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

Pronounced on: 10th February, 2023

+ CS(COMM) 64/2021

INTERCONTINENTAL GREAT BRANDS Plaintiff
Through: Mr. C.M. Lall, Sr. Adv. with
Ms.Nancy Roy, Mr.Abhishek Kotnala and
Ms.Jyotideep Kaur, Advs.

versus

PARLE PRODUCT PRIVATE LIMITED Defendant
Through: Mr. Sandeep Sethi, Sr. Adv.
with Mr. N.K.Bhardwaj, Mr. Bikash Gorai,
Ms.Nabhanya Sharma, Mr.Abhiraj Jayant,
Advs.

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T

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10.02.2023

I.A.1803/2021 (under Order XXXIX Rules 1 and 2)

1. In the year 1912, so states the plaintiff, cream-filled sandwich cookies were introduced in the worldwide market by National Biscuit Corporation under the brand name OREO. The plaintiff claims, today, to be the owner and proprietor of the OREO brand of biscuits.

Registrations held by parties

2. The plaintiff and defendant hold the following registrations under the Trade Marks Act (to the extent they are relevant to the controversy in issue):

Plaintiff's registrations

Trade Mark	Goods	Date	Class	Status
	Biscuits, cookies and crackers	1 st March 2012 Proposed to be used	30	Registered
	Biscuits, cookies and crackers	30 th April 2010 Proposed to be used	30	Registered
	Bakery goods, biscuits, cookies, brownies, cheese cakes, cookie crumbs, frozen confections, ice-cream, ice-cream cones, puddings, pies, pie crusts and hot chocolate	3 rd November 2015 Proposed to be used	30	Protection granted
	Biscuits, cookies and crackers	3 rd May 2010 Proposed to be used	30	Registered
	Biscuits, crackers cookies and crackers.	30 th June 2010 Proposed to be used	30	Registered
OREO (Word)	Biscuits, cookies and crackers.	17 th May 1991 Proposed to be used	30	Registered
OREO (Word)	Biscuits, cookies, crackers, ice-cream, frozen and chilled confectionery	8 th December 2014 User claimed since 1 st March	30	Registered

		2011		
OREO O'S (Word)	Breakfast cereal	10 th April 2006 User claimed since 1 st March 2003	30	Registered
	Coffee, tea, cocoa, sugar, rice tapioca, sago, artificial coffee, flour and preparations made from cereals, bread pastry, biscuits, cookies, crackers and confectionery, teas, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices ice	24 th June 2003 Proposed to be used	30	Registered
	Biscuits, cookies and crackers	12 th September 2011 User claimed since 31 st March 2011	30	Registered
	Biscuits, cookies and crackers	3 rd May 2010 Proposed to be used	30	Registered

Defendant's registrations

Trade Mark	Goods	Date	Class	Status
FABO		22 nd November 2010		Registered
FABIO		2 nd July 2018		Registered

3. The plaintiff alleges that the defendant Parle Products Pvt. Ltd., has, in or after January 2020, introduced its own range of vanilla cream filled chocolate biscuits under the brand “FAB!O”. The plaintiff alleges that, prior to 2020, the defendant was using the brands FAB and FAB! for its biscuits. After 2020, the defendant introduced cream filled chocolate sandwich biscuits under the mark “FAB!O”. The plaintiff points out that the FAB!O mark is being used only for cream filled chocolate sandwich biscuits which were identical to the biscuits manufactured and sold by the plaintiff under the OREO trademark. For all other biscuits, the defendant continues to use the FAB! mark. The allegation of the plaintiff is that the mark on the defendant’s biscuit, though written FAB!O is bound to be pronounced FABIO. The mark is, therefore, according to the plaintiff, deceptively similar to the plaintiff’s OREO mark.

4. The trade dress of the package under which the defendant is manufacturing and selling its FAB!O biscuits is also, it is submitted, deceptively similar to the trade dress of the plaintiff’s package. Here, again, the plaintiff seeks to point out that though the defendant, under the impugned FAB!O mark, manufactures and sells vanilla as well as chocolate cream filled sandwich biscuits, the dress of the package in which the defendant sells its vanilla cream filled biscuits is deceptively similar to the trade dress of the plaintiff’s OREO package, whereas the package in which the defendant sells its chocolate cream filled biscuits is of a different colour. As such, the plaintiff submits that the defendant has used a trade dress which approximates and is nearly identical to the trade dress of the plaintiff’s OREO package only for its vanilla cream filled sandwich biscuits. The intent to

imitate the plaintiff's OREO brand is, therefore, submits the plaintiff, painfully apparent.

5. The deceptively similar trade dress of the package in which the defendant sells its FAB!O vanilla cream filled chocolate biscuits also, therefore, alleges the plaintiff infringes its registered device marks.

6. The plaintiff also alleges infringement, by the defendant, of its registered  and  marks. It is further submitted that the design of the defendant's FAB!O biscuit is deceptively similar to the design of the plaintiff's OREO biscuit. The plaintiff, therefore, alleges infringement, by the defendant, of the design of its OREO biscuit, which, too, is registered as a trademark in favour of the plaintiff.

7. The plaintiff also, in these circumstances, alleges that the defendant is attempting to pass off its FAB!O range of vanilla cream filled chocolate biscuits as the plaintiff's, or as emanating from the plaintiff's stable. A purchaser of average intelligence and imperfect recollection, who sees the plaintiff's biscuit, whether loose or in packed condition and the defendant's biscuit, loose or packed, at two different points of time, is bound to confuse the latter for the former or to presume an association of the FAB!O biscuit with the plaintiff.

8. Predicated on these allegations, the plaintiff has instituted the present suit, seeking an injunction against the defendant, and all others acting on the defendant's behalf, from using the FAB!O mark or a trade dress which is deceptively similar to the trade dress of the plaintiff's OREO biscuits and biscuit packs. In the interregnum, by

the present application, the plaintiff has sought *ad interim* injunction against the defendant.

9. I have heard Mr. Chander M. Lall, learned Senior Counsel for the plaintiff and Mr. Sandeep Sethi, learned Senior Counsel for the defendant, at length.

Rival contentions

10. The rival submissions of learned Senior Counsel for the parties, on the various aspects that arise for consideration, may be noted thus:

(I) Infringement – OREO v. FAB!O

11. Mr. Chander Lall alleges that FAB!O is phonetically similar to OREO. He has drawn particular attention, in this context to

- (i) para 26 of the written statement filed by the defendant in response to the plaint, in which it is averred that “a common consumer even a small child is highly unlikely to slur the word 'FAB!O' (*pronounced as fabo/ fab-ee-yo*) to 'OREO' in any case” and
- (ii) the following advertisement, figuring on the defendant’s Facebook page:



The defendant has, therefore, submits Mr. Lall, acknowledged that its mark, though written as FAB!O is to be pronounced as “fab-ee-yo”, i.e. as “FABIO”, similar to the manner in which OREO is pronounced. Phonetic similarity, therefore, stands admitted by the defendant.

12. “OREO” being a purely invented word, Mr. Chander Lall submits that it is entitled to enhanced protection under the Trade Marks Act.

13. *Per contra*, Mr. Sethi, learned Senior Counsel for the defendant submits that there is no phonetic similarity between “OREO” and “FAB!O”. The only common letter, between these two words, he points out is “O”. Relying on the decisions of learned Single Judges of this Court in *Biofarms v. Sanjay Medical Store*¹, *Cadila Laboratories Ltd. v. Dabur India Ltd*², *CFA Institute v. Brickwork Finance Academy*³ and *Diageo North America, Inc. v. Shiva Distilleries Ltd*⁴, Mr. Sethi submits that, where the first syllable of the two marks is different, it cannot be said that they are phonetically similar. He also cites, in this context, the decisions of the High Court of Bombay in *Johann A. Wulfing v. Chemical Industrial & Pharmaceutical Laboratories Ltd*⁵ and *Messrs Reckitt and Colman of India Ltd v. Medicross Pharmaceuticals Pvt Ltd*⁶ and of the High Court of Madras in *Titan Industries Ltd. v. Kanishk Jewellery*⁷.

¹ (1997) 66 DLT 705

² (1997) 66 DLT 741

³ 2020 (84) PTC 12 (Del)

⁴ (2007) 143 DLT 321

⁵ 1984 PTC 81

⁶ (1992) 3 Bom CR 408

⁷ (2003) 26 PTC 145

14. Even otherwise, Mr. Sethi submits that the mark FAB!O, as used by the defendant on its biscuit packs is structurally, visually and phonetically dissimilar to the OREO mark of the plaintiff.

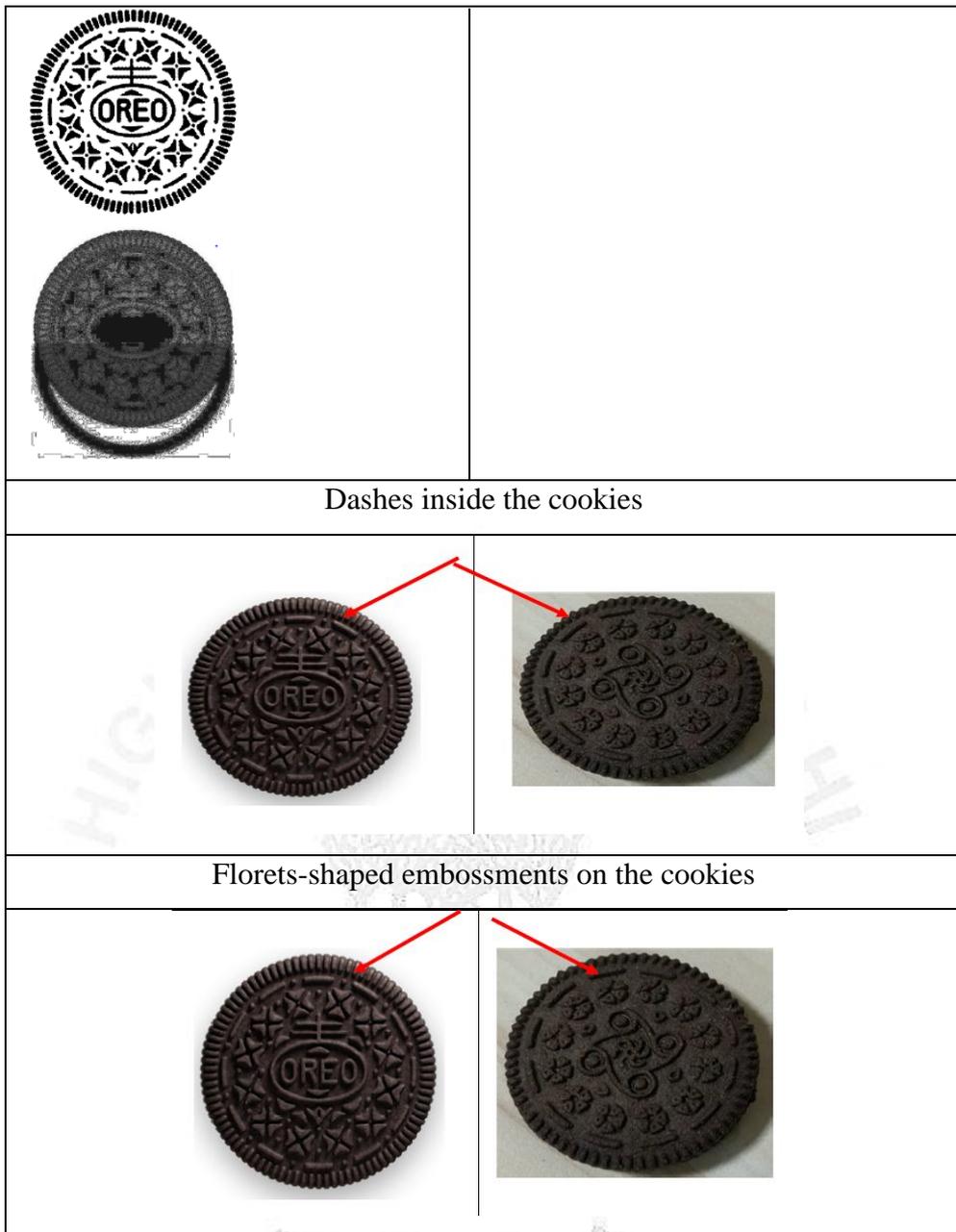
15. Answering the submission of Mr. Sethi that infringement stands discountenanced where the first syllable of the two marks is different, Mr. Chander Lall submits that the words constituting the mark are from the same origin. Else, he submits, a dissimilar first syllable does not automatically discredit the plea of infringement, for which purpose he cites *Amritdhara Pharmacy v. Satya Deo Gupta*⁸.

(II) Infringement of the cookie design

16. The design of the defendant’s FAB!O biscuit, submits Mr. Lall, infringes the design of the plaintiff’s OREO cookie, in which the plaintiff holds a subsisting trademark registration. He submits that the (i) outer ridge, (ii) inside dashes just inside the circumference, and (iii) florets-shaped embossing are features which are common to the designs of the two biscuits. Besides, he submits, both are in the form of black circular biscuits in which white vanilla cream is filled. A tabular representation, in this regard, is also provided in the written submissions filed by the plaintiff thus:

Plaintiff’s OREO Cookie trade dress	Defendant’s FAB!O impugned cookie trade dress
Ridges on the outer edge of the cookies	
	 <p style="text-align: right; font-size: small;">Activate Go to Setti</p>

⁸ (1963) 2 SCR 484

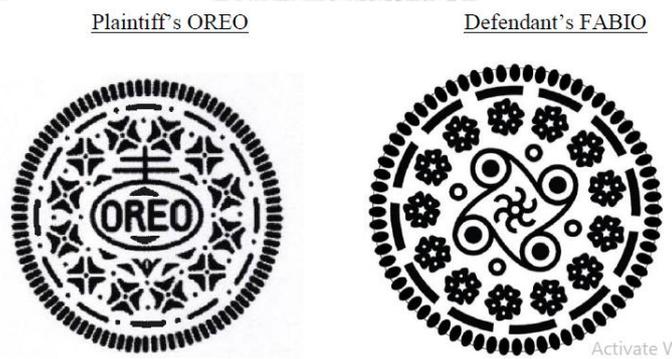


Mr. Lall, therefore, submits that the design of the defendant's cookie copies all the essential features of the design of the plaintiff's cookie, in which the plaintiff holds trademark registrations.

17. As such, the design of the defendant's cookie infringes the trademark registration held by the plaintiff in respect of its cookie design.

18. Mr. Sandeep Sethi, seriously disputes this submission. In the first place, he submits that the biscuits of the plaintiff as well as of the defendant are never sold open or loose and, as such, the similarity in design of the biscuits themselves, even if it were to be assumed to exist, is inconsequential. That apart, he submits that a purchaser who seeks to purchase biscuits never purchases the biscuits on the basis of the pattern on the surface of the biscuit.

19. Mr. Sethi further submits that there is no similarity between the design of the plaintiff's and the defendant's biscuits. Though both have embossing on the surface, the embossing is, he submits, totally different. For this purpose, a comparative representation has been provided in the written submissions of the defendant, thus:



20. Insofar as the elements cited by the plaintiff as being identical between the designs of the plaintiff's biscuit and the defendant's biscuit are concerned, Mr. Sethi submits that they are all common to the trade. Outer ridges and outer borders consisting of dashes and floret-shaped designs on the biscuit surface are, he submits, commonly used in such biscuits. Mr. Sethi has, with his written submissions, cited examples of biscuits which, according to him, have similar designs on their surfaces and has provided, for the said purpose, the following examples:

<p><u>Sunfeast Vanilla Crème</u></p> 	<p><u>McVities Dark Cookie Cream</u></p> 
<p><u>Britannia Pure Magic</u></p> 	<p><u>Britannia Treat</u></p> 
<p><u>Cremica Vanilla</u></p> 	<p><u>Zess Biscuit</u></p> 

21. Mr. Sethi, therefore, disputes the contention of Mr. Lall that the design of the defendant's FAB!O biscuits infringed the design of the plaintiff's OREO biscuit or was deceptively similar thereto.

(III) Similarity in trade dress

22. Mr. Lall contended that the defendant's FAB!O range of vanilla cream filled chocolate sandwich biscuits was sold in a package, the trade dress of which was nearly identical or, at the very least, deceptively similar, to the trade dress of the plaintiff's OREO biscuit packages. A comparative depiction of the two packages has been provided, in the plaint thus:



23. The features of the FAB!O packing which are similar to those of the OREO packing according to Mr. Lall are

- (i) a blue and white colour scheme with an overall blue background,
- (ii) slanted placements of the “OREO” and “FAB!O” words on the pack, with equal slanting angles,
- (iii) the words OREO and FAB!O written in white letters with a blue outline,
- (iv) similar placement of the biscuits, with the brand touching the biscuit and
- (v) the packages being similar in size.

A consumer of average intelligence and imperfect recollection, who sees the two packs at different points of time, he submits, is bound to confuse one for the other.

24. Mr. Lall has pressed into service, in this context, the principle of “initial interest confusion”. The aspect of confusion between competing marks, for the purposes of assessing infringement or passing off, he submits, is not to be seen by a close study of the two marks, but from the “initial interest” point of view. If, therefore, an unwary customer of average intelligence and imperfect recollection is to feel initial interest in the defendant’s product, thinking it to be the plaintiff’s, he submits that a case of infringement and/or passing off is made out. To emphasise the initial interest confusion aspect and also to support his submission that a trade dress is a source identifier of the product, Mr. Lall has relied on the judgments of Coordinate Benches of this Court in *Colgate Palmolive Co. v. Anchor Health and Beauty*

*Care Pvt Ltd*⁹ and of a learned Single Judge of the High Court of Calcutta in *LA Opala R.G. Ltd. v. Cello Plast*¹⁰.

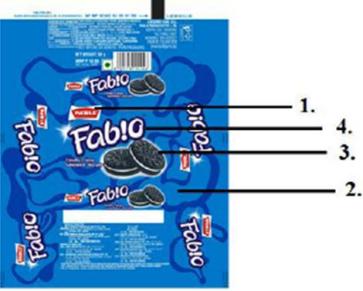
25. Responding to Mr. Lall's contention, Mr. Sandeep Sethi submits that the aspects emphasised by Mr. Lall as being common to the packings in which the plaintiff sells its OREO biscuits and the defendant sells its FAB!O biscuits are all common to the trade. In fact, he submits that the plaintiff is claiming exclusivity on the basis of the overall appearance of its packing which, again, is common to the trade. The defendant has placed on record, with its submissions, the following photographs of biscuits manufactured and sold by other manufactures in packings of similar colour and with similar features such as biscuits being dunked in milk etc:



26. Besides, he submits, there are clear distinguishing features between the packing of the plaintiff's and of the defendant's biscuits, which he had sought to demonstrate, in a tabular fashion, thus:

⁹ (2003) 108 DLT 51

¹⁰ (2018) 4 Cal LT 553

S.No	Defendant's FAB!O pack	Plaintiff's OREO pack
(a)		
1	<p>The house mark 'Parle'/'' is prominently placed on the packaging and appears three times on its front face and a total of 7 times on all over the packaging.</p>	<p>The house mark 'Cadbury' appears non prominently and appears only once on the front face of the packaging.</p>
2	<p>The packaging is in Light blue color and has a dark blue colored swirl in the packaging background.</p>	<p>The packaging color is Dark Blue along with the color brown.</p>
3	<p>The image of the biscuits consists of two biscuits wherein one biscuit is lying flat and another biscuit is resting on it's edge in a tilted manner. This image appears thrice across the entire packaging. One on the front, one each on either sides.</p>	<p>The image of biscuit consists of only one biscuit which is splashing inside a glass of milk. Appears only once on the packaging.</p>
4	<p>The mark "FAB!O" appearing on the packaging is written in white text with a thin dark blue outline.</p> 	<p>The mark "OREO" appearing on the packaging is written in white text and has a thick outline of light blue and white.</p> 
5	<p>No such feature</p>	<p>Has an image of a biscuit falling into a glass of milk along with the text "TWIST LICK DUNK" on the rear of the packaging.</p>

27. Mr. Sethi submits that, where the individual elements of the plaintiff's and the defendant's packing are common to the trade, there can be no question of deceptive similarity being pleaded on the basis of overall appearance of the packs. The plaintiff, he submits, would have to establish similarity of individual elements of the packings, in order to make out a case of deceptive similarity of trade dress. For making out a case of passing off, predicated on similarity of trade

dress, Mr. Sethi submits that the plaintiff would have to establish that the defendant had copied same feature of the plaintiff's trade dress which was peculiar to the plaintiff. He has placed reliance, in this context, on the following passages from "Law of Passing-Off" by Christopher Wadlow:

"A passing-off action based on similarities of get-up of packaging depends, like all others, on proof that the defendant has made a misrepresentation damaging to the plaintiff. In theory, this means that the plaintiff must prove that his get-up is distinctive of him and that the defendant's get-up is similar enough to deceive, notwithstanding any other differences between the two sets of goods. In practice, get-up cases where there is no close copying or other evidence of an intention to deceive are often decided in the defendant's favour on the ground that such similarities as exist are insufficient to cause confusion. If so, then there is no need to consider whether the plaintiff's get-up as a whole is distinctive. The most that need be said is that those features of get-up which are common to the plaintiff and defendant are not so overwhelmingly distinctive of the plaintiff as to outweigh the differences. In the reported cases on get-up the issue of distinctiveness is even more difficult to disentangle from the issue of deceptive similarity than is the case for other types of mark.

What the plaintiff has to prove has been stated by Lindley M.R. as follows:

"What is it that the plaintiffs must make out in order to entitle them to succeed in this action? They must make out that the defendants' goods are calculated to be mistaken for the plaintiffs', 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 defendants' are like his by reason of those features which are common to them and other people, but he must make out that the defendants' 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 plaintiffs' from other goods which have, like his, the features common to the trade."

It is not sufficient for the plaintiff to show that he has adopted some novel, original and striking features for his get-up and that the defendant has copied them or innocently adopted similar features. That is to understand the term "distinctive" as if it meant the same as eye-catching. The test for distinctiveness is the

function the get-up actually serves, rather than how well it is adapted to serve it. The colour grey is properly said to be distinctive if it serves to identify the goods of one particular manufacturer, although no colour could be said to be less distinctive in the popular sense. Despite some statements apparently to the contrary, it is not necessary for the get-up relied on to have been novel when it was adopted if it is distinctive in fact, although it is easier to prove distinctiveness for get-up which was totally new. Conversely, if the get-up does not distinguish the plaintiff's goods from those of actual or prospective rivals then however remarkable it may be it is not distinctive in the legal sense.

“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.”

Nor is it sufficient for the plaintiff to show that the defendant's goods are easily confused with his when they are placed side by side, still less when the doctrine of imperfect recollection is relied on. He must show that the confusion arises from those features of the get-up which are distinctive of him, at least in combination, and features which are common to the trade or otherwise not distinctive are to be disregarded.

Finally, the plaintiff cannot pick and choose those elements of his get-up which find counterparts in the defendant's get-up and rely on those alone. It is tempting for the plaintiff to suggest that the only features of his get-up which matter are those which are also to be found in the defendant's get-up, or to describe the distinctiveness of his get-up in vague terms which are wide enough to embrace that of both parties. The get-up of the plaintiff's goods as a whole has to be compared to that of the defendant's as a whole, including features which are not to be found in the

plaintiff's get-up. Weight also has to be given to differences in brand names or other marks.”

Mr. Sethi also relies on the following passage from *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger S.A. and Champagne Lanson Pere et Fils*¹¹ as quoted with approval by a Division Bench of this Court in *Britannia Industries Ltd. v. ITC Ltd*¹²:

“To make good a right to the exclusive use of a trade name, mark or get-up (not being a registered trade mark) the claimant must normally establish that it has become distinctive of his goods or business to the exclusion of the goods or business of anyone else. That it has become distinctive in this way is normally, if not always, the consequence of use of the name, mark or get-up by the claimant or his predecessors in trade or business which has resulted in the name, mark or get-up being associated in the minds of the public, or of the relevant section of the public, with the goods or business of the claimant and his predecessors exclusively.”

28. Mr. Sethi also relies, in this context, on the following passage from the judgment of a learned Single Judge of this Court in *Surya Food and Agro Ltd. v. Om Traders*¹³:

“(VIII) The United States District Court for the Northern District of Illinois, Eastern Division, in *Keebler Company v. Nabisco Brands, Inc.*¹⁴, held that it is common in the cookie and cracker market to find similar product types in similar package colours and that virtually every colour is in use by the cookie manufacturers, making it almost impossible to select new colours without using a colour already in use; the primary colours red, yellow and blue are widely used and that since consumers, when selecting cookie and cracker products in stores are often confronted with a wide array of similarly coloured cookie and cracker products, it is probable that such consumers are less likely to be confused or misled merely by similarities in the colour of packaging. It was further held that to establish a cause of action for trade dress infringement, the plaintiff must prove that its trade dress is protectible i.e. it is inherently distinctive or has acquired secondary meaning and that there is a likelihood of confusion. It was yet further observed on a cursory glance at almost every single package of cookies introduced into evidence in that case established that photograph of the cookie products on the front and on the side of the packaging was extremely common, almost universal, as was the use of descriptive phrases to describe the qualities of the product.

¹¹ (1978) RPC 79

¹² (2017) 240 DLT 156 (DB)

¹³ 2019 SCC OnLine Del 8227

¹⁴ 1992 U.S. Dist. LEXIS 6826

(XIII) The High Court of Justice, Chancery Division also in *Imperial Group Plc. v. Philip Morris Limited*¹⁵, concerned with the question, whether adoption by the manufacturers of cigarettes under the mark “Raffles”, of a black pack with gold embellishments resembling the packaging of the “John Player Special” or “JPS” cigarettes of the plaintiff constituted a colourable imitation of the getup of the cigarette pack of the plaintiff, held that nobody seeing or buying a pack of “Raffles” could for one moment imagine that they were seeing or buying a pack of “John Player Special” or “JPS”. It was held that the test to be applied is, whether the defendants' goods are calculated to be mistaken for the plaintiffs' and applying the said test, it was found that the features in which the two resembled each other were common to the trade and black alone or black with gold embellishments in the field of packs of cigarettes could not deceive anyone into buying the cigarettes of the defendant, thinking the same to be the cigarettes of the plaintiff. It was further held that the name “John Player Special” or “JPS” on the one hand on the pack of cigarettes of the plaintiff and the name “Raffles” on the pack of cigarettes of the defendant on the other hand was proper and sufficient distinction to prevent any such deception.”

29. Mr. Sethi further submits that the manner in which the defendant promotes its product is also distinct and unique. He has referred, in this context, to the following advertisements of the defendant’s products, which have been placed on record by the plaintiff itself:



¹⁵ [1984] R.P.C. 293



30. As such, Mr. Sethi submits that no case of any likelihood of confusion in the mind of a customer, merely because of any perceived similarity in the trade dress of the defendant and the plaintiff, *vis-à-vis* the packings in which the FAB!O and OREO biscuits are sold, can be said to have been made out.

31. Mr. Sethi also emphasises the fact that the defendant's packing has, on it, the  logo prominently displayed. This, he submits, effaces any possibility of confusion in the mind of the purchaser. It also indicates that there was no intent, on the part of the defendant, to pass off its FAB!O biscuits as connected in any way, with the plaintiff's OREO biscuits.

32. Mr. Lall, apropos this last contention of Mr. Sethi, submits that the mere fact that the  logo is displayed on the face of the defendant's packing cannot be a ground to discredit the plaintiff's allegation of similarity of trade dress. Else, he submits, the defendant would be in a position to, too, by adding the  logo on the pack, infringe every trademark.

(IV) Intent to imitate and consequences thereof

33. Mr. Lall has submitted, with great stress, that the impugned FAB!O mark of the defendant transparently discloses an intent to imitate. The defendant, he points out, is using the said mark only for the category of biscuits which is sold by the plaintiff under the OREO mark, i.e. vanilla cream filled chocolate sandwich biscuits. In respect of all biscuits except chocolate sandwich cookies, he submits that the defendant uses the FAB! Mark. Even in respect of chocolate cream filled chocolate sandwich biscuits, he submits that the defendant, though it uses the FAB!O mark, sells the biscuits in a purple coloured packing. The intent to imitate the OREO brand of biscuits of the plaintiff and to capitalise on the goodwill that it has earned is, therefore, according to Mr. Lall, transparent.

34. Mr Lall further points out that the defendant has provided no justification for using the FAB!O mark solely for this category of biscuits. Though the FABIO word mark is registered in favour of the defendant since 2nd July 2018, Mr. Lall submits that it has never used that mark. The defendant has never cleared any product under the brand name FABIO. Nor has it ever cleared, manufactured or sold any product under the brand name FABO. The defendant, therefore, even while obtaining registrations for the FABO and FABIO marks, never used them. Rather, perceiving the goodwill that the plaintiff's OREO brand of biscuits had garnered over time, the defendant, according to Mr. Lall, decided to cleverly use the FAB!O mark so as to make it appear that it was merely an extension of the earlier FAB! mark, even while thus creating a mark which was phonetically and even otherwise deceptively similar to that of the plaintiff.

35. Where, thus, a clear intent to imitate and, therefore, to infringe, was apparent on facts, Mr. Lall submits, relying on *Slazenger & Sons*

*v. Feltham & Co.*¹⁶, that the Court should presume that the attempt at deceiving the customer, towards which the defendant has strained every nerve, is successful. Additionally, while comparing the marks in such a case he submits, relying on *Munday v. Carey*¹⁷, that the Court has to emphasise aspects of similarity rather than dissimilarity.

36. Mr. Sethi disputes these submissions. He submits that the FAB!O mark is merely an amalgam of the FAB! and FABO marks. The exclamation mark, he submits, was added to incorporate a fun element in the mark and make it unique *vis-à-vis* other marks.

37. The submission of Mr. Lall that perceived dishonesty on the part of the defendant, altered the tests to be applied, he submits, has no foundation in the Trade Marks Act. Sections 29(1) and (2)¹⁸ of the Trade Marks Act, he submits, do not differentiate between an honest defendant and a dishonest defendant. Honesty, he submits, finds place statutorily only in Section 29(8)¹⁹. The emphasis placed by Mr. Lall on the perceived dishonesty on the part of the defendant is, therefore, he submits, misconceived. Mr. Sethi relies, for this purpose, on the

¹⁶ (1889) 6 RPC 531

¹⁷ (1905) R.P.C. 273

¹⁸ 29. **Infringement of registered trade marks.** –

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services 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.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of –

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

¹⁹ (8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

following passages from the judgment of the Supreme Court in *Wockhardt Ltd. v. Torrent Pharmaceuticals Ltd*²⁰, the judgment of this Bench in *Britannia Industries Ltd. v. ITC Ltd.*²¹ and the judgment of the UK Privy Council in *Cadbury Schweppes Pty. Ltd. v. The Pub Squash Co. Pty. Ltd.*²²:

*Wockhardt Ltd*²⁰

“8. We may indicate, at this juncture, that insofar as the second test is concerned, this Court has in a plethora of judgments held that though passing off is, in essence, an action based on deceit, fraud is not a necessary element of a right of action, and that the defendant's state of mind is wholly irrelevant to the existence of a cause of action for passing off, if otherwise the defendant has imitated or adopted the plaintiff's mark. We need only state the law from one of our judgments, namely, in *Laxmikant V. Patel v. Chetanbhai Shah*²³, which reads as under: (SCC p. 73, para 13)

“13. In an action for passing off it is usual, rather essential, to seek an injunction, temporary or ad interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly [*Law of Trade Marks and Trade Names* (12th Edn., Sweet & Maxwell, London 1986).] (*ibid*, para 16.16) passing off cases are often cases of deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in *Law of Passing Off* (1995 Edn., at p. 3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing off (*ibid*, paras 4.20 and 7.15). As to how the injunction granted by the court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiff's distinctive trade mark or business name, the order may be an absolute

²⁰ (2018) 18 SCC 346

²¹ (2021) 86 PTC 61

²² (1981) R.P.C. 429

²³ (2002) 3 SCC 65

injunction that he would not use or carry on business under that name. (Kerly [*Law of Trade Marks and Trade Names* (12th Edn., Sweet & Maxwell, London 1986)], *ibid*, para 16.97).”

This judgment has been followed in *S. Syed Mohideen v. P. Sulochana Bai*²⁴ at pp. 699-700. Also, in *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*²⁵, this Court held: (SCC p. 151, para 14)

“14. The second element that must be established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [*Cadbury Schweppes*²¹, *Erven Warnink Besloten Vennootschap v. J. Townend and Sons (Hull) Ltd*²⁶].”

Cadbury Schweppes Pty. Ltd.²¹

“First, the "compartmentalisation" point. The Appellants' submission may be summarised as follows. Counsel attributed the error, into which, on his submission, the judge fell, to the structure of the judgment. The judge, as their Lordships have already noted, dealt with the cause of action in passing-off first. At that stage he made no findings as to the conduct of the Respondent's officers, Mr. Brooks and his colleagues. He found that there was no "relevant misrepresentation on the part of the Defendant as to its goods" without considering the Defendant's intentions. But intention is relevant. Having found no misrepresentation, he then considered the case of unfair trading. He now found as a fact that the Respondent set out deliberately to take advantage of the Appellants' efforts to develop the market for "Solo"; but this was of no consequence, since he had already found no deception or misrepresentation. Had the learned judge appreciated that the case must be considered as a whole, and not in separate compartments, he would have had regard to the Respondent's intention in determining whether there was deception or the probability of deception; and, had he done so, only one conclusion was possible: namely, that the Respondent was passing off its goods as the goods of the Appellants.

This is a formidable submission.

²⁴ (2016) 2 SCC 683

²⁵ (2004) 6 SCC 145

²⁶ (1980) RPC 31

Where an intention to deceive is found, it is not difficult for the Court to infer that the intention has been, or in all probability will be, effective: *Slazenger*¹⁶ per Lindley L.J. at p. 538. But in dealing with the issue of deception the learned judge directed himself correctly and made the comment, which is also good law, that

".....the Court must be on its guard against finding fraud merely because there has been an imitation of another's goods, get-up, method of trading or trading style (see, for example, *Goya Limited v. Gala of London Limited*²⁷)."

After a very careful consideration of the judgment as a whole, their Lordships do not think that in the arrangement of the subject-matter of his judgment the judge allowed himself to overlook the importance, subject to safeguards, of a Defendant's intention when deciding the issue of deception.

Once it is accepted that the judge was not unmindful of the Respondent's deliberate purpose (as he found) to take advantage of the Appellants' efforts to develop "Solo", the finding of "no deception" can be seen to be very weighty: for he has reached it, notwithstanding his view of the Respondent's purpose. But it is also necessary to bear in mind the nature of the purpose found by the judge. He found that the Respondent did sufficiently distinguish its goods from those of the Appellants. The intention was not to pass off the Respondent's goods as those of the Appellants but to take advantage of the market developed by the advertising campaign for "Solo". Unless it can be shown that in so doing the Respondent infringed "the Plaintiffs' intangible property rights" in the goodwill attaching to their product, there is no tort: for such infringement is the foundation of the tort: see Stephen J., in *Hornsby Building Information Centre Pty. Ltd. v. Sydney Building Information Centre Pty. Ltd.*²⁸ (supra)."

ITC²¹

"49. I am willing to go along with Mr Jayant Mehta in his submission that, in designing the impugned pack of "VEDA DIGESTIVE" biscuits, the defendant may have made a conscious attempt to "copy" the plaintiff's packing. A conscious attempt at copying, however, by itself does not constitute either infringement or passing off. The matter has, in either case, to be examined from the point or view of the customer of average intelligence and imperfect recollection. Unless such a consumer is liable to get confused or deceived, howsoever questionable the intentions of the defendants may be, no case of infringement or passing off can be said to exist."

²⁷ (1952) 69 R.P. C. 188

²⁸ (1978) 52 A.L.J. R. 392

38. With respect to his submission that the depiction, on the defendant's packages, of the  logo would eliminate any chance of deception or confusion, Mr. Sethi points out that the  logo was not merely identifying the name of the manufacturer of the biscuits, but was in fact the defendant's housemark. To support his submission that the depiction of such a housemark on the packing would eliminate any chance of confusion in the mind of the average purchaser, Mr. Sethi relies on the following passages from the judgment of the Chancery Division of the High Court of UK in *Fisons Ltd. v. E.J. Godwin (Peat Industries) Ltd.*²⁹ and of a Division Bench of the High Court of Bombay in *Meso Pvt. Ltd. v. Liberty Shoes Ltd.*³⁰:

*Fisons*²⁹

"Although there is no direct evidence of this, it can confidently be assumed that the decor and layout of the Fisons "Gro-bag" was within the knowledge of persons working in the art department of BXL. It should not, therefore, come as a matter of much surprise that certain similarities exist between the design of Fisons' "Gro-bag" and the design of the defendants "Crop-bag". The defendants' bag looks identical in size. It is also yellow. It has two cut-out panels in place of Fisons single cut-out panel. The amateur gardener is told where to cut by dotted lines of envelope design, as in the case of Fisons product. Each corner of the defendants' bag has an assembly of varied vegetables and fruit in vivid green and red, in place of Fisons continuous border of large tomatoes and small marrows.

Finally, as in the case of the Fison bag, the name of Godwins is printed in large letters along the top half of the cut out area. It has "Godwins Crop-bag" in place of "Fisons Gro-bag". "Godwins" and "Crop-bag" are in red. It will be recalled that on the Fison bag, "Fisons" is in black, "Gro-bag" being in red. I expect that Fisons have printed their name on their "Gro-bag" in black in order to emphasise it. It is a cardinal feature of this case that Fisons, according to the evidence before me, have always relied prominently on their name. Their name is in the forefront of all their products which have been brought to my attention. They do not seem to rely on get-up divorced from their name. Their name is

²⁹ (1976) RPC 653

³⁰ 2020 (1) Mh.L.J. 253

in all instances that I can recall, and certainly in the case before me, a prominent part of their get-up.

If the Fison "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. I suspect that the deponents who have professed to discern a possibility of confusion have been directing their minds to similarities in design and neglecting the clear message conveyed by the dissimilarity of the two names. I am wholly unconvinced on the evidence presented to me and the arguments so far deployed, that any buyer of normal mental capacity with the remotest conception of what he was seeking to purchase could be misled."

Meso³⁰

"MESO Private Limited, the Appellant/Plaintiff, manufactures and sells of various cosmetic products, including two perfumes with trademarks Legend and Flirt. The Liberty Group, the Respondents/Defendants, launched two perfumes with names Legend and Flirt. This led to MESO filing a Trade Mark suit in this Court and moving for an injunction to restrain Liberty from selling these perfumes. The learned Single Judge initially granted an ex parte ad-interim order of injunction, which was subsequently vacated. Being aggrieved, MESO approached with this appeal seeking a grant of an injunction against Liberty Group regarding these two products. We are not inclined to grant an injunction as prayed for. The factual backdrop and the reasons are as follows.

27. The second facet of defence is regarding use of a mark along with House name by the registered owners and others. In *Valvoline Cummins Ltd. vs. Apar Industries Ltd.*, I.A. 16704/11 in CS (OS) 2597/11 decided on 25 November, 2013, the Division Bench of the Delhi High Court observed that using the name of the company before the name of the product and mark differently by the plaintiff and the defendant thereof made the two products totally different. In another case of *Peshawar Soap and Chemicals Ltd. vs. Godrej Soaps Ltd.*³¹, the Court held that using its house mark 'Godrej' along with the mark 'Nikhar' removed the likelihood of confusion. MESO has sought to distinguish these decisions submitting that in the case of *Valvoline Cummins Ltd.*, the mark '4T Premium' was of a lubricant which was descriptive. It is

³¹ (2001) 90 DLT 289

contended that in the case of Peshawar Soap, the Court observed that expression Nikhar was descriptive of the product shampoo/soap. It is contended that the argument that the mark is used coupled with house name is not available in the present case. We are of the view that assuming the decisions in the cases of Valvoline Cummins and Peshawar Soap are based on different facts; a sequitur does not follow that the defence for the usage of a trademark along with house name with no likelihood of confusion, is not available in other cases.

30. We have been shown the wrappers of these perfumes. The wrapper of perfume marketed by MESO under the name Flirt has "FLIRT" printed on it in bold letters with "DEVON" also prominently written on the wrapper. Similar is the position with trademark Legend wherein "LEGEND" is written on the wrapper which also has "DEVON" written on the wrapper. Both these words 'legend' and 'Flirt' along with word "DEVON" appear on the same side of the wrapper. The wrappers of the perfumes marketed by Liberty also has words 'FLIRT and 'LIBERTY' written on the same side of the wrapper. The house names are clearly noticeable on these wrappers. The marks Legend or Flirt are, therefore, along with house name when the consumers notice these products. MESO is thus selling the products as Devon Legend and Devon Flirt, while liberty is selling them as Liberty Legend and Liberty Flirt.

35. Therefore, the defence of Liberty that use of Legend and Flirt along with its house name will not cause confusion regarding the marks of MESO has to be accepted at this stage to sustain the order of refusal of an injunction. The learned single Judge has placed conditions on Liberty in respect of disclosure of accounts, which according to us are sufficient safeguards till the disposal of the Suit.”

Analysis

The terrain

39. It would be better, at the outset, to chart out the terrain where the game is to be played.

The concept of “confusion”; Section 29 deconstructed

40. Section 29(1) applies where the impugned mark is “identical with, or deceptively similar to” the asserted mark. It specifies no other criterion.

41. Section 29(2) envisages two situations. Clause (a) applies where the impugned mark is identical to the asserted mark, but the goods and services of the defendant are only similar to those of the plaintiff. Clause (b) applies where the impugned mark is only similar to the asserted mark, and covers cases where the goods and services of the defendant are either identical or similar to the goods and services of the plaintiff. Clause (c) applies where the marks, as well as the goods and services, of plaintiff and defendant are identical. That said, “identity” would also be subsumed within “similarity”, so that, in the eventuate, clause (a) applies where the marks are identical, whereas clause (b) applies where they are similar. In each case, the goods or services of the defendant have to be at least similar to those of the plaintiff. Clause (c), of course, applies where marks and goods/services are identical.

41.1. In each case, however, the similarity/identity of the marks and goods/services must be likely to *either*

- (i) confuse the public, *or*
- (ii) have an association with the plaintiff’s mark.

41.2. Where marks and goods/services are both identical between plaintiff and defendant, i.e. in cases covered by clause (c) of Section 29(2), Section 29(3) statutorily presumes likelihood of confusion on the part of the public. Of course, being a presumption, it is always rebuttable.

42. Section 29(4) is the only provision, in Section 29, which applies where the goods or services of the defendant *are not identical, or even similar* to those of the plaintiff. Identity, or even similarity, of goods and services is not, therefore, a *sine qua non* for infringement; however, in such cases, Section 29(4) must be found, on facts, to be applicable. Where the goods and services of the defendant are neither identical, nor similar, to those of the plaintiff, and the ingredients of Section 29(4) are not satisfied, therefore, there can be no infringement.

42.1. What, then, does Section 29(4) require? Pared to its essentials, the provision applies where, *cumulatively*,

- (i) the defendant's mark is identical with, or similar, to the plaintiff's mark,
- (ii) the defendant's goods or services are neither identical with, nor similar to, the plaintiff's goods or services,
- (i) the plaintiff's mark has a reputation in India,
- (ii) the use of the defendant's mark is without due cause, *and*
- (iii) the use of the defendant's mark *either*
 - (a) takes advantage of, *or*
 - (b) is detrimental to,the distinctive character or repute of the plaintiff's mark.

43. It is necessary to note, here, that, though sub-sections (1) to (4) of Section 29 all refer to infringement by an *unregistered* trade mark, it is now settled, by the judgment of the Division Bench of this Court in *Raj Kumar Prasad v. Abbott Healthcare Pvt Ltd*³², that the proprietor of one registered trade mark can sue the proprietor of another registered trade mark. The view, which has been taken on a

³² (2014) 60 PTC 51

conjoint reading of Sections 28(3), 29 and 124 of the Trade Marks Act, has been consistently followed in a number of decisions of this Court, including the recent decision of another Division Bench in *Corza International v. Future Bath Products Pvt Ltd*³³.

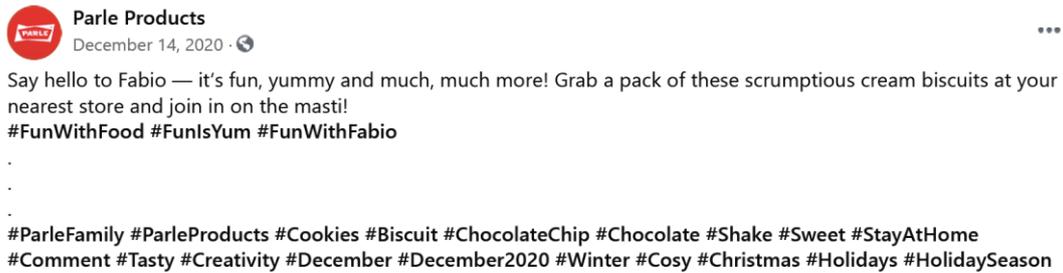
44. With that, one may proceed to examine the individual aspects of the controversy.

45. Infringement and passing off

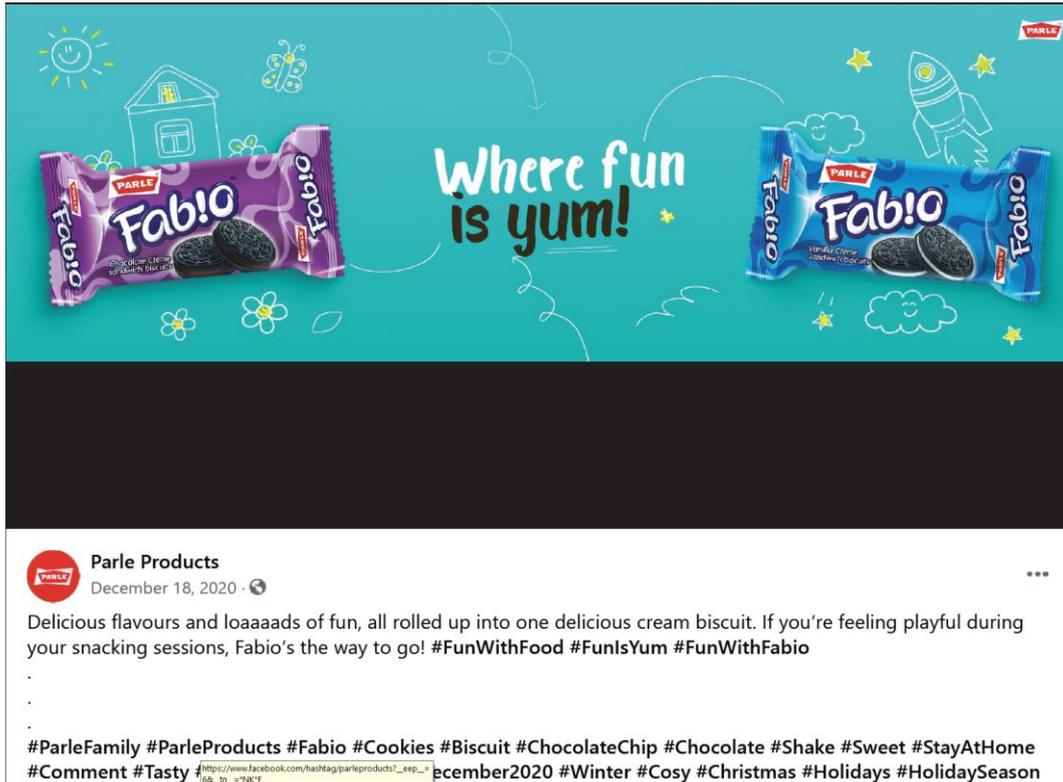
45.1. At the very outset, I may observe that it would be facile to suggest that any customer would be deceived into mistaking “FAB!O” for “OREO”. This is not, therefore, one of those cases in which the *names* of the plaintiff’s and defendants’ product sound so alike, to the ear, that one may mistake the latter for the former. There are a number of precedents in which the plaintiff’s and defendant’s marks sound the same and have, therefore, been held to be phonetically similar. They cannot, however, apply to the case on hand.

45.2. Before proceeding further, I may note that, though the defendant has stylistically written its mark as ‘FAB!O’, the ‘!’ is merely an ‘I’ in disguise. The defendant’s own promotional material bears this out. For instance, below the promotional advertisement that appears on the defendant’s Facebook page and reproduced in para 11 *supra*, one finds the following:

³³ 2023 SCC OnLine Del 153



Similarly, the following advertisements are also to be found on the defendant's Facebook page:



The same reference, to FAB!O as “Fabio” in the text of the captions used by the defendants, is to be found on other pages on its Facebook website, such as:





Parle Products

December 21, 2020 · 🌐

...

Whether you like vanilla or chocolate — everyone can agree that Fabio is very, very yum! Have you grabbed your pack yet? Find it at your nearest store!

#FunWithFood #FunIsYum #FunWithFabio

45.3 Thus, save and except in the mark as depicted on the cookie packs, the defendants, at all other points, refer to their biscuit as “Fabio”, not as “Fab!o”. The “i” in “Fabio” has, therefore, been made to stand on its head and metamorphose into an exclamation mark, only for the purposes of the mark as depicted on the biscuit packs, as “Fab!o”.

45.4 In fact, in the advertisement reproduced in para 11 *supra*, the defendant has expressly disabused the consumer public of any notion that the “!” exclamation mark in FAB!O is to be seriously regarded as an exclamation mark at all, by clarifying that FAB!O is to be pronounced “*fab-ee-yo*”. With that, the defendant has, in my view, given up all chance of seeking to make more of the “!” exclamation mark in FAB!O than what it really is; an “I” in disguise. All arguments of the defendant having introduced the exclamation mark to lend an air of “fun” to the mark, too, thereby, cease to be of relevance. Whatever be the purpose of interspersing, between “FAB” and “O”, the exclamation mark, the advertisements of the defendant contain clear and unambiguous representations that the mark is, actually, “FABIO”, and nothing else.

45.5 Are “FABIO” and “OREO”, then, phonetically similar?

45.6 Mr. Sethi sought to introduce a principle of “first syllable dissimilarity”. According to him, where the first syllable in the competing marks is different, the marks cannot be treated as

phonetically similar. The first syllable in the plaintiff's mark being "O" and the first syllable in the defendant's mark being "Fa", Mr. Sethi would submit that "OREO" and "FABIO" cannot be treated as phonetically similar.

45.7 Though Mr. Sethi has referred to certain decisions on the point, it is not necessary to labour on the issue, as there exist binding judicial precedents which have held marks to be phonetically similar and, therefore, likely to confuse or deceive, even where their first syllables are different. In *Amritdhara Pharmacy*⁸, while holding "Amritdhara" to be phonetically similar to "Laxmandhara", the Supreme Court observed thus:

7. Let us apply these tests to the facts of the case under our consideration. It is not disputed before us that the two names "Amritdhara" and "Lakshman-dhara" are in use in respect of the same description of goods, namely a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townfolk, literate as well as illiterate. As we said in *Corn Products Refining Co. v. Shangrila Food Products Ltd.*³⁴ the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man *the overall structural and phonetic similarity of the two names "Amritdhara" and "Lakshmandhara" is, in our opinion, likely to deceive or cause confusion.* We must consider the overall similarity of the two composite words "Amritdhara" and "Lakshmandhara". We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as "current of nectar" or "current of Lakshman". *He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase.*"

(Emphasis supplied)

Following *Amritdhara Pharmacy*⁸, a Division Bench of this Court, in

³⁴ (1960) 1 SCR 968

*Pankaj Goel v. Dabur India Ltd*³⁵, held the marks “HAJMOLA” and “RASMOLA” to be similar. “Haj” and “Ras” are no less dissimilar from each other than “Fab” and “Or”. The plea of Mr. Sethi, predicated on the dissimilarity between the first syllables of “FABIO” and “OREO” cannot, therefore, be accepted.

45.8 The manner in which the defendant has, in its advertisements³⁶, declared that its “FAB!O” mark is required to be pronounced as “fab-ee-yo” amounts to a candid acknowledgement that “FAB!O” is required to be pronounced like “OREO”, which would be pronounced “or-ee-yo”. Having so represented to the public, it can hardly lie in the mouth of the defendant to contend that “FAB!O” and “OREO” are *not* phonetically similar.

45.9 The two concluding syllables, of the three syllables which constitute each of the words “FABIO” and “OREO” being the same, i.e. “ee-yo”, the names undoubtedly rhyme. Rhyming word marks have been held to be phonetically similar in *Encore Electronics Ltd. v. Anchor Electronics & Electricals Pvt. Ltd.*³⁷ (“ANCHOR” *vis-à-vis* “ENCORE”), *Amritdhara Pharmacy*⁸ (“AMRITDHARA” *vis-à-vis* “LAXMANDHARA”), *Pankaj Goel*³⁵ (“HAJMOLA” *vis-à-vis* “RASMOLA”), *Rasiklal Manikchand Dhariwal v. M.S.S. Food Products*³⁸ (“MANIKCHAND” *vis-à-vis* “MALIKCHAND”) and *Bengal Waterproof Ltd. v. Bombay Waterproof Manufacturing Co.*³⁹ (“DUCKBACK” *vis-à-vis* “DACKBACK”). In fact, in *F. Hoffmann la Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.*⁴⁰, the

³⁵ 2008 (38) PTC 49

³⁶ Refer para 11 *supra*

³⁷ (2007) 35 PTC 714

³⁸ (2012) 2 SCC 196

³⁹ (1997) 1 SCC 99

⁴⁰ (1969) 2 SCC 716

Supreme Court has approved the judgment of the House of Lords in *Aristoc Ltd. v. Rysta Ltd.*⁴¹ which held the word “ARISTOC” to be phonetically similar to “RYSTA”.

45.10 On the aspect of phonetic similarity, further, much turns on the concluding “O” in “OREO” and “FAB!O”. It is of some significance, here, that the defendant had, before adding the terminal “O” for a select range of cookies, been selling biscuits, and cookies, under the FAB! mark in its packs of Bourbon biscuits and its ‘JAM-IN’ range, of jam filled biscuits. Images of these biscuits packs have also been thus provided in the written submissions filed by the defendant:



Thus, the FAB!O mark was reserved, by the defendant, for its range of cream filled chocolate sandwich biscuits. Of these, too, the packs in which it packed and sold said sandwich biscuits, when filled with chocolate cream, differed in appearance from those in which it sold the sandwich biscuits filled with vanilla cream, thus:

Chocolate cream filled FAB!O sandwich biscuits



⁴¹ 62 RPC 65 HL

Vanilla cream filled FAB!O sandwich biscuits



45.11 FAB!, with or without the “!” exclamation mark, has a laudatory meaning and connotation, which may appropriately be applied to biscuits as extolling their taste. FAB!O, on the other hand, is meaningless.

45.12 Why, even while using the laudatory “FAB!” mark for its other biscuits, did the defendant choose, solely for cream filled chocolate sandwich biscuits, choose to add an ‘O’, rendering the name meaningless? The defendants have no response forthcoming.

45.13 Names ending in “O”, let alone “IO”, are not commonplace in biscuits, and Mr. Sethi, too, does not seek to so contend. By adding an “O” to its earlier “FAB!” mark, the defendant has made the concluding “io” intonation in its “FAB!O” mark identical to the concluding “eo” intonation in the plaintiff’s “OREO” mark. Seen in conjunction with the fact that the “FAB!O” mark is used by the defendant only in respect of cream filled chocolate sandwich biscuits, and that, in fact, the blue package is used only for vanilla cream filled chocolate sandwich biscuits, the Court is inclined, *prima facie*, to hold that the defendant has consciously sought to approach as close to the plaintiff’s “OREO” mark as possible by adding a terminal “O” to its pre-existing “FAB!” mark. A customer of average intelligence and imperfect recollection, who is aware of the plaintiff’s vanilla cream filled chocolate OREO cookies and the package in which it is sold and

later comes across the defendant's vanilla cream filled chocolate FAB!O cookies, in a deceptively similar blue package, may legitimately be expected to draw an association between the FAB!O and OREO marks as both being used by the same manufacturer. The possibility of an association between the impugned mark of the defendant and the plaintiff's mark being drawn cannot be gainsaid.

45.14 The terminal "eo" sound in "OREO" is, conceivably, one of the striking features of the plaintiff's product, which distinguishes the biscuits in the mind of the average consumer of imperfect recollection. There is no other biscuit with a similar sounding name, with a concluding "eo" sound. When, therefore, another identical vanilla cream filled chocolate sandwich cookie enters the market, named "FAB!O" with a concluding "io" sound, there is every likelihood of the lay consumer, who remembers having had the "OREO" biscuit earlier, presuming a connection between the new "FAB!O" biscuit and the earlier "OREO" biscuit. The only alternative inference that such a customer would draw, if he was told that the two biscuits were, in fact, made by two different companies, would be that the clear intent was to make the name of the biscuit sound similar to "OREO", especially as it is not the defendant's case that a terminal "eo" sound is common to the biscuit – or any other – trade. The presumption would stand strengthened if the customer were to be informed that, for all biscuits *other than cream filled chocolate sandwich biscuits*, the name used by the defendant is just "FAB!", minus the terminal "O".

45.15 The defendant has provided no explanation for its decision to add an "O" to its existing FAB! mark, specifically for cream filled chocolate sandwich biscuits. The Court is, in the circumstances, inclined to the view that the addition of the 'O' was inspired by the

plaintiff's successful 'OREO' brand.

45.16 Inasmuch as the addition of the terminal "O" in the pre-existing "FAB!" mark of the defendant, which renders the concluding letters of the defendant's mark "IO" phonetically identical to the concluding "EO" letters of the plaintiff's "OREO" mark, has a prominent part to play in creating confusion. The addition of "O" by the defendant is *prima facie* deliberate.

45.17 The defendant has, in fact, in its written submissions, admitted the fact that, for its bourbon and jam filled biscuits, the defendant was using the mark "FAB!" without the terminal "O". The addition of the terminal "O" solely for packs in which cream filled chocolate sandwich biscuits were packed and sold, indicates, *prima facie*, that the defendant was seeking to capitalize on the goodwill earned by the plaintiff in respect of similar cream filled chocolate sandwich biscuits. This impression is strengthened by the difference in the packs in which the defendant was packing and selling its chocolate cream filled chocolate sandwich biscuits and its vanilla cream filled chocolate sandwich biscuits. A blue and white packing, using the shade of blue strikingly similar to the shade of blue used in the plaintiff's pack, was reserved for vanilla cream filled chocolate sandwich biscuits, just as the plaintiff is doing. For chocolate cream filled chocolate sandwich biscuits, the defendant uses a purple packing. When one compares, therefore, the marks and packing used by the defendant for its bourbon biscuit, "jam-in" jam-filled biscuits, chocolate cream filled chocolate sandwich biscuits and vanilla cream filled chocolate sandwich biscuits, it becomes immediately apparent that it is solely in respect of the vanilla cream filled chocolate sandwich biscuits, in packs which are strikingly similar to those in which the plaintiff packs and sells its

vanilla cream filled chocolate sandwich biscuits, that the defendant is using the “FAB!O” mark and a packing which is of the same colour scheme and, even otherwise, strikingly similar to the packing of the OREO biscuits of the plaintiff.

45.18 The difference in the design on the surface of the sandwich biscuits/cookies can hardly be made out by a glance at the packs, especially when they are displayed on a shelf at same distance from the customer. There is a difference, jurisprudentially, in the standard and test to be applied while gauging infringement, as compared to passing off. Infringement, as a statutory tort confined to Section 29 of the Trade Marks Act, necessarily predicates the existence of a registered trade mark. There can be no infringement of an unregistered trade mark. In assessing infringement, therefore, one compares the registered trade marks to assess whether they are so similar as to lead to confusion or deception, as envisaged by Section 29. As against this, passing off is a common law tort, which stands saved by Section 27(2) of the Trade Marks Act as an independent right available to the user of a mark, registered or unregistered. Infringement, therefore, is intended to protect the intellect that has been expended in conceptualizing and creating the allegedly infringed mark. It is a pure intellectual property right, and is independent of the intent of the alleged infringer. There is, therefore, no distinction between deliberate and innocent infringement, though deliberate copying might, in a given case, justify invocation of the *Slazenger*¹⁶ principle, discussed elsewhere in this judgement. The right to act against infringement is, therefore, *protective* in nature. It protects intellectual property.

45.19 Passing off, on the other hand, is, classically, a “tort of deceit”. Passing off actions, unlike infringement actions, are *both protective and punitive*. They protect the goodwill and repute earned by a person, in his goods or services, over a period of time, against those who seek to unfairly capitalize on them, who stand punished in the bargain. Passing off, as a common law action is, therefore, intended to punish the man who “passes off” his goods or services as the goods or services of another, or resorts to imitative subterfuge (as understood in law) to lead the public into believing an association between them. Declaring passing off to a “broader” action than infringement, the Supreme Court, in *S. Syed Mohideen v. P. Sulochana Bai*⁴², ruled thus:

“Thirdly, it is also recognized principle in common law jurisdiction that passing off right is broader remedy than that of infringement. This is due to the reason that the passing off doctrine operates on the general principle that no person is entitled to represent his or her business as business of other person. The said action in deceit is maintainable for diverse reasons other than that of registered rights which are allocated rights under the Act.”

45.20 In actual practical application, one often sees that the dividing line between infringement and passing off, in a given case, is, despite the jurisprudential distinction between the two rights, thin. The reason is obvious. Both rights are predicated on confusion and/or deception (between which, too, the dividing line is, again, thin, and stands largely obliterated by the definition of “deceptively similar” in Section 2(h)⁴² of the Trade Marks Act, which merges the two concepts) and, in each case, the matter is to be assessed from the point of view of the customer of average intelligence and imperfect recollection. Where the viewer, and the point of view, both coalesce, some amount of overlap is bound to occur.

⁴² (h) “deceptively similar” 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*;

45.21 A consumer from whose perspective the infringement, or passing off, is to be examined, is a customer of average intelligence and imperfect recollection. If one were to compare the blue OREO and “FAB!O” packs, from the images in para 22, and to apply the test of a customer of average intelligence and imperfect recollection, the distinguishing features between these two packings cannot be said to be such as would convince such a customer that the two packings were of biscuits manufactured by two different entities. One may contradistinguish the present case, for example, *Britannia*²¹ (on which Mr Sethi sought to rely), in which this Bench found, between the competing biscuit packs, several distinctive features, which effaced, *prima facie*, the change of confusion or deception. As against this, in the present case, the only real difference between the packs in which the plaintiff’s ‘OREO’ and the defendant’s vanilla cream filled ‘FAB!O’ sandwich biscuits are sold, is the presence of the “Cadbury” logo in the former and the “Parle” logo in the latter.

45.22 Though it is true that the logo of the manufacturers of the biscuits, i.e. of Parle in the case of “FAB!O” and Cadbury in the case of OREO, are visible on the packs, a customer of average intelligence need not be a person who is aware of the identity of the manufacturers of the respective cookies. That apart, the brand names for biscuits, cookies or like goods ending in “IO” or “EO”, being rare in the market, a customer of average intelligence, who has partaken of OREO cookies and, later, found “FAB!O” cookies in the market with identical cookies being shown on the packs, has every likelihood of presuming an association between the “FAB!O”, he saw later and the OREO that he had consumed earlier. No doubt, a customer who was actively conscious of the fact that OREO biscuits are manufactured by the plaintiff and “FAB!O” biscuits are manufactured by the defendant,

may not be so confused, but then such awareness cannot be attributed to a customer of average intelligence. The customer of average intelligence cannot be a person who regularly partakes either of the plaintiff's or of the defendant's cookies, or is a devotee of either. Such a customer is, obviously, unlikely to be confused between the two. The mythical customer, from whose point of view the issue is to be assessed, is one who, on one occasion, has had the OREO cookies and, on a later occasion, has the "FAB!O" cookies. Given all the similar features between the two packs in which the two cookies are sold, to which I have already alluded hereinabove, the likelihood of such a customer presuming an association between the "FAB!O" and OREO brand on the basis of the said similarities, in my opinion, looms large.

45.23 Given (i) the phonetic similarity in the "OREO and FAB!O" with the strategic terminal 'O', (ii) the blue colour of the packs, used by the defendant *only* for their vanilla cream filled chocolate sandwich biscuits, and (iii) the pictures of black cookies with white vanilla filling, there is every likelihood of an average intelligence and imperfect recollection presuming an association between the "FAB!O" and OREO marks. The trade dress of the defendant's vanilla cream filled FAB!O chocolate cookie is, therefore, in my considered opinion, deceptively similar to the trade dress of the plaintiff's vanilla cream filled OREO chocolate cookie.

45.24 Mr. Sethi has sought to contend that the trade dress employed by the plaintiff for its OREO cookies is common to the trade. The defendant has placed on record, in this context, photographs of

Sunfeast Vanilla Crème, McVities Dark Cookie Cream, Britannia Pure Magic, Britannia Treat, Cremica Vanilla and Zess Biscuits⁴³.

45.25 The argument, as advanced, however, remains inconclusive, and its inconclusive form, cannot be of avail to the defendant. Commonality to the trade, statutorily, is not a defence against infringement, though it curtails the right of the plaintiff. Section 17(2)(b)⁴⁴ of the Trade Marks Act stipulates that no exclusivity can be claimed in respect of any part of a trade mark which is common to the trade. Section 17 itself relates to “the effect of registration of a mark”.

45.26 In my opinion, merely citing trade dresses of cookies manufactured by others, which may be similar to the trade dress of the plaintiff and of the defendant, cannot suffice to hold that the trade dress of the plaintiff’s cookies is common to the trade. It would have to be shown that those other cookies manufactured, who were selling their cookies, had adopted a similar trade dress prior to the adoption of the trade dress by the plaintiff in respect of its OREO cookies. The emergence, in the market, of similar cookies in packages bearing a similar trade dress after a trade dress of the plaintiff’s OREO cookies has become known to the public, cannot render the plaintiff’s trade dress as common to the trade. Substantial use by the using the same trade dress, on whose basis a plea of “commonality to the trade” is

⁴³ Refer para 20 *supra*

⁴⁴ **17. Effect of registration of parts of a mark. –**

- (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.
- (2) Notwithstanding anything contained in sub-section (1), when a trade mark –
 - (a) contains any part –
 - (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or
 - (ii) which is not separately registered by the proprietor as a trade mark; or
 - (b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

urged, has also necessarily to be established. No such evidence is forthcoming in the present case. There is every possibility that the other cookie manufacturers, who have similar trade dress, copied the plaintiff's trade dress. In that event, it would become a case of several infringers of the plaintiff, and its trite, in law, that a plaintiff is not required to sue every infringer. One may borrow, in this context, a useful leaf from *Pankaj Goel*³⁵, in which the Division Bench of this Court held as under:

“21. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, *we find that the Appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business.* The Supreme Court in *National Bell v. Metal Goods*⁴⁵, has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In *Express Bottlers Services Pvt. Ltd. v. Pepsi Inc.*⁴⁶, it has been held as under:-

“...*To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point... The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers...*”

⁴⁵ (1970) 3 SCC 665 : AIR 1971 SC 898

⁴⁶ (1989) 7 PTC 14

22. In fact, in *Dr. Reddy Laboratories v. Reddy Paharmaceuticals*⁴⁷, a Single Judge of this Court has held as under:—

“...the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of “Taj Hotel”, the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers.” ”

(Emphasis supplied)

These findings and observations apply *mutatis mutandis* to the plea of commonality of the trade dress of the ‘OREO’ packs of the plaintiff to the trade, and effectively answer the submissions of Mr Sethi in that regard. The plea cannot, therefore, be accepted.

45.27 Mr. Lall has sought to submit that the aspect of deceptive similarity has to be viewed from the point of “initial interest confusion”.

45.28 There is substance in this contention. What counts is the immediate effect that the impugned packing would have on the unwary customer of average intelligence and imperfect recollection. If, at first glance, a consumer is likely to be confused, and evinces interest in the product, the test of initial interest confusion stands satisfied, and the mark loses distinctiveness. The varieties of “confusion” have been thus identified, by a Division Bench of this Court in *Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender &*

⁴⁷ (2004) 29 PTC 435

*Distilleries Pvt. Ltd*⁴⁸, relying on McCarthy on Trademarks and Unfair Competition:

“5. Confusion can be of the following categories:

- Point of sale confusion-this refers to confusion that takes place at the time of purchase.
- Post sale confusion - this includes confusion of those other than the purchaser.
- Initial interest confusion - this refers to confusion that may be caused initially, i.e. prior to purchase, but at the time of purchase of the alleged infringer/tortfeasor's product or using its service, the consumer is not confused.
- Reverse confusion - this occurs when consumers purchase the goods or use services of the senior user thinking them to originate from the junior user.”

A consumer of average intelligence and imperfect recollection who has earlier purchased and had the OREO cookie would, when he sees the FAB!O cookie pack, be clearly likely to associate the FAB!O cookie with the OREO cookie that he had earlier enjoyed (assuming he did). That, by itself, satisfies the test of “initial interest confusion”.

45.29 In the above analysis, the Court has kept in mind the following principle for comparison, as enunciated by Kekewich, J. in *Munday v. Carey*¹⁷, which Courts in this Court have been following in case after case:

“Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity.”

“Dishonesty”, in this exordium, has to be understood not in its classical sense, but as representing an attempt to copy the trade mark, or trade dress, of another, so as to result in possible confusion in the mind of the average consumer, thereby capitalizing on the goodwill

⁴⁸ (2015) 63 PTC 551

earned in the earlier mark. In the facts of the present case, therefore, the minor differences in detail between the blue FAB!O pack of the defendants and the blue OREO pack of the plaintiff are so minor as would be required to cede place to the overall impression that the similarities between the two products would convey to the average consumer of imperfect recollection.

45.30 Whether seen in isolation or cumulatively, the aforementioned factors do indicate, *prima facie*, that the defendants have, in (i) adopting the FAB!O mark solely for vanilla filled chocolate sandwich biscuits, (ii) advertising the product as they have, stressing the manner in which “FAB!O” is to be pronounced, and (iii) using, solely for the vanilla filled chocolate FAB!O cookies, a pack which is deceptively similar in appearance to the OREO cookie pack of the plaintiff, made an effort to approach as close to the plaintiff’s registered trade mark, and trade design, as possible. In such circumstances, the test to be applied stands thus authoritatively identified by Lindley, LJ, in *Slazenger*¹⁶:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?”

45.31 By applying the *Slazenger* principle, where the defendant has, by adding a terminal “O”, sought to render its mark phonetically similar to “OREO”, so as to create confusion in the mind of customer of average intelligence and imperfect recollection, the Court would be inclined to believe that the attempt is successful.

45.32 Mr Sethi had sought to press into service, in this context, my

decision in *Britannia*²¹, to contend that mere intention to confuse could not make out a case of infringement or passing off. There can be no gainsaying the proposition. Infringement, or passing off, unquestionably, requires, for even a *prima facie* finding to that effect to be returned in favour of the plaintiff, *actual likelihood of confusion or deception on the part of the defendant*. If no such likelihood exists, the fact that the plaintiff *intended to confuse or deceive* is of no moment. Where, then, does *Slazenger* fit in?

45.33 The answer, to my mind, is obvious. The Court would examine whether the impugned mark or trade dress, when examined vis-à-vis the asserted mark or trade dress and the surrounding circumstances of the case, reveals, *prima facie*, an intent on the part of the defendant to confuse or deceive the plaintiff's customers. It is trite that the Court, when it has – as it does, on occasion – to don the gown of the psychoanalyst, has to tread cautiously. The Court is not, therefore, lightly to come to a conclusion on the point, and it is only where the intention is *prima facie* apparent from the facts that a finding, in the affirmative, should be returned. *If such an intent is prima facie apparent*, however, the Court must, then, when examining whether the mark of the defendant is so similar to the mark of the plaintiff as to confuse or deceive, lean towards a presumption that the nefarious intent of the defendant is successful. That presumption, however, does not absolve the Court of the duty to, by itself, assess whether there is, in fact, confusing or deceptive similarity between the rival marks or trade dresses, viewed from the point of a customer of average intelligence and imperfect recollection. If there is no such similarity, or if the defendant's mark contains distinctive or distinguishing features which are sufficient to disabuse, even to the customer of average intelligence and imperfect recollection, any

association with the plaintiff's mark, then, the mere fact that the defendant might have had an intent to confuse or deceive would not justify a finding, even *prima facie*, either of infringement or of passing off. *While coming to this finding*, however, the Court would, applying the *Slazenger* principle, lean towards a presumption that the defendant is successful in its attempt to confuse or deceive. In *Britannia*²¹, I felt the features which went to distinguish the defendant's biscuit pack from the plaintiffs to be too numerous to be ignored even by the customer of average intelligence and imperfect recollection; ergo, I held that infringement or passing off could not be said to have taken place. In the present case, a conjoint appreciation of the phonetic similarity between the plaintiff's and defendant's marks, seen in the light of the similarity in trade dress, propel me to hold to the contrary. Unlike *Britannia*²¹, therefore, the dissimilarities between the two marks cannot be regarded as so many as to override the *Slazenger* presumption.

45.34 For all these reasons, I am of the opinion that the defendant has, *prima facie*, infringed the registered trade marks of the plaintiff, and has also, by adopting a trade dress which is deceptively similar to that of the plaintiff's 'OREO' brand of cookies, sought to pass off its FAB!O brand of vanilla cream filled chocolate cookies as bearing an association with the plaintiff's OREO cookies.

46. Infringement or passing off based on similarity of cookie design

46.1 I am unable to subscribe, however, to Mr Lall's contention that the cookie/biscuit design of the defendant infringes the registered biscuit design of the plaintiff, or that, by similarity of biscuit design, the defendant is passing off its "FAB!O" biscuit as the plaintiff's

“OREO” biscuit, or as associated with it.

46.2 Infringement

46.2.1 A comparison of the surface designs of the plaintiff’s OREO biscuit and the defendant’s FAB!O biscuit, as provided in para 19 *supra*, reveals that the designs are almost totally dissimilar. Infringement could be alleged only if the design on the surface of the defendant’s FAB!O biscuit were identical, or confusingly or deceptively similar, *to the design on the plaintiff’s OREO biscuit which stands registered as a trade mark*. Insofar as the surface designs of the biscuit are concerned, the registration held by the

plaintiff is of the  mark. The mark, as registered, clearly discloses the shapes of the individual florets as well as the prominent legend ‘OREO’ in an elliptical enclosure towards the centre of the

biscuit. The  design of the defendant’s FAB!O cookie has no such elliptical enclosure or any logo whatsoever on its surface; the florets are distinct and different in shape and the overall appearance of the surface design is also different. The mere existence of a ridged outer surface and an outer border comprising of ‘dashes’ (– –) cannot render the two designs confusingly or deceptively similar. To a person of imperfect recollection, too, the design of the FAB!O biscuit cannot be regarded as confusingly similar to that of the OREO biscuit.

46.2.2 Infringement has to be assessed by comparing the marks feature for feature, and, so done, I am not convinced, *prima facie*, that the



surface design of the defendant's FAB!O biscuit infringes



the registered design of the plaintiff's OREO biscuit.

46.3 Passing off

Insofar as the surface design on the plaintiff's biscuit is concerned, the plaintiff has a still weaker case for passing off, against the defendant. Mr Sethi is correct in his submission that the biscuits are never sold loose and that, therefore, the surface design of the biscuits cannot be regarded as an attempt by the defendant to pass off its FAB!O biscuit as the OREO biscuit of the plaintiff, or as related thereto. Besides, the prominent embossing, towards the very centre of the plaintiff's biscuit, of the OREO logo, would obviously register in the mind of the average consumer, even if he be of imperfect recollection. The absence of any such logo on the defendant's FAB!O biscuit is itself, sufficient to distinguish biscuit from biscuit. In any event, and at the cost of repetition, as the biscuits are never sold loose, the aspect of passing off is really of little significance.

Conclusion

47. For the aforesaid reasons, the defendant as well others acting on behalf of the defendant are restrained from using the impugned FABIO or FAB!O mark for any purpose whatsoever. The defendant is also restrained from manufacturing, packing or selling their vanilla cream filled chocolate sandwich biscuits in the impugned pack or using the impugned trade dress. This injunction shall also apply to

stocks presently in the defendant's possession and as yet uncleared, though it would not apply to stocks which have already been released in the market.

48. The aforesaid injunction shall remain in force pending disposal of the suit.

49. IA 1803/2021 stands allowed accordingly.

50. Observations and findings in this order are only *prima facie*, and are not intended to influence the Court when the suit is finally considered on merits.

C. HARI SHANKAR, J

FEBRUARY 10, 2023

Kr/dsn/AR

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