

IN THE HIGH COURT OF SINDH AT KARACHI

HCA NO. 354 of 2008

Present:-

Mr. Justice Aqeel Ahmed Abbasi.

Mr. Justice Muhammad Junaid Ghaffar.

English Biscuits (Pvt.) Ltd. ----- APPELLANT

Vs.

Pakistani Dairy Products (Pvt.) Ltd.----- RESPONDENT

Date of hearing: 18.11.2014, 27.05.2015 & 21.9.2015.

Date of order: 09.12.2015.

Plaintiffs: Through Mr. Zain Shaikh Advocate.

Respondent Through Mr. Mirza Mehmood Baig Advocate.

J U D G M E N T

Muhammad Junaid Ghaffar, J. Through instant appeal the appellant has impugned order dated 10.11.2008, whereby the application under Order 39 Rule 1 & 2 CPC filed by the appellant, for grant of injunction in Suit No. 377 of 2005 has been dismissed, whereas, the respondent's application under Order 39 Rule 4 CPC for vacating the interim order has been allowed.

2. Briefly, the relevant facts are that appellant had filed Suit No. 377 of 2005 and had sought injunction against the respondent for

restraining them from infringing appellant's Trademark "PARTY" in respect of Ice Cream products. Along with the Suit the appellant had also filed an application for injunction under Order 39 Rule 1 & 2 CPC bearing CMA No. 1947 of 2005 wherein on 29.3.2005, an ad-interim injunction was granted in favour of the appellant against which the respondent had filed application under Order 39 Rule (4) read with Section 151 CPC, bearing CMA No. 2681 of 2005 which has also been allowed through the impugned order. The appellant's case as set up in the Memo of plaint is, that the appellant is the registered proprietor in respect of the Trademark "PARTY" registered under No. 123264 in Class 30 in respect of Biscuits since December 1993 whereas, the appellant has also applied for registration of "NEW PARTY" label which is pending for Registration under No. 180506 since September 2002, and so also for the Trademark "PARTY" word which is pending registration since February 2005 also in Class 30. The appellant claims that they have used the registered Trademark "PARTY" in Pakistan continuously since 1989, and, have pioneered and built up an extensive market throughout Pakistan for their products under the Trademark "PARTY", which is known to the public and trade as a product of high quality. It is further claimed that the appellant's particular products have acquired great reputation and popularity in Pakistan, which is identified and asked for by the trade and public generally by the distinctive Trademark "PARTY", hence the appellant have acquired the exclusive right to use the said registered Trademark "PARTY" on its products. It is further stated that due to great popularity of appellant's products in Pakistan, the respondent has introduced in the market an "Ice Cream" that bears the identical Trademark "PARTY", in order to trade

on the great reputation of the appellant since 2004, and the respondent is dishonestly trading, selling and offering Ice Cream under identical and deceptive Trademark “PARTY” which has led to confusion, deception, infringement and passing off the name of the appellant in the Pakistani market. It has also been claimed that the respondent’s product bears a Trademark of the appellant and being deceptive and confusing in nature, thus constitute infringement of the Trademark of the appellant. After issuance of summons and notices in the Suit the respondent had filed counter affidavit and written statement, whereafter, the learned Single Judge vide impugned order has been pleased to dismiss the injunction application and has allowed the respondent’s application under order 39 Rule (4) by recalling the interim order dated 29.3.2005; hence instant appeal.

3. Learned Counsel for the appellant has contended that the learned Single Judge has erred in law and facts while passing the impugned order and has failed to consider, that there is a marked change in the Trademark law, after promulgation of the Trademarks Ordinance, 2001 (“Ordinance 2001”) particularly, Section 40 thereof, which now provides and caters for a number of additional situations whereby, a registered Trademark could be infringed as compared to the repealed Trade Mark Act, 1940. Learned Counsel has further contended that the impugned order is a non-speaking order and has been passed without proper application of an independent mind, and, has failed to consider the settled law and precedents of this Court and of the Hon’ble Supreme Court, on the subject controversy. Learned Counsel has further submitted that in view of Section 40(3) of the Ordinance 2001, which provides that a person shall infringe a

registered Trademark, if such person uses a mark which is identical with, or deceptively similar, to the Trademark in relation to goods and services of the same description as that of the goods and services in which the Trademark is registered, which has been incorporated in the Ordinance 2001, to comply with Pakistan's International obligations under Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights ("TRIPS") provides for infringement in a much broader perspective and has enlarged its scope. Learned Counsel has further submitted that though initially (which according to the appellant was not in their knowledge) the registration of the appellant in respect of the Trademark "PARTY" under registration No. 123264 in Class 30, incorporated a restrictive condition, to the effect that *the mark will be used for biscuits only*, against which a rectification application was filed by the appellant through J.M. No. 28 of 2005 and vide order dated 7.2.2007, a learned Single Judge of this Court, has been pleased to dispose of the same by replacing the said condition, with the words *that instant registration is granted in favour the applicant in respect of biscuits only*, whereas, according to the learned Counsel, the learned Single Judge has failed to take into consideration the order so passed in the aforesaid J.M. Learned Counsel has further submitted that according to Section 40 (3) of the Ordinance 2001, the goods in question i.e. Biscuits and Ice Cream are goods of the same description, and the Trademark law internationally, as well as locally, has developed in this regard and there are various Judgments of the Foreign Countries as well as from our own jurisdiction, wherein it has been observed that the expression "the same goods" is not synonymous with "goods of the same description" as the word "same" does not mean identical, but

denote(s) a rather close similarity; and “the same description” does not mean to look for a description which applies for both goods, but rather indicates a similarity in various respects. Per learned Counsel in the present situation, there are various factors which are to be looked into and which include, inter alia, the nature, the end users and the method of use and as to whether, they are in competition with each other or are complementary, while deciding the issue in respect of similarity of goods. Per learned Counsel since the appellant is registered under Class 30, which includes the products Biscuits as well as Ice Cream, therefore, in terms of Section 40 of the Ordinance 2001 the appellant can sue the respondent for infringement of its registered Trademark “PARTY”, which though, apparently is not being used by the appellant in respect of the product “Ice Cream” but for “Biscuits”. In support of his contention the learned Counsel has relied upon the case reported as *Seven-Up Company Vs. Kohinoor Thread Ball Factory and 3 others (PLD 1990 SC 313)*, *Mars Incorporated Vs. Pakistan Mineral Water Bottling Plant (Pvt.) Ltd (2001 MLD 39)*, *Unilever PLC., A British Company of Port Sunlight Wirral Merseyside, England Vs. R.B. Oil Industries (Pvt.) Ltd, Karachi (1999 MLD 1447)*, *M/S Alpha Sewing Machine Company Vs. Registrar of Trade Marks and another (PLD 1990 SC 1074)*, *Kabushiki Kaisha Toshiba Vs. Ch. Muhammad Latif (PLD 1990 SC 27)* and cases from the foreign jurisdiction reported as *Pfizer Limited & Pfizer Inc. Vs. Euro food Link (UK) Limited (2000 ETMR 896) & (2001 FSR 3)*, *Kwality Food Products (1981 PTC 228)*, *Sabel Vs. AG, Rudolf Dassler Sport, (1997 ECR I-6191) & (1998 PRC 199)* and *Lloyd Schuhfabrik Meyer & Co. GmbH Vs. Klijsen Handel BV (1999 ETMR 690)*.

4. Conversely learned Counsel for respondent has contended that there is no similarity of goods in Biscuits and Ice Cream as the respondent is using the word “PARTY” in conjunction with its

registered Trademark “IGLOO” in respect of Ice Cream, hence the product of the appellant and that of the respondent are poles apart, distinct, dissimilar and distinguishable. Learned Counsel has further contended that insofar as the word “PARTY” is concerned, it is being used by the respondent in conjunction with its household name and Trademark “*Peak Freans*” which is the most prominent, acclaimed and distinctive feature of the appellant’s product and therefore, the provisions of Section 40(3) of the Ordinance, 2001 does not apply in the instant matter. Per learned Counsel Class 30 of the Ordinance, 2001 corresponds to International Classification of goods, commonly known as “NICE” Classification, which covers more than 300 goods / commodities, out of which the appellant is registered in respect of Biscuits only, hence, such registration is confined to said goods and does not, in any manner, grant right over any or all other goods falling in the same Class, whereas, the Trademark in question exists only in respect of goods to which it is applied and not independent thereof. Learned Counsel has further submitted that it is an admitted position and which has not been denied by the appellant, that the appellant is not the only registered proprietor of Trademark “PARTY” in Class 30 as M/s Shipton Tea Company, has been registered for “Tea,” whereas, M/s Aziz Product, Karachi, for “Pan Masalah”, and these registrations are much prior to the registration of the appellant, therefore, per learned Counsel the appellant cannot claim any exclusive right in respect of its registration in Class 30, except for Biscuits. Learned Counsel has also referred to the counter affidavit filed by the appellant in respect of CMA No. 2681 of 2005 in Suit No. 377 of 2005, specially, annexure A/3, which appears to be a letter dated 17.6.1996, whereby, the appellant had responded to a Show

Cause Notice issued by the Trademarks Registry, and has contended that the appellant is blowing hot and cold in the instant matter, as on the one hand they have alleged infringement against the respondent in respect of the Trademark "PARTY", whereas, in the aforesaid reply, they have contended that Trademark "PARTY" registered in favour of M/s Aziz Product, Karachi, is for Pan Masalah, which product is entirely different in nature, though both the products fall in same Class, yet their effects are poles apart, distinct, dissimilar and distinguishable. Learned Counsel further submitted that based on this line of argument of the appellant, the product in question i.e. "Biscuits" and "Ice Cream" also do not have any similarity, though they fall in the same Class. Learned Counsel further contended that without prejudice to the above submission. even otherwise, the appellant has no exclusive right in its registration of Trademark "PARTY", as a specific condition is attached in respect of the registration, which even after passing of the order dated 7.2.2007 in J.M. No. 28 of 2005, does not materially modify the conditional registration of the appellant, as it still remains a registration confined to or in relation to "Biscuits" only. In this regard learned Counsel has referred to the provision of section 42(2) of the Ordinance 2001. Learned Counsel further submitted that even otherwise, the getup and the packing of the goods of the respondent in respect of "Ice Cream", is dissimilar and not identical to the label and packing of the appellant's product, i.e. "Biscuits", whereas, the primary and or basic mark being used by the respondent is "IGLOO", which admittedly, is a house mark of respondent, and the mark "PARTY" is being used by the respondent in conjunction with its house mark, therefore, even otherwise, no case for passing off is made out. It has been further

contended by the learned Counsel that since damages have been quantified by the appellant, therefore, no injunction can be granted. In support of his contention the learned Counsel has relied upon the cases reported as *Anglo Indian Drug and Chemical Co. Vs. Swastik Oil Mills Co. Ltd.* (AIR 1935 Bombay 101), *Haji Danu Mian Saudagar Vs. Shaikh Muhammad Idris and another* (PLD 1969 Karachi 245), *Abdul Wasim Vs. M/S Haico through Sole Proprietor / Partner and 2 others* (2002 CLD 1623), *General Biscuit and another Vs. English Biscuit Manufacturers (Pvt.) Ltd.* (2004 CLD 680), *Lyons Maid Limited Vs. Trebor Limited* (1967 PRC 222), *Nugget Polish Company Ltd. Vs. Harboro Rubber Company* (1912 PRC 133), *Turner's Motor Manufacturing Company Ltd. Vs. M/S Petrol Car Syndicate Ltd.* (1907) 24 PRC 531, *Lcrimar Productions Inc. and others Vs. Sterling Clothing Manufacturers (Pvt.) Ltd.* (1982 PRC 395), *Crystal Vs. Piano Vs. Piano Crystal* (2007 CLD 802), *Zeera Plus Vs. Gluco Plus* (2004 CLD680), *Tasty Gold Vs. Piece Gold* (2004 CLD 1163), *Independent Media Vs. Ali Saleem and another* (2006 CLD 97), *Pakistan Vs. M/S Mehran Sugar Mills Ltd. Karachi* (2001 YLR 1237), *Managing Committee, Revenue Employees, Cooperative Housing Society, Rawalpindi Vs. Secretary, Cooperative Societies, Government of Punjab, Lahore and 3 others* (2001 CLC 838), *Attock Industrial Products Limited Vs. Heavy Mechanical Complex (Pvt.) Limited* 1999 MLD 1876, *Trademark Tibet for Cream Vs. Trademark Tibet for threads* (PLD 1969 Karachi 245), *Kraft General Foods Inc. Vs. Abid Anjum, Manager / Partner / Proprietor, Tango Enterprises and 3 others* (1994 MLD 607), *Imperial Tobacco Co. India Ltd. Vs. Mullaji Jamaluddin* (AIR 1937 Nagpur 158), *Lyons Maid Ltd Vs. Trebor Ltd* (PRC 84 1967 222), *Sun Line Trade Mark* (1970 PRC 207), *Turner's Motor Manufacturing Company Ltd. Vs. M/S Petrol Car Syndicate Ltd.* (107 PRC 531), *Helena Rubinstein Ltd. Application (Trade Mark)* (1960 PRC 231), *British Sugar PLC Vs. James Robertson & Sons Ltd.* (1996 PRC 251), *Coombe Vs. Mendit Ltd.* (1913)30 PRC 709, *Lorimar Productions Inc. and others Vs. Dallas Restaurant* (1982 PRC 395), *Consort Trade Mark* (1980 PRC 160) and *Toranto Trade Mark* (1979 PRC 155).

5. We have heard both the learned Counsel and perused the record including the R & P, as well as file of J.M. No. 28 of 2005, which was summoned during hearing of the instant appeal. By consent of both the learned Counsel instant appeal is being finally decided of at Katcha peshi stage. From perusal of the record, it appears that the appellant, who is engaged primarily in manufacturing and selling of Biscuits, is using various Trademarks including the Trademark “PARTY” in respect of Biscuits. The biscuits of the appellant are very descriptively known by the name of “*Peak Freans*” which appears to be a Trademark dominating the other marks and brand of biscuits of the appellant. Through instant proceedings, the appellant has sought injunction against the defendant in respect of the alleged infringement of the Trademark “PARTY” which is being used by the appellant in respect of one of its types of “Biscuits” and by the respondent in respect of its brands of “IGLOO” Ice Cream. The main contention raised on behalf of the appellant appears to be, that since Biscuits as well as Ice Cream are products Classified under Class 30 of the Fourth Schedule to the Trademark Rules, 2004 (“Rules”) therefore, they can or are to be termed as goods of the same Class or of similar Class. It is further case of the appellant, that in compliance of the TRIPS Agreement certain changes have been introduced in law, through Section 40 of the Ordinance 2001, therefore, the appellant is within its right to sue the respondent for infringing the appellant’s Trademark “PARTY”, though the same is admittedly being used by the respondent not in respect of Biscuits but for Ice Cream. The case as setup by the appellant appears to be, that both “Biscuits” and “Ice Cream” are goods of “same description” and the use of the Trademark of the

appellant amounts to infringement in terms of Section 40(3)(a) of the Ordinance 2001, as being goods of same description as that of goods in respect of which the Trademark is registered in favor of the appellant. Before proceeding any further on merits of the case with regard to infringement as alleged on behalf of the appellant in terms of Section 40 of the Ordinance, 2001, it is important as well as relevant to observe that a claim for infringement of a Trade Mark can only be held valid, once the Trade Mark is registered in terms of Section 33 of the Ordinance, 2001. Needless to state that such registration must be without any limitation(s) and or restriction(s) (see S. 39 *ibid*). Since in the instant matter it is an admitted position that the appellant's Trade Mark is registered with certain restrictions and or limitations, we deem it appropriate to discuss this aspect of the case before we give any findings on the merits of alleged infringement being claimed on behalf of the appellant in terms of section 40 of the Ordinance, 2001.

8. It is not in dispute that appellant's Trade Mark had been registered with certain restrictions as discussed hereinbefore. In this regard it is the claim of the appellant that they were not aware of any such condition attached to their Registration Certificate, and, it only came to their knowledge, when the respondent filed an application under Order 39 Rule (4) CPC for vacating / recalling of the interim injunctive order in Suit, before the learned Single Judge and annexed copy of such registration, whereby, it transpired that a condition was imposed by the Registrar to the effect that "it is a condition of the registration that the mark will be used for biscuits only". It is the case of the appellant that pursuant to such notice and knowledge, they preferred a rectification application bearing J.M. No. 28 of 2005 under Section

96 of the Ordinance, 2001 before this Court, seeking deletion and amendment of the condition imposed in the Trademark Register in respect of its Trademark under No. 123264 in Class 30. This Court vide order dated 7.2.2007 disposed of the aforesaid J.M. No. 28 of 2005, whereby, the aforesaid condition imposed by the Registrar was replaced by the words “the instant registration is granted in favour of the applicant in respect of biscuits only”. On perusal of the proceedings in J.M. as referred to hereinabove, and the order passed thereon, we are of the considered view that insofar as the contention of the learned Counsel for the appellant to the effect that vide order dated 7.2.2007 in the aforesaid J.M, the condition imposed by the Registrar has been deleted is concerned, the same does not appear to be correct and is misconceived. On careful examination of the substitution of the words through the aforesaid order in J.M, it does not appear that any material change has been affected in favour of the appellant. Prior to such amendment through the order in J.M, the restriction was to the effect that the Trademark will be used for biscuits only, whereas, after replacement / substitution by order dated 7.2.2007, it reads that the registration in favour of the applicant is in respect of biscuits only. The cumulative effect, in our considered view in both the situations is the same. It was to be exclusively used for biscuits, whereas, now it has been granted in respect of biscuits. It still is conditional and is subject to qualification and is not exclusive. The primary purpose of putting restriction in the Trademark Registration of the appellant was that the same was being granted to the appellant in respect of “Biscuits” only whereas, after passing of order in aforesaid J.M, it still remains and is confined in respect of “Biscuits” only. The order of the Registrar, whereby restriction was imposed in the Registration

Certificate of the appellant, as well as the order of the learned Single Judge in the aforesaid J.M, have been passed, after considering the fact that prior to this registration of the appellant, there were two other parties who had the same Trademark namely “PARTY” registered in their names for their products of “Tea” and “Pan Masalah”, therefore, the subsequent registration which was granted to the appellant, had to have some restrictions placed on to it. To add further, it may be observed, that even otherwise, the word “PARTY” is neither a coined word nor the appellant claims it to be having any special attachment to it for any reason and in fact, is rather a dictionary / descriptive word, for which no exclusive rights can be conferred in terms of Section 39 of the Ordinance, 2001. This restriction in the Trademark Registration does not give any exclusive rights to the appellant to seek infringement in terms of Section 40 of the Ordinance, 2001, as it is not unqualified. Reference in this regard may be made to Sections 42 of the Ordinance, 2001 which provides as follows:-

“42. When a trade mark is not infringed.---(1) A person shall not infringe a registered trade mark when:--

- (a) the person uses in good faith:-
 - (i) the person’s name or the person’s place of business, so long such use does not result in a likelihood of confusion or otherwise interfere with an existing trade mark or other property right; or
 - (ii) the name of the predecessor in business of the person or the name of the predecessor’s place of business;
- (b) the person uses a mark in good faith to indicate:-
 - (i) the kind, quality, quantity, intended purpose, value geographical origin, or some other characteristic, of goods or services; or
 - (ii) the time of production of goods or of the rendering of services;

- (c) the person uses the trade mark in good faith to indicate the intended purpose of goods, in particular as accessories or spare parts, or services; or
 - (d) the person uses the trade mark for the purposes of comparative advertising.
- (2) If the right to the use of a trade mark given under section 39 by registration is subject to any conditions or limitations entered on the Register, such right shall not be deemed to be infringed by the use of any such trade mark as aforesaid in any mode, in relation to goods or services to be exported to any market, or in any other circumstances, to which, having regard to any such limitations the registration does not extend.
- (3) Where registration of a trade mark is subject to a disclaimer, a person shall not infringe the trade mark by using disclaimed part of the trade mark.”

9. The aforesaid provision of sub-section (2) stipulates that a person shall not infringe a registered Trademark when the right to use of a Trademark under Section 39 of the Ordinance, 2001 whereby, the mark is registered under the Ordinance, is subject to any condition or limitation entered on the register, and such right shall not be deemed to be infringed by the use of any such Trademark as aforesaid, in any mode in relation to goods or services to be exported to any market or in any other circumstances to which having regard to any such limitation, the registration does not extend. Therefore, in the instant matter, when the registration certificate of the appellant’s Trademark is subject to restriction to the effect, that it is only in respect of “Biscuits”, the question of infringing such mark, whereby the same is allegedly been used by the respondent in respect of a product other than “Biscuits”, does not arise. The registration of the appellant does not extend to any other product except “Biscuits” notwithstanding the order dated 7.2.2007 passed in J.M. (rectification), therefore, by virtue of latter part of Section 42(2) of the Ordinance, 2001, the respondent’s use of the

same mark in respect of its product “Ice Cream does” not fall within infringement in terms of Section 40(3)(a) of the Ordinance, 2001, as contended on behalf of the appellant. The contention that both the goods in question are of the “same description” does not arise in the instant matter nor is relevant for the simple reason that the Trade Mark, on the basis of which infringement is being alleged, is conditional and not exclusive, and therefore, we have not recorded any finding with regard to the question that as to whether the goods in question would fall within the definition of “*the goods of same description*” or not, and leave it open for decision in any other appropriate case. Hence, the contention that such use by the respondent falls within the definition of infringement as provided under Section 40(3)(a) of the Ordinance, 2001 is also misconceived and is hereby repelled.

10. Though, on the basis of aforesaid discussion it can be safely held that the appellant’s case is not of infringement and the appellant has failed to make out a case of infringement for various reasons, such as restrictions/limitations in the grant of registration, whereas, the learned Counsel for the appellant has neither argued nor has laid much stress through written synopsis of his arguments, on its alternative prayer of “passing off” (though raised in the plaint as well as in the injunction application), and neither the learned Single Judge has discussed the said issue, however, we deem it appropriate to discuss and decide the same as well, as we are of the view that notwithstanding the refusal of injunctive relief by way of an infringement action, the appellant can still press its claim for “passing off”, in the instant matter, on the ground that respondents act in using the Trade Mark “PARTY” is calculated to pass off their

goods as those of the appellant. It is a settled proposition of law in ours as well as English and other common law jurisdictions, that a claim for “passing off” is generally been added as a second string to actions of infringement and may succeed, in appropriate cases, even though the claim for infringement had failed. Though under normal circumstances, the claim for “passing off” is pressed upon in respect of Trade Marks which are yet to be registered, but the same principle would apply in case where certain restrictions and / or limitations have been imposed on registration of such mark. The mark of the appellant is though registered; yet, the appellant cannot lodge a claim for infringement as the same being not permissible in terms of Section 40(2) of the Ordinance, 2001 as discussed in the earlier part of this judgment.

11. Therefore, the case of the appellant, at most, and without prejudice, can be examined to the extent of passing off. The prerequisites of a claim for “passing off” are that an aggrieved party must satisfy the Court, at least to an extent, that members of the public at large have been led to believe and or have been deliberately induced to believe, that in buying “PARTY” ice cream, they were in fact buying a product in the name of “PARTY” that had originated from or belongs to the appellant. The appellant is also required to dispel the impression before the Court that neither the Trade Mark “PARTY” is descriptive or generic in nature (being a dictionary word) and is also not a *publici juris*. In short the appellant, at least at the stage of seeking an injunctive relief, is also required to prima facie establish that its propriety right in business or the goodwill acquired over a certain passage of time is likely to be injured by such use of the Trade Mark by the respondent through misrepresentation. If at

any point of time the appellant is in a position to establish that the respondent's conduct has been such so as to mislead the unwary consumers into a mistaken belief that the respondents goods or their business is either (a) the goods or business of the appellants (b) connected with the appellants goods or business in some way or the other by which it is likely to damage the appellants goodwill in that business, the respondents will be liable to be held to have committed the tort of passing off. In short the cumulative effect should be that it has in some way been aimed or calculated to damage the appellant's goodwill. Insofar as, the claim in respect of passing off is concerned, it is admittedly a claim to protect goodwill and in cases of fraud, the existence of goodwill and the actual damage being caused by using such goodwill as alleged is to be seen and minutely examined especially at the injunctive stage. The reputation and goodwill may be there, but whether the respondent is being benefited by use of such reputation or goodwill is the moot question, which is to be examined at this stage of the proceedings when the evidence is yet to be recorded. Such scrutiny can only be done on the basis of a tentative assessment of the case as a whole, including the claim of the appellant as set up on the basis of documentary evidence annexed with the plaint. It is not possible to arrive at any just definition of the exact nature of such goodwill; it is perhaps probably not capable of being defined in such a manner. In the case of **REUTER VS MULHENS [1953] 70 [R.P.C] 253**, it has been described as "*In the context of passing off, it has been stated to represent, in connection with any business or business product, the value of the attraction to customer which the name and reputation possessed*". Be that as it may, at-least a party claiming or alleging passing off must satisfy

goodwill which must be so, which is really likely to be damaged by the alleged misrepresentation.

12. It may also be borne in mind that Trade Mark Law is not a branch of law in which reference to the cases as a precedent could be of any real assistance, except analogically, for the reason that in every Trade Mark Case before a Court, the factual aspect and history of that case is more weighty than the question of law involved therein. The conclusion arrived at while dealing with a certain provision of Trade Mark Law, may not become a binding precedent just because of the peculiar and distinguishable facts of that case. Therefore, while relying upon any such case law as a precedent the cardinal and pivotal step is to examine and compare the facts of each and every case, before agreeing or disagreeing with case law precedent. The House of Lords in the case of ***Reckitt & Colman Products Ltd V. Borden INC. and others*** [1990] 1 WLR 491, speaking through Lord Oliver of Aylmerton has laid down certain principles as well as guidelines by summarizing the law of passing off in one short general proposition—*no man may pass off his goods as those of another*. He has further observed that the plaintiff or the claimant has to establish three elements in order to succeed in a passing off action:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labeling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognized by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff.....Thirdly, he must demonstrate that he suffers orthat he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff”.

At pg 505 of the same report it has been observed as follows;

Then it is said—and again there is no disagreement as to this---that the mere fact that the produce of the appellants and that of the respondents may be confused by members of the public is not of itself sufficient. There is no “property” in the accepted sense of the word in a get-up. Confusion resulting from the lawful right of another trader to employ as indicative of the nature of his goods terms which are common to the trade give rise to confusion. It probably will do so where previously another trader was the only person in the market dealing in those goods, for public which knows only of A will be prone to assume that any similar goods emanate from A. But there can be no cause of action in passing off simply because there will have been no misrepresentation. So the application to the defendants’ goods of ordinary English terms such as “cellular clothing” (Cellular Clothing Co. Ltd. V. Maxton and Murray (1988) 16 R.P.C. 397) or, “Office Cleaning” (Office Cleaning Services Ltd V. Westminster Window and General Cleaners Ltd. (1064) 63 R.P.C. 39) or the use of descriptive expressions or slogans in general use such as “Chicago Pizza” (My Kinda Town Ltd. v. Soll (1983) R.P.C. 407) cannot entitle a plaintiff to relief simply because he has used the same or similar terms as descriptive of his own goods and has been the only person previously to employ that description.

At pg: 508 it has been further observed as;

(As Romer L.J. observed in Payton & C. Ltd. v. Snelling, Lampard & Co. Ltd. 17 R.P.C. 48, 56:

“when one person has used certain leading features, though common to the trade, if another person is going to put goods on the market, having the same leading features, he should take extra care by the distinguishing features he is going to put on his goods, to see the goods can be really distinguished...”

I stress the words “to see that the goods can be really distinguished,” for much has been made of the fact found by the judge and, indeed, readily observable by your Lordships that a careful shopper who read the labels attached respectively to the appellants and the respondents products would have no difficulty whatever in distinguishing them. Lord Alexander has submitted forcefully that the labels employed in connection with the Mark II and Mark III versions are so essentially different that, fairly regarded, they are sufficient to avoid any possibility of confusion, and your Lordship Halsbury L.C. in Schweppes Ltd. v. Gibbens (1905) 22 R.P.C. 601, a case involving virtually identical bottles of soda water bearing labels which, seen from a distance, bore a strong resemblance to one another. Lord Halsbury L.C. said, at pp. 606-607:

“The question that we have to determine is whether in selling the bottle a person is likely to be deceived by the resemblance of the one thing to the other; and if a person is so careless that he does one thing to the other; and if a person is so careless that he does not look, and does not, as I think Lord Macnaghten described it in another case, ‘treat the label fairly,’ but takes the bottle without sufficient consideration and without reading what is written very plainly indeed upon the face of the label on which the trader has placed his own name, then we certainly cannot say he is deceived---in fact he does not care which it is. That would be the true inference which I think a person would draw from conduct so described. The whole question in these cases is whether the thing ---taken in its

entirety, looking at the whole thing---is such that in the ordinary course of things a person with reasonable apprehension and with proper eyesight would be deceived. Looking at it in this way, it seems to me it is only necessary here to put the two things side by side to say that, if you do look and if you do treat the two labels fairly, no human being could be deceived.”

At pg: 509 of the same report it has been further observed as;

That was a case in which, when the plaintiff's and the defendants' marks were placed side by side, the differences were clearly apparent. Nevertheless both were traders exporting produce to Eastern markets, where customers were likely to be illiterate and Lord Blackburn quoted with approval the speech of Lord Kingstown in *Leather Cloth Co. Ltd. v. American Leather Cloth Co. Ltd.* (1865) 11 H.L.Cas. 523, 539, in the course of which he posed the question of “how far the defendants' as to be calculated to deceive incautious purchasers.” That, he said, was the question to be asked in that case. It is also the question to be asked in this case. It has, however, to be asked in every case against the background of the type of market in which the goods are sold, the manner in which they are sold, and the habits and characteristics of purchasers in that market. The law of passing off does not rest solely upon the deceit of those whom it is difficult to deceive.

In the same law report Lord Jauncey of Tullichettle has further elaborated the concept of a passing off action at pg: 510 in the following terms;

General law applicable to passing off action

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 pretense 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.

13. Here in the instant matter, the claim of the appellant rests on the use of the word “PARTY” which according to the appellant is synonym with its biscuits and by using it on the “ICE CREAM” being sold by the respondent, the respondent is being benefitted at the expense of the appellant. However, mere use of such word is not

enough in a passing off claim, as it is required to be established that in doing so, actual misrepresentation is being caused which is effectively deceiving the public at large. On a careful examination of the get up and the packing used in both the competing products, we do not see any reason that how a buyer of these two distinct products would get confused in buying the respondent's products as that of the appellant. As discussed earlier, both, the appellant as well as the respondent, have a distinct what can more appropriately termed as, a House Mark (***Peek Freans and Igloo***) so to say, and their products are generally being sold by recognizing these Trade Marks or *House Marks*, as their respective Marks and not by individual Trade Marks. The appellant has though annexed a dossier of documents with the plaint to show that it has generated huge sales of the product in question and has also incurred heavy expenditure on its advertisement and sales promotion, however, in this particular case, considering the Trade Mark itself (not being a coined word, rather a descriptive dictionary word), and the dissimilarity in the products (Biscuits as against Ice Cream), we do not recognize them to be a justification to establish, at this stage of the case, to grant any injunctive relief of passing off in their favor, as it requires further evidence in this regard. Mere use or even prior use in the peculiar facts and circumstances of this case would not suffice to claim such relief, which in any other case may be a reason to grant an injunctive relief of passing off. In our considered view there is no iota of confusion existing in favor of the appellant in the present situation as the products in question are materially different, whereas, the Mark in question is also not distinct and or unique, to grant any injunctive relief in favor of the appellant for a passing off action.

14. In view of hereinabove facts and circumstances of the instant case, we are of the view that the appellant has failed to make out a case for grant of any injunctive relief either for infringement or for passing off in its favor at this stage of the case; therefore, instant appeal being misconceived is hereby dismissed. However, it may be clarified that whatever has been observed in the above order is tentative in nature, and is based on the material available before us, as well as before the learned Single Judge, whereas, the Suit filed by the appellant shall be decided on the basis of evidence led by the parties and on the merits of the case without being influenced by the observations hereinabove. The impugned order is though upheld by dismissal of this appeal, however, for our own reasoning and discussion.

Appeal stands dismissed.

JUDGE

JUDGE

ARSHAD/