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IN THE HIGH COURT OF KARNATAKA AT BENGALURU

DATED THIS THE 28TH DAY OF SEPTEMBER, 2021

PRESENT

THE HON'BLE MR.JUSTICE ARAVIND KUMAR

AND

THE HON'BLE MR. JUSTICE PRADEEP SINGH YERUR

COMMERCIAL APPEAL NO.105/2021

BETWEEN:

ITC LIMITED
A COMPANY WITHIN THE MEANING
OF COMPANIES ACT, 2013
HAVING ITS REGISTERED OFFICE
AT 37, J.L.NEHRU ROAD
KOLKATA - 700 071

AND OFFICE OF ITS FOOD
DIVISION AT:
18, BANASWADI MAIN ROAD
MARUTHI SEVA NAGAR
BENGALURU 560 005

REPRESENTED BY ITS
DULY CONSTITUTED ATTORNEY
AND FINANCE MANAGER - SOUTH
TRADE MARKETING & DISTRIBUTION
MR.HARSH BAID
AGED ABOUT 32 YEARS
SON OF MR.JUGRAJ BAID

...APPELLANT

(BY SRI. K.G.RAGHAVAN, SENIOR COUNSEL A/W
MR.DHARMENDRA CHATUR, ADVOCATE, SANJANTHI
SAJAN POOVAYYA & CO, ADVOCATES)

AND:

CG FOODS (INDIA) PRIVATE LIMITED
A COMPANY WITHIN THE MEANING
OF COMPANIES ACT, 2013
HAVING ITS REGISTERED OFFICE
AT 434, UDYOG VIHAR,
PHASE III, GURUGRAM - 122016
HARYANA

ALSO HAVING OFFICE AT:
NO.35/4, KVR BUILDING
2ND CROSS, 3RD MAIN
NEW THARAGUPET
BENGALURU 560 002.
REPRESENTED BY ITS
MANAGING DIRECTOR

...RESPONDENT

(BY SRI.DHYAN CHINNAPPA, SENIOR COUNSEL A/W
SRI LOMESH KIRAN N, SRI ABHINAV V & SRI TEJAS,
ADVOCATES)

THIS COMMERCIAL APPEAL IS FILED UNDER SECTION 13(1A) OF THE COMMERCIAL COURTS ACT, 2015 READ WITH SECTION 104 AND ORDER XLIII RULE 1(r) OF CPC PRAYING TO SET ASIDE THE COMMON ORDER ON I.A.NOS.1 TO 3 DATED 22.06.2021 (ANNEXURE-A) PASSED IN COMMERCIAL O.S.NO.177/2021 BY THE LEARNED LXXXIV ADDITIONAL CITY CIVIL AND SESSIONS JUDGE, BENGALURU AND CONSEQUENTLY ALLOW I.A.NO.1 AND I.A.NO.2 FILED BY THE PLAINTIFF/APPELLANT UNDER ORDER XXXIX RULES 1 & 2 READ WITH SECTION 151 CPC IN RESPECT OF PASSING OFF AND COPYRIGHT INFRINGEMENT RESPECTIVELY, AND ALSO DISMISS I.A.NO.3 FILED BY THE DEFENDANT/RESPONDENT UNDER ORDER XXXIX RULE 4 READ WITH SECTION 151 CPC.

THIS APPEAL BEING HEARD AND RESERVED FOR JUDGMENT, COMING ON FOR PRONOUNCEMENT THIS DAY, **ARAVIND KUMAR J.**, DELIVERED THE FOLLOWING:

JUDGMENT

This is a plaintiffs appeal in a suit for passing off and copyright infringement, challenging the common order dated 22.06.2021 passed by LXXXIV Additional City Civil and Sessions Judge, Commercial Court, Bengaluru (for short 'trial judge') on I.A.Nos.I to III in O.S.No.177/2021, allowing the defendant's application (I.A III) for vacation of ex-parte interim order and refusing to grant the relief of temporary injunction on the applications (I.A.No.I and I.A.II) filed by the plaintiff.

2. The plaintiff had filed I.A.I seeking to prevent the defendant from passing off defendant's wrapper as that of the plaintiffs. I.A II had been filed to temporarily injunct the defendant, pending completion of suit, from using a wrapper which has the effect of infringing the plaintiff's copyright in its (plaintiffs) wrapper.

3. Though matter is listed for admission, by consent of learned Advocates, the appeal is admitted and is taken up for final disposal, since hearing the

interlocutory applications filed along with appeal is as good as hearing the appeal on merits.

4. For purpose of convenience, the application is referred to as 'plaintiff' and respondent as 'defendant'.

5. The brief facts relevant or preface for the present dispute are crystallized herein below :

Plaintiff has stated in the plaint that it is one of India's largest business conglomerates, having diversified presence across industries such as cigarettes, Fast Moving Consumer Goods, hotels, packaging, paperboards and specialty papers and agribusiness. It is stated to have launched itself into the manufacturing and sales of 'instant noodles' in September 2010, under the brand name, '**Sunfeast YiPee!**' and plaintiff manufactures, markets and sells under said brand different variant of noodles, including 'Magic Masala', 'Mood Masala', 'Classic Masala', to name a few. Plaintiff claimed protection from alleged misrepresentation and copyright infringement in respect of the 'overall visual appearance' (wrapper) of 'Magic Masala' variant of

Sunfeast Yippee noodles. The wrapper of "Sunfeast Yippee Magic Masala" has the following look on the wrapper:



6. The defendant has pleaded in its written statement that it is an Indian company, established in the year 2002 and is engaged in the business of manufacturing, supplying, and exporting food products. The defendant-company is part of the global conglomerate – CG Corp. Global, which is considered to be a leading player in the FMCG and packaged foods segment. The defendant claims that it carries on its business globally in the instant noodles market under the brand name '**WAI WAI**'. It claims to manufacture two types of noodles – ready to eat noodles (white noodles) or brown noodles.

7. The plaintiff alleges that the wrapper adopted by the defendant for packaging, one of its white-noodles product, 'WAI WAI Xpress Noodles Majedar Masala' is deceptively similar or nearly identical to its (plaintiff's) wrapper used for packaging 'Sunfeast Yippee Magic Masala' brand of noodles. Plaintiff claims that the action of the defendant has caused damage to its goodwill and reputation in the market and as such defendant has to be restrained from using same.

8. The visual appearance of defendants wrapper is captured below :



It is in this narrow factual setting, that the plaintiff has sued defendant and it bases its cause of action in passing off and copyright infringement.

9. Before we proceed to consider the submissions of the parties, it would be helpful to state facts which are not in dispute in the present appeal. The defendant does not dispute that the plaintiff commenced operations for sale of its 'Magic Masala' variant of Sunfeast Yippee noodles in 2010 and is therefore, admittedly, the prior user. The use of an image of a bowl of noodles on the defendant's packet is not objected to by the plaintiff – as it is descriptive of the contents of the packet and therefore, common to the trade.

10. We have heard Sri K G Raghavan, learned Senior counsel appearing on behalf of appellant-plaintiff and Sri Dhyan Chinappa, learned Senior counsel appearing for respondent-defendant.

CONTENTIONS OF THE PLAINTIFF :

11. Sri K.G Raghavan, learned Senior counsel appearing for appellant-plaintiff submitted, at the very

outset, that the entire case depends on a combination of visual impression and judicial estimation of the effect likely to be produced, when a person of 'average intelligence and imperfect recollection' is likely to see the whole visible external appearance (what is popularly referred to in the IP industry as the 'get up') of the two competing wrappers. His principal contention is that, an ordinary purchaser would be misled into purchasing a pack of **Wai Wai X-Press Majedar Masala** noodles instead of their own **Sunfeast Yippee Magic Masala** brand of noodles on account of the similarity in the general appearance of the competing wrappers. Having taken us through the essential features of the plaintiff's wrapper and then through the allegedly strong similarities in the defendant's wrappers, it was contended by learned senior counsel that extent of similarity is sufficient to 'deceive' that class of persons who are likely to buy plaintiff's goods. Elaborating further, he has argued that noodles, as an article of sale, is a 'low involvement product' – that noodles-purchasing decisions are often quick and impulsive; and purchasing

public would not be 'brand conscious', as some might be when purchasing a car or other luxury items. According to him, the class of persons who form their core consumer base is extremely wide-netted – it includes persons of all age categories (without any exclusion for economic or social reasons)– that is to say, children, teens and adults. Hence, the standard person to be considered, in assessing the probability of deception, has to be a an ordinary unwary purchaser who is neither too careful nor too careless.

11.1. Learned Senior counsel has been fair in conceding that, in law, an appeal against a discretionary order is an appeal on principle, the appellate Court having a narrow scope to interfere or substitute its own discretion to that of the trial Court. Yet, learned Senior counsel appearing for appellant has attempted to make out a case for allowing this appeal, by attacking the correctness of the findings recorded by commercial court under the impugned order, to which we shall make more detailed reference later. According to him, the court below has fallen into error on a matter of principle in so

far as it has laid emphasis on the 'dissimilarities' between the competing wrappers, instead of estimating the effect of the similarities. In support of his contentions, he has relied upon the following judgments:

- (1) **(2002) 3 SCC 65**
LAKSHMIKANT V. PATEL vs CHETABHAI
SHAH & ANR
- (2) **(2004)3 SCC 90**
MIDAS HYGINE INDUSTRIES vs SUDHIR
BHATIA
- (3) **(2003) SCC ONLINE DEL 1005**
COLGATE PALMOLIVE COMPANY vs
ANCHOR HEALTH AND BEAURY CARE
PVT LTD
- (4) **2018 SCC ONLINE DEL 10823**
MARICO LIMITED vs MUKESH KUMAR
- (5) **(2001) 5 SCC 73**
CADILA HEALTH CARE LIMITED vs
CADILA PHARMACEUTICALS LTD.

CONTENTIONS OF THE DEFENDANT :

12. Per contra, Sri Dhyan Chinappa, learned Senior counsel appearing for defendant contends that 'perception' is the crux of this entire issue. He contends that the test for estimating the likelihood of deception, is a combination of different factors. Each of the factors must be put to scale for arriving at a nearly accurate

estimate of the 'likelihood of deception'. The extent of similarities, the circumstances of the sale, the persons to be considered, the distinguishing features of the defendant's wrappers are all relevant circumstances and must be accounted for in the ultimate analysis. He would also contend that the most important feature in a product of this kind, containing a 'composite mark' (includes get up, visual marks, labels, symbols, logos, devices and verbal marks) is the 'brand name' or generally speaking, the 'verbal mark'. He would contend that the so-called ordinary purchaser must be kept in mind and in his opinion, the said purchaser is more likely to identify the packet he wants to purchase through a verbal mark such as the brand name, rather than rely on the colour-scheme or the general get-up, for source identification. He has further contended that get-up on a package or wrapper is of secondary significance when the brand name and other verbal marks are quite visibly embossed in distinct scripts and designs. He would submit that on the other hand, if the verbal name were to be similar, phonetically or visually, then

even a high level of differentiation in the get up will not be sufficient to obviate confusion. The 'ordinary purchaser', according to Mr. Chinappa, is not the one who goes to a shop and asks for a pack of 'noodles', without displaying any concern for the article he wishes to buy. An ordinary purchaser can be said to be 'deceived', when he asks for or is looking for 'Yippee' noodles, he is given or picks up 'Wai Wai' noodles instead. However, he fairly admits that Sri Raghavan, learned Senior counsel appearing for plaintiff is correct, on the proposition that sufficiency of similarities and not dissimilarities is the relevant test for likelihood of deception. He contends that the 'sufficiency of similarity' analysis cannot be done without looking at dissimilarities as well. He has elaborated this point with the assistance of an illustration namely, he would submit that if the offending mark were to contain 3 similarities and 7 dissimilarities, then the Court cannot ignore the 7 dissimilarities and decide only on the basis of the similarities. The competing wrappers must be evaluated as a 'whole', the plaintiff cannot dissect out to

its convenience and claim similarity in particular features, ignoring the dissimilarities in other features. He contends that competing products in a certain industry would have common features which are either generic or descriptive of the product in question and it is inevitable. Elaborating on this, he submits that the image of the 'noodles' is common to the trade and is a descriptive mark; the emoji/cartoon found on defendant's wrapper is a usual feature on packages of similar kind; the plaintiff's orange-red colour-scheme is not something peculiar to the plaintiff only and several other wrappers have adopted a similar colour scheme. In this background, he submits that, on an overall consideration of the competing wrappers, after ignoring the descriptive marks and marks common to trade, it is the 'brand names' that is really distinctive of the plaintiff and since the brand names are completely dissimilar, there is no likelihood of confusion. If the plaintiff's case is that the colour scheme has been copied to the extent that it may lead to confusion, the plaintiff will have to show that the 'orange-red' colour scheme has acquired

such a high level of distinctiveness in the market, that the ordinary purchaser would ignore all other features and rely solely on the colour scheme to identify the products of the plaintiff. He has further argued that plaintiff has taken contradictory stands on the question of the essential features of its wrappers and has drawn the attention of this court to the order passed by Madras High Court, in which, essential feature claimed by the plaintiff was the verbal mark 'Magic Masala'; whereas in Karnataka, against a different defendant altogether, the essential feature claimed now is the entire face of the wrapper. In support of his contentions, he has relied upon the following judgments:

- (1) **CS COMM NO.10/2019 BEFORE DELHI HC**
SURYA FOOD AND AGRO LIMITED
Vs. V. OM TRADERS
- (2) **FAO (OS) COMM NO.77/2016 BEFORE DELHI HC**
BRITANNIA INDUSTRIES V. ITC LIMITED
- (3) **FAO OS 549/2011, Delhi High Court**
CARLSBERG INDIA PVT. LTD vs RADICO
KHAITAN LTD.
- (4) **(2000) SC ONLINE CAL 536**
KUBER KHAINI PRIVATE LIMITED vs
PRABHOODLAL RAMRATAN DAS

(4) **(1978)4 SCC 118**
RG ANAND V. DELUX FILMS

REPLY ARGUMENTS:

13. In his rebuttal arguments, Sri Raghavan, learned Senior counsel has invited attention of the court to the case of **COLGATE PALMOLIVE COMPANY vs ANCHOR HEALTH AND BEAUTY CARE PRIVATE LIMITED** reported in **2003 SCC ONLINE DEL 1005** to contend that the Courts have interfered and injuncted defendants from using products, where even though the brand name was distinct, the colour scheme and overall get up was likely to confuse the purchaser. He asserts that the defendant has taken a calculative step to adopt an appearance, deceptively similar to the plaintiff's product - Magic Masala (brand of noodles) as it has been selling like hot cakes in the market. The orange-red colour 'Magic Masala' brand of noodles hogs a market share of 24% out of the total market share of Sunfeast Yippee Noodles which is approximated to be about 24.6%. It is in this context, he contends that the Court

must evaluate the defendant's wrapper and draw an inference of an intention to deceive adopted by defendant. To a pointed query raised to him on this issue, Sri Raghavan has fairly admitted that dominant feature of the composite mark is the 'entire visible appearance' of the package. He has further stated that the consuming public is not aware of brands like 'Wai Wai' or 'Yippee' – all they are concerned with is the general visual impression. He submits that the plaintiff takes no objection to the use of the image of the bowl of noodles in the pack. The main grievance reiterated is, that of copying the colour scheme, its constitution and arrangement of the features in the composite mark on the defendant's product-wrapper.

14. During the course of arguments, learned Senior counsel appearing for both parties have relied upon number of authorities. The authorities produced in written form greatly exceed the orally cited authorities. Learned Senior Counsel have been fair in submitting that they do not expect this court to consider every authority cited, but to be guided by the time-tested

principles laid down therein, the source of, almost all of which, goes back to the common law developed by the erudite and scholarly judges of the United Kingdom. For it can be said without the slightest degree of hesitation, that the ultimate decisions, especially in actions for passing off, turns on 'perception and visual appreciation' – something which can vary greatly, from person to person, thereby making it unsafe to rely on factual conclusions. Yet, this court has made every attempt to consider the case laws orally cited during the course of our order.

15. In the backdrop of the rival contentions raised by learned Senior Counsels, the following issues emerge for consideration at the hands of this Court.

"(1) Whether the impugned order passed by the Commercial court requires to be re-looked into by this court in appellate jurisdiction by re-appreciating the facts?

(2) Whether, having regard to the principles for grant of temporary injunction,

the defendant's wrapper can be said to be a material misrepresentation of the plaintiff's wrapper?

(3) Whether the defendant's wrapper can be said to have infringed the copyright that exists in the packaging of the plaintiff's wrapper?

(4) Whether the impugned order of the trial judge can be said to be arbitrary, perverse and against settled principles of law?

RE:POINT (1):

16. In an appeal against exercise of 'discretion' by the court of first instance, the power of the appellate court to interfere with the exercise of discretion is restrictive. Merely because, on facts, the appellate court would have concluded differently from that of the court below, that would not, by itself, provide justification for appellate court to interfere. To justify interference, the appellant would have to demonstrate that the discretion has been shown to have been exercised arbitrarily, or

capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against the exercise of discretion is an appeal on principle. [See **Wander Ltd. & Anr. v. Antox India P. Ltd. 1990 (Supp) SCC 727; Skyline Education Institute (India) Private Ltd. ((2010) 2 SCC 142]**

17. In order to persuade us to interfere with the order of Commercial court, Mr. Raghavan has pointed out that the learned trial judge has misdirected itself on a point of 'principle', namely, instead of first determining the similarity in features of the two competing wrappers and then to examine if the similarities were sufficient to deceive a man of average intelligence and imperfect recollection, the learned trial judge has engaged in a microscopic comparison of the two wrappers to identify dissimilarities. It was further submitted that although the principle of law was correctly identified, the learned trial judge has erred in its application namely, principle governing comparison of rival marks. Upon perusal of paragraphs 33-38, we notice, that the contention of Mr.

Raghavan, that the learned trial judge has adopted a wrong approach in conducting the 'deceptive similarity' analysis, does have some substance. Ideally, before proceeding to consider if the defendant's wrapper was deceptively similar to that of the plaintiff, the learned trial judge ought to have first identified the distinctive features in the plaintiffs wrapper and then proceeded to examine if there existed similar features in the defendants wrapper so as to lead an ordinary purchaser to accept defendant's product as that of plaintiff. Instead, the court has directly approached the deceptive similarity test by engaging in a side to side comparison.

18. Appeal being a continuation of original proceedings and right to appeal not being merely a matter of procedure but it is a substantive and vested right, we are of the considered view that findings recorded by the learned trial Judge requires to be re-looked into by re-appreciating the pleadings in the background of rival contentions raised.

19. In the instant case, as observed hereinabove, learned trial Judge ought to have undertaken the exercise of ascertaining the distinctive features in the plaintiff's wrapper in the first instance and ought to have proceeded to examine if there existed similar features in the defendant's wrapper. As against this exercise which was required to be undertaken, learned trial Judge has adopted the approach of deceptive similarity test by engaging in comparing the wrappers of plaintiff and defendant in holding the same by side by side and comparing them. Hence, we are of the considered view that impugned order requires to be re-looked into and accordingly, Point No.1 is answered in the affirmative. Hence, appeal is admitted for consideration.

RE: POINT NO.(2)

20. One of the cause of action upon which the plaintiff rely is passing-off and to establish an arguable case in passing-off action, the plaintiff must show a misrepresentation express or implied that the defendants wrapper is connected with or may be

associated with the plaintiffs' business and that as a consequence damage is likely to result to the plaintiffs.

21. In passing-off, although the ultimate question is one of whether the defendant is liable for making a material misrepresentation as to the source of goods or identity of the business, it would be convenient to break this down into specific questions or points :

"1. Distinctiveness of the plaintiffs mark - In terms of goods, what features of the claimant's goods are distinctive of him, to what extent and for what reasons?

2. Deceptive Similarity : Are the defendant's goods sufficiently similar in those features to be taken for the claimant's? Also, has the defendant taken other measures, or are there any other factor, which effectively eliminate the possibility of confusion?"

22. Professor Christopher Wadlow's 'The Law of Passing-off'¹ is regarded to be the only specialist practitioner's reference work dealing with the common law torts of unfair competition by misrepresentation,

namely passing-off. In his book, the author finds that, the plaintiff, in an action for passing off has this unique advantage, as compared to the plaintiff in an infringement action, in that he is *'given complete freedom in asserting what distinguishes his goods from others. He is not put to an election, as in the case of registered trade marks, which has to be made before any individual competitor is in his sights* ². The availability of 'choice' in asserting what makes the plaintiffs product distinctive to him has not been free from misuse, he notes. The distinctive features in the plaintiffs goods are claimed in such a way *'so as to fit the facts of the case in hand rather than to identify the features which either the public or the claimant really regard as most significant.'* This observation of the learned commentator is of particular significance in the facts of the present case.

23. In C.S No. 231 of 2013 initiated by the very same plaintiff ('TTC') in respect of the same wrapper which is subject matter here, the plaintiff had filed an

¹ 6th Edition published by Sweet & Maxwell

² Para 8-2 Chapter 8-'Signs'

original suit against 'Nestle' in the High Court of Madras alleging that defendant has passed off their product as that of the plaintiffs, by use of the phrase '**Magical Masala**', which they claimed to be deceptively similar to phrase 'Magic Masala' which appeared on the plaintiffs wrapper. In paragraph 8,9,12 of the judgment rendered by Sri Justice C Saravanan, he records the plaintiffs claim that *'the expression Magic Masala forms the predominant feature of the plaintiffs composite trademark Sunfeast Yippee Noodles Magic Masala'*. It further records the submission of the plaintiff that the *'expression 'Magic Masala' had become distinctive and was immediately identified by the trade and the public as that of the plaintiff'.....that general public associated Sunfeast Yippee! Noodles Magic Masala with the expression Magic Masala'*.

23.1 Relying on the paragraphs 8,9,12, Mr. Chinappa has attempted to throw light on the contrasting stands taken by the plaintiff company, in the case before the Madras High Court and the case presently before us, on what exactly the plaintiff claims

to be the distinguishing features of its packaging. The plaintiffs have claimed distinctiveness in the mark '**Magic Masala**' in their case before the Madras High Court in CS No. 231 of 2013, since the defendant therein was using the mark 'Magical Masala'. Having been unsuccessful in that suit, the plaintiffs, as Professor Wadlow puts it, so as to fit the facts of the case in hand, have now realigned their stance in the present suit and claimed distinctiveness in the entire visual appearance of its wrapper. Mr. Raghavan, in reply to this submission, by drawing our attention to the prayer sought for in CS. No. 231 of 2013, contended that decision in that suit, turned on whether Magical Masala was deceptively similar to Magic Masala and nothing more; he contends that the Madras High Court was not called upon to consider the entire wrapper, as is claimed in this case.

24. We are unable to agree with said submissions. The question we are inquiring at this stage is one of distinctiveness and not one of 'deceptive similarity'. It is only after understanding what is

distinctive of the plaintiff's goods, then we can proceed to decide if the extent of resemblance in respect of the said distinctive features, are such as to lead the ordinary purchaser to be misled into buying defendant's packs as that of plaintiffs.

25. During the course of the hearing, for the purpose of greater clarity, we posed a pointed question to Sri Raghavan, learned senior counsel on what he claims to be 'distinctive' of the plaintiffs goods – namely, is it in the verbal marks, 'Sunfeast Yippee', 'Magical Masala' or the orange-red colour scheme or the entire get up. His reply was that plaintiff claims distinctiveness in the overall appearance of the wrapper, not limiting itself to any particular feature. We find, that plaintiffs have, in fact, pleaded the distinguishing features of their product as per what suits their case and this, according to us, keeping Wadlow's observations in view, is a clear case of abuse of the freedom that the plaintiff enjoys in a suit for passing off. Be that as it may.

26. As stated earlier, understanding what is factually distinctive of the plaintiffs goods is key in assessing the probability of deception. We have already noticed that plaintiff has taken contradictory stands as regards what it claims to be distinctive of its goods in respect of the same wrapper. In that case, do we ought to consider 'Magic Masala' as the predominant feature or do we take the case of the plaintiff as pleaded in this case, that, it is the overall appearance of the wrapper which remains distinctive of their goods. This brings us to the question of what makes a particular feature or aspect 'distinctive' in law, for the purpose of a passing off action?

27. Professor Wadlow claims that term '**distinctive**' has a meaning of its own, in the legal sense, which does not coincide with the ordinary use of the term in common parlance. In its legal sense, a name, mark or get-up can be said to be distinctive *'if it denotes the goods of the claimant to the exclusion of all others'*. What plaintiff claims to be distinctive may be 'distinctive in fact' but the plaintiff cannot have the final say on

what is distinctive in law. The observations made by Mr Wadlow would be of benefit. It reads:

"It is the significance which the relevant public attaches to the supposed mark which is all-important. Matter which is not relied on by the public in this way is not in law distinctive, irrespective of how novel, striking or different it may be. Such matter probably does not serve as a sign at all, and certainly not as a sign performing the functions of a trade mark. Conversely, matter may be distinctive in the legal sense although it is altogether unremarkable in its own right. What is important is the function the mark serves, rather than how well it is adapted to serve it."

The author further observes that distinction between '**distinctiveness in law**' and '**distinctiveness in fact**' must be borne in mind particularly in the context of 'get up' cases. From this exposition on the concept of 'distinctiveness', it can be concluded the features relevant for our analysis, does not include all features (that is, overall get up) as claimed by the plaintiff, but it is those distinguishing features which perform the function of a trade mark – the function of a trade mark being that of 'source identification'. To put it simply, the

question that can be posed in the facts obtained in the instant case for being answered would be:

"What are the feature (s) of the plaintiff's wrapper which is 'relied upon' by the relevant public in making their decision to purchase the product of the plaintiff?"

OR

What are the feature(s) of the plaintiff's mark which serve to inform (recall value) and help the purchaser in associating the goods in question to be that of the plaintiff?"

28. It is important to remember that at this stage of the analysis, we are only concerned with the plaintiff's wrapper and are unconcerned with other competing wrappers.

29. It may be helpful to consider some leading authorities on this aspect as well. In **PAYTON V SNELLING, LAMPARD**³ which was a case involving the get-up in packaging of tins used for selling coffee, the

³ (1899)17 R.P.C. 48 affirmed in (1901)A.C.308:17 R.P.C.628

plaintiffs had complained that the tins of the defendants product were decorated in the same colours and in practically the same manner. On what the plaintiff has to prove in case of this nature (involving a composite mark), Lindley MR, speaking for the House of Lords, has said this :

"They must make out that the defendant's goods are calculated to be mistaken for the plaintiff's, and, where, as in this case, the goods of the plaintiff and the goods of the defendants unquestionably resemble each other, but where the features in which they resemble each other are common to the trade, what has the plaintiff to make out? He must make out not that the defendant's are like his by reason of those features which are common to them and other people, but he must make out that the defendant's are like his by reason of something peculiar to him, and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods which have, like his, the features common to the trade."

In a separate opinion, Roman LJ has emphasised the importance of remaining alive to the distinction between "***distinctiveness in fact***" and "***distinctiveness in law***" and not to confuse the two as one and the same thing. He said :

“Too often it is supposed that the trial of that issue [whether the get-up is calculated to deceive] is the same thing as trying another question, namely, whether the plaintiff has not been the first person to adopt a novel get-up, and it seems to be supposed by some that, if the plaintiff establishes in a case like this, that he is the first person to adopt what is called a new get-up or a novel get-up, then the defendant could be restrained if the defendant being in the same trade adopts that novel get-up. Of course the two questions are really quite-distinct. A trader by adopting a novel get-up does not thereby acquire a monopoly in that get-up. Of course it may well be that if a plaintiff has adopted a novel get-up for his goods that fact has to be borne in mind in considering, if the defendant adopts it, whether or not what the defendant is doing is calculated to deceive. It is a notion that runs through the minds of a great many persons in trades that, if a trader once adopts a novel get-up, he acquires some proprietary right in that get-up. Of course he does not do anything of the kind.”

30. We shall now proceed to analyze the features of the plaintiffs wrapper which can be said to be ‘distinctive’ not in the everyday sense, but in its legal sense. In other words, we are required to identify the features which are peculiar to the plaintiff’s wrapper and which serve to distinguish his goods from that of his competitors. In doing so, it would be helpful to take a re-

look at some of the factual averments found in the plaint.

31. The plaintiff launched itself into the ‘instant noodles’ market in the year 2010 under the brand “Sunfeast Yippee”. Under this brand, the plaintiff is said to have manufactured and marketed different variants (flavours) of noodle packs; one among which, is the **“Sunfeast Yippee! Magic Masala”** noodles. The striking common feature that can be found across all the different variants is the mark of the brand name “Sunfeast Yippee” found at the heart of the pack– Yippee being written in yellow coloured stylised font just below the traditional ‘Sunfeast’ logo mark. The brand ‘Sunfeast Yippee’ is a registered trademark of the plaintiffs. The plaintiffs claim to have spent an estimated INR 665 Crores in running an advertising campaign for its Sunfeast Yippee brand of noodles, which includes the Magic Masala sub-brand. It is claimed that the TV commercials have been uploaded on their Youtube page. The aggressive advertising campaign coupled with a

quality product has led them to capture the number 2 spot in the overall instant noodles market in India – with Sunfeast Yippee enjoying a 24.6 % share of the market, 24% of which is contributed by the 'Magic Masala' brand.

32. We have perused the documents [pg 8-37 of Vol.II] filed along with the plaint which reflect the various advertisements taken out by the plaintiff in print media, digital media and television commercials for promoting its brand of noodles. We have also listened to the TV commercials which have been uploaded on YouTube on the Sunfeast Yippee YouTube Channel. On an overall appreciation of the said documents and audio-visual clippings, we find as follows :

33. The entire focus of the TV Commercial advertising campaign has been to mentally imprint the brand name 'Yippee' in the mind, eyes and ears of viewer. Upon having watched and heard some of the commercials on its YouTube channel, we notice- 'Its Yippeeee Time'; 'Get your Yippeeee Now'; 'Hamara har

day happy hota hai, kyunki har day yippee hota hai'; 'Apna Yippee Noodles Hai, Zara Style se Khao'; 'Yeh hai Apna Yippee Noodles' are only some, among many other lines, which advertisers have used in their TV commercials to generate goodwill among potential customers for their 'Yippee' brand of noodles. The brand logo and marks are quite visibly displayed in large size and bright colours to bring it directly into focus of the viewer.

34. Even a bare look at the wrapper of the Magic Masala brand would indicate that 'Yippee' written in yellow color and relatively, the largest font (in both 12 Rs packs and 48 Rs pack) stands out in contrast to the 'Sunfeast' logo which is written in red font against a red background; and with respect to Magic Masala, which is written in dark blue color in a much smaller font size against an orange background. 'Yellow' being a light as well as bright colour, coupled with the fact that Yippee bears a stylised script and large font, appears to strike itself to the sensory organs quite easily purely on first impression as well.

35. Again, if we look at print media advertising campaign, the advertisement published in Dainik Bhaskar on 06.07.2020 bears the logo of 'Sunfeast Yippee' brand at the top, below which, is found the catch-line - 'Many Yippee Returns of the Day MSD' with a picture of famous Cricketer Sri Mahendra Singh Dhoni.

36. All the above observations have led us to conclusively find that the features which can be said to be 'distinctive' in law in the sense that the relevant public would rely on such features to associate the goods as that of the plaintiff or to identify the goods as that of plaintiff or to distinguish the goods of the plaintiff from others would be, essentially, the brand 'Sunfeast Yippee' and to a lesser extent, the sub-brand which indicates the various flavours - in this case, 'Magic Masala'. Sri Raghavan, learned senior counsel made great efforts to persuade us that the orange-red colour scheme found in the plaintiff's wrapper is unique and that no other competitor has adopted a similar

combination of colour scheme except the defendant. He has also submitted that the 'Sun' emoji found in all Sunfeast-brand products has been copied without any explanation by the defendant. This proposition of learned senior counsel would result in conflating the concept of "distinctiveness in fact" and "distinctiveness in law" as per our considered view. The question ought not to depend merely on whether a certain feature of the plaintiff's wrapper is novel, original or striking. It must go further and ask whether such a feature is relied upon to identify the source of the goods. No doubt, the emoji of a 'sun' appearing on the wrapper and the colour scheme are eye-catching features and may be said to be distinctive in the everyday sense of that term, but that is of no consequence so long as it is not shown to be 'distinctive in law'. The test for distinctiveness, as noticed earlier, is the function that the get up actually serves, rather than how well it is adapted to serve it. This is not to suggest that colours or combination of colours have not been held to be 'distinctive in law'. There have been an adequate number of cases where a

single colour or combination of colours have been protected but in all of those cases, the colours had achieved a high level of distinctiveness in law and plaintiff had demonstrated that customers relied on the colour to identify the goods of the plaintiff.

37. Thus, questions that would arise is: (1) Can it be said that the red-orange colour scheme is so distinctive that it serves to identify such packs as the noodle packs of the plaintiffs only? and (2) Does the sight of the red-orange colour, without anything else, immediately bring to mind, 'Yippee Noodles Magic masala'?

38. Perhaps, a strong case for claiming distinctiveness in orange-red colour-scheme could have been made out if all the sub-brands of 'Sunfeast Yippee' noodles variants were of the same orange-red colour scheme, and the market share enjoyed was more than, say, 75%. Since Sri Raghavan, learned Senior counsel has himself conceded that the plaintiff has no objection with use of phrase 'noodles' as it is common to trade, we need not elaborate anything further on that aspect.

39. It is an unrivalled proposition that the “classical trinity” of goodwill, misrepresentation and damage, as formulated by Lord Oliver in **RECKITT & COLMAN V BORDEN**⁴, form the three essential elements of an action for passing-off. The entire basis of an action for the tort of passing-off lies in the making of a misrepresentation by the defendant which is calculated to cause damage to the business or goodwill of the claimant. The design that a typical form of misrepresentation generally takes is for the defendant to adopt that feature of the plaintiffs mark which the ordinary purchaser is most likely to associate or use to identify the goods as that of a plaintiff. In that sense, the defendant, by adopting a mark already distinctive of the claimant, tries to encash on the goodwill of the plaintiff and thereby causes ‘damage’ to it. The misrepresentation has to be a ‘material’ one for it to be actionable. The law of passing off, as held in Payton’s case supra, is not a general tort of misappropriation or of “unfair copying”. It was held therein that :

⁴ (1990)1 All E.R. 873

"The claimant may have expended money, time, effort and ingenuity on introducing or popularising new goods or services; or an original way of promoting them. It may be the "custom of the trade" to allow him to reap the benefit without close competition, but so far as the law of passing-off is concerned all these may be copied wholesale if no misrepresentation results".

Therefore, in practical terms, the misrepresentation must be believed by those to whom it is communicated [through word marks, visual marks, labels or the entire get up as a whole], and such persons must be likely to act in reliance of the supposed misrepresentation. As we have noted above, persons are likely to act in reliance of those features of a plaintiffs product which is said to be 'distinctive' of it in the legal sense. Hence, it can be concluded here that the question of distinctiveness and that of misrepresentation are not independent of each other but are strongly interdependent and are always capable of interacting with each other. This conclusion of ours is supported by the general rule that was expressed by Lord Oliver in the Jif Lemon case, *Reckitt & Colman v Borden*, where it was opined :

“Thirdly, [the plaintiff] must demonstrate that he suffers or, in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

40. In a similar vein, Lord Halsbury, in his much celebrated text, Halsbury's Laws of England (4th Ed. Vol. 48 para 163), has dealt with the subject of ‘Establishing Likelihood of Deception’ in the following way :

"To establish a likelihood of deception or confusion in 'an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements :

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons.; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected. While it is helpful to think of these two factual elements as two successive hurdles which the plaintiff

must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact."

Source identification, being dependent on features distinctive of the plaintiffs goods, the misrepresentation, for it to be material and actionable, must relate back to such distinctive features for a 'source confusion' to arise in the mind of the ordinary purchaser.

41. We now bring our focus back to the main question of whether the plaintiff has been able to make out a 'prima facie' case that the defendant is liable for making a material representation of the distinctive feature used in its wrapper. On a consideration of the principles laid down in leading authorities⁵, the test to determine 'deceptive resemblance' is essentially decided by asking two questions :

⁵ **Lakshmikant V. Patel v. Chetabhai Shah &Anr.** [2002 3 SCC 65]; **Midas Hygiene Industries v Sudhir Bhatia** [2004 3 SCC 90]; **Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt. Ltd.** [2003 SCC Online Del 1005]; **Marico Limited v. Mukesh Kumar** [2018 SCC Online Del 10823] **Cadila Health Care Ltd. V. Cadila Pharmaceuticals Ltd.** [2001 5 SCC 73]; **Surya Food and Agro Limited v. Om Traders** [CS Comm No. 10/2019 before Delhi HC]; **Britannia Industries v. ITC Limited** [FAO (OS) Comm No. 77/2016, Delhi High Court]; **Carlsberg India Pvt. Ltd. V. RadicoKhaitan Ltd.** [FAO OS 549/2011, Delhi High Court] ; **Kuber Khaini Private Limited v. PrabhoodlalRamratan Das** [2000 SC Online Cal 536];

1) Who are the persons whom the resemblance must be likely to deceive or confuse? In other words, who is the hypothetical purchaser we must have in mind, from whose lens we are supposed to estimate the likelihood of deception?

2. What are the 'rules of comparison' that must be adopted in guiding this exercise of whether deceptive resemblance exists?

We proceed to consider the two questions separately.

1. Persons to be considered

42. Both the learned Senior Counsel have spent a significant amount of time in helping us identify and construct the hypothetical 'person', for the deceptive similarity analysis cannot proceed further, without first understanding the person from whose lens we have to appreciate the competing wrappers; and in the ultimate

analysis, it is the 'perception' of that person which will decide whether the similarities are sufficient to produce or likely to produce the effect of confusion. It is well known that 'perceptions', be it ocular, mental or aural, can vary based on age, gender, social and economic exposure, intellect and other such factors. Therefore, the Courts will tread carefully at this stage since the practical consequences of a misplaced identification of the average consumer or the ordinary purchaser can lead to sharply different outcomes. The hypothetical person, as a legal construct, is not to be understood as importing a single, unchanging and constant 'standard of reference'. The hypothetical person is fluid in the sense, he takes the shape that is given to him. He must be understood, keeping in view the nature of the goods sold, the circumstances of sale, the class of persons to whom the product is sold and other factors. For instance, if the relevant consumer for a certain product 'X' is largely doctors and pharmacists, while constructing the 'hypothetical person' in that context, it would be quite natural to impute such a person with

intelligence more than the average man and imply an exercise of higher degree of caution, so as to be much less likely to be deceived as compared to the general public. For a contrasting example, we can consider the case of **EDGE V NICCOLLS**⁶. There, the relevant public for the goods in question were identified as mainly comprising cottagers, washerwomen and the like who at that time would often have been illiterate. In that background, the Court held the adoption by the defendant of a similar get-up to that of the plaintiff outweighed their use of their own brand name. Narrower the market for the product, easier it is to come to a near exact estimation of the 'hypothetical person'

43. As fairly submitted by Sri. Raghavan, learned Senior counsel, the relevant public for the instant noodles market is far from what can be said to be narrow. It transcends local state borders as well as foreign borders. The quickness in its preparation makes it a feasible breakfast or lunch option for working

⁶ (1911) A.C.693

professionals. Without doubt, it can be said that children of all ages and types remain loyal patrons of some of these brands. The 'low cost' of the product makes it an attractive buy for the labour and non-professional working class. Seen as a whole, it is impossible to draw a boundary line to define the relevant public with some degree of certainty. Hence, we must go back to the general principles that have been developed in the Common Law world in constructing this so-called hypothetical person (or purchaser).

44. In **PASQUALI CIGARETTE CO LTD V DIACONICOLAS & CAPSOPOLUS**⁷, a case on the get-up of cigarette packets, said Solomon J., on how must we understand the ordinary purchaser has held:

“Now when one talks about the ordinary purchaser being deceived or being induced to accept one manufacturer's goods as the goods of another there is some difficulty perhaps in understanding exactly what that means. An ordinary purchaser certainly does not mean the very careful man who knows exactly what he wants and takes very good care when he is buying an article that he gets what he

⁷ (1905)T.S. 472 (South Africa)

actually wants, who looks closely at the article he is buying, and who would detect any striking difference between the article he is purchasing and the article he intended to purchase. Nor does it mean the very careless man who does not know the peculiar characteristics of the article he wants to buy, and who is not at all particular about what he gets, but who when he asks for an article accepts what is given him as being the article he requires, and therefore does not look at it and does not very much care whether he is getting the article he asked for or not. The ordinary purchaser does not mean either the very careful or the very careless and ignorant man. I think it must mean someone between the two. I take it the ordinary purchaser is a man who knows more or less the peculiar characteristics of the article he wants; he has in his mind's eye a general idea of the appearance of the article, and he looks at the article not closely, but sufficiently to take in its general appearance."

45. In **NATIONAL CARBON CO'S CASE**⁸, Baguley J. said the eye of the judge is the final arbiter, but the Judge must not use, if the expression be allowed, his own eyes; he has got to look at the articles with the eyes of the public who may be expected to buy those articles, especially when, the people who buy those articles include people of all classes including many persons living in the jungle, uneducated, illiterate

and who may be regarded as equivalent to the incautious, ignorant, or unwary up-country purchasers.

Vide para 17.05, Kerly in his authoritative commentary on the subject of Trade Mark law deals with the question of "whom the mark must be calculated to deceive" as under : *"The persons to be considered in estimating whether the resemblance between the marks in question is likely to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used provided that such persons use ordinary care and intelligence. In some cases confusion, that matters to those concerned may be irrelevant in law since it does not lead the public into receiving the wrong goods or services."*

46. Once the relevant public is defined, what we can infer from a reading of the authorities highlighted above is that, the standard to be adopted is that of purchasers using ordinary caution, which in practice is likely to tend towards the incautious or unwary unless

⁸ AIR 1939 Rangoon 113

the goods are major purchases. As invented by Foster J. in **MORNING STAR VS EXPRESS NEWSPAPERS**⁹, if only a 'moron in a hurry' can be said to misled, then that is not sufficient for establishing the likelihood of deception. In Payton's case supra, it has been held that the hypothetical purchaser must be assumed to be aware of what makes the plaintiffs product distinctive in the market and to expect that the plaintiff would not be the only person who would be supplying the goods or services in question. With this background, we are clear on the standard of reference that must be applied from the hypothetical purchaser's point of view.

47. Before we proceed to apply the 'perception test', on facts, from the lens of the hypothetical purchaser constructed by us, it would be necessary to consider the 'rules of comparison' that must guide the analysis.

⁹ 1979 FSR 113

2. Rules of Comparison

48. For understanding the rules that govern the comparative appreciation the two comparative wrappers from the viewpoint of our hypothetical purchaser, we propose to rely on three leading authorities – from three different jurisdictions (India, Australia and the UK), the test formulated in all of which, it will be seen, broadly converge at a common point.

49. First, we consider the leading English authority, authored by Lord Robert Parker in **IN RE PIANOTIST CASE**¹⁰, commonly relied upon by the Hon'ble Supreme Court of India and other High Courts. Lord Parker famously said in comparing the defendants mark with that of the plaintiff, it must be remembered, as:

“You must take the two words. You must judge them, both by their look and by their sound. You must 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

¹⁰ 1906(23)RPC 774

surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case.”

50. Next, we take up a lesser known, but a highly useful test, and the one preferred by us, formulated by Per Dixon and McTiernan JJ of the Australian High Court in the case of **AUSTRALIAN WOOLLEN MILLS LTD V FS WALTON & CO LTD**¹¹. It was said, therein :

"In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire

¹¹ (1937) 58 C.L.R. 641

to have the goods, then similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard."

51. And lastly, one of the oft-cited decision of the Hon'ble Supreme Court of India on the aspect relating to the factors which must be accounted for in the 'rules of comparison', in **CADILA HEALTHCARE LIMITED VS CADILA PHARMACEUTICALS LIMITED**¹² has held:

"Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered: a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works. b) The degree of resemblances between the marks, phonetically similar and hence similar in idea. c) The nature of the goods in respect of which they are used as trade marks. d) The similarity in the nature, character and performance of the goods of the rival traders. e) The class of purchasers who are

¹² (2001)5 SCC 73

likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods. f) The mode of purchasing the goods or placing orders for the goods and g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks. Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case."

52. Having understood the legal framework and principles according to which the inquiry for a passing off action must proceed, we shall, lastly, consider leading authorities on passing off actions based on get up.

53. Though Sri Raghavan, learned Senior counsel appearing for plaintiff has argued that plaintiff claims distinctiveness in the brand name and get up, in combination, during the course of his oral submission, he has laid greater emphasis on defendant's adoption of a similar colour scheme (red-orange) and emoji. Mr. Chinappa, learned Senior counsel appearing for defendant counters this, by submitting, that the 'brand

name' must be given greater weight in comparison to the get-up and he further submits that plaintiff cannot be permitted to lay greater emphasis on certain aspects of its wrapper for that would amount to a violation of the 'anti-dissection rule'.

54. This brings us to yet another interesting question – In case of appearance of packaging of goods (be it labels, wrappers etc.), does the use of a distinct brand name outweigh the adoption of a similar get up? Must they both be given the same weight or is one more important than the other when it comes to the question of denoting source of the goods? We propose to analyse a variety of cases in order to cull out the 'principles' which must guide the Courts in dealing with passing off actions in relation to get up cases

Cases where injunction has been refused :

55. **RIZLA VS BRYANT & MAY**¹³ presents a case where the only significant similarity in the parties pack

¹³ 1986 R.P.C. 389 (Per Walton J)

of cigarettes was the 'colour scheme'. The plaintiff "Rizla" sold papers for rolling cigarettes with the three colours blue, green and red corresponding to the weight of the paper and whether it was cut at the corners. The defendants introduced corresponding packets of papers adopting the same colour coding as the plaintiffs, but with otherwise distinct get-up and under the brand name "Swan". Though evidence was led to suggest that customers used to ask for plaintiffs goods as a packet of reds, blues, or greens, it was not sufficient to establish that the reliance on 'colour' was to denote the plaintiff's brand as opposed to the type of paper. The distinct brand name 'Swan' used by the defendants also contributed to lowering the risk of the likelihood of deception.

Walton J, while refusing to grant interlocutory order of temporary injunction in *Rizla v Bryant & May* held that where two or more colours are used separately for goods from the same manufacturer, the natural inference may be that the colours serve to differentiate

different kinds (flavours) or qualities rather than to denote the trade source.

56. It is common for the plaintiff to argue, as was sought to be done in this case, that the only characteristics of his get-up that count are those that are also present in the defendant's get-up, or to define the distinctiveness of his get-up in broad terms that encompass both parties' get-ups. Can the plaintiff 'pick and choose' elements/ particular aspects of his get up which find place in the defendant's wrapper and rely only on those elements to make out a case for passing off?

57. In **SCHWEPPE V GIBBENS**¹⁴ the plaintiffs and the defendant both marketed their soda water bottles with a brown label, featuring a red disc in the centre. These features, individually and in combination, were alleged to be common to the trade but the House of Lords did not find it necessary to enter into that question. The labels bore the respective names

¹⁴ (1905)22 R.P.C. 601 (H.L.)

“Schweppes” and “Gibbens”. This, and the fact that the plaintiffs’ bottle had two labels and the defendant’s only one meant there was no likelihood of deception. Lord Lindley said :

“It appears to me that the real answer to the appellants’ case is this—that they invite your Lordships to look, not at the whole get-up, but at that part of the get-up which suits their case. The resemblances here are obvious enough, but, unfortunately for the appellants, so are the differences. The differences are not concealed; they are quite as conspicuous as the resemblances. If you look at the whole get-up, and not only at that part of it in which the resemblances are to be found, the whole get-up does not deceive.”

58. The principle that we can derive from **Schweppes vs Gibbens** is that the whole get-up of the plaintiff’s goods must be compared to the overall get-up of the defendant’s goods, including aspects not contained in the plaintiff’s get-up. Differences in brand names or other features must also be given due weight and consideration, as facts and circumstances warrant.

59. **MOROCCANOIL V ALDI**¹⁵ is a recent judgment of the England & Wales High Court, in which the Court had to decide on a conflict between similarities in get up of two competing products having distinct brand names.

The claimant company (C) brought a claim for passing off against the defendant supermarket (S), which had launched a hair oil product, 'Miracle Oil', which according to C, was so similar of its own hair oil product "Moroccanoil", that consumers would mistake 'Miracle Oil' for 'Moroccanoil' or assume that they shared a common manufacturer or that there was otherwise a trade connection between the two. Images of the competing labels produced below would indicate the basis of such claim laid. Like in the present case, C claimed distinctiveness in the name and get up in combination (that is, as a whole).

¹⁵ (2014) EWHC 1686 (IPEC)



The Court dismissed C's claim upon appreciation of evidence and held that the similarities in get-up were not sufficient on their own to amount to a misrepresentation. C had argued that the get up, by itself, was distinctive of its product. The Court's response was :

"41. There was argument about whether the get-up of Moroccanoil was by itself distinctive of MIL's product. I found this artificial. The product is inevitably sold and marketed in packaging which has both the Moroccanoil name prominently on it as well as the get-up. The get-up without the name could never have become distinctive because it has never been before the public. This is not a Jif lemon

type case in which the public would not notice the brand name.

42. There was evidence that some customers ask for 'the product in the brown bottle with the turquoise label'. Tracey Woodward, who is a consultant in the cosmetics industry and has worked for a hair salon, said in cross-examination that staff in a salon would always refer to the product as 'Moroccanoil', but clients tend to remember a product by its colour or texture. She said it was equivalent to clients asking for a red lipstick rather than referring to a brand name. I do not find this analogy persuasive. I accept her evidence that some salon customers identify the product by reference to its colour but this is consistent with their momentarily forgetting its name. It does not suggest to me that the product is identified by its get-up irrespective of what name appears on the packaging."

The Court while acknowledging the market reality that 'goods are almost always referred to by their trade names, not their get-up' refers to and agrees with Professor Wadlow's summary at ¶8-133 of *The Law of Passing Off* (4th ed)

"The difficulty confronting the claimant in all actions for passing-off based on get-up is that it is unusual for one trader's goods to be distinguished from those of his competitors exclusively, or even primarily, by their get-up. Normally a brand name or other mark is chosen and given prominence and it is this on which consumers are expected and encouraged

to rely. To make out a case based solely on similarities of get-up the claimant must show that deception is likely to notwithstanding the absence of his own brand name on the defendant's goods and the likely presence there of the defendant's brand name and perhaps other distinguishing matter. Not surprisingly, the cases in which passing-off has been found have predominantly been ones of deliberate deception.”

60. In **FISONS V. GODWIN**¹⁶, the High Court of Australia held that it will be difficult to establish a risk of confusion and thus succeed in a claim of passing off where a brand name appears on the competing packaging that is significantly different from that of the plaintiff. Brightman J observed:

“If the Fisons ‘Gro-bag’ had not contained the name ‘Fisons’ or if the name ‘Godwins’ had not been so prominently displayed, I might well have reached a different conclusion, but I doubt whether the defendants could have done much more to signify to a buyer that he was looking at a product of Godwins and not at a product of Fisons.”

61. In **BURFORD V. MOWLING**¹⁷ the High Court of Australia held that defendants were entitled to sell

¹⁶ (1976) R.P.C. 653

¹⁷ (1908)8 C.L.R. 212

their soap in boxes which were the same size shape material and colour to the boxes in which the plaintiff sold their soap as there was a difference in name. In **PARKDALE PTY LIMITED V. BUXU PTY LIMITED**¹⁸, Gibbs C.J. stressed the importance of the use of the difference in brand name to distinguish goods of similar appearance. In **RED BULL GMBH V. MEAN FIDDLER**¹⁹ Lewison J. refused to grant an interlocutory injunction against the defendant which sold an energy drink as a substitute for the plaintiffs product even though he thought there was a striking similarity in the design of the two cans because the brand names Red Bull and Sinergy were prominent in each of the cans and the defendant gave certain undertakings in relation to "switch selling"

Cases where injunction have been granted :

62. In **RECKITT & COLMAN V BORDEN**²⁰, one of the leading modern authorities on passing off in the

¹⁸ (1982)149 C.L.R. 191

¹⁹ (2004) E.W.H.C. 991

²⁰ (1990)1 All.E.R 873

context of get-up of goods, the House of Lords granted an injunction against the copying of a container for lemon juice which imitated the size, shape and colour of a real lemon.

63. The plaintiffs brand 'Jif' was the only brand of lemon juice available for sale in the UK market since 1956. Its characteristic feature : that it was packaged in a plastic squeeze pack imitating a real lemon in size, shape and colour. The product had a collar, shaped in the form of a leaf, where the name 'Jif' appeared. The defendants came out with a nearly similar product design for sale of lemon juice, except that, the collar around the neck bore a different name - 'RaeLemon'. The trial judge found that shoppers wishing to purchase Jif crucially relied on the lemon shape itself and ignored the label. The label would often be removed and discarded after purchase so that when a replacement was eventually required the unadorned lemon would be the point of reference. And hence it concluded that the defendants product, 'Rae Lemon' would cause confusion with Jif and that the name on the labels was insufficient

to dispel it. The House of Lords upheld the decision of the trial judge. The implications of over 30 years' de facto monopoly in the sale of lemon juice packaged in life-like plastic lemons coupled with the fact of the uniqueness of this get-up in a competitive market was itself an indication that the get-up was distinctive in the legal sense. Another surrounding circumstance which was taken to be relevant was that the competing brands of plastic lemon would not often be stocked side by side because supermarkets normally carried only one brand of lemon juice. Consumers would therefore have no opportunity to compare one brand to the other to refresh their memory.

It was observed that what is important to note in this case is that trial judge had sufficient evidence in front of him to conclude that the customers relied on the lemon-shaped container (and not the brand name, Jif, as such) to 'link it' to the plaintiff. This, along with the other factors noted above led the Court to give greater weight to the get up notwithstanding the distinct brand names.

64. The importance of defining the relevant public [so as to construct an accurate standard of the hypothetical purchaser] and understanding the usual manner in which the ordinary purchaser would behave can be noticed from the decision in **WHITE HUDSON & CO V ASIAN ORGANISATION**²¹, a decision of a Privy Council, from a case arising out Court of Appeal in Singapore. The plaintiff, in that case, made and sold in Singapore cough sweets wrapped in red cellophane with the brand name "Hacks" and a list of ingredients printed on it. The vast majority of non-English-speaking native customers, who were unable to read the words printed on the wrapper, asked for the sweets by describing them as "red paper cough sweets". The defendant came out with a similar product (cough sweets) of similar size, shape and colour, and also wrapped it in red cellophane and printed the name "Pecto" along a list of ingredients, on it. While holding the defendants liable, it was held that plaintiff had established that the get-up was

²¹ (1965)1 All ER 1020

distinctive of their sweets and there was a probability of confusion as most customers could not read the word "Pecto," which was thus insufficient to distinguish defendant's sweets.

65. There are several other cases where Courts have granted and refused injunctions in the context of having to compare between similar get ups and different names and vice versa. But each case would turn on its own facts. The idea of dealing with a select few was to understand the leading principles that courts have followed in exercising their discretion in such cases.

Conclusion :

66. Very few traders, if any, still employ get-up as their single or primary means of indicating the origin of their products and services. What matters, though, is how customers really identify competing items. It is not unusual to find customers choose items from supermarket shelves based on some component of the overall design as well as the name. Identifying the

particular visual cues on which the customer relies is what the court will have to carefully judge. In the absence of data and evidence, court will have to take a prima facie view based on all surrounding or attendant circumstances. Though it is a market reality for consumers to rely on verbal marks (brand names, sub-brands) rather than visual marks (labels, get up, logos) in a composite mark, we should not be taken to say that, in every case of this kind, the similarities in get-up is of relatively lesser importance than brand names/identities. In certain circumstances, as seen in cases discussed above, the Courts have enjoined defendants from using deceptively similar get-up notwithstanding the use of sharply distinctive brand names. In general, therefore, it would not be an easy task for a plaintiff to establish a case of passing off by "get up" alone, especially at the interlocutory stage, unless the resemblance between the goods is so close that it can hardly have occurred except by deliberate imitation.

67. We shall now consider to apply the legal principles in a consolidated manner to the facts of the present case. It is at this stage (examination of 'deceptive resemblance') that we are now called upon to consider the plaintiff's wrapper along with defendant's wrapper. The question we would pose to ourselves is:

"Having regard to the appearance of the two competing wrappers, the usual manner in which ordinary persons behave and the circumstances in which the goods are sold, would the hypothetical person constructed by us, from the point of his perception, be deceived?"

Appearance of the Competing Wrappers and First Impressions :

68. It is hard to imagine an ordinary consumer to photographically capture every detail of the plaintiff's wrapper. Keeping this practical reality in mind, we would avoid a side-by-side comparison of the two competing wrapper. We are more concerned with the

impression produced on the mind of potential customers by the plaintiff's wrapper. Seen in this light, it would be noticed that the plaintiff's wrapper is dominated by verbal marks as compared to purely visual marks. The pure visual marks that are clearly visible on a casual look are the 'bowl of noodles', 'sun emoji', the red-orange colour scheme. The bowl of noodles is common to trade and thus, recedes into insignificance from the purchaser's point of view. The 'sun emoji' and 'colour scheme', as has been noted earlier, is not distinctive of the plaintiff's goods. The striking and most distinguishing feature of the plaintiff's wrapper is the brand name 'Sunfeast Yippee' that appears in the heart of the pack. The bright yellow colour given to the large sized 'Yippee' mark, against a red background, makes it a stand-out feature. The 'Magic Masala' in blue colour which denotes the flavour of the product is also given a certain degree of prominence as seen from its placement and design.

69. The defendant's wrapper does not contain the brand name 'Sunfeast Yippee'. The layout is conspicuously at variance. The brand name 'Wai Wai' appears on the left-side along with the flavour variant, 'X=press Majedar Masala', just below it. The font design and colour combination used for the font is not similar to that of defendant.

Conduct of Business and Circumstances of the Sale :

70. The way in which goods or services are supplied has a strong influence on the probability of deception occurring. For, it is at that point of time, mostly, that the parties' respective names or marks will come to the attention of those likely to buy them. If the goods on offer are purchased from a shop assistant over the counter, they are more likely to be requested by name, therefore aural similarity becomes important. In cases where self-service is the usual mode of shopping, then get-up and visual marks assume greater relative importance but without altogether displacing the brand name. In the digital e-market world that we today find

ourselves enveloped within, the 'unique' circumstances of the digital mode of shopping must be accounted for. With this short preface, we proceed to analyse the facts.

ANALYSIS :

71. The instant noodles market, like every other conceivable goods/services, has taken its business to the digital form, in addition to sales from brick & mortar stores. The brick & mortar stores can be further subdivided into over the counter-shopkeeper assisted sales (like we see in pharmacies) and supermarkets, where customers are expected to engage in self-shopping, with option to seek assistance if need be. Accordingly, this Court, has to consider 'usual manner in which ordinary people behave' in making their noodle-purchasing decisions in each of the three scenarios, for a holistic understanding of the likelihood of deception.

72. Both the competing products are sold on a wide variety of online digital platforms, including app-based third party facilitated market places – which

include – to name a few, the websites of Amazon, Big Basket, Swiggy, Flipkart, Grofers etc.

73. We have tried to study the user interface that the hypothetical purchaser would engage in, for buying the plaintiffs Yippee! Magic Masala brand of noodles on Flipkart, and believe that the same principle would apply across different platforms.

74. A simple search of the word 'Noodles' has thrown up 1134 products from a variety of brands and manufacturers. A search for the word 'Red-Orange Noodles' has thrown 78 results, none of which include either the plaintiffs wrapper or the defendants wrapper. The most prominent wrapper displayed when 'Red-Orange Noodles' is searched for, would be as under :



Nongshim Red Super Spicy, Shin Ramyun, Soon Veggie & Sh...

4 x 120 g

₹499 ₹599 16% off



Nongshim Red Super Spicy Instant Noodles 120gm*5 Pack (...)

5 x 120 g

5★ (5)

₹599 ₹699 14% off

If the search word is altered to 'Sunfeast Yippee', the website throws 10 results, all of which includes the Sunfeast Yippee brand of noodles. Among the various sub-brands, the 'Magic Masala' brand of noodles is

displayed five (5) times separately. Interestingly, the search for 'Sunfeast Yippee' or 'Sunfeast Yippe Magic Masala' does not provide the options of any competing brand, much less the brand of Wai Wai Noodles marketed by the defendant.

The picture below indicates the form in which Sunfeast Yippee 'Magic Masala' is available and display for sale on one of largely visited Website :



Sunfeast Yippee Magic Masala Instant
Noodles Vegetarian

270 g

4.2 ★ (300)

₹46

Grocery

The form in which Wai Wai Xpress Masala is found on the website Flipkart is extracted below :



75. As noticed from the images extracted above, in a digital mode of shopping, the brand name of Sunfeast Yippee along with the sub-brand (flavour variant) 'Magic Masala' appears distinctly below the wrapper of the plaintiff's noodle packet. Similar is the case with the defendant's product. It has already been noticed above that use of the search term – 'red-orange noodles' does not display the plaintiff's packet. This further corroborates our finding made in a previous part

of the judgment that the plaintiffs wrapper cannot be said to have achieved distinctiveness in the 'red-orange colour scheme'. The use of the brand name and sub-brand name in the digital mode provides an additional security against the risk of deceiving even a 'moron in a hurry'- for he would see the brand name appear at the time of viewing the products on offer and subsequently at the time of billing as well. Hence, we find that as far as the digital mode of shopping is concerned, the chances of deception, seen from the usual way in which an ordinary purchaser would behave on a digital set-up, is not sufficient to meet the standard of a passing off action.

76. We now proceed to put to test the perception of a hypothetical purchaser, who desires to physically shop in a brick and mortar store. We ought to impute knowledge to the hypothetical purchaser, as held in Payton's case referred to supra, that the plaintiff is not the only person selling products of this kind in the market. Moreover, the plaintiff, itself, has spent huge amounts of money in advertising its varied brands and

thereby made the consumer aware of the existence of a variety of sub-brands within its larger brand of Sunfeast Yippee! Noodles. From its advertising campaign, we have noticed above, that the primary focus has been to visually and aurally imprint the brand 'Sunfeast Yippee', the word 'Yippee, and the sub-brand (flavour variants) in the mind, eyes and ears of the viewer. Moreover, in the world of large-sized hypermarkets, the ordinary purchaser is used to viewing a multiplicity of brands in respect of the same product and obtains the benefit of comparing products and its prices. In a sense, he is left spoilt for choice given the variety of brands that have entered the market. It is unlikely to find big supermarket chains having exclusive tie-ups with only a single brand of noodle packets (as was the case in Reckitt's case). Further, the general idea of the appearance of the article that would be left in the mind of the purchaser when he sees plaintiffs wrapper, cannot be seen in isolation; it has to be understood chiefly from the manner in which the plaintiff has sought to generate goodwill; that is, through its advertising campaigns. And

when seen in that background, the advertiser has succeeded in developing recall value for the 'Yippee' mark to the highest extent, and to a slightly lesser, though similar extent, 'Sunfeast Yippee' as a composite mark, and to 'Yippee Magic Masala'. In this backdrop, we hold that, from the perception of the hypothetical purchaser, even after making allowance for imperfect recollection, the point of reference for purchasing the plaintiff's goods is primarily the brand – Sunfeast Yippee, or the mark – Yippee or the phrase 'Yippee Magic Masala'. We find it rather unconceivable, at this stage (without any data or evidence in front of us) to conclude that the hypothetical purchaser would go and ask for 'red-orange noodles'. Even if he does, it is very unlikely that a shopkeeper would straightaway handout the 'Yippee Magic Masala' brand of noodles since it has been show to us that there are other wrappers which may though not have, strictly speaking, an identical colour scheme but have similar colours on their wrappers.

For the above reasons, we are of the prima facie view, that plaintiff has been unable to demonstrate the

likelihood of deception and accordingly we answer point No.(2) in the negative.

RE: POINT NO.(3) :

77. The test for copyright infringement has been laid down in **R.G ANAND VS DELUXE FILMS**²², where a three Judge Bench of Hon'ble Apex Court has stated thus :

"3. One of the surest and the safest test to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original."

78. In **C. CUNNIAH & CO. VS. BALRAJ & CO**²³., the Division Bench of the Madras High Court held :

7. "The sole question for our consideration, therefore, is whether the respondents picture is a copy or a colourable imitation of the appellants picture. In Hanfsataengl v. W.H. Smith and Sons 1905 1 Ch.519, Kekewich J. defined the copy thus :

"A copy is that which comes so near to the original as to suggest that original to the mind of every person seeing it. Applying this test, the degree of resemblance

²² 1979 SCR(1) 218

²³ AIR 1961 MADRAS 111

between the two pictures, which is to be judged by the eye, must be such that the person looking at the respondents picture must get the suggestion that it is the appellants picture....."

79. The judgment in *C. Cunniah & Co. Vs. Balraj & Company* was followed by a Division Bench of the Madras High Court in **D.C.S. BUREAU VS. UNITED CONCERN**²⁴, . It was also referred to by the Hon'ble Supreme Court in *R.G. Anand Vs. Delux Films*²⁵ and by this Court in **ASSOCIATED ELECTRONICS VERSUS M/S. SHARP TOOLS** reported in **AIR 1991 KARNATAKA 406**.

80. It is well established now that while deciding the question of infringement of copyright it is not necessary that the defendants work must be an exact reproduction of the plaintiffs work. What is essential is to see whether there is a reproduction of the substantial part of the plaintiffs work.

81. In *D.C.S. BUREAU VS. UNITED CONCERN* cited supra, the Division Bench held :

²⁴ AIR 1967 MADRAS 381

²⁵ AIR 1967 SC 1613

"It appears to us that these variations should have been made by the defendants only after they had incorporated in their picture the substantial features of the plaintiffs painting already referred to most probably by using a photographic process. For the purpose of infringement of copyright, an exact reproduction or copy is not necessary. What is essential is to see whether there is a reproduction of substantial part of the picture..... But the essential reproduction of the substantial features of the plaintiffs picture has already been effected and that constitutes the infringement of the copyright. The further modifications or variations will not alter the effect of such infringement as long as the mind is able to form on an examination of the two pictures that basically and in substance one is a reproduction of the other."

82. It cannot be disputed that the plaintiff can claim copyright in the entire get-up ('artistic work') of its noodles packet even without registration. But as we have noticed previously, it cannot be said that the defendant has copied the essential features of the plaintiffs work. If the plaintiff cannot demonstrate that substantial features of the plaintiff's get up has been reproduced in the defendant's get up, then merely showing similarity or identity in other non-essential features will be of no consequence.

In view of the aforestated discussion, we answer point No.(3) in the negative and in favour of defendant.

83. In order to make it convenient for Courts to deal with injunction applications, in a pending suit, seeking relief against passing off, we have summarized the principles which must guide the courts in the inquiry into an action for passing off.

Nature of Inquiry for a Passing Off action in 'Get Up' cases: Broad Summary:

1. In an action for passing off, the plaintiff, in essence, pleads for protection against supposed misrepresentation causing damage to his business goodwill.

2. Get up refers to the whole visible external appearance of the goods in the form in which it is presented to the world at large, for public consumption.

3. In most cases, the 'get up' of a certain good or service, would be composed of a variety of marks²⁶ – it may include visual imagery such as device, logo, symbol, emoji, signature, colour combinations etc.; or verbal expressions such

as words, phrases, slogans etc. individually or in combination. It is strongly believed that *“the eye is not an accurate recorder of visual detail, and ... marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.”* Hence, it is not every aspect/feature that the Court must take interest in. Traders may assign greater prominence to certain aspects than others in terms of shape, font and color; some aspects are mere fanciful additions with no particular utility except to add to the aesthetic value or attractiveness of the packaging.

4. Similarity in essential features is what amounts to misrepresentation as it deceives or is likely to deceive the buyer into thinking he has purchased what he wanted, when in reality, he has purchased a different product. Similarity in unessential features, howsoever strong, amounts to mere copying without the strength to deceive. The law of passing off does not concern itself with allegations of ‘unfair copying’ of this kind – it is interested to protect plaintiff only against ‘material misrepresentation’ of his goods. Materiality of

²⁶ See definition of Mark in Section 2(m) of Trade Marks Act.

the misrepresentation rests in innocent or intentional adoption of the essential features of the plaintiff's packaging.

5. The question of whether defendant is liable for material misrepresentation of plaintiff's goods can be broken down into separate questions :

Distinctiveness of the plaintiff's mark - In terms of goods, what features of the claimant's goods are distinctive of him, to what extent and for what reasons?

Deceptive Similarity : Are the defendant's goods sufficiently similar in those features to be taken for the claimant's? Also, has the defendant taken other measures or are there other factors, which effectively eliminate the possibility of confusion?

6. The first stage of the analysis begins with an inquiry into the distinctiveness of the plaintiff's goods. The critical question of fact which must be answered at the very outset is – what are the features by which the public distinguishes plaintiff's goods from other competitors? In answering this question, it is important to remember the fine distinction between the meaning of '*distinctiveness*' in law' and '*distinctiveness*' in the everyday sense. This would help in filtering out the essential features from the unessential. The essential

features of the get-up are those which the consuming public attaches importance to, for it enables them to identify the source of the goods. The weight attachable to a particular aspect of the mark depends on the function it plays in the consumer's purchasing decisions.

6.1 The court must next, study the extent of distinctiveness among the essential features of the plaintiffs goods in a relative sense. This question bears some importance, in the next stage, during the deceptive resemblance analysis. For instance, a descriptive term may be sufficiently distinctive to be protected against idle copying, but may still not enjoy protection of such wide scope as a term which is wholly arbitrary. In respect of an wholly arbitrary mark, the defendant adopting a mark which incorporates the same predominant idea even if the expression differs may be sufficient to cause deception.

This completes the first stage of the inquiring into the features which can be said to distinctive of the plaintiffs goods.

7. The Court must next proceed to inquire if the defendant has adopted the essential features identified above, to such an

extent, that it would lead persons of average intelligence, in that class of the public likely to buy proprietary articles of that sort, into accepting the goods of the defendants as and for the goods of the plaintiffs. For short, it may be described as the test of 'deceptive similarity'.

The test of deceptive similarity is inquired into in the following way :

7.1 The Court must first, construct the hypothetical purchaser, who is deemed to be representative of the consumers of the goods or services in question. The hypothetical purchaser is a creation of the Court. The 'perceptive' abilities of this person is calibrated and measured having regard to nature of the goods sold, the market share of the plaintiff's goods, the circumstances of sale, the class of persons to whom the product is sold and other factors. The standard of his 'perceptive abilities' is not constant; it is a function of a balancing of multiple factors. It would be helpful to consider Solomon J's conception of the 'ordinary purchaser' in *Pasquali Cigarette Co Ltd v Diaconicolas & Capsopolus* cited supra while constructing the hypothetical purchaser in a given case.

7.2 The next step is to be clear of the rules governing comparison of the marks. For this, it would be helpful to consider the combination of factors and rules discussed in Pianotist case, the Australian Woolen Mills case and the Cadila Healthcare referred to supra. The comparative appreciation based on the rules/factors is to be made from the perception of the hypothetical purchaser constructed above. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected

7.3 If, the Court, with the eyes of the hypothetical purchaser, and having regard to the rules governing comparison of marks, finds that there is even a likelihood of deception, the test of deceptive similarity is satisfied.

8. In this sense, 'material misrepresentation' occurs when the central or prominent feature [or the "idea of the mark"] of plaintiffs goods **[test of distinctiveness]** is embodied in the defendant's such a way that the public may be led to believe that there is or may be a relevant connection between the two parties **[test of deceptive similarity]**. And as Lord Halsbury has advisedly said, though it is

useful to consider 'distinctiveness' and 'deceptive resemblance' as two successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether material misrepresentation is likely is ultimately a single question of fact.

9. In passing off actions based on get up cases, the plaintiff must show that deception is likely to notwithstanding the absence of his own brand name on the defendant's goods and the likely presence there of the defendant's brand name and perhaps other distinguishing matter. The whole get-up of the plaintiff's goods must be compared to the overall get-up of the defendant's goods, including aspects not contained in the plaintiff's get-up.

RE. POINT No.4:

84. In the light of discussion made herein above, we are of the considered view that order of learned trial Judge dismissing the applications filed by the plaintiff for grant of temporary injunction deserves to be affirmed.

Hence, we proceed to pass the following:

JUDGMENT

- (i) Appeal is dismissed.
- (ii) Order dated 22.06.2021 passed in O.S.No.177/2021 by learned LXXXIV Additional City Civil and Sessions Judge (CCH-85) (Commercial Court), Bengaluru, on I.A.Nos.I to III is affirmed.
- (iii) Costs made easy in the peculiar circumstances of the case.

**SD/-
JUDGE**

**SD/-
JUDGE**