintiffs are not descriptive of their product.

7.4. The submission advanced by Dabur that one of the registrations, which bears the tagline “Be 100% sure”, contains a disclaimer *qua* the same and, therefore, had lost its legal efficacy, is flawed, as it does not prevent the

plaintiffs from claiming common law rights. Notwithstanding the disclaimer, the plaintiffs would be entitled to sue for the tort of passing off in addition to infringement, provided other registrations bear no such disclaimer. [See: *Cadbury India Ltd. & Ors. vs. Neeraj Food Products*, 2007 (34) PTC 370]

7.5. The fact that there are other entities which manufacture and sell soap bars that bear the shape and configuration similar to the 2009 design and the subject design registration – does not foreclose the plaintiffs’ right to seek relief as these designs do not precede the aforementioned designs owned by the plaintiffs. [See: *Pankaj Goel vs. Dabur India Ltd.*, 2008 (38) PTC 49]

Submissions on behalf of Dabur: -

8. Mr. Hemant Singh, on the other hand, in opposition, made the following submissions.

- i. Dabur has not committed any design infringement, as alleged, or at all. The soap bar manufactured by Dabur bears the shape and configuration of publicly known designs which precede the subject design registration. The following designs have been in public realm prior to the subject design registration.

Name of entity	Design number	Registration date	Date of publication
Unilever	DM-012454	22.12.1988	28.02.1989
Unilever	DM/031/397	-	31.03.1995
HUL	233189	10.12.2010	27.01.2012
HUL	233190	10.12.2010	27.01.2012

- ii. Dabur actions are within the sphere of the “Gillette Defence” doctrine. In other words, if a defendant uses a design which is in public domain, it would not constitute infringement. [See: *Glaverbel vs. Dave Rose*, 2019]

(43) PTC 630; and *Sandeep Jaidka vs. Mukesh Mittal*, 2014 (59) PTC 234]

- iii. The subject design registration is invalid as it is neither novel nor original in view of the aforementioned prior designs. In this behalf, reliance was placed on Section 4 (a) and (c) read with Section 19 (1) (c) of the Designs Act.
- iv. The plea of invalidity *qua* a registered design can be raised by a defendant as a defence in a suit for infringement. The grounds for cancellation of registration available under Section 19 of the Designs Act can be invoked, as defence, in an action for design infringement. In this context, reference was made to the provisions of Section 22 (3) of the Designs Act.
- v. Design registration can be sustained, if challenged, if it is novel and original on the date of its priority. In the instant case, the design was registered in 2015 bearing a priority date of 04.11.2014.
- vi. The test of novelty is that the suit design must be substantially different in its visual appeal and effect when compared to an earlier known design. In other words, the suit design should not be merely a trade variant of an earlier known design. [See: *Baldev Singh vs. Shiram Footware*, 1997 (17) PTC 268]
- vii. The fact that the subject design registration is invalid is demonstrable, if regard is had to the 2009 registration. In this behalf, reference was made to the averments made in paragraph 32 of the plaint. In this context, it was also submitted that the best-case scenario for the plaintiffs is that the subject design registration is a trade variant of the 2009 design.
- viii. The attempt made by the plaintiffs to explain away the charge levelled against them that the subject design registration is only a trade variant of the 2009 design by placing reliance on Section 6 of the Designs Act, must

fail for the reason that the two designs are owned by separate juridical entities. In other words, since the proprietor/owner of the 2009 design and the subject design registration are not common, the saving provision, which is, subsection (4) of Section 6 of the Designs Act would not help the cause of the plaintiffs. Therefore, the logical corollary should be that the subject design registration is declared invalid on the ground of lack of novelty and/or originality when compared to the known design which, in this case, apart from other designs that are in public domain, is the 2009 design. [See: *Whirlpool v. Videocon*, 2014 (60) PTC 155 [Bom]; *Videocon v. Whirlpool*, 2012 SCC OnLine Bom 1171 (DB); and *Vodafone International Holdings BV v. Union of India & Anr.*, (2012) 6 SCC 613]

- ix. An interim injunction is not granted in a design infringement action if there is a credible challenge put forth with regard to its validity on the ground of lack of novelty. The subject design registration not being “substantially different” from earlier known designs, as is sought to be demonstrated by reference to other registered designs published both in India and abroad, the plaintiffs’ prayer for interim injunction ought to be rejected. [See: *Glaverbel S.A. vs. Dave Rose & Ors.*, 2010 SCC OnLine Del 308; *Baldev Singh vs. Shriram Footwear*, 1997 SCC OnLine Del 314; *Sandeep Jaidka vs. Mukesh Mittal and Another*, (2014) SCC OnLine Del 2970; and *Bharat Balar & Another vs. Rajendra Distributors & Others*, 2015-3-L.W. 292]

Reply to the charge of passing off: -

9. Passing off is an action in deceit. For the plaintiffs to succeed in such an action, it would have to establish a proprietary right in the impugned trademark. In this case, the plaintiffs have claimed that Dabur is guilty of passing off on account of similarity in the colour that the two competing packaging’s bear,

[which is, the colour green]; the colour of the soap bar [which is orange in colour]; and the use of generic and descriptive phrases or taglines. None of these features can be made subject matter of proprietary rights. There are only a limited number of colours available in the universe and, especially, in the sphere of soap bars which are promoted as disinfectants.

9.1. Likewise, the plaintiffs cannot, in law, claim proprietorship of generic or descriptive trademarks and taglines as they are common to the trade as also the English language.

9.2. Marks which are descriptive cannot be monopolised and, therefore, no passing off action will lie against its use. [*Marico Ltd. vs. Agro Tech*, 2010 SCC OnLine Del 3806]

9.3. Since the taglines or descriptive marks are not registered, therefore, no case of infringement can be made out by the plaintiffs. The mere fact that the label is registered does not give rights in the descriptive marks. In this behalf, reference was made to Section 17 of the Trade Marks Act, 1999 [in short “Trade Marks Act”].

9.4. An action for passing off would be maintainable only if the trademark used by the defendant or the overall get-up and trade dress is similar to the plaintiffs’ trademark or trade dress. The deception, must lead to confusion with regard to the origin of the goods. Thus, an allegation of passing off cannot be sustained where the defendant’s product can easily be distinguished. The present matter is one such case.

9.5. When the competing packaging and products are examined, it is clear that the only similarity is in the usage of the background colour [which is green] in respect of packaging and the colour of the soap which is orange. Both features

are common to trade. The aforesaid is evident if one were to peruse the following illustrations.

Extracts taken from pages 19 and 20 of the short reply affidavit filed by Dabur



9.6. Dabur itself has been using the green colour for its packaging in respect of soap bars manufactured and sold by it in the international market. Furthermore, the plaintiffs themselves have been using different colours for packaging their Dettol-brand soap bars and, therefore, the claim of exclusivity *qua* the green-colour is flawed.

9.7. The plaintiffs have failed to establish that the packaging used by them and the descriptive elements superimposed on it have acquired distinctiveness.

9.8. Dabur's soap bar is distinguishable from that of the plaintiffs' soap bar. This is discernible by having regard to Dabur's packaging. The packaging used bears the Dabur brand prominently leaving no scope for confusion in the minds of an ordinary consumer having imperfect memory. [See: *Kaviraj Pandit Durga Dutt vs. Navratna*, AIR 1965 SC 980]

9.9. The plaintiffs have failed to make out a *prima facie* for grant of injunction. Dabur has been in the business of manufacture and sale of soap bars in India since 2010. Dabur has attained, in a short time, a turnover of Rs. 6

crores on account of sales of “Dabur Sanitize” soap bar and, therefore, if injunction is granted, it would cause irreparable injury to its business interests.

Analysis and reasons: -

10. Having heard learned counsel for parties and perused the record, to my mind, what needs to be put, at the forefront, are two things. Firstly, a comparative chart of various design registrations. Secondly, the get-up/packaging/trade dress of the competing products.

COMPARATIVE TABLE OF THE PLAINTIFFS DESIGNS WITH PRIOR DESIGNS & DEFENDANT’S PRODUCT

Pffs’ design registration no. 229435 dt. 21.5.2010	Pffs’ design registration no. 229436 dt. 21.5.2010	Pffs’ design registration no. 271671 dt. 24.4.2015	Unilever Design reg no. DM/031 397 dt 28.11.1994 (Netherlands) Publ: 31.01.1995	Unilever Design reg no. DM/012 454 dt 22.12.1988 (Netherlands) Publ: 28.02.1989	Unilever Design registration no. 233189 dt 11.6.2010 (India) Publ: 27.05.2011	Unilever Design registration no. 233190 dt 11.6.2010 (India) Publ: 27.01.2012	Dabur Sanitize Soap

Extracts taken from pages 9 to 12 of the documents filed by the plaintiffs: -



11. The first table, which sets out prior publications of known designs, to my mind, *prima facie* establishes that there is a serious and credible challenge that the subject design registration is new or original. The principle feature of the subject design registration is the rounded corners and the two “dimples” on either side of the soap bars. The prior designs which were published by Unilever on 28.02.1989 and 31.01.1995 are similar to the subject design registration [as is apparent to an instructed eye]. The main features of the soap bars i.e. rounded corners and dimpled sides are apparent in both the subject design registration as also the aforementioned prior publications.

11.1. The prior publications concerning Unilever soap bar made on 28.02.1989 and 31.01.1995, thus, provide significant heft to Dabur’s claim that the subject

design registration is not validly registered if one were to bear in mind the provisions of Section 19(1)(b) and (c) read with Section 4(a), (b), (c) of the Designs Act.

11.2. The argument advanced on behalf of the plaintiffs that the WIPO search report does not disclose the date of publication is, on the face of it, incorrect.

11.3. Document - 2 filed with Dabur's short-affidavit-in-reply, which is, the extract from WIPO search report adverts to the date of the publication.

11.4. The submission of Mr. Lall that **registrations** of the known and similar designs made outside the country would not *ipso facto* lead to cancellation of designs registered in India under Section 19(1)(a) of the Designs Act unless such designs are registered in India as per the statutory protocol provided, in that behalf, is correct.

11.5. That being said, a design which is registered abroad can be protected, in India, provided an application for that purpose is made with the concerned authorities in India within a period of six (6) months from the date when the protection is sought *qua* the design in the United Kingdom or other convention countries or group of countries which are members of inter-governmental organisation. The applicant can be either the person who initially applied for protection of the design either alone or jointly with any other person. In such an eventuality, the applicant would be entitled to claim that the registration under the Designs Act is prior to other applicants and shall, thus, have the same priority date as the date of the application where it was first preferred [i.e. the country which falls within the ambit of Section 44].

12. However, insofar as **prior publication** is concerned, it should [if it is a design on paper] depict the shape or other features of the article which are clear to the eye.

12.1. The ocular impression should be the same as one would experience of the design-in-issue if it were to be applied to a physical object. If such a situation obtains, as it does, in this case, in my view, then, it would fall within the purview of Section 4(b) of the Designs Act.

12.2. In other words, the prior publication [in this case of Unilever] would fulfil the indicia of being in ‘tangible form’ or use prior to the date of filing. In the instant case, as noticed above, the Unilever designs were published on 28.02.1989 and 31.01.1995. These designs give the same visual impression which one would obtain when applied to the concerned article i.e. a soap bar. [See: *Reckitt Benkiser India Ltd. vs. Wyeth Ltd.*, 2013 SCC OnLine Del 1096]

13. Therefore, the argument advanced by Mr. Lall that the extracts from the WIPO search do not come within the scope of Section 4(b) of the Designs Act is untenable and, hence, rejected. The said provision, when read with Section 19(1)(b), and juxtaposed with the circumstances brought to fore in this case, at least at this stage, presents a credible challenge to the validity of the subject design registration.

14. At this juncture, I may also indicate that on behalf of Dabur, Mr. Singh had submitted that the assertions made in paragraph 32 of the plaint would, without more, establish that the subject design registration is neither new nor novel. The relevant extract from paragraph 32 of the plaint is set forth hereafter.

“32. On the aspect of shape comparison, it is submitted that for purposes of passing off, the test is of an ordinary and unwary customer with imperfect recollection, i.e. the test is of a man who may have seen the Plaintiff’s product at one given point of time and has a faint recollection of the former. **To such a person, the Defendant’s soap would be considered deceptively and confusingly similar to Plaintiff’s 2010 shape as well as the 2015 shape.** An unwary customer would largely be attracted by the overall outer shape of the two products with the unusual dimple/dip on both sides. It is submitted that none of the other soaps have this feature. Most soaps available in the market are either rectangular or rectangular with round/oval edges. None of the leading soaps in the market have the unique dimple/dip on both sides.”

[Emphasis is mine]

14.1. Mr. Lall, when confronted with this assertion in the plaint, sought refuge in the provisions of Section 6(4)(b) of the Designs Act. Based on the said provision, Mr. Lall argued that the Designs Act permits similar designs to be registered by the same proprietor. It was contended that the similarity of the subject design registration with the 2009 design would not invalidate the former.

15. In my view, this argument would hold well if the proprietor of the subject design registration and the 2009 design were the same person/entity. The proprietor of the subject design registration is RB (US) while the proprietor of 2009 design is Reckitt Benckiser (Overseas) Health Limited.

15.1. A design is a tangible asset, which, in law, can have only one proprietor as, in law, like any other asset, it would bear a value. None of the judgements cited by Mr. Lall rail against this proposition. The argument that the two designs are owned by a group of concerns which fall under the same corporate umbrella is not good enough to fall within the framework of Section 6(4)(b) of the designs Act.

16. Therefore, to my mind, this aspect as well presents a credible challenge insofar as the plaintiffs seek to invoke their statutory rights under the Designs Act *qua* the subject design registration.

Passing off: -

17. Passing off is a tortious action for deceit. For such an action to succeed, it must have, in the very least, the following three indicia's, commonly known as the "classical trinity". The said markers are articulated in what is commonly known as the Jiff Lemon case [*Reckitt & Colman Products Ltd. vs. Borden*

Inc., [1990] 1 All E.R. 873] and can, broadly, be paraphrased in the manner set forth hereafter.

- i. First, the plaintiff must be able to establish that it has the necessary goodwill and reputation in the goods sold or services offered to the consumers at large which in turn should be interlinked with the get-up in which they are proffered.
- ii. Second, the plaintiff must be able to demonstrate that the defendant's misrepresentation *qua* the goods or services offered by him have led consumers to believe that they originate from the plaintiff.
- iii. Third, that the action of the defendant has resulted in damage or is likely to result in damage on account of the misrepresentation of the defendant with regard to the origin of the goods and services.

17.1. The aforesaid principles were reiterated in *Consorzio Del Prosciutto Di Parma vs. Asda Stores Limited and Others*, [2001] UKHL 7; and *Harrods Limited vs. Harrodian School Limited*, 1996 RPC 697.

17.2. It is pertinent to note, while applying the first indicia set out hereinabove, the difference between reputation and goodwill has to be borne in mind. While goodwill is inextricably linked to territory, reputation may extend beyond the geographical area where business is carried out. [See: Kerley Law of Trademarks and Tradenames, 15th edition, paragraph 18-025, page 580]

17.3. Therefore, in a case, where a plaintiff institutes a passing off action, it is incumbent upon him to demonstrate that he has *inter alia* goodwill in the jurisdiction over which the concerned Court has sway.

17.4. The very same parameters have been adopted by this Court as well. In this behalf, see the following observations in *Rich Products Corporation &*

Anr. vs. Indo Nippon Food Ltd., 2010 SCC OnLine Del 734 [which were sustained by the Division Bench of this Court, *vide* judgement dated 20.09.2010, passed in RFA (OS) No. 37/2010].

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

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

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

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

18. In the instant case, what has come through is that the plaintiffs’ assertion that Dabur has committed the tort of passing off is, broadly, pivoted on the following three grounds.

- i. First, the colour, smell, configuration, and shape of the soap bar.

- ii. Second, the taglines used by the plaintiffs *qua* its products such as “be 100% sure”; “everyday protection against a wide range of unseen germs”; “germ protection for the whole family”; and “protection from 100 illness causing germs”.
- iii. Third, the device of a sword and an overlapping plus + design on the product/packaging.

18.1. Insofar as the first aspect is concerned which is the colour, shape, and smell of the soap bar – there is enough and more material to show that there are several soap bars in the market with similar features if not identical features.

18.2. Likewise, insofar as the second and third aspects are concerned, which pertain to, the use of taglines and indications by Dabur that are similar to those taglines and indications used by the plaintiffs – it is required to be noticed that neither the taglines nor the indications/signs are registered with the trademark authority. Since the competing products, like others products in the market, are hygiene-products, the taglines and indications/signs used by the plaintiffs appear to be “customary” in the “current language” of the trade for the purpose of designating hygiene-products which includes soap bars. [See: *Merz & Kreel GmbH & Co.*, Case C-517/99, European Court of Justice (2001)]

18.3. That being said, one cannot quibble with the proposition that taglines or indications/signs, over a period of time, by their constant use, can get embedded in the minds of the customer so as to remind them of the origin of the goods.

18.4. In other words, the taglines and indications/signs can, over a period of time, acquire a secondary meaning and/or significance whereby goods and services offered by the plaintiff can be distinguished from those of its competitors. This aspect, however, is a matter which falls in the realm of evidence. The evidence placed before the Court should be such which

demonstrates distinctiveness. [See: *Rich Products Corporation & Anr. vs. Indo Nippon Food Ltd.*, 2010 SCC OnLine Del 734]

18.5. The use of such taglines and indications/signs is not enough to establish distinctiveness. Therefore, financial figures placed on record with regard to sales turnover and advertising spend may point in the direction of the use of taglines and indications/signs but that, by itself, may not be enough to establish distinctiveness. [See: *British Sugar PLC vs. James Robertson & Sons*, 1996 RPC 281] The plaintiffs have not placed on record any surveys of customers, which would, at least *prima facie*, establish the distinctiveness of their taglines or indications/signs. I must add a caveat here that even surveys have to be looked at carefully, albeit, at the stage of trial as their outcome would be dependent on the sample and the quality of the questions put to the consumers.

19. It would be relevant to note that, at this juncture, there is no tangible material placed before me by the plaintiffs which would persuade me to hold that the taglines and indications/signs and other features referred to hereinabove remind the consumer of the plaintiffs' product.

19.1. Besides this, as alluded to hereinabove, passing off action is a tort of deceit and when one looks at the get-up adopted by Dabur, it is clear, at least at this stage, that it does not intend to misrepresent that the soap bar manufactured by it originates from the plaintiffs. The packaging boldly bears the mark "Dabur". The background colour is dark green as against the packaging of the plaintiffs which has a combination of white and light green. Dabur's packaging



bears a cross and a shield whereas that of the plaintiffs' bears a plus + sign.

19.2. To my mind, even if the test of “imperfect memory” is applied [which, in any case, cannot be pressed too far], it does not have me conclude, at least at this stage, that Dabur’s product could be confused with that of the plaintiffs’.

19.3. Clearly when a consumer buys defendant’s product, it cannot miss the word mark “Dabur”.

20. In my opinion, the cumulative effect of the packaging adopted by Dabur is one which seeks to distinguish its product from that of the plaintiffs’. It needs to be emphasized that insofar as the shape and configuration is concerned, the same is not apparent to the consumer till such time the packaging is removed.

21. It has to be borne in mind that when a Court adjudicates upon an infringement or a passing off action, it is required to take into account, not only the rights of the plaintiff and the defendant, but also the interests of the public at large. While the plaintiff is interested in preserving and protecting the investment made by her/him in the mark so that she/he can derive maximum gains, the defendant asserts a countervailing right, which is, to attract maximum number of consumers. The public, on the other hand, seek creation of an environment which is conducive to a healthy competition amongst manufacturers and sellers.

22. I may also indicate that in a passing off action, while precedents are good for the purposes of alluding to the established principles, most cases turn on the facts obtaining in the matter. The following observations in the *Jiff Lemon’s* case bring this aspect to the forefront, which practitioners and courts, need to bear in mind.

“Although your Lordships were referred in the course of the argument to a large number of reported cases, this is not a branch of the law in which reference to other cases is of any real assistance except analogically. ...”

22.1. Therefore, multiplying authorities will not take the matter any further. Each case, more often than not, especially, in a passing off action, turns on its own facts.

Conclusion: -

23. Therefore, for the foregoing reasons, I am not inclined to grant an injunction in favour of the plaintiffs and against Dabur.

24. The captioned application is, accordingly, dismissed.

25. It is clarified, though, that the observations made hereinabove will not impact the final adjudication of the case. Furthermore, Dabur will maintain an account of sales made (along with supporting documents) concerning its soap bar which bears the impugned design and get-up. The details and the accompanying documents, backed by an affidavit of an authorised representative, will be placed on the Court record, every quarter, till the final adjudication of the case.

RAJIV SHAKDHER, J

NOVEMBER 27, 2020

[Click here to check corrigendum, if any](#)

At 10:30 A.M.

Present: Ms. Nancy Roy, Advocate on behalf of the plaintiffs

Mr. Manish Mishra, Advocate on behalf of Dabur

CS(COMM) 319/2020

26. I am informed by Mr. Manish Mishra, who appears on behalf of Dabur, that the matter, in the usual course, is fixed before the Joint Registrar (Judicial) on 04.12.2020 for completion of pleadings.

27. Accordingly, let the suit be listed before the Joint Registrar (Judicial) on the aforementioned date. The Joint Registrar (Judicial) will ensure that the pleadings are completed and admission/denial of the documents is carried out by the parties before the matter is listed in Court.

28. List the matter before this Court on 02.03.2021. The date already fixed in the matter i.e. 02.12.2020 shall stand cancelled.

RAJIV SHAKDHER, J

NOVEMBER 27, 2020

[Click here to check corrigendum, if any](#)

