A

PARLE PRODUCTS (P) LTD.

v.

J. P. & CO. MYSORE

January 28, 1972

B

[C. A. VAIDIALINGAM, I. D. DUA AND G. K. MITTER, JJ.]

Trade and Merchandise Marks Act, 1958, s. 2(d)—'Deceptively similar'—Proper approach by court for determining if one mark is deceptively similar to another.

The appellants filed a suit for an injunction restraining the respondents C from infringing their registered trade mark used on packets of biscuits manufactured by them. The suit was dismissed by the trial court and the High Court.

Allowing the appeal to this Court,

HELD : (1) Under the Trade and Merchandise Marks Act, 1958, a registered trade mark is infringed by a person who uses, in the course of D trade, a mark which is identical with or deceptively similar to, the trade mark, in relation to any goods in respect of which the trade mark is registered; and the expression 'deceptively similar' means a mark which so nearly resembles another mark as likely to deceive or cause confusion. In order to come to the conclusion whether one mark is deceptively similar to another the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design, and if so, whether they are of such E character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. [292 B-D; 294 D-F]

In this case, the packets of biscuits manufactured by the appellants and respondents were practically of the same size, the colour scheme of the two wrappers was almost the same, and the designs on both, though not F identical, bore such a close resemblance that one could easily be mistaken for the other. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs' wrapper. Though the trial court and the High Court had concurrently found that the defendants' wrapper was not deceptively similar to that of the plaintiffs, the finding must be set aside as it G was not arrived at on a proper consideration of the law. [294 F-H]

Durga Dutt v. *Navaratna Laboratories* [1965] 1 S.C.R. 737 followed.

Kerly's Law of Trade Marks and Trade Names, 9th ed. para 838 referred to.

CIVIL APPELLATE JURISDICTION : C.A. No. 1051 of 1967.

H

Appeal by special leave from the judgment and decree dated July 5, 1966 of the Mysore High Court in Regular First Appeal No. 170 of 1963.

S. T. Desai and *I. N. Shroff*, for the appellant. A

S. K. Mehta and *K. L. Mehta*, for the respondent.

The Judgment of the Court was delivered by

Mitter, J. This is an appeal by special leave from a judgment of the Mysore High Court confirming the dismissal of a suit for an injunction restraining the respondent from infringing the registered trade mark of the plaintiffs used on packets of biscuits. B

The facts are as follows. The plaintiffs—appellants before us are manufacturers of biscuits and confectionery and are owners of certain registered trade marks. One of them is the word C "Gluco" used on their half pound biscuit packets. Another registered trade mark of theirs is a wrapper with its colour scheme, general set up and entire collocation of words registered under the Trade Marks Act 1940 as No. 9184 of 7th December, 1942. This wrapper is used in connection with the sale of their biscuits known as "Parle's Gluco Biscuits" printed on the wrapper. The D wrapper is of buff colour and depicts a farm yard with a girl in the centre carrying a pail of water and cows and hens around her on the background of a farmyard house and trees. The plaintiffs claim that they have been selling their biscuits on an extensive scale for many years past under the said trade mark which acquired great reputation and goodwill among the members of the E public. They claimed to have discovered in March 1961 that the defendants were manufacturing, selling and offering for sale biscuits in a wrapper which according to them was deceptively similar to their registered trade mark. The plaintiffs assert that this act of the defendant constitutes an infringement of their trade mark rights. As in spite of lawyer's notice the defendants per- F sisted in manufacturing, selling and using the wrappers complained of with regard to their biscuits, the plaintiffs filed the suit claiming injunction as already mentioned.

The defendants pleaded ignorance of the registration of the trade marks claimed by the plaintiffs. They denied that the wrapper used by them in connection with the sale of their biscuits was G deceptively similar to the plaintiffs' trade marks as alleged or that they had in any way infringed the trade mark rights of the plaintiffs. They pleaded further that there was a good deal of difference in the design of their wrapper from that of the plaintiffs and relied on certain features of their design which were said to be quite dissimilar to those of the plaintiffs' wrapper inasmuch as H the defendant's wrapper contained the picture of a girl supporting with one hand a bundle of hay on her head and carrying a sickle and a bundle of food in the other, the cows and hens being unlike

A those of the plaintiffs' wrappers. There was also said to be difference in the design of the buildings on the two wrappers and the words printed on the two wrappers were distinct and separate.

The trial court meticulously examined the features found on the two wrappers and the packets of biscuits produced before it B and took the view that there were greater points of dissimiiarity than of similarity between the two and as such it was unlikely that the defendants, goods could be passed off as and for the goods of the plaintiffs. After pointing out the distinguishing features of the wrappers, the trial court concluded that there was no chance of a seller committing fraud on a customer and an ordinary pur- C chaser would certainly refuse to purchase the defendants' goods if he was offered them as and for the plaintiffs' goods. Accordingly the trial court held that the plaintiffs had failed to establish their case.

Although the High Court held that in such a case it was not necessary for the plaintiffs to adduce evidence that any particular D individual had been deceived by the defendants' wrapper and it was undeniable that the general get up of the two wrappers was more or less similar, it went on to observe that the court had to bear in mind that it was dealing with packets of biscuits which were generally used by people of the upper classes, and a purchaser desirous of getting a packet of Parle biscuits would go and ask for the same as such, in which case there could be no E scope for deception; again the plaintiffs could have no cause for grievance if a purchaser was content to buy any biscuits which were offered to him by the shopkeeper. The High Court also took the view that there were several distinguishing features between the two wrappers and these could be noticed even from a distance. According to the High Court, the similarity in the F two wrappers lay in the facts that both were partly yellow and partly white in colour and both bore the design of a girl and some birds. "But" the High Court said "there the similarity ends. The lady in the wrapper used by the plaintiff company has a pot on her hand while the lady in the wrapper used by the defendant has a hay-bundle on her head. In fact, they are not identical G in features. In the defendants' wrapper we have got a cow and in the plaintiffs' wrapper we have got two calves. The upper portion of the defendants wrapper is not similar to that of the plaintiffs' wrapper." The High Court went on to comment:

> "It is true that in a passing off action, one is not to look to minor details but must take into consideration H the broad features. Even if we take the broad features of the two wrappers into consideration, we do not think that they are similar. At any rate, they are not so similar as to deceive an ordinary purchaser of biscuits."

With due respect to the learned Judges of the High Court, we are constrained to remark that they fell into an error. The plaintiffs' marks were registered under the Trade Marks Act, 1940 which was however repealed by s. 136 of the Trade and Merchandise Marks Act, 1958. Under sub-s. (2) of the said section any registration under the Act of 1940 if in force at the commencement of the Act of 1958 was to continue in force and have effect as if made, issued and given under the corresponding provisions of the Act of 1958. Under s. 21(1) of the Act of 1940 the registration of a person in the register as proprietor of a trade mark in respect of any goods gave to that person the exclusive right to the use of the Trade mark in relation to those goods and that right was to be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, used a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it was registered. Under s. 28(1) of the Trade and Merchandise Marks Act, 1958 the registration of a trade mark in Part A or Part B of the register gave to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods in respect of which the trade mark was registered and to obtain relief in respect of the infringement of the trade mark in the manner provided by the Act. Under s. 29(1):

> "A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user thereof using by way of permitted use, uses in the course of a trade a mark which is identical with, or deceptively similar to, the trade mark, in relation to any goods in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark."

The expression "deceptively similar" has now been defined under s. 2(d) of the Act of 1958 thus:

> "A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;"

It is to be noted that although there was no such provision in the definition section of the Act of 1940 s. 21(1) of the said Act was to the same effect. The Indian Trade Marks Act of 1940 was based on the English Trade Marks Act, 1938 and s. 21 of the Act of 1940 was more or less similar to s. 4 of the English Act of 1938.

A To decide the question as to whether the plaintiffs' right to a trade mark has been infringed in a particular case, the approach must not be that in an action for passing off goods of the defendant as and for those of the plaintiff. According to this, Court in *Durga Dutt* v. *Navaratna Laboratories*(1):

> B "While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the C use of the trade mark in relation to those goods (vide s. 21 of the Act). The use by the defendant of the trade mark of the plantiff is not essential in an action for passing off, but is the *sine qua non* in the case of an action for infringement."

D In the above case the Court further pointed out :

> "In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court E reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his F goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the G plaintiff."

According to Karly's Law of Trade Marks and Trade (9th edition paragraph 838) :

> "Two marks, when placed side by side, may exhibit many and various differences vet the main idea left on H the mind by both may be the same. A person acquainted with one mark, and not having the two side by side

(1) [1965] 1 S.C.R. 737, 754

for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own."

It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluco Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. Afterall, an ordinary purchaser is not gifted with

A the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the Bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points
B there was similarity and in how many others there was absence of it.

It was argued before us that as both the trial court and the High Court had come to the same conclusion namely, that the defendants', wrapper was not deceptively similar to the plaintiffs', the finding is one of fact which should not be disturbed by this
C Court. Normally, no doubt this Court does not disturb a concurrent finding of fact. But where, as here, we find that the finding was arrived at not on proper consideration of the law on the subject it is our duty to set the same aside on appeal.

In the result, we hold that the defendant had infringed the
D registered trade mark of the plaintiff and the suit of the plaintiff should be decreed and an injunction granted restraining the defendant-respondent from selling or using in any manner whatsoever biscuits in wrappers similar in appearance to the registered trade mark of the plaintiffs on their packets. The appellants will be entitled to their costs throughout.

E V.P.S. *Appeal allowed.*