$~

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

% *Date of Decision: 29th May, 2026*

\+ CS(COMM) 637/2024

GRM FOODKRAFT PVT LTD AND ANR .....Plaintiffs

Through: Mr. J. Sai Deepak, Senior Advocate with Mr. Utkarsh Joshi, Ms. Sudarshana Bandyopadhyay, Mr. Vinay Thakur and Mr. Abhishek, Advocates.

versus

KS AGRO IMPEX AND ANR. .....Defendants

Through: Mr. Chander M. Lall, Senior Advocate with Mr. Ankur Sangal, Mr. Ankit Arvind, Mr. Shaurya Pandey and Ms. Ananya Mehan, Advocates for D-1.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

I.A. 35064/2024 *(u/O XXXIX Rules 1 and 2 CPC, filed by Plaintiff)* and **I.A. 40114/2024** *(u/O XXXIX Rule 4 CPC, filed by Defendant No. 1)*

1. This judgment will dispose of an application filed by the Plaintiffs under Order XXXIX Rules 1 and 2 CPC and an application under Order XXXIX Rule 4 CPC filed on behalf of Defendant No.1.

2. To the extent necessary, the case set up by the Plaintiffs is that Plaintiff No.1 is a wholly owned subsidiary of Plaintiff No.2 and was incorporated on 07.07.2020 and Plaintiff No.2 is an entity registered under Companies Act, 1956 and was incorporated in 1995. In 1974, Plaintiffs' predecessors commenced business of rice milling and processing as a family business by the name of Garg Rice & General Mills. Between 1974-1979,

they established the first rice milling plant in Panipat, Haryana and during this time they were only engaged in sale of rice in the domestic market. Another milling plant was set up in 1980 and later in 1988, they commenced their international business with export to Saudi Arabia and other middle eastern countries. By 2024, Plaintiff No.2 had expanded its market presence to encompass more than 38 countries, thereby attaining recognition of being among the top basmati rice exporters from India.

3. It is stated that Plaintiffs' products earned recognition and certification from prominent global associations for excellence in food safety, packaging, storage and distribution and their products are certified under Good Manufacturing Practice and Hazard Analysis Critical Control Point standards, ensuring that rigorous protocols are followed throughout the manufacturing process to guarantee safety and quality of its offerings. Plaintiffs' goodwill and reputation, both internationally and in India, is established by sales turnover for financial years 2020-2021 to 2022-2023, as follows:-

Sales In India of Plaintiff No.1:-

Financial Year	Sales turnover (INR crores)
2020 – 2021	58
2021 – 2022	189
2022 – 2023	264

International Sales of Plaintiff No.2:-

Financial Year	Sales turnover (INR crores)
2020 – 2021	652
2021 – 2022	911
2022 – 2023	1063

4. It is stated that in 2020, Plaintiff No.1 was set up as a wholly owned subsidiary of Plaintiff No.2 to specifically focus on domestic market and it adopted the house mark '10X' with individual sub-brands/trademarks for each product appearing in conjunction with 10X on the product packaging. In 2021, Plaintiff No.1 launched 'Golden Sella Basmati Rice' under the trademark and sub-brand 'Zarda King'. Plaintiff No.1's product range of rice includes steam rice and long grain rice, which are generally consumed on daily basis as also 'cream sella' and 'golden sella' which are premium brands and priced higher than the daily consumable varieties. Golden Sella Basmati Rice was launched under the mark and sold in different sized packaging with a special and aesthetically designed trade dress having unique features such as: (i) green and gold colour scheme; (ii) letters inscribed in special gold font and a style resembling the Urdu/Arabic script; (iii) placement of mark 'Zarda King' as a the sub-brand in the centre in a uniquely stylised/designed golden font in two lines ; (iv) design of hanging lanterns and stars on the upper part of the packaging in golden colour; (v) a crescent-shaped moon with a star placed in the top centre of the packaging; (vi) image of a building resembling Arabic architecture with minarets; and (vi) image of a plate of pulao at the bottom of the packaging, as follows:-



5. It is stated in the plaint that on 04.11.2022, trademark (device)  under application no. 5669692 and trademark (device)  under application no. 5669694 were assigned by Mr. Dhruv Kumar Singhal in favour of Plaintiff No.1 vide Assignment Deeds dated 06.08.2023. Plaintiffs achieved immediate success in the product Golden Sella Basmati Rice under the specially designed unique packaging and earned revenues exceeding Rs.86 crores in three years from 2021, which together with expenses incurred by Plaintiff No.1 in promoting and advertising the product as follows, reflect not only the immense goodwill and reputation garnered in short span of time but are also pointers to the distinctiveness of the packaging/trade dress and its association in the minds of public with the Plaintiffs alone:-

Financial Year	Marketing and Sale and Promotion Expense (INR)
2023 – 2024	2,86,26,255 (Approx Rs 2.86 cr)
2022 – 2023	3,60,47,399 (Approx Rs 3.60 cr)
2021 – 2022 (1 Oct 2021 onwards)	1,71,95,742 (Approx Rs 1.7cr)

6. In the first week of July, 2024, Plaintiff No.1 learnt through trade channels that Defendant No.1 is a producer and seller of rice and was selling Golden Sella Basmati Rice and when the product was purchased from the market, it was discovered that the packaging was deceptively similar to Plaintiff No.1's packaging of Golden Sella Basmati Rice inasmuch as almost every essential element, colour scheme, font stylization and even the word 'Zarda', prominently placed on Plaintiffs' packaging, were copied with

an intent to encash on the formidable goodwill and reputation of the Plaintiffs. It was also found that Defendant No.2 manufactures and supplies product packaging to many entities including Defendant No.1 and was also supplying the impugned packaging to Defendant No.1. After carrying out an extensive survey, Plaintiffs filed the present suit and by an *ex parte* ad interim order dated 01.08.2024, Court restrained the Defendants and all others acting on their behalf from selling, offering for sale and advertising their product in impugned trade dress/packaging 

, which in *prima facie* view of the Court was confusingly or deceptively similar to the trade dress/packaging of the Plaintiffs and/or variants thereof. Court granted liberty to Defendant No.1 to carry on its business by using different trade dress/packaging, which was distinct and not deceptively similar to that of the Plaintiffs. Defendant No.1 thereafter filed an application under Order XXXIX Rule 4 CPC for vacation of *ex parte* ad interim injunction in which notice was issued on 04.10.2024. Be it noted that during the pendency of the proceedings, Defendant No.1 had proposed revised packaging, but the matter could not be settled owing to Plaintiffs' perception that they were also deceptively similar and consumers will continue to be confused.

7. Learned Senior Counsel for the Plaintiffs argued that Plaintiffs designed and adopted a special packaging in 2021 with a unique trade dress to sell the Golden Sella Basmati Rice under the sub-brand Zarda King and have been continuously, extensively and uninterruptedly using the same ever since. Defendant No.1 dishonestly and deliberately adopted the impugned packaging/trade dress in which it was selling identical product i.e Golden

Sella Basmati Rice and which is deceptively and confusingly similar to Plaintiffs' packaging/trade dress. The adoption is clearly *mala fide* with an intent to mispresent to the public that Defendant No.1's product has an association with the Plaintiffs and thereby encash on the immense goodwill and reputation garnered by the Plaintiff in a short period through sale of rice in the unique packaging and this causes irreparable harm and damage to Plaintiffs' goodwill and reputation. Golden Sella Basmati Rice sold by the Plaintiffs under the distinctive packaging has earned revenues exceeding Rs.86 crores in three years from 2021, the year in which it was launched and Plaintiffs have expended a substantial sum of over Rs.8 crores in promoting and advertising the product. Celebrities such as Mr. Salman Khan and Ms. Saina Nehwal have endorsed the brand and its visibility extends to hoardings and YouTube videos across several markets and creates a memory recall. Plaintiffs have placed on record CA Certificate, investment filings, listings on IndiaMart, sales invoices etc. which corroborate the immense goodwill and reputation in the distinct packaging. Thus, all the three ingredients of passing off i.e. goodwill and reputation, misrepresentation and irreparable harm and damage to the goodwill and reputation are satisfied in the present case and the *ex parte* ad interim injunction order deserves to be confirmed.

8. It was further urged that Defendant No.1's Golden Sella Basmati Rice packaging/trade dress is a near replica of Plaintiffs' trade dress and almost all essential and prominent features have been copied to confuse the consumers, such as: (i) green and gold colour scheme; (ii) stylization of english letters in gold to resemble the Urdu/Arabic script; (iii) word 'Zarda' in same golden font and style *albeit* with a suffix 'Special'; (iv) hanging lanterns and stars at the top of the packaging in golden colour; (v) below the brand name 'Zarda' is written in Urdu/Arabic script; (vi) a monochromatic

picture depicting a traditional Arabic building with four minarets at the lower end of the packaging in golden colour; and (viii) picture showcasing a plate with pulao at the bottom of the packaging. In any event, the test is not to see individual elements but one of 'overall impression' and on this touchstone when rival trade dresses are compared, they are deceptively similar and there is every likelihood of confusion in the minds of target demographic. The similarities in the impugned packaging leave no doubt that the intent behind copying was to take unfair advantage of and encash on the goodwill of the Plaintiffs for unlawful monetary gains by misrepresenting to the public that there is some association/affiliation with the Plaintiffs. This amounts to passing off and infringement of the copyright which Plaintiffs hold in the original artistic work in the trade dress.

9. It was further argued that a market survey carried out by the Plaintiffs among 208 persons in 7 cities, comprising 109 street hawkers, 75 rice retailers and 24 rice distributors, showed that 81% were aware of Plaintiffs' packaging and 85% could identify the same from a distance. 52% persons identified Plaintiffs' packaging based on colour while 28% identified basis the packaging and 18% identified on the basis of the design. When the product of Defendant No.1 was shown, 10% associated the same with the Plaintiffs. The survey indicates that the green colour combination and the unique design of the packaging have a great bearing on the recall value of the product in the eyes of the consumers.

10. It was urged that it cannot be overlooked that the target audience of the product in question primarily comprises of street hawkers, rice distributors and rice retailers in Tier-II and Tier-III cities/towns and not all customers/consumers will be discerning. Likelihood of confusion gets enhanced owing to rival products being identical; trade channels and

consumers being common; and packaging with strikingly identical green background and green and gold combination with Zarda inscribed on it being often stacked together on the same shelves in the shops/stores. In fact, use of word 'Zarda' adds to the likelihood of confusion amongst potential consumers who will be led into believing that the impugned product is another variant from the Plaintiffs and gives strength to Plaintiffs' stand that Defendant No.1 intends to pass off its goods as those of the Plaintiffs. The true test of passing off is the existence of similarities and not dissimilarities since confusion originates from similarities in the minds of persons with average intelligence and imperfect recollection, as held in ***Ruston & Hornsby Ltd. v. Zamindara Engineering Co., (1969) 2 SCC 727*** and ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73*** . It was emphasised that in case of edible products such as rice greater sensitivity is required and the threshold of deceptive similarity is far lower. ***[Dominos IP Holder LLC and Another v. Dominick Pizza and Another, 2023 SCC OnLine Del 6135; Ferrero SPA and Others v. M.B. Enterprises, 2025 SCC OnLine Del 5105;*** and ***Capital Foods Private Limited v. Sankalp Recreation Private Limited and Ors., MANU/DEOR/ 75775/2025].***

11. Placing heavy reliance on the judgment in ***Parle Products (P) Ltd. v. J.P. and Co., Mysore, (1972) 1 SCC 618,*** it was argued that the instant case fits into the facts of the said case where the Supreme Court ruled that Defendants' wrapper was deceptively similar to Plaintiffs, since the rival packets were of the same size; colour scheme was almost similar; and the rival wrappers depicted a girl with one-arm raised and carrying something in the other, surrounded by cows and hens or chicken in the background. The words 'Gluco Biscuits' in one and 'Glucose Biscuits' in the other occupied prominent places at the top with a good deal of the similarity

between the two writings. The Supreme Court observed that if one was not careful enough to note the peculiar features of the wrappers on Plaintiffs' goods, he might easily mistake Defendants' wrapper for the Plaintiffs if shown to him some time after he had seen one of the Plaintiffs'. Reliance was also placed on the judgment of the Division Bench of this Court in ***Under Armour Inc v. Anish Agarwal and Another, 2025 SCC OnLine Del 3784*** for the proposition that similarity of rival trade dresses will lead to initial interest confusion and of Co-ordinate Bench in ***Marico Limited v. Mr. Mukesh Kumar and Others, 2018 SCC OnLine Del 10823,*** where it was held that the trade dress was novel and distinctive and Plaintiff could claim exclusivity over several elements as a whole such as coconut tree, broken coconut device, a flag with a dark blue background, descriptions in white font including blue colour of the bottle. Emphasising on the proposition that if the dominant colour scheme is copied, it is sufficient to make out a case of passing off, reliance was placed on the judgments of this Court in ***Mondelez India Foods Pvt. Ltd. and Another v. Neeraj Food Products, 2022 SCC OnLine Del 2199*** and ***Colgate Palmolive Company & Another v. Anchor Health and Beauty Care Pvt. Ltd., 2003 SCC OnLine Del 1005***.

12. It was contended that Defendant No.1's stand that the word Zarda is generic or descriptive or common to trade, is misplaced. Zarda is not commonly understood as reference to a sweet dish and does not ordinarily translate to Golden Sella Basmati Rice, which is the product in question here and therefore, in the context of the present product, the mark is at the highest suggestive and hence, inherently distinctive. Assuming the word Zarda is generic/descriptive, this argument cannot rescue Defendant No.1 in the context of the present packaging, which is an imitation of Plaintiffs' packaging and as a part of overall plan to copy and pass off its goods as

those of the Plaintiffs. As for common to trade, it is trite that Plaintiffs are not required to chase and sue every third party using the word Zarda, assuming this position is factually correct. None of the documents filed by Defendant No.1 show any party using the word Zarda with a packaging deceptively similar as in the instant case with same colour combination and elements. Defendant No.1 has not only copied the word Zarda but has dishonesty and cleverly laboured hard to add the suffix 'Special' to create a false illusion of distinction.

13. Taking the Court through the comparative table of the rival trade dresses/packaging, it was asserted that the impugned packaging is a near replica of Plaintiffs' packaging and thus there is no merit in the defence raised by Defendant No.1 that owing to use of house mark 'DOUBLE CHABI', on its packaging there is no scope of confusion amongst members of the public. In products such as rice the first point of decision making is the visual impression of the colour scheme, getup and layout rather than textual content and for ready reference, comparative of the rival packaging is as follows:-

Plaintiffs' Product packaging	Defendant No 1's Product packaging ("Impugned Product packaging")
	

14. Learned Senior Counsel for Defendant No.1 submitted that said Defendant was established as a partnership firm in 2016 and in July, 2024, two of its partners applied for registration of a label with 'Double Chabi

Zarda Special' for Basmati Rice and began using the same. Defendant No.1 is a reputed business entity and is selling over 50 kinds of rice products under the brand Double Chabi and is also exporting the same to over 25 countries. Plaintiffs' allegations of infringement of copyright and passing off are frivolous and without merit, inasmuch as Plaintiffs cannot assert any exclusive right or monopoly on individual elements of the trade dress such as green and gold colours, English letters, hanging stars and lanterns, crescent shaped moon and plate of pulao etc. It is a settled law that colours and colour combinations are not inherently distinctive and distinctiveness has to be established by long use and voluminous sales, which Plaintiffs are unable to substantiate. Plaintiffs do not have any registration in the trade dress or the trademark Zarda King and plaint lacks any assertion that Plaintiff No.1 is the 'Author' of the artistic work in the packaging and consequently, copyright holder. Reliance was placed on the judgment of this Court in ***Britannia Industries Ltd. v. ITC Limited, 2017 SCC OnLine Del 7391,*** to bring home the point that colours and colour combinations are not inherently distinctive and to succeed in a claim of passing off, distinctiveness has to be established by showing long and consistent user and that members of public associate the colour and/or combination thereof with the Plaintiffs alone, which they have failed to establish, even *prima facie.*

15. It was argued that the word Zarda is non-distinctive and means a traditional boiled sweet rice dish made from milk, saffron, sugar and food colouring. The word Zarda comes from the Urdu word Zard which means 'yellow' and which is why Zarda is often a very bright hue of yellow or orange. Many sellers use the word Zarda to describe a particular type of rice and also in the same font and documents to this effect have been filed. Zarda

is written in English on the impugned packaging in a particular font resembling the Urdu script only because Zarda is a dish originating from the Mughals and not with the objective of imitating or copying Plaintiffs' trade dress and moreover, Plaintiffs cannot claim any independent or exclusive right over the word Zarda, much less in the stylization or font as they do not have registration in the word Zarda and significantly, at the time of filing the trademark application for the device mark , disclaimer was given that no right will be claimed over the word Zarda, the same being a generic word. In any event, reading of the plaint and the reliefs sought shows that Plaintiffs have not even asserted any right on the word Zarda and hence, any claim of dishonest user by Defendant No.1 is misplaced in law. Reliance was placed on the judgments in ***Sanjha Chulha v. Sanjha Chulha and Others, 2022 SCC OnLine Del 3616*** and ***Rhizome Distilleries P. Ltd. and Others v. Pernod Ricard S.A. France and Others, 2009 SCC OnLine Del 3346***.

16. It was also argued that there is no similarity, leave alone deceptive similarity, between the rival trade dresses. Plaintiffs' trade dress has a packaging with glossy finish without polka dots, while Defendant No.1's packaging is dark green in colour with white polka dots in the background and a matte finish. Importantly, Plaintiffs use their house mark 10X prominently on the packaging while Defendant No.1 uses its house mark DOUBLE CHABI prominently on its packaging and this crucial difference is sufficient to discard any argument of customer confusion. Moreover, Plaintiffs' packaging is completely sealed from the sides with no foldable

ends while packaging of Defendant No.1 has foldable sides with DOUBLE CHABI logo printed on both sides. Plaintiffs' packaging has an image of a pulao dish in a plate towards the left of the packaging which is very different from the placement in the centre in the impugned packaging. Another crucial distinction is the prominent red colour strip in the lower part of Defendant No.1's packaging and the blue/purple background in Plaintiffs', with images of a building with minarets and floral imprints. While examining deceptive similarity, Court cannot completely disregard the points of dissimilarity as irrelevant. Dissimilarities, if sufficient, can obviate possibility of confusion in a given case as held in ***Britannia Industries Ltd. v. ITC Ltd. and Others, 2021 SCC OnLine Del 1489*** and ***Carlsberg India Pvt. Ltd. v. Radico Khaitan Ltd., 2011 SCC OnLine Del 5497***.

17. It was emphasised that in order to succeed in a claim for passing off, Plaintiffs have to establish all three ingredients: goodwill and reputation, misrepresentation and damage, however, Plaintiffs have failed to place any material on record which establishes their goodwill and reputation in their trade dress/packaging and/or that it is distinctly associated with them in the minds of the public. ***[Ref.: M.L. Brothers LLP v. Uma Impact Private Limited and Another, 2023 SCC OnLine Del 1492].*** In other words, the argument was that Plaintiffs have only shown sales turnover and advertisement expenses in respect of the entire business under the mark 10X and no separate figures are forthcoming related to sale of Golden Sella Basmati Rice under the sub-brand Zarda King and the packaging/trade dress, claimed to be unique. Plaintiffs have also failed to make out a case of misrepresentation and/or dishonest use or adoption by Defendant No.1 and *per contra*, Defendant No.1 has established its *bona fides* by showing that it has consistently used its house mark DOUBLE CHABI on the impugned

packaging, which clearly makes the impugned packaging distinct and easily identifiable by any customer of average intelligence and imperfect recollection. ***[Ref.: Intex Technologies (India) Ltd. & Anr. v. M/s AZ Tech (India) & Another, 2017 SCC OnLine Del 7392].*** Plaintiffs have thus failed in discharging the onus of showing that Defendant No.1 is passing off its product using allegedly deceptively similar packaging. The survey report filed by the Plaintiffs is a self-serving document with no credibility attached to it. Moreover, rival products are sold in 30 Kgs bags and a consumer buying a 30 Kg bag of rice would be a discerning consumer and there would be no likelihood of confusion. ***[Ref.: Pernod Ricard India Private Limited and Another v. Karanveer Singh Chhabra, 2025 SCC OnLine SC 1701].*** Plaintiffs have also failed to prove the third ingredient for passing off i.e. injury or damage. No material on record suggests actual confusion, complaints and/or loss of profit. In any case, it is settled that if Defendant is able to show any added matter which is sufficient to dispel confusion, case of passing off must fail. ***[Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, 1964 SCC OnLine SC 14].***

18. Heard learned Senior Counsels for the parties and examined their rival submissions.

19. As per the case set up by the Plaintiffs, they launched the product Golden Sella Basmati Rice under the 10X mark with sub-brand Zarda King in a distinct and unique packaging/trade dress and there is no dispute that the



mark of the Plaintiffs is not registered and the application is pending *albeit* there is a dispute between the parties as to the disclaimer

given before the Registrar of Trade Marks with respect to the mark Zarda. Plaintiffs' claim of passing off and copyright infringement essentially revolves on the packaging/trade dress in which they sell this special variety of basmati rice. It is asseverated that the packaging was specially and aesthetically designed and is unique, owing to the green and gold colour scheme; exclusive gold lettering in English designed with unusual font/stylization to resemble Urdu/Arabic script; prominent placement of the mark Zarda King in the centre in uniquely styled and designed golden font in two lines; design of hanging stars and lanterns at the top of the packaging in golden colour; crescent shaped moon with a star placed near the top centre of the pack; and a depiction of a pulao plate at the bottom of the packaging with minarets and floral pattern etc. This unique trade dress, Plaintiffs claim, qualifies both as trade dress protected under the Trade Marks Act, 1999 and an original artistic work within the meaning of the Copyright Act, 1957.

20. Contrary to the stand of Defendant No.1, Plaintiffs claim to have placed on record documents showing sales turnover from 01.10.2021 to the end of financial year 2023-24 reflecting sales exceeding Rs.86.16 crores in respect of Golden Sella Basmati Rice sold under the unique packaging with 10X mark and sub-brand Zarda King as also expenditure of about 8 crores incurred on promotion and marketing and basis the revenue earned, expenses incurred, social media presence, brand endorsements by celebrities and listings on third party websites such as IndiaMart etc., it is asserted that Plaintiffs have garnered immense goodwill and reputation and their unique packaging/trade dress has become distinctive and has a recall value in the minds of the public. Case of passing off is set up against Defendant No.1 by pleading and arguing that it has adopted a deceptively similar/nearly

identical packaging/trade dress for identical product i.e. Golden Sella Basmati Rice and comparison of the rival packaging will demonstrate that every effort has been made by Defendant No.1 to come as close as possible to the Plaintiffs by copying almost all prominent elements, with a view to misrepresent to the public that its rice emanates from the house of the Plaintiffs or has some association with them and this is causing irreparable damage to the Plaintiffs' goodwill and reputation apart from financial loss. It was urged that the test of comparison is the 'overall impression' and on applying this test and finding that there was dishonest copying by Defendant No.1 of all essential elements, *ex parte* ad interim injunction was granted by the Court, which deserves to be made absolute till the disposal of the suit and Defendant No.1's application for vacation deserves to be dismissed.

21. Defendant No.1, on the other hand, seeks vacation of the *ex parte* injunction order by highlighting what it perceives are the stark differences in the rival packaging/trade dresses and asserting that no party can claim proprietary rights or monopoly in colours, colour combinations, individual elements such as stars, lanterns, images of dishes such as pulao or even in the word Zarda, which is generic, descriptive and common to trade and in which Plaintiffs do not have registration. Defendant No.1 on the very fundamental level questions and contests the allegation of deceptive similarity of its packaging/trade dress. Defendant No.1 also strenuously refutes the allegation of *mala fide* intent to copy/imitate the trade dress of the Plaintiffs and in support places heavy reliance on prominent display of its house mark DOUBLE CHABI on the packaging as a strong indicator to the members of public and members of trade that its product has no association/affiliation with Plaintiffs' brand and product. Goodwill and reputation claimed by the Plaintiffs, an essential ingredient of passing off

action, is opposed by contending that the documents showing sales/expenses are in respect of entire business and not specific to sales, if any, under the packaging which is the subject matter of this suit and hence, the relief sought must fail on this point alone.

22. Passing off is a tortious act and the classic trinity test required to be passed is goodwill and reputation; misrepresentation; and damage/injury. The House of Lords in ***Reckitt & Colman Products Ltd. Respondents and Borden Inc. and Others Appellants, [1990] 1 WLR 491***, observed that passing off is aimed at protecting the goodwill associated with the mark and relevant observations are as follows:-

> *"The basic underlying principle of such an action was stated in 1842 by Lord Langdale M.R. in Perry v. Truefitt (1842) 6 Beav. 66, 73 to be: "A man is not to sell his own goods under the pretence that they are the goods of another man ...." Accordingly, a misrepresentation achieving such a result is actionable because it constitutes an invasion of proprietary rights vested in the plaintiff. However, it is a prerequisite of any successful passing off action that the plaintiff's goods have acquired a reputation in the market and are known by some distinguishing feature. It is also a prerequisite that the misrepresentation has deceived or is likely to deceive and that the plaintiff is likely to suffer damage by such deception. Mere confusion which does not lead to a sale is not sufficient. Thus, if a customer asks for a tin of black shoe polish without specifying any brand and is offered the product of A which he mistakenly believes to be that of B, he may be confused as to what he has got but he has not been deceived into getting it. Misrepresentation has played no part in his purchase."*

23. In ***Laxmikant V. Patel v. Chetanbhai Shah and Another, (2002) 3 SCC 65,*** the Supreme Court reiterated the three essential ingredients of passing off and further held that fraud is not a necessary element of the right of action and likelihood of damage is enough and if shown, it is usual and rather essential, to seek an injunction. Essentials of an action of passing off and the reason why protection in such cases is necessary has been the subject matter of several decisions but to avoid prolixity, I may refer to the following passages from the judgment of this Court in ***Dabur India Limited***

v. Shree Baidyanath Ayurved Bhawan Pvt. Ltd., 2012 SCC OnLine Del 3332:-

> ***"42.*** *As mentioned earlier, it has been held in various decisions that no man is entitled to represent his goods as being the goods of another which such representation is made by the use of any mark, device, colous combinations or other means. Such person or trader cannot be permitted to make a false representation to the purchaser of his goods because it constitutes an invasion of proprietary rights vested in the rightful owner pre-condition of any successful passing off action is that mark in question must have acquired a reputation in the market and are known by some distinguishing feature. In case, prima facie, proves a tangible threat by the defendant to trade in the same manner even incorrectly that would be likely to give rise to deception or confusion.*
>
> ***43.*** *The following are the essential characteristics of an action of passing off:—*
>
> *(a) In Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd., 1980 RPC 31, Lord Diplock stated the essential characteristics of a passing off action as under:*
>
> *"(1) misrepresentation, (2) made by a person in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably forseable consequence and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so."*
>
> *(b) The essentials of passing off action in Halsbury's Laws of England Vol. 38 (3rd Edition) para 998 as given below are worth noting:*
>
> ***"998. Essentials of the cause of action***
>
> *The plaintiff must prove that the disputed name, mark, sign or get up has become distinctive of his goods in the sense that by the use of his name or mark, etc in relation to goods they are regarded, by a substantial number of members of the public or in the trade, as coming from a particular source, known or unknown; it is not necessary that the name of the plaintiff's firm should be known.....The plaintiff must further prove that the defendant's use of name or mark was likely or calculated to deceive, and thus cause confusion and injury, actual or probable, to the goodwill and the plaintiff's business, as for example, by depriving him of the profit that he might have had by selling the goods which ex hypothesi, the purchaser intended to buy. Thus, the cause of action involves a combination of distinctiveness of the plaintiff's name or mark and an injurious use by the defendant of the name or mark or a similar*

name or mark, sign, picture or get-up does or does not amount to passing off is in substance a question of evidence; the question whether the matter complained of is likely to deceive is a question for the Court."

44. *The judgment passed in the case of Laxmikant Patel v. Chetanbhai Shah, reported in (2002) 3 SCC 65, the relevant para-10 of which reads as under:—*

"The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that his goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury."

24. Coming to the instant case, the action of passing off by the Plaintiffs pertains to the rival packaging/trade dress for identical products i.e. Golden Sella Basmati Rice. Plaintiffs claim that all elements of their packaging from colour/colour combination to individual elements such as image of pulao dish, hanging lanterns and stars design, font/colour/style of word Zarda, have been copied by Defendant No.1. Broadly understood, the points of opposition raised by Defendant No.1 are: no deceptive similarity in the rival trade dresses; no proprietary right or monopoly can be claimed on colours/colour combinations or generic elements like stars, moon, lanterns, minarets, dishes etc.; word Zarda is generic/descriptive/common to trade; failure of Plaintiffs to establish distinctiveness in the trade dress and/or goodwill and reputation; and prominent display of house mark DOUBLE CHABI on the impugned packaging by Defendant No.1 which leaves no scope for confusion.

25. To analyse the respective stands, first things first: the question is whether there is any identity/deceptive similarity between the rival

packaging/trade dresses. If the answer to this question is 'no', further determination is not warranted. Upon perusal of the competing packaging, I find striking similarities in the two, which outweigh the minor dissimilarities. Plaintiffs' packaging 

is a combination of special/unique elements such as: green and gold colour scheme; exclusive gold lettering in English, aesthetically designed in an unusual font/style to resemble the Urdu/Arabic script; prominent placement of the sub-brand 'Zarda King' in the centre in uniquely styled and designed golden font; design of hanging stars and lanterns at the top of the packaging in golden colour; crescent shaped moon with a star placed near the centre on top; and a depiction of a pulao plate at the bottom of the packaging with minarets and floral pattern etc. Compared with this, Defendant No.1's impugned packaging/trade dress 

with colour combination and elements such as: (i) green and gold colour scheme; (ii) gold lettering in English resembling the Urdu/Arabic script; (iii) word 'Zarda' with suffix 'Special' in golden and stylized font with diamond shaped dots unevenly distributed between the words 'Zarda Special'; (v) design of hanging stars and lanterns at the top of the packaging in golden colour; (vi) 'Zarda' written in Urdu/Arabic script; (vii) imagery of pulao dish in the lower half of the packaging, is deceptively similar. Defendant No.1 has visibly copied all essential elements to come as close as possible to Plaintiffs' trade dress.

26. In ***Parle Products (supra),*** the dispute before the Supreme Court

centred around biscuit wrappers. Parle's wrapper for 'Gluco F Biscuit' featured a farmyard scene with a girl carrying pail of water and in the background were cows and hens and a farmhouse. Defendant was selling 'Glucose Biscuits' in a wrapper depicting a girl holding hay on her head and carrying a sickle and food and the backdrop was a building. The Supreme Court held that the test is of 'overall similarity' and on this anvil ruled that Defendants' wrapper was deceptively similar to Parle's, observing that anyone who had a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen the other day, as after all an ordinary purchaser is not gifted with the powers of observation of Sherlock Holmes. Relevant paragraphs from the judgment are as follows:-

> ***"9.*** *It is, therefore, clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can essily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluco Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Homes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to*

the decisions referred to at the bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it.

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

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

27. It is thus settled that the test is 'overall impression and similarity' and Courts must give greater attention to points of similarities than dissimilarities, especially when one sees dishonesty. ***[Munday v. Carey, 22 RPC 273]***. In ***Cadila Health (supra)***, the Supreme Court held that what has to be seen in an action of passing off is similarity between the marks and determine if there is likelihood of confusion or deception and not differences in essential features as products are purchased by villagers and townsfolk, literate as well as illiterate and the question has to be approached from the point of a man with average intelligence and imperfect recollection. In ***Cadbury India Ltd. & Ors. v. Neeraj Food Products, 2007 SCC OnLine Del 841,*** Plaintiff was aggrieved by Defendant's adoption of a trade dress on the pillow pack which it perceived was deceptively similar to its packaging. Court found that the rival pillow packs were of the similar size and every essential feature of Plaintiff's pillow pack was found in the pack of the Defendant, except that one displayed the manufacturer as Cadbury and product as GEMS and other displayed the manufacturer as Neeraj and

product as JAMES BOND and held that Plaintiff had made out a *prima facie* case of passing off by the Defendant. Relevant passages from the judgment are as follows:-

> ***"24.*** *The case of the plaintiff so far as its complaint against the defendant in respect of the infringement on account of the copying of essential features of the plaintiff's packaging as also passing off its goods as those of the plaintiff requires a comparison of the packaging of the defendant against the plaintiffs pillow pack.*
>
> *The packaging of the defendant is not identical to that of the plaintiff. As per the law laid down in Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories (supra), the tests for the infringement action and dishonest passing off claim would remain the same.*
>
> ***25.*** *The plaintiffs pillow packs which have been placed on record have a blue background with 'GEMS' written in bold white italicized letters in a script which is not uniform. The word 'GEMS' is written against a chocolate brown background with a blue outline in an oval formation in the centre of the pack. An impression of small diversely coloured round chocolate button like tablets have been strewn around the word 'GEMS'. It has been pointed out that the chocolate tablet impressions are in fact an image of the products which are contained inside the packaging which are of identical round shape and form and have diverse and attractive colour coatings over the chocolate inside. The colour combination of the tablets as contained in the pillow pack and which has been printed on the pillow pack are red, yellow, green and mauve. The plaintiff has displayed full tablets as well as half cut tablets to represent the chocolate which is contained therein. The visual impression which is created on the pillow pack and the packaging of the plaintiff is that of an explosion of chocolate tablets in the middle and the tablets flying out from its centre. White lines around the brown oval in the middle add to the creation of such a impression.*
>
> ***26.*** *The defendant's pillow pack is not only of the same size as that of the plaintiff but is in the same blue background as that of the plaintiff. The plaintiffs pack has a brown oval at the centre, while the defendant has placed brown colour in a diamond shape. The plaintiff has displayed the origin of the product that is the name of the manufacturer as Cadbury's on the top left corner of the packet. The defendant has placed its name identically at the top left corner. The brown oval on the plaintiffs pack is bordered by a purple oval while the brown diamond on the defendant pillow pack is also bordered with the purple border. The plaintiff has written the word 'GEMS' in white colour. The defendant has used an identical white for writing 'JAMES BOND'. Even the scripting is identical. The plaintiff scripting of the word 'GEMS' is not uniform. The defendant*

has also placed 'JAMES BOND' in a script which is not uniform. Just as the plaintiff, the defendant has also created a visual impression of an explosion in blue colour in the middle with lines emanating from the centre and tablets flying out therefrom. The colour combination of the tablets is similar to that of the plaintiffs while the defendant has also placed half tablets showing the chocolate centres just as those of the plaintiff.

27. *From a bare perusal of the two pillow packs, it would appear that the same are of similar size and that every essential features of the plaintiffs pillow pack is to be found in the packaging of the product of the defendant. The only difference which is to be found is in the fact that while the plaintiff pillows pack displays the manufacturer as Cadbury, the defendant's displays the manufacturer as Neeraj. While the plaintiff has displayed the product as 'GEMS', the defendant has displayed the same as 'JAMES BOND'.*

28. *Thus the essential features of the pillow pack of the plaintiff have been adopted by the defendant in its packaging. The products are sold in small pouches or pillow pack of identical size and shape. The concept or idea which has been conceptualized by the plaintiff of an explosion of chocolate tablets emanating from the central brown oval circumscribed by the blue oval have been copied in totality by the defendant. The defendant has also placed identical multicoloured chocolate tablets as well as displayed half cut tablets showing chocolate centered in the same manner as have been displayed by the plaintiff on its packaging.*

xxx xxx xxx

31. *Holding that it is the points of similarity which have to be given greater attention to than those of dissimilarity in 22 RPC 273, Munday v. Carey, it was held thus:—*

> *"... 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."*

xxx xxx xxx

45. *The defendant has adopted a pillow pack which is almost identical to that of the plaintiff. To a person of even average intelligence and imperfect recollection, the overall structural and phonetic similarity as also the similarity of the concept and idea in the two marks is reasonably likely to cause a confusion between them."*

28. In this context, I may also allude to the judgment of this Court in ***Allied Blenders alias Distillers Private Limited v. Hermes Distillery Private Limited, 2024 SCC OnLine Del 217***, where Plaintiff complained of similarities in the labels in respect of whiskies. On a comparison of the

competing labels, Court found similarities which are captured in paragraph 53 of the judgment in terms of background red and white colours, gold line, lettering, placement of trademarks, outer gold border and insignia and held that on a first glance the overall appearance of the two labels was similar and negated the stand of the Defendant that there were differences which must be considered. Court was of the view that there was 'smart copying' and the chart of differences showed extraordinary effort put by the Defendant in identifying the differences. Relevant passages are as under:-

> *"**Analysis and Conclusions***
>
> ***36.** The short question that arises in the present application under Order XXXIX Rule 1 & 2 CPC is whether the use of the Defendant's label violates the Plaintiff's rights and whether it constitutes infringement or passing off. The first and foremost factor that needs to be considered is the comparison between the two labels. A perusal of the above comparison would show that while the two labels are not identical, there are some clear elements of similarities between the two. Such elements includes:—*
>
> *i) The use of the ribbon like feature in the Plaintiff's and the Defendant's labels.*
>
> *ii) The placement of the white window in the red background.*
>
> *iii) The placement of insignia/coat of arms.*
>
> *iv) The placement of other descriptive matter.*
>
> *xxx xxx xxx*
>
> ***39.** The test for comparing the above labels, as laid down in several judgments of the Supreme Court such as in Parle (supra) and S.M. Dyechem Ltd. (supra) is not one of identity but of similarity. Further, following the decision of the Supreme Court in Corn Products Refining Co. v. Shangrila Food Products Ltd. (AIR 1960 SC 142), the plank of similarity is to be tested from that of a consumer with average intelligence, imperfect recollection or a hazy recollection. Considering the large-scale sale of the Plaintiff's products under the 'OFFICER'S CHOICE' mark, the Defendant is obviously aware of the 'OFFICERS CHOICE' products and labels. It is the overall combination of various elements that makes the label confusingly and deceptively similar and not any specific single feature, for example, the Defendant uses a similar ribbon device in its Indian brandy label. The competing labels are extracted below:*



xxx *xxx* *xxx*

45. *In Skechers USA INC v. Pure Play Sports (2016/DHC/4344), the Plaintiff alleged that the Defendants substantially copied the trade dress of their shoes, leading to potential confusion among customers. The competing trade dresses incorporated different marks, Plaintiff's trade mark being 'SKECHERS' and Defendant's being 'PUREPLAY'. The Court held that the Defendant substantially copied the trade dress of the Plaintiff's shoes, leading to potential confusion among customers. Despite the presence of different marks, the Court found that such distinction was insufficient to eliminate the possibility of confusion for an unwary customer. The relevant portions of the decision are extracted below:*

> *"18. Having myself seen the shoes of the plaintiff and compared the same with those of the defendants, I am, prima-facie, satisfied that the visual impression gathered from the trade dress of the competing products is that trade dress of the plaintiffs product is substantially copied by the defendants which is likely to result in confusion. There is every likelihood that an unwary and gullible customer may get confused as to the source of origin of the shoes of the defendants, and may assume that the same come from the source of the plaintiff as the shoes of the defendants have a remarkable resemblance with those of the plaintiffs.* ***No doubt, the trademarks of the plaintiff, i.e. SKECHERS is inscribed on the inner sole of the plaintiffs shoes, and the defendants mark PUREPLAY is similarly inscribed on the inner sole of the defendants shoes, and there is no similarity in the said two word marks. However, that by itself, does not appear to be sufficient to dispel the possibility of confusion in the mind of an unwary customer. This is, because, the several aspects of trade dress are strikingly similar between the shoes of the plaintiffs and those of the defendants and the overall get up and trade dress is also markly similar. The word marks of the parties are printed on the inner sole, which is not what catches the attention of a consumer looking to buy a stylish shoe.*** *As the plaintiffs themselves state - and this is evident*

from a visual examination of the shoes in question, the "selling point" of these shoes in their catchy colour combinations, and texture combinations, coupled with their cuts and stitching styles. It is these features that would catch the attention of the consumer and it is likely that the consumers - who would be youngsters more often than not, would overlook the labels printed inside the shoe sole which contain the word marks. So far as the logos of the parties are concerned, though they are printed on the sides of the shoe uppers, they are not all that prominent, as to immediately strike to the mind of a consumer. The logos, by themselves, may not even cause brand recall to the consumers.

19. The two logos of the plaintiffs and the defendant, as affixed on the sides of the shoe uppers of the respective parties are not the prominent and striking features in the overall trade dress of either of the parties. The submission of learned counsel for the defendant, premised on the different word marks of the plaintiffs and the defendant is answered in Colgate (supra) in the following words:

...

20. If one were to apply the aforesaid test - as laid down in Colgate (supra) and Gorbatschow (supra) to the facts of this case, at this stage it would appear that the adoption of several unique features by the plaintiffs on its GOwalk series by the plaintiffs gives their shoes a unique trade dress which acts as a source identifier. The distinctive get up at the back of the shoe with an inverted triangular and stitching/lining in U shape below the said cut, appear to be completely capricious and prima-facie cannot be described as functional. The very distinctive and unique outsole, and suspension rebound go pillars on the sole have been completely copied by the defendant.

***21. The onus would lie heavily on the defendant to explain as to why the defendants have adopted the strikingly similar get up and trade dress in respect of their shoes as that of the plaintiffs. Prima-facie, at this stage it can be said that the defendants shoes are a result of a conscious and substantial imitation of the colour combination, textures, style, cut and stitching of the plaintiffs** shoes**. The copying of - what the plaintiffs describe as the "responsive rebound go pillars technology", by the defendants on the soles of their shoes, in my view, is a give-away of the defendants attempt to copy the plaintiffs trade dress**."*

xxx *xxx* *xxx*

***48.** A ld. Single Judge in Allied Blenders IV (supra) held that a bare comparison of the Plaintiff's 'OFFICERS CHOICE' label with the Defendant's 'CHETAK' label reveals that they are deceptively similar. The relevant portion of the said decision is a follows:*

"33. On merits, the claim of the plaintiff, prima facie, merits acceptance. A bare comparison, of the label of the "Officers Choice" label used by the plaintiff, vis-à-vis the "Chetak" label used by the defendant, reveals that they are deceptively similar. In both the labels, (i) there is a gold line, dividing the label into an upper and lower half, (ii) the lower half has a red background, whereas the upper half as a white background, (iii) the lettering, on the lower red half of the label, is in white, and the lettering, in the upper white half of the label is in red, (iv) the placement of the trademarks "Officers Choice" (in the case of the plaintiff's label) and "Chetak", in the case of the defendant's label, are similar, and covers a major portion of the upper white half of the label and (v) both labels have an outer gold border. The overall appearance of the two labels is, at a plain glance, similar, and constitutes, therefore, similar trade dresses. The two labels are, therefore, deceptively similar, as perceived by the man of average intelligence and imperfect recollection.

34. The defendant in the written submission merely contends, in this regard, that the name of the defendant's product was different from that of the plaintiff's, there was the feature of a horse above the word "Chetak" in the label of the defendant, and the packaging of the goods was different, as the bottles were different in shape, size, and had different caps. These features do not, however, prima facie, detract from the overall similarity in the essential features of the labels used by the plaintiff and the defendant.

35. ***The plaintiff has also placed, on record, orders passed by this Court, in earlier suits, filed by the plaintiff, against defendants who were manufacturing and selling Whisky, under labels which infringed the "Officers Choice" trademark of the plaintiff. A tabular depiction, of these orders,*** *with* ***the labels which were subject matter of consideration therein, is provided thus:***

...

36. The written submissions filed by the defendant to not dispute this position. All that is said is that the orders, on which the plaintiff relies, were either passed ex parte, or were passed in suits which were finally settled.

37. ***Be that as it may, it is an undeniable fact that the plaintiff has been granted ad interim relief,*** *by* ***this Court, on multiple occasions, against the defendants who were selling Whisky using labels which were deceptively similar to the "Officers Choice" label of the plaintiff, and which are also similar to the label used by the present defendant on its "Chetak" Whisky.***

38. ***This fact, seen in the background of the admitted reflection, on the website of the defendant, of*** *the* ***plaintiff's products - which the defendant has, in its written submissions, sought to explain, by***

contending that it was merely representing the work earlier done, by or for the plaintiff - clearly indicates that a consumer, of average intelligence and imperfect recollection, is likely to confuse the product of the defendant with that of the plaintiff.

39. Additionally, I may note, the "triple identity" test also stands satisfied in the present case, as the mark of the defendant is deceptively similar to the trademark of the plaintiff, they are being used on identical goods, and these goods are sold through similar trade channels and are available at the same outlets.

40. For all these reasons, I am of the opinion that, pending hearing and final disposal of the present I.A., the plaintiff is entitled to ad interim relief, in terms of the prayers in the present application.

41. Accordingly, there shall be an ad interim injunction, restraining the defendant from using, manufacturing, selling, exporting, importing, offering for sale, distributing or otherwise dealing in any product, under the impugned "Chetak" label, or under any trademark or tradename which is deceptively similar to the "Officers Choice" and "Officers Choice Blue" trademarks, registered in favour of the plaintiff."

xxx xxx xxx

***53.** In the present suit, the Court has found the following similarities in both the labels:*

(i) The lower half of the label has a red background, and the upper half has a white background,

(ii) There is a gold line, between the upper and lower half,

(iii) The lettering, on the lower red half of the label, is in white, and the lettering, in the upper white half of the label is in red,

(iv) The placement of the trade marks 'OFFICERS CHOICE' (in the case of the Plaintiff's label) and 'PEACE MAKER', in the case of the Defendant's label, are similar, and covers a major portion of the upper white half of the label and

(v) both labels have an outer gold border.

(vi) The use of certain insignia is also similar in nature. The intricate differences cannot be noticed in the emblem/insignia.

***54.** Thus, the overall appearance of the two labels is similar at first glance, constituting similar trade dress. Therefore, the two labels were deceptively similar as perceived by a person of average intelligence and imperfect recollection.*

***55.** It is also the settled position that in the case of labels/trade dress, the Court has to consider the totality of the trade dress and not specific*

elements. The Defendant has sought to highlight the differences in the following manner:—

Annexure A

Comparison of the Defendant's label and Plaintiff's unregistered label

Defendant's label	Plaintiff's label
	
Uses a Bright Red shade (Pantone 032C) on its packaging and a dark gold thin border	Uses a Dark Red Shade (Pantone 186C) and a bright golden thick border all across the packaging.
The White portion of the Label where the mark 'Peace Maker' is written is in the shape of a Tag/ Bookmark and has a dotted inline. This usage of the Tag on a liquor bottle is unique and distinctive to the .Defendant's product.	The White Portion of the Label where the mark 'Officer's Choice' is cut in a triangular shape from the bottom with a Gold and Black Border.
No such feature.	The label contains the 'Epaulets Tag'
The label has the Defendant's house mark  consisting of two persons and the words 'Hermes Distillery' written prominently	The label has the Plaintiff's house mark  consisting of two horses and the abbreviation 'OC'

56. *A perusal of the above chart shows that the so-called differences actually establish a broad similarity. The mention of a Pantone shade of red to distinguish the two product labels, the ribbon-like cut in the white portion of the label, as well as the intricate differences in the insignia used, in fact, have the opposite effect of highlighting the similarities rather than the differences.*

57. *The Court is convinced, prima facie that there is a clear attempt to indulge in "smart copying" which in the opinion of the Court would still be copying. The chart of differences, in fact, shows that extraordinary effort has been put by the Defendant in identifying the differences. The*

> *broad similarities are so obvious at the first look, the differences are nudged into oblivion.*
>
> ***58.*** *In Baker v. Master Printers Union of New Jersey, [47 USPQ 69], it has been appropriately observed as follows:*
>
> > *"The most successful form of copying is to employ enough points of similarity to confuse the public with enough points of difference to confuse the courts. Few would be stupid enough to make exact copies of another's mark or symbol."*

29. In an action pertaining to passing off, importance of trade dress is so profound that it cannot be overemphasized. In ***Colgate Palmolive (supra),*** this Court highlighted the objective of securing protection against imitation and copying in trade dress and observed that trade dress is the soul for identification of the goods as to their source and origin and is liable to cause confusion in the minds of unwary consumers. It was also observed that it is the overall impression that the customer gets to the source and origin of the goods from visual impression of colour combination, shape of container, packaging etc. Conscious imitation or substantial imitation of colour combination or get up or layout again bares the design of the Defendant in causing confusion in the minds of the customers and Court is not required to find out whether there is confusion or deceptiveness. The test is whether there is likelihood of confusion or deceptiveness in the minds of unwary customers irrespective of dissimilarity in the trade name. In the case of passing off, the second or for that purpose the subsequent comer has the obligation to avoid unfair competition and become unjustly rich by encashing on reputation of the prior comer. The second comer must establish its own goodwill by creating its own trade dress with distinctive features and attract the attention of purchasing public. Discussing the principle of dishonest adoption, Court held that points of similarities must be given greater attention than those of dissimilarities and where Court sees

dishonesty, even though the similarities were less greater, attention ought to be paid to the similarities. Plaintiffs have also correctly relied on the judgement in ***Under Armour (supra)*** and given the deceptive similarity in the rival packaging, the initial interest confusion test will squarely apply in this case.

30. With the aforesaid principles in the backdrop, when the rival packaging are compared the overall impression is that they are deceptively similar. The test is not of identity but deceptive similarity and judged from the point of a person with average intelligence and imperfect recollection. At the cost of repetition, both packaging are 30 kg in size and Defendant No.1 has copied almost all elements such as green and gold colour scheme; gold lettering in English designed exclusively to resemble the Urdu/Arabic script; use of word 'Zarda' and that too in the same golden font and style; design of 'hanging' lanterns and stars at the top of the packaging in golden colour; 'Zarda' written in Urdu/Arabic script; and a picture showcasing a plate with pulao at the bottom of the packaging with minarets etc. Learned Senior Counsel for Defendant No.1 attempted to bring forth, what the said Defendant perceives as dissimilarities i.e. white polka dots, matte finishing, use of house mark DOUBLE CHABI in multiple places including on foldable sides, placement of plate of pulao at the centre and red colour strip at the bottom, to establish that there is no deceptive similarity and no intent to copy. The test, however, is not to focus on dissimilarities but on similarities of essential elements. It is enough if there is overall similarity, which is the case here, to mislead anyone who looks at one packaging today and mistakes the other if shown on another day as being one he had seen before, as observed in ***Parle Products (supra),*** because an ordinary person is not Sherlock Holmes. There is no doubt that products being identical, they

will be stacked together in small and big shops and will be bought by all kinds of consumers, illiterate or literate and in villages and towns, who cannot be assumed to be blessed with elephant memory and may not be discerning. In most cases, consumers have hazy memories and more often than not, the intricate differences are not discernible. There are many similarities in the rival packaging such as the green background, stars/lanterns, gold Arabic style lettering, imagery pulao plate, use of word Zarda in an exclusive style and font and contextually, all of this for identical products. In my *prima facie* view, overall getup, layout and visual impression are enough to confuse any consumer and this is particularly true for rice which is a FMCG/food product, where purchase is quick, literacy levels vary and consumers rely heavily on colours/lay out/get up etc. rather than precise textual distinctions as also visual impressions carried forward from previous purchases.

31. Much was argued on behalf of Defendant No.1 that word Zarda is generic/descriptive meaning sweet rice dish and its use by any party cannot amount to passing off as no party much less the Plaintiffs can claim any monopoly over it. Assuming at this stage for the sake of argument that Zarda is generic or descriptive, that does not materially dilute Plaintiffs' claim of passing off, since the gravamen of the action lies not only *per se* in the use of Zarda as a sub-brand but also in the deceptive imitation of overall trade dress, get up and visual presentation. It cannot be glossed over that in Plaintiffs' trade dress Zarda may function as a memorable component in consumer recollection, especially when seen in the overall setting of numerous other similar elements and resultantly, add to the consumer belief that the product belongs to or has some connection with the Plaintiffs. As rightly urged by the Plaintiffs, in this backdrop use of suffix 'Special' with

Zarda is not enough for any consumer, guided by overall impression, to draw out a fine distinction in the rival brands and is perhaps an unsuccessful step towards creating an illusion that Defendant No.1's packaging is different so as to avoid an action for dishonest copying and imitation.

32. Defendant No.1 is also wrong in contending that Plaintiffs have not shown sales of Golden Sella Basmati Rice under the 10X Zarda King sub-brand with its alleged unique packaging. Plaintiffs have filed on record *inter alia* documents to show yearly turnovers from 2021-2022 to 2023-2024, which steadily increased and the cumulative sales in three years exceeded Rs.86.16 crores under the brand 10X ZARDA KING. Plaintiffs have also placed on record GST invoices for printing multi-layered laminated packaging in question as also news article from Hello Entrepreneurs and photographs of brand endorsements by Mr. Salman Khan and Ms. Saina Nehwal. Plaintiffs have also filed photographs of billboards and hoardings promoting its brand along with screenshots of promotions on YouTube and IndiaMART listings. CA Certificate and sales invoices demonstrate sales exceeding Rs.86 crores in 3 years under the packaging in question. Revenues earned and expenses of 8 crores together indicate strong market presence and goodwill of the Plaintiffs and highlight the distinctiveness of the trade dress. Sales worth approximately Rs. 90 crores in 3 years cannot *prima facie* be regarded as nominal or insignificant for FMCG product such as rice and supports the claim of the Plaintiffs of having garnered immense goodwill and distinctiveness in the trade dress. One also wonders !!! if Plaintiffs' trade dress was not distinctive and/or created a formidable goodwill and reputation in the market, why Defendant No.1 chose to copy it to the maximum extent possible? Certainly some minor differences are there but as observed in ***Allied Blenders (supra),*** this is 'smart copying'. I am

reminded of the oft quoted observation from ***Baker v. Master Printers Union of New Jersey, [47 USPQ 69] –*** *"The most successful form of copying is to employ enough points of similarity to confuse the public with enough points of difference to confuse the court. Few would be stupid enough to make exact copies of another's mark or symbol".* Defendant No.1 has in fact put in efforts and labour to bring out some differences while copying, however, on the first impression principle the similarities are far too many and so obvious that the differences take a back seat and fade into oblivion.

33. Defendant No.1 also contests the claim of passing off by the Plaintiffs on the ground that there can be no monopoly on colours. In ***Colgate Palmolive (supra),*** Court held that it is the overall impression that the customer gets as to the source and origin of the goods from visual impression of colour combination, shape, packaging etc. and may be, no party can have monopoly over a particular colour but if there is substantial reproduction of the colour combination in the similar order on the packaging, which is imprinted on the minds of the consumers, it is liable to cause confusion and dilution of the colour combination. Trade dress plays a vital role in identifying products and tracing their origin to the source and its imitation is liable to cause confusion in the minds of unwary customers, particularly, those who have been using the products over a long period of time. Relevant paragraphs of the judgment in ***Colgate Palmolive (supra)*** are as under:-

> ***"55.*** *May be, no party can have monopoly over a particular colour but if there is substantial reproduction of the colour combination in the similar order either on the container or packing which over a period has been imprinted upon the minds of customers it certainly is liable to cause not only confusion but also dilution of distinctiveness of colour combination. Colour combination, getup, layout and size of container is sort of trade dress which involves overall image of the product's features. There is a*

wide protection against imitation or deceptive similarities of trade dress as trade dress is the soul for identification of the goods as to its source and origin and as such is liable to cause confusion in the minds of unwary customers particularly those who have been using the product over a long period.

56. *The difference in the style of the words appearing on the container or packing identifying its manufacturers by way of style, colour combination or textures or graphics is certainly significant or relevant for determining the overall imitation of the container but if a product having distinctive colour combination, style, shape and texture has been in the market for decades as in this case it is in the market since 1951 it leads to ineluctable inference of having acquired secondary meaning on account of its reputation and goodwill earned at huge cost.*

57. *It is not the diligent or literate or conscious customer who always remain conscious to the quality of goods he has been purchasing which determines an offence of passing off. It is the unwary, illiterate and gullible persons who determine by arriving at a conclusion whether the infringed goods are confusingly similar in colour combination, getup, layout printed over the container or packing. If it is not so then the offence of passing off will cease to have its existence once the guilty party chooses a different trade name."*

34. Some of the observations by this Court in ***Dabur India (supra)*** are also relevant to this issue and are as follows:-

"48. *It is also pertinent to mention that the subject matter of the colour combination, get-up and layout are not only covered in the subject matter of copyright but also covered under the common law remedy i.e. law of passing off. Even in the New Trade Mark Act, 1999 the definition of the mark is given in Section 2(m) which says that "Mark" include a device, brand, style, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. As per the definition and as per the judgments mentioned above it is clear that the colour scheme, get up, layout and combination of colours is covered under the action for passing of also.*

49. *It appears that the work in question is an original artistic work within Section 2(c) of the Copyright Act and same is protected under Section 51 of the Copyright Act, 1957 in case the same has been copied by the defendant in material in case the plaintiff is able to show the case of infringement of copyright, then an injunction under Section 55 of the Act can be issued against infringing party.*

50. *No doubt, it has been seen that in the trademarks and Copyright cases, each case dependent upon its own fact and thus it has to be decided as per its own merit. In the present, there is no valid explanation given as why the*

defendant's new packaging has similar essential feature, get up, layout, colour combination and placement of features as that of the plaintiff packaging which is being used by the plaintiff since the year 2006.

51. *The defendant's counsel has merely tried to justify the stand of the defendant on all individual features rather overall combination of colours and layout. The defendant main stress was to challenge the rights claimed by the plaintiff. No justification was given by the defendant as how to hit upon the new packaging which his similar to the packaging of the plaintiff. It appears to the Court that in case, both packaging used by the parties are compared in meaningful manner, it can easily come to the conclusion that one is designed by placing the another. From the placing used by the defendant, it is obvious that all essential features are deceptively similar to the packaging of the plaintiff. The letters used in the packaging are in the same colour. Side penal and arrangements and placement of pictorial device of fire are almost similar. One fails to understand, when the defendant had so many packagings which were being used by the earlier in the course of its business which includes black colour packaging, why the defendant has adopted and used the packaging similar to that of the plaintiff. The said conduct of the defendant cannot be called as a bonafide as the defendant is in the same trade and the defendant must be aware about the packaging of the plaintiff at the time of its adoption."*

35. In ***Mondelez India (supra),*** Court compared the similarities in the rival trade dresses including the colour scheme and held that Plaintiff had made out a case of passing off. Relevant passages are as follows:-

"28. *In the background of these pleadings and documents placed on record by the parties, this Court is of the opinion that the present is a case of res ipsa loquitur. The comparative labels set out hereinabove show that the two products have startling similarities. Some of the features, which are similar, are set out below:*

A. The Defendant's pillow pack is of the same blue/purple background and of the same size as that of the Plaintiffs'.

B. The Plaintiffs' pillow pack has a brown oval at the centre, while the Defendant has placed a diamond in brown colour at the centre.

C. The Plaintiffs have displayed the origin of the product i.e., the name of the manufacturer as 'CADBURY'S' on the top left corner of the pillow pack. The Defendant has placed its name 'NEERAJ' in an identical manner and positioning at the top left corner, as that of the Plaintiffs.

D. The brown oval on the Plaintiffs' pillow pack is bordered by a blue/purple oval while the brown diamond on the Defendant's pillow pack is also bordered with the blue/purple border.

E. The Plaintiffs have inscribed the trade mark 'GEMS' in the colour white, and the Defendant has used an identical white for writing 'JAMES BOND'.

F. Further, the Defendant has also copied the Plaintiffs' scripting of the trade mark 'GEMS' on the pillow pack. The trade mark 'GEMS' is written in an uneven script and the Defendant has also placed 'JAMES BOND' in an uneven script.

G. Just as the Plaintiffs, the Defendant has also created a visual impression of an explosion in blue/purple colour in the middle with lines emanating from the centre and tablets flying out.

H. The colour combination of the tablets adopted by the Defendant is also similar to that of the Plaintiffs.

I. The Defendant has also placed half chocolate-tablets showing the chocolate centre in the exact same manner as the Plaintiffs.

J. Additionally, the Defendant has conceptualized the impugned product 'JAMES BOND' by being inspired by the character namely 'GEMS BOND', as used by the Plaintiffs for promotion of their 'GEMS' branded products, as submitted hereinabove.

29. *In two seminal judgments of the Supreme Court, the test of infringement and deceptive similarity of competing marks is well settled. The Supreme Court in Corn Products Refining Co. v. Shangrila Food Products Ltd., (1960) 1 SCR 968, has observed that the said question has to be approached from the point of view of a man of average intelligence and of imperfect recollection. It was observed that, to such a man, the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them. The relevant extracts from the judgment in Corn Products (supra) are set out below:*

> *"18. We think that the view taken by Desai, J., is right. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai, J., that the marks with which this case is concerned are similar. Apart from the syllable "co" in the appellant's mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other.*

19. We also agree with Desai, J., that the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. The Aquamatic case (Harry Reynolds v. Laffeaty's Ltd.) is a recent case where the test of the commonness of the idea between two marks was applied in deciding the question of similarity between them. ***Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them****."*

30. *In Parle Products (P) Ltd. v. J.P. & Co., Mysore [(1972) 1 SCC 618 : AIR 1972 SC 1359], it was held that the Court has to see similarities and not the dissimilarities. The relevant extracts of the said judgment, which has been followed in innumerable judgments subsequently, are set out hereinbelow:*

"According to *Kerly's Law of Trade Marks and Trade Names* ***(9th Edition Paragraph 838) "Two marks,*** *when* ***placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with the one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted.***

It would be too much to expect that persons dealing with trademarked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. ***Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own****.*

It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered*. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other.* ***It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him****."*

31. *Similar is the view taken by the ld. Single Judge of this Court in ITC Ltd. v. Brittania Industries Ltd. [(2016) 233 DLT 259], wherein the Plaintiff sought to restrain the Defendant from violating its rights in the*

Plaintiff's packaging/trade dress of 'Sunfeast Farmlite Digestive - All Good' biscuit by using a deceptively and confusingly similar trade dress for its 'Nutri Choice Digestive Zero' biscuit. On the aspect of deception and confusion, the Court placed reliance upon Parle Products (supra) and observed as under:

> *"36. Biscuits are normally stacked on shelves in a grocery shop or a supermarket. Usually there is an entire section where the biscuits of different manufacturers are arranged side by side.* ***Where the product is an eatable like a biscuit, the colour and the colour scheme of the packaging plays an important role in the consumer making an initial choice and in enabling a discerning consumer to locate the particular brand of a manufacturer. The aspect of 'initial interest' was explained by this Court in*** *Baker Hughes Limited v. Hiroo Khushalani* ***as under:***
>
> > ***"In some case, however, it is also possible that such a purchaser after having been misled into an initial interest in a product manufactured by an imitator discovers his folly, but this initial interest being based on confusion and deception can give rise to a cause of action for the tort of passing off as the purchaser has been made to think that there is some connection or nexus between the products and business of two disparate companies."***
>
> *37. Therefore, when another competing variant of the biscuit is introduced six months later and a consumer on the basis of the popularity of a product that has recently been introduced makes a mistake as to which packet of biscuit he is picking up, it can be argued that the initial interest was based on confusion and deception and, therefore, gives rise to a tort of passing off. In Wal Mart (supra) it was observed that the product's trade dress can be protected only if it is shown that it had acquired a secondary meaning "since design, like colour, is not inherently distinctive." However, the product in that case was a certain kind of clothing. In that context, it was said that the colour by itself does not identify the source of the product.* ***However, that may not be entirely true when it comes to products like biscuits. The packaging of a biscuit does become associated with the manufacturer or brand. The colour on the wrapper would certainly play an important part****.*
>
> *38. Similar marks or features used in wrappers of competing biscuits was the subject matter of Parle Products (P) Ltd. v. J.P. & Co. (supra). The Appellants there owned certain registered trademarks one of which was "Glucose" and was used on their half pound biscuit packets. Another registered trade mark was a wrapper with its colour scheme, general set up and entire collocation of words. The wrapper was of buff colour and depicted a farm yard with a girl in the centre carrying a pail of water and cows and hens around her on the background of a farmyard house and trees. The Respondent's*

wrapper contained a picture of a girl supporting with one hand a bundle of hay on her head and carrying a sickle and a bundle of food in the other, the cows and hens surrounding her. The trial court declined the injunction. The High Court looking at the broad features did not think that they were so similar so as to deceive an ordinary purchaser. Since it was an action for infringement, the Supreme Court declined to treat it as a case of passing off. Nevertheless, it explained that in order to come to a conclusion whether one mark is deceptively similar to another "the broad and essential features of the two are to be considered." It was further explained as under:

> *"They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other.* ***It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other****. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluco Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings.* ***Anyone in, our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs goods, he might easily mistake the defendants' wrapper for the plaintiffs if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes****. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered."*
>
> *(emphasis supplied)*

36. In this context, it would be useful to allude to the judgment of the Co-ordinate Bench of this Court in ***Emami Limited v. Dabur India Limited, MANU/DE/0676/2026***, wherein the following observations are made:-

"ANALYSIS AND FINDINGS:

8. The controversy in the present Application is restricted to the question as to whether the Impugned Trade Dress used by the Defendant is passing off the Defendant's Product as that of the Plaintiff's Product. The Plaintiff has restricted the prayer in this Application only for granting injunction restraining the Defendant from using the Impugned Trade Dress on Defendant's Product on the ground of passing off.

9. The passing off is based on similarities of get-up of packaging used by the defendant that amounts to misrepresentation damaging the plaintiff. The plaintiff must prove that the get-up used by the plaintiff is distinctive and the defendant's get-up is similar enough to deceive, notwithstanding any other differences between the two sets of goods. The plaintiff must make out that the defendant's goods are calculated to be mistaken for the plaintiff's goods, and both the goods unquestionably resemble each other and the features that resemble with each other are not common to the trade. The distinctive nature of the features adopted by the plaintiff must be 'eye-catching' and serve to identify the goods of one particular source. The plaintiff must show that the confusion arises from those features of the get-up, which are distinctive to the plaintiff taken in combination with each other. The plaintiff cannot pick and choose the elements of get-up and must be considered as a whole for comparing it with the get-up of the defendant as a whole, including the features which are not be found in the plaintiff's get-up, including the brand names or other marks.

xxx xxx xxx

13. The Plaintiff has contended that the Defendant's Product using the Impugned Trade Dress is a deliberate attempt to imitate the Plaintiff's Trade Dress by copying the elements / features to pass off the Defendant's Product as that of the Plaintiff. It is submitted by the Plaintiff that the Impugned Trade Dress leads the consumer to believe that there is an association between the Defendant's Product and the Plaintiff, where none exists. The Plaintiff has alleged that both the Plaintiff's Product and the Defendant's Product are red in colour, which are packaged in transparent bottles having identical shapes and configuration. The use and placement of hibiscus, ice and ayurvedic herbs on the packaging of the Defendant's Product is identical and deceptively similar to the Plaintiff's Trade Dress leading to confusion and / or deception in the minds of general public.

14. The Plaintiff has relied upon the case of Dabur Ltd. (supra) to argue that when there is no valid explanation given as to why the Impugned Trade Dress has similarity of essential features, get-up, layout, colour combination and placement of features with the Plaintiff's Trade Dress, the Impugned Trade Dress is liable to be restrained. The Plaintiff has contended that the Impugned Trade Dress is a slavish imitation of the Plaintiff's Product, which is evident from the comparison of sachets of the Plaintiff's Product and the Defendant's Product. It is also contended by the Plaintiff that the Defendant has adopted identical sachets to that of the

Plaintiff by using the same terms 'Raahat', 'Aaraam' and 'Tarotaazgi' in Hindi, which is appearing on the sachets of the Plaintiff's Product.

15. The Plaintiff has relied upon Corn Products (supra), Heins Italia (supra) and Cadila Healthcare (supra) to contend that in passing off action, similarities rather than dissimilarities have to be taken note and the colour scheme and overall effect of the packaging have to be seen. The Plaintiff has submitted that the Impugned Trade Dress is completely dishonest and malafide with the clear intention of passing off the Defendant's Product as that of the Plaintiff. The Plaintiff has also relied upon Midas Hygiene (supra) and Hindustan Pencils (supra) to argue that if a party for no apparent reasons adopts a deceptively similar trade dress, it would be difficult to avoid an order of injunction as it is assumed that the adoption was dishonest and indicates that the defendant tried to pass off its goods as those of the plaintiff.

16. The Plaintiff has submitted that the essential features of the Plaintiff's Trade Dress are not common to the trade and are distinctive. It is also contended by the Plaintiff that the fact that the Defendant has claimed that the Impugned Trade Dress is distinctive and has also applied for the trade mark registration on proposed-to-be-used basis, establishes an unequivocal establishment by the Defendant that the Plaintiff's Trade Dress possesses inherent distinctiveness. The Plaintiff has relied upon Procter and Gamble (supra) to argue that the Defendant cannot dispute the distinctive character of the Plaintiff's Trade Dress as the Defendant itself has claimed that Impugned Trade Dress is distinctive, when the same is essentially identical to and an imitation of the Plaintiff's Trade Dress.

17. The Plaintiff has submitted that the claim of the Defendant of prior use of red oil is not relevant as the said product of the Defendant is not in the cooling oil segment, but it is used for massage oil segment for the infants.

18. Per contra, the Defendant has contended that the Plaintiff has failed to establish the trinity test for seeking relief of passing off as the Plaintiff has not been able to establish goodwill with respect to the Plaintiff's Trade Dress, there has been no misrepresentation by the Defendant and the Plaintiff is not likely to incur any damages. The Defendant has also submitted that the prominent house mark of the Defendant 'DABUR' is the distinguishing feature in the Defendant's Product, which dispels any possibility of confusion between the Defendant's Product and the Plaintiff's Product. Further, it was contended that the Plaintiff has multiple variants and products under the brand, 'NAVRATNA' and the sales figures provided are not exclusive to the Plaintiff's Product using the Plaintiff's Trade Dress in question in the present Suit. It was submitted that to establish goodwill, the Plaintiff must produce sales figures pertaining to the Plaintiff's Product and not the entire 'NAVRATNA' brand. The Defendant relied upon Soothe Healthcare (supra) to submit that the cumulative sales and advertising expenses of all products under a particular mark without pointing out the goodwill of the particular

product in question is not sufficient to establish the goodwill of that particular product. The Defendant also relied upon the decision of the Supreme Court in Brihan Karan (supra) to submit that it is necessary for the Plaintiff to provide the expenditure incurred on promotion and advertisement of the Plaintiff's Product to establish goodwill.

19. The Defendant also submitted that on a holistic comparison of the Defendant's Product and the Impugned Trade Dress with the Plaintiff's Trade Dress, there are substantial and inherent dissimilarities in the elements and the features. It was submitted that in the case of passing off, the Plaintiff must establish that the Defendant has copied or tried to copy some of the essential features of the Plaintiff's Trade Dress, which are distinctive and associated with the Plaintiff alone, however, the Plaintiff has failed to do so. It was also argued by the Defendant that the red colour is functional in nature and as a result of the ingredients used in producing the cooling oil and, therefore, the Plaintiff cannot claim any right over it as held in M/s. M.L. Brothers (supra).

20. It was further argued by the Defendant that the features such as hibiscus flower, ice blocks, menthol leaves and descriptive words such as 'thanda', 'cool', 'cool tel' and 'cooling oil' are all common / generic in nature and common to the trade. It was argued by the Defendant that when the outer packaging of both the Plaintiff's Product and the Defendant's Product are compared as a whole, the products are dissimilar and can be easily distinguishable. It was submitted by the Defendant that the Plaintiff is not the first adopter and user of the red colour packaging for cooling hair oils. The Defendant relied upon Zydus Wellness (supra) to argue that mere use of red colour by the Defendant does not make the Impugned Trade Dress similar to the Plaintiff's Trade Dress.

21. Having heard the learned Counsel for both the Plaintiff and the Defendant and considering the material placed on record, the overall comparison of the Defendant's Product with the Plaintiff's Product shows that there is an attempt to imitate the essential features of the Plaintiff's Trade Dress by the Impugned Trade Dress. The Impugned Trade Dress is deceptively similar to the Plaintiff's Trade Dress as the essential features of the Plaintiff's Trade Dress such as colour of the packaging, colour of the cap, colour of the liquid, shape of the bottle and the use of combination of red, white, yellow and gold with the essential features of ice cubes, hibiscus flowers, ayurvedic herbs are copied in the Impugned Trade Dress along with the use of the words 'Raahat', 'Aaraam' and 'Tarotaazgi' in the same order. The common features in the Plaintiff's Trade Dress and the Impugned Trade Dress does not appear to be a mere coincidence. Even the quantity of the oil, i.e. 270 ml is identical in both the Plaintiff's Product and the Defendant's Product. The overall comparison of the get-up at the point of sale creates an impression that the Impugned Trade Dress is an imitation of the essential features of the Plaintiff's Trade Dress. It is not necessary to have exact identity for side-by-side

comparison between the Impugned Trade Dress and the Plaintiff's Trade Dress. It is sufficient if there is an overall similarity in the idea or impression assessed from the perspective of a consumer of average intelligence having imperfect recollection as held in Cadila Healthcare (supra). A holistic view of the Impugned Trade Dress appears to be deceptively similar to the Plaintiff's Trade Dress. The Defendant has not offered any explanation or bonafide reason for adopting the Impugned Trade Dress having identical features to that of the Plaintiff's Trade Dress.

22. It is settled law that to determine the passing off, the focus must be on the similarities rather than dissimilarities. The overall appearance at first impression is crucial to identify the passing off. The meticulous side-by-side dissection is not necessary and the trade dress has to be judged as a whole. Based on the overall get-up of the Defendant's Product, it is evident that the same is likely to cause confusion as the dominant similarities between the Impugned Trade Dress and the Plaintiff's Trade Dress overwhelm the minor differences. The argument that a well-known house mark will dispel the confusion, cannot be accepted in view of the overall similarity which is evident from the holistic comparison of the Defendant's Product with the Plaintiff's Product.

23. The Plaintiff has prima facie established the goodwill by showing the consistent and uninterrupted use of the Plaintiff's Product since 1989. Considering the sales turnover, it indicates that the Plaintiff has longstanding and formidable reputation.

24. The Defendant's Product was launched in 2023 and there is no dispute that the Plaintiff's Product was well established in the market at the time of the launch of the Defendant's Product. Therefore, the Defendant cannot deny the Plaintiff's goodwill or attempt to have a free ride on the same.

25. The Plaintiff cannot claim monopoly on red colour, herbs, hibiscus flower if they are considered individually. However, the distinctive combination, arrangement and presentation resulting in ensemble, which has been in use for a considerable long period has acquired secondary meaning in favour of the Plaintiff's Product. Even though the individual components of the Plaintiff's Trade Dress are common to the trade, the overall get-up of the Plaintiff's Trade Dress requires protection.

26. The Defendant's reliance on third-party material does not disentitle the Plaintiff as the Plaintiff is not required to sue every small infringer as held in Pankaj Goel (supra) and National Bell (supra).

27. The Plaintiff has prima facie established distinctiveness in the Plaintiff's Trade Dress whereas the Defendant has not been able to establish any distinction between the Impugned Trade Dress and the Plaintiff's Trade Dress. Accordingly, the Plaintiff has been able to establish the ingredients of passing off as per the settled principles of law."

37. This judgment has been upheld by the Division Bench in ***Dabur India Limited v. Emami Limited, 2026 SCC OnLine Del 3922 (DB)***. Court has emphasized on the importance of colours as part of a trade dress and has negated the contention of Dabur that if the individual elements of trade dress are common to trade, use of combination by the Appellant would not amount to passing off. Relevant paragraphs are as follows:-

> *"**60.** Mr Bhandari has contested the said submission by saying that the other players in the cooling oil segment as referred to by Mr Sethi, do not have different get-up/trade dress and in any case they do not have a large market share as compared to the respondent/plaintiff, as such not affecting the respondent. It is settled position of law that the plaintiff is dominus litis, it would be upto them to decide whether an action against trademark and passing off is to be brought against such third party players. As stated above in an action of passing off, the Court has to look at the overall appearance of the product and not individual aspects/attributes of the trade dress including the house mark of the respondent which in itself has acquired considerable goodwill over the years.*
>
> ***61.** In view of our above conclusion, the plea of Mr Sethi that Red Colour packaging, ice cubes, hibiscus, herbs, flowers, etc. are common to the trade for Red colour oil cannot be prima facie accepted. We agree with the conclusion drawn by the learned Single Judge in the impugned order, more particularly in paragraph No. 21, which we reproduce as under:*
>
> > *"21. Having heard the learned counsel for both the Plaintiff and the defendant and considering the material placed on record, the overall comparison of the defendant's Product with the Plaintiff's Product shows that there is an attempt to imitate the essential features of the Plaintiff's Trade Dress by the Impugned Trade Dress. The Impugned Trade Dress is deceptively similar to the Plaintiff's Trade Dress as the essential features of the Plaintiff's Trade Dress such as colour of the packaging, colour of the cap, colour of the liquid, shape of the bottle and the use of combination of red, white, yellow and gold with the essential features of ice cubes, hibiscus flowers, ayurvedic herbs are copied in the Impugned Trade Dress along with the use of the words 'Raahat', 'Aaraam' and 'Tarotaazgi' in the same order. The common features in the Plaintiff's Trade Dress and the Impugned Trade Dress does not appear to be a mere coincidence. Even the quantity of the oil i.e. 270 ml is identical in both the Plaintiff's Product and the defendant's Product. The overall comparison of the get-up at the point of sale creates an impression that the Impugned Trade Dress is an imitation of the essential features of the Plaintiff's Trade Dress. <u>It is not necessary to have exact identity for side-by-side comparison</u>*

between the Impugned Trade Dress and the Plaintiff's Trade Dress. It is sufficient if there is an overall similarity in the idea or impression assessed from the perspective of a consumer of average intelligence having imperfect recollection as held in Cadila Healthcare (supra). A holistic view of the Impugned Trade Dress appears to be deceptively similar to the Plaintiff's Trade Dress. The defendant has not offered any Explanation or bonafide reason for adopting the Impugned Trade Dress having identical features to that of the Plaintiff's Trade Dress."

(Emphasis supplied)

62. *It follows on a comparison of the products of the parties, it is clear that the overall similarity including the presence of the yellow triangle which states "New" in Hindi, the flower, ice cubes, herbs even the terms "Raahat"* (राहत), *"Aaram"* (आराम) *and "Tarotaazgi"* (तरोताज़गी) *find mention in the same sequence bereft of a justification for such an adoption of the impugned trade dress including the common bottle size of 270 ml. As such we find ourselves in agreement with the findings of the learned Single Judge.*

63. *In so far as the submission of Mr Sethi that the house mark of the appellant being "DABUR" under which the trade name "COOL KING" operates, and in that sense, the house mark being a well known mark is enough to distinguish the product of the appellant from that of the respondent. This submission has been contested by Mr Bhandari by stating that even "EMAMI" is well known mark and the house mark shall not have any bearing or effect on the trade dress and get up, which has been adopted by the appellant-defendant as late as 2023 with a clear motive to pass off its product as that of the plaintiff's/respondent's.*

64. *Mr Sethi, has also argued that if the individual elements of trade dress are common to the trade then a combination thereof cannot be said to constitute passing off. We do not agree with this submission. We concur with the findings of the learned Single Judge that the test for passing off has to be examined on the touchstone of similarities rather than the dissimilarities. Mr Sethi has also argued that apart from the features which according to him are common to the trade, even the shape of the bottle is distinctive which in its 270ml size has a unique cooling tube. We find that both the products look similar enough to cause damage to the respondent's product and the appellant should not be allowed to blow hot and cold on this aspect to suit its case.*

xxx xxx xxx

67. *Mr Sethi has relied upon various judgments, being Star Bazar Pvt. Limited v. Trent Limited, 2010 SCC OnLine Del 4764; Marico Limited v. Agro Tech Foods Limited, ILR 2010 Supp (3) Del 402; Holy Cow Foundation v. Patanjali Gramodyog Nyas (Trust), 2026 DHC: 146; Gensol Electric Vehicles Pvt. Limited v. Mahindra Last Mile Mobility Limited, 2025:DHC:116; Intex Technologies (India) Limited v. Tech*

(India), 2017 SCC OnLine Del 7392; Meso Pvt. Limited v. Liberty Shoes Limited, AIR 2019 Bom 35; Valvoline Cummins Limited v. Apar Industries Limited, 2013 DHC:6052; and Peshawar Soap and Chemicals v. Godrej Soaps Limited, 2000 SCC OnLine Del 959 : (2001) 58 DRJ 170 to state that the presence of the house mark "DABUR" on the appellant's packaging is enough to allay any confusion in the minds of the consumer.

68. With regard to said submission, it is settled law in the case of passing off, the consumer is taken to be a person of an average intellect and imperfect recollection [Reference: Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73]. This combined with the fact that the goods are being sold at a low cost, which would entail that the degree of care exercised by an average consumer at the time of purchase would be at a lower threshold, the presence of the house mark has little role to play in this background, given the other overlapping features in the trade dress. In other words, it is only the get up and trade dress of the product which will determine the sale of the products and in view of the fact that trade dress and get up of the appellant product is likely to cause confusion, cannot be discountenanced. Hence, the judgments as relied upon by Mr Sethi have no applicability to the present case given the distinguishing factual aspects and the general rule of assessment in passing off action. Each case has to be considered in the context of its unique factual background."

38. Another plank of the argument on behalf of Defendant No.1 was that impugned trade dress was *bona fidely* adopted inasmuch as throughout its trade dress, Defendant No.1 is using its house mark "DOUBLE CHABI", which clearly distinguishes it from Plaintiffs' trade dress and it is trite that when brands of the products are clearly identifiable, there is no scope of confusion. Reliance was placed on the judgments in ***Intex Technologies (supra)*** and ***Britannia Industries v ITC (2021) (supra)***. This argument only deserves to be rejected in the facts of this case, where *prima facie* it is found that there is substantial copy of the trade dress as also given the nature of the products i.e. rice, where visual impression generally dominates consumer's decision and hence, the importance of trade dress cannot be underscored. There can be no quarrel with the proposition that in a given case, the house mark may serve as a source identifier and distinguish the product in

question, however, in the present case given the deceptive similarity of the impugned trade dress, presence of house mark of Defendant No.1 i.e. DOUBLE CHABI is not sufficient to defeat Plaintiffs' claim of passing off. The competing products are identical, namely rice, which are marketed to the same class of consumers through common trade channels. Rice is typically a fast-moving consumer good, sold from retail shelves, kirana stores and/or wholesale counters and very often is purchased by consumers based on prior memory of packaging, colour schemes, layout and general trade dress rather than detailed scrutiny of brand distinctions. In such environments, buying decisions are predominantly driven by visual recognition of packaging and similarity in trade dress including its colour scheme rather than careful and considered textual analysis of brand names or house marks. In this scenario presence of the house mark DOUBLE CHABI is *prima facie* not sufficient to dispel consumer confusion. In coming to this conclusion, I find strength from the judgment of the Division Bench in ***Dabur India (DB) (supra),*** where the Division Bench observed that given the overlapping features in the trade dress which are likely to cause confusion, presence of house mark has little role to play. Relevant passage is as follows:-

> ***"65.*** *Mr Sethi has also relied upon the decision in the case of Kellogg Company v. Pravin Kumar Bhandbhai, 1996 SCC OnLine Del 170 : (1996) 16 PTC 187 to say that the presence of the house mark is a distinguishing feature. Whereas Mr Bhandari has opposed the said submission by relying on the judgments in the cases of N. Ranga Rao and Sons v. Anil Garg, 2005 SCC OnLine Del 1293 and Euro-Solo Energy Systems Ltd. v. Eveready Industries India Ltd., 2009 SCC OnLine Cal 1991 and argued that the said judgment does not lay an absolute rule that the house mark is a complete cure for the overall similarity appearance. The trade dress has to be taken as a whole and not in part/in isolation in view of the judgment in Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73. The said principle is clear and has been upheld by the Courts that the same falls under the anti-dissection rule in cases concerning trade mark and the same has been upheld by the Supreme*

Court in Pernod Ricard (supra). However, the Supreme Court in Pernod Ricard (supra) had held that the Courts are not precluded from applying the dominant feature test. In the present case, since there are similarities between the trade dresses of the parties, wherein the respondent is the prior bona fide user of the same, we accept the argument of Mr Bhandari and are of the view the said judgment does not help the case of Mr Sethi."

39. In ***Colgate Palmolive (supra),*** this Court held that despite the marks 'Colgate' and 'Anchor' being distinct with not even an iota of similarity either in look or sound, an illiterate person who goes to the shop with an instruction to buy Colgate Tooth Powder which has a trade dress of colour combination of red and white, will not be able to distinguish the tooth powder if he is handed over Anchor Tooth Powder contained in a container with identical trade dress and colour combination of red and white in the same order and proportion. The difference in names/brands will not make any difference to such a consumer and goods of Defendant could be easily passed off as goods of the Plaintiff. Same contention was also negated by this Court in ***Allied Blenders (supra).*** In the said case, the competing labels in question were held to be deceptively similar owing to substantial imitation of the trade dress of Plaintiff's label by the Defendant, despite Plaintiff's label having its trademark 'Officer's Choice', which was clearly structurally, visually and phonetically different from Defendant's mark 'Peace Maker', prominently displayed on its label. Court placed reliance on the judgment in ***Skechers USA INC v. Pure Play Sports (2016/DHC/4344)*** where Plaintiff's trademark was SKECHERS and Defendant's mark was PUREPLAY and Court had held that no doubt, the respective marks were inscribed on the rival products but were not enough to dispel the confusion arising from similar trade dress. Court also relied on another judgment of this Court in ***Allied Blenders and Distillers Pvt. Ltd. v. Agribiotech***

Industries Limited (ABIL), 2020 SCC OnLine Del 2770 (‘***Allied Blenders-II***’) wherein it was held as follows:-

> *“**47.** On merits, the claim of the plaintiff, prima facie, merits acceptance. A bare comparison, of the label of the “Officers Choice” label used by the plaintiff, vis-à-vis the “Chetak” label used by the defendant, reveals that they are deceptively similar. In both the labels, (i) there is a gold line, dividing the label into an upper and lower half, (ii) the lower half has a red background, whereas the upper half as a white background, (iii) the lettering, on the lower red half of the label, is in white, and the lettering, in the upper white half of the label is in red, (iv) the placement of the trademarks “Officers Choice” (in the case of the plaintiffs label) and “Chetak”, in the case of the defendant's label, are similar, and covers a major portion of the upper white half of the label and (v) both labels have an outer gold border. The overall appearance of the two labels is, at a plain glance, similar, and constitutes, therefore, similar trade dresses. The two labels are, therefore, deceptively similar, as perceived by the man of average intelligence and imperfect recollection.*
>
> ***48.** The defendant in the written submission merely contends, in this regard, that the name of the defendant's product was different from that of the plaintiffs, there was the feature of a horse above the word “Chetak” in the label of the defendant, and the packaging of the goods was different, as the bottles were different in shape, size, and had different caps. These features do not, however, prima facie, detract from the overall similarity in the essential features of the labels used by the plaintiff and the defendant.”*

40. It will also be useful to refer to the judgment of the Calcutta High Court in ***Edible Products (India) Limited v. Shalimar Chemical Works Private Limited, 2025 SCC OnLine Cal 9444,*** where it was held that use of ‘KMP’ as opposed to ‘Shalimar Coconut Oil’ loses significance in the larger backdrop of the similarity in the packaging of the competing products. Therefore, what emerges from reading of the aforementioned judgments is that in passing off action, undoubtedly trade dress and getup of the packaging constitutes an essential component of the goodwill and reputation *albeit* the Plaintiff must show that general public associates the trade dress/packaging with it, for seeking even *prima facie* protection in the nature of interim injunction. Before concluding the discussion on trade dress *qua*

passing off action, it would be instructive to refer to a few passages from the judgment of this Court in ***Seven Towns Ltd. & Anr. v. M/s. Kiddiland & Anr., 2016 SCC OnLine Del 5168*** as follows:-

> *"**45.** In passing off, undoubtedly trade dress and get up of the packaging, presentation of the product through label, etc. constitute essential components of the goodwill and reputation of a commercial enterprise. The case of William Grant & Sons Ltd. v. McDowell & Co. Ltd. (1994) 55 DLT 80 also supports such a proposition. Yet, for seeking even prima facie protection in the nature of interim injunction there should be material disclosing that the general public associates the shape in question (which is asserted by the plaintiff as their distinctive mark or get up) only with the plaintiffs. Whilst in the case of trade dress in the form of label or mark, distinctiveness is easily discernable in the case of shape based trade dress, the plaintiffs have to necessarily show that the get up of the product or article has an integral association only with it. Unless this requirement is pleaded and established, (and for interim injunction purposes, at least prima facie) every product with a commonplace shape would "ride" on the reputation of an exclusive trademark, based on a distinctive name, label or color combination of the packaging or label, etc. In this case, the distinctiveness of the shape of the product asserted to be unique or solely associated with the plaintiffs has not been so pleaded and established.*
>
> *xxx xxx xxx*
>
> ***47.** This Court in the case of Anglo-Dutch Paint Color and Varnish Works Pvt. Ltd. v. India Trading House, AIR 1977 Delhi 41 (paras 11 and 12) held as under:*
>
> > *"11. As to the extent and scope of the work "mark" as defined in Section 2(j) of the Trade and Merchandise Marks Act, 1958, the observations of Graham, J. in Smith, Kline & French Laboratories Limited's Trade Mark : (1974) R.P.C. 91 (3) at page 95 may be seen……*
> >
> > > *…….It was so in the Hoffmann-La Roche Chlordiazepoxide case, (1972) R.P.C. 1 (4). .....At page 99 of the same judgment it was observed by Graham, J. as under:*
> > >
> > > > *"I cannot see why other manufacturers should want to adopt the applicants' colour arrangements here except for the improper motive of trying to benefit from the latter's established goodwill."*
> >
> > *In this judgment, Garham, J. relied on the observations of Harman Lord Justice in the Court of Appeal in the case of F. Hoffmann-La Roche & Company A.G. v. D.D.S.A. Pharmaceuticals Limited : (1972)*

R.P.C. 1 (4). It is worthwhile to quote the words of Harman Lord Justice at page 20:

> *"Goods of a particular get-up just as much proclaim their origin as if they had a particular name attached to them, and it is well known that when goods are sold with a particular get-up for long enough to be recognised by the public as goods of a particular manufacturer it does not matter whether you know who the manufacturer is."*

12. As stated earlier, instead of receiving any satisfactory answer, I received no answer from the defendants to the plain question as to why they wished to mark their goods in violet grey and white. The only answer which I could suggest to myself was that they have adopted the colour-scheme in order to attract to themselves some part of plaintiff's good-will and trade on their reputation and in fact to represent to public that their goods are the goods of the plaintiff. This is exactly a classic case of 'passing off'."

xxx *xxx* *xxx*

51. *In Cadbury India Ltd. v. Neeraj Food Products, 142 (2007) DLT 724, this Court while discussing the principle of dishonest adoption observed as under:*

> *"31. Holding that it is the points of similarity which have to be given greater attention to than those of dissimilarity in 22 RPC 273 Munday v. Carey, it was held thus : -*
>
> > *"...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."*
>
> *32. It would be also useful to consider the principles which were laid down in 1996 RPC 697 Harrods Ltd. v. Harrodian School Limited wherein it was held that the deception is the gist of the tort of passing off and it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct, nevertheless, the question why the defendant chose to adopt a particular name or get up is always highly relevant."*

52. *In Frito-Lay India v. Radesh Foods, 2009 (40) PTC 37 (Del.) this Court laid down the Test of close proximity for determining dishonest adoption in the following words:*

> *"There are many combinations and permutations of designs, colours and graphics that can be achieved and used in relation to packaging designs…. It is clear that the defendants adoption and use of the impugned packaging design is not a mere coincidence or an innocent act but, a concerted and a deliberate attempt to achieve the maximum proximity with the plaintiff's Lays packaging design. …."*

xxx *xxx* *xxx*

55. *The plaintiffs have given the details of the similarities between the two products of the parties. The same are mentioned in para 24(d) of the plaint, which are as under:*

Sl. No.	***Rubik's Cube manufactured and sold by the plaintiffs.***	***Rancho's cubes manufactured and sold by the defendants***
1.	*The entire cube consists of 6 different coloured stickers namely particular shades of green, red, blue, yellow, white and orange*	*The entire cube consists of different coloured stickers namely particular shades of green, red, blue, yellow, white and orange*
2.	*The sticker is square shaped with rounded edges*	*The sticker is square shaped with rounded edges*
3.	*The black border/cage consisting, of lines of a particular width.*	*The black border/cage consisting of lines of a particular width*
4.	*The puzzle is in the shape of a cube and its size is and each side has 9 stickers*	*The puzzle is in the shape of a cube and its size is and each side has 9 stickers*
5.	*The shape of the packaging which is transparent is diagonal which gives an impression that 3 dimensional triangles are bulging out of the front and the back of the box*	*The shape of the packaging which is transparent is diagonal which gives an impression that 3 dimensional triangles are bulging out of the front and the back of the box*
6.	*There are indentations on the transparent packaging forming a grid corresponding to the grid on the face of the Rubik's cube*	*There are indentations on the transparent packaging Forming a grid corresponding to the grid on the face of the Rancho's Cube*
7.	*Label consists of a combination of the colours (red, blue, green, orange and*	*Label consists of a combination of the colours (red, blue, green, orange and yellow) as*

	yellow) as well as artistic features like the distinct comic font with each letter of the mark in a different colour and the words "Ages 8 to Adult" placed on the lower left hand comer of the label.	*well as artistic features like the distinct comic font with each letter of the mark in a different colour and the words "Ages 8 to Adult" placed on the lower left hand comer of the label*

56. *Thus, irrespective of fact whether any case of infringement of copyright has been made out or not, still the passing off action would lie if a valid case is made out. In the facts and material placed on record, it appears to the Court that the passing off action would lie.*

57. *While overruling the decision of S.M. Dyechem v. Cadbury India Ltd. reported in (2000) 5 SCC 573 in the case of Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd. reported in (2001) 5 SCC 73, the principles laid down in Dyechem case (supra) that the prominence must be given to the dis-similarities, the Supreme Court in Cadila case (supra) after discussing the law laid down by the Supreme Court for the last years and the Supreme Court had come to the conclusion that while comparing the two products, it is essential that prominence should be given to similarities rather, dis-similarities. In Dyechem case (supra) the similar view was taken as in Kelloggs case. Thus in a way the view taken in Kelloggs case (supra) and Dyechem case (supra) was not approved in the subsequent judgment i.e. Cadila case (supra).*

58. *The arguments of the defendants are that no exclusivity can be claimed in basic colors or the color black which forms the border/cage. The said submissions have no force as the plaintiffs are not seeking protection in any single feature but in the combination of all these features which constitutes the get up of a product namely the combination of shape/size/color-combination/black border of the squares etc.*

xxx *xxx* *xxx*

61. *It has been accepted by the House of Lords that if the defendant attaches his own label to the prior user's trade dress then in such event far from serving to distinguish the goods, the label would actually tantamount to ". a deliberate appropriation of that get up as their own". In other words, merely using their own label on the plaintiffs' trade dress not only causes deception but also has the consequence of diluting the plaintiffs' goodwill in the trade dress.*

xxx *xxx* *xxx*

64. *Furthermore, it has also been held by this Court in N. Ranga Rao v. Anil Garg, 2006 (32) PTC 15 (Del.) that the dictum in Kellogg's*

case to the extent it relied on the Schwepps case, would not hold good in view of the subsequent development of the law in Cadilla. It was further held that in any case the reasoning in Kellogg would apply only where the customers can readily be characterised as "sophisticated and discerning" and not in a case as the present.

***65.** Again in Sanjay Kapur v. Dev Agri Farms, 2014 (59) PTC 93 the Single Judge of this Court distinguished the judgment in Kellogg's case as having been passed in the peculiar facts of that case namely the trade dress being entirely different. The Division Bench upheld this finding of the Single Judge and further observed that it would not be correct to say that "merely because a trademark [or label] is displayed on the packaging material [or trade dress], even then notwithstanding a striking similarity in the packaging material there would be no likelihood of deception".*

***66.** It is rightly submitted by the learned counsel for the plaintiffs that marks/trade dress will always have points of dissimilarities. Where these dissimilarities outweigh the differences, then it might be correct to say that the trademarks/trade dress is not similar. Public interest is of utmost concern in these cases and despite dissimilarities, if there is bound to be consumer confusion, then trademarks/trade dress must be held to be similar. Moreover, this argument goes totally contrary to the law laid down by the Supreme Court in Cadila (supra) wherein it was laid down that while comparing trademarks/trade dress, the focus has to be on similarities and not dissimilarities, particularly when the trade dress has acquired immense goodwill and worldwide reputation by virtue of long and extensive user. It was further observed that it would be incorrect to say that differences in essential features are at all relevant as has been sought to be urged by the defendants. In other words all that is relevant and has to be compared are the similarities in the trade dress and not the dissimilarities.*

***67.** The same view has been taken by this Court in Cadbury India v. Neeraj Food (supra) wherein it was observed that the points of similarity which have to be given greater attention to than those of dissimilarity and that one has to pay great attention to the items of similarity, and less to the items of dissimilarity (paras 31 & 32).*

xxx xxx xxx

***70.** Lastly, it was mentioned by the counsel for the defendants that without prejudice, the defendants have offered to change the size of the coloured stickers on the 6 faces of the cube from present 'square' to 'circular'. On such change to circular stickers, not only is the impression of any alleged "black border/cage" completely unfounded, but also the look of the defendants' product will become materially different from that of the plaintiffs. The sample of the same was shown. The plaintiffs have rejected the offer given by the defendants to alter/change its trade dress as counsel for the plaintiffs upon instruction submits that the changes suggested by the defendants may also amount to confusion and deception. He says that*

the black colour used in change/alter would create confusion and deception as in many cases a child is bound to identify a toy by its trade dress.

xxx *xxx* *xxx*

72. *However, it is submitted by the learned counsel for the plaintiffs that the present case is a classic example of how a defendant first seeks to adopt the trade dress of the plaintiffs in entirety and then to satisfy the Court seeks to introduce "variations in detail". This approach is totally flawed inasmuch as, it is observed by the Supreme Court in Parle Products (P) Ltd. v. J.P. and Co. (1972) 1 SCC 618 that : -*

> *"Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with"*

73. *The above observations have been followed by this Court in Cadbury v. Neeraj Foods (supra).*

74. *The said approach is also totally contrary to the law laid down by this Court in Colgate Palmolive v. Anchor Health (supra) wherein it was laid down that that a second comer has to make every effort to stay as far away as possible from the trade dress of a prior user and create its own goodwill.*

75. *In view of the above explanation given on behalf of the plaintiffs and the changes suggested by the defendants, I am of the view that without going into the controversy as to whether the changes suggested about the trade dress by the defendants or it should not be used in the market, it is proper that the Court should not express any opinion at this stage as it is the duty of the Court to decide the dispute in hand which is to be decided. If the defendants wish to use any changed version, it is upto them and in case of any complaint by the plaintiffs, it would be decided at that time. An opinion cannot be expressed at this stage in view of non-agreement on behalf of the plaintiffs. Thus, the present interim application is being decided on the basis of material and facts before the Court.*

76. *As far as the impugned trade dress used by the defendants at the time of filing of the suit, the plaintiffs have made a prima facie good case; the balance of convenience also lies in favour of the plaintiffs and against the defendants. The interim orders against the defendants have been operating since about 5 years and 9 months. In case, the interim order is not passed, the plaintiffs would suffer irreparable loss and injury. Under these circumstances, the trial of the suit is expedited.*

77. *Till the disposal of the suit, the defendants, their servants, agents and other persons on their behalf are restrained from manufacturing, selling or marketing Rancho's Cubes on any other puzzles or toys with a similar trade dress, get up and colour combination as Rubik's game of the*

plaintiffs and they are also restrained to pass off their goods as that of the plaintiffs."

41. Defendant No.1 also defended the passing off action on the ground that Zarda is common to trade and relied on a list of documents showing user by third parties. I have perused the documents and find no merit in this argument for multiple reasons. Firstly, as noted above, case of the Plaintiffs is essentially one of deceptive imitation of overall trade dress, get up and visual presentation and Zarda may function as a memorable component in consumer recollection, especially, when seen in the overall setting of numerous other similar elements and add to the consumer belief that the product belongs to or has some connection with the Plaintiffs. None of the documents filed by Defendant No.1 reflect use of Zarda with a deceptively similar trade dress as in the instant case by Defendant No.1. Be that as it may, it is trite that Plaintiffs are not required to run after each and every party. In ***Marico Limited (supra),*** Court held as follows:-

> ***"54.*** *As far as the defendants' argument that the colour blue is common to the trade and/or the plaintiff has not taken legal action against such similar infringers, this Court is of the view that the defendants have not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to plaintiff's distinctiveness. No sale figures of third parties using the blue colour bottles have been placed on record by the defendant. Consequently, this Court at this stage cannot presume extensive use of the blue colour by third parties.*
>
> ***55.*** *This Court is of the view that the plaintiff is not expected to sue all small type infringers who may not be affecting the plaintiff's business. The Supreme Court in National Bell v. Metal Goods reported in (1970) 3 SCC 665 : AIR 1971 SC 898 has held that a proprietor of a trademark need not take action against an infringer who does not cause prejudice to its distinctiveness. In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc. reported in (1989) 7 PTC 14 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…"

56. *In Dr. Reddy Laboratories v. Reddy Pharmaceuticals reported in 2004) 29 PTC 435 a coordinate Bench 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."

42. This view is also expressed by the judgement of the Division Bench in ***Dabur India (supra) (DB)***, holding that Plaintiff is the *dominus litis* and it is upto it to decide whether an action against passing off is to be brought against third parties as also by the Calcutta High Court in ***Edible Products (supra).***

43. In light of the aforesaid judgments, factual matrix brought forth by respective parties and on comparison of the competing packaging/trade dresses, I am of the *prima facie* view that Defendant No.1 has substantially copied the trade dress/packaging of the Plaintiffs in an attempt to come as close as possible and the use of the house mark DOUBLE CHABI is insufficient to dispel consumer confusion for a commodity such as rice. The entire basis of the trademarks regime is consumer confusion and public

interest, which will be hampered if Defendant No.1 is permitted to sell its product Golden Sella Basmati Rice in the impugned packaging and keeping this in the backdrop and looking at the deceptive similarity in the competing trade dresses, Defendant No.1 was rightly injuncted by this Court vide *ex parte* ad interim injunction order passed on 01.08.2024 with liberty to Defendant No.1 to carry on its business using different trade dress/ packaging, which is not identical/deceptively similar to Plaintiffs' packaging. It was rightly emphasised that in case of edible products such as rice greater sensitivity is required and the threshold of deceptive similarity is far lower. Court finds no reason to vacate the said order in the given facts and circumstances. The judgments relied on behalf of Defendant No.1, do not aid in any manner in seeking vacation of the injunction order. Plaintiffs have made out a case for passing off by *prima facie* demonstrating substantial goodwill and distinctiveness in the packaging/trade dress and hence the judgments in ***M.L. Brothers (supra)*** and ***Britannia Industries v. ITC (2017) (supra),*** do not help. In view of the overall similarity in the competing trade dresses, the house mark DOUBLE CHABI is not aiding in distinguishing the two and thus the judgments in ***Intex Technologies (supra)*** and ***Britannia Industries v. ITC (2021) (supra)*** are inapplicable.

44. The judgment in ***Pernod Ricard (supra)*** is also distinguishable on facts since consumers of commodities such as rice cannot be equated with consumers of high-end whiskies, which were found to be discerning consumers by the Supreme Court in the said judgment. Judgment of this Court in ***Sanjha Chulha (supra)*** is distinguishable on facts. The two issues arising in the said case were prior user of the device mark 'SANJHA CHULHA' as also whether registration of the device mark granted exclusive right to the appellant to use the work mark 'Sanjha Chulha'. The judgment

in ***Rhizome Distilleries (supra),*** also does not aid Defendant No.1. In the said case, the Division Bench was of the view that the two labels i.e. IMPERIAL BLUE and RHIZOME Imperial Gold were totally dissimilar and if a flat amber bottle was used by the defendants, no deception was likely to arise.

45. In view of the aforesaid, Plaintiffs have made out a *prima facie* case in their favour for continuing the *ex parte* ad interim order 01.08.2024 and balance of convenience also lies in their favour and against the Defendants. *Ex parte* ad interim order has been operation in favour of the Plaintiffs for almost 2 years and if in the given facts, the same is not confirmed and vacated, irreparable harm and injury shall be caused to the Plaintiffs. Accordingly, till the disposal of the suit, Defendants and all others acting on their behalf are restrained from selling, offering for sale and/or advertising Golden Sella Basmati Rice in the impugned trade dress/packaging 

, which is confusingly and deceptively similar to Plaintiffs' trade dress/packaging 

.

46. However, this will not preclude Defendant No.1 to carry on its business for sale of Golden Sella Basmati Rice using trade dress/packaging which is distinct and not deceptively similar to the trade dress/packaging of the Plaintiffs. It is also made clear that Defendant No.1 shall not use the packaging which were proposed to the Plaintiffs during the course of

hearing as they were found to be deceptively similar to Plaintiffs' trade dress/packaging.

47. I.A. 35064/2024 is allowed and I.A. 40114/2024 filed by Defendant No.1 for vacation of *ex parte* ad interim order is dismissed.

48. Both applications stand disposed of.

49. It is made clear that the views expressed in this judgment are only *prima facie* and will have no bearing on the final adjudication of the suit.

JYOTI SINGH, J.

MAY 29, 2026*/YA/S.Sharma*