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Equivalent Citation: (2008)ILR 1Delhi1242, MIPR2007(3)497, 2008(36)PTC168(Del)**IN THE HIGH COURT OF DELHI**

C.S. (O.S.) No. 605/2007

Decided On: 23.10.2007

Appellants: **Cadila Healthcare Ltd.****Vs.**Respondent: **Gujarat Co-operative Milk Marketing Federation Ltd. and Ors.****Hon'ble Judges/Coram:**

G.S. Sistani, J.

Counsel:

For Appellant/Petitioner/plaintiff: Mihir Thakore, Sr. Adv., S.B. Chatrapatti and Prathiba M. Singh, Advs

For Respondents/Defendant: Mihir H. Joshi, Sr. Adv., Nandish Chudgar, Mahesh Agarwal and Sandeep Mittal, Advs. for Respondent Nos. 1 and 2 and Himanshu Bagai, Adv. for Respondent No. 3

Subject: Intellectual Property Rights**Acts/Rules/Orders:**

Code of Civil Procedure, 1908 (CPC) - Section 151, Code of Civil Procedure, 1908 (CPC) - Order 39 Rule 1, Code of Civil Procedure, 1908 (CPC) - Order 39 Rule 2, Code of Civil Procedure, 1908 (CPC) - Order 39 Rule 4; Designs Act, 1911; Gujarat Co-operative Societies Act, 1967 - Section 167

Cases Referred:

Erven Warnink B.V. v. J. Townend Y Sons (Hull) Ltd. [1979] A.C. 731; Spalding v. Gamage; Hindustan Radiators Co. v. Hindustan Radiators Ltd. AIR 1987 Delhi; Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories PTC (Suppl) (2) 680 (SC); Proctor and Gamble v. Office, Harmonisation (2002) RPC 17; Globe Super Parts v. Blue Super Flame AIR 1986 Del. 245; Reddaway v. Banham (13) 1896 RPC 218; Lakshmikant V. Patel v. Chetanbhat Shah and Anr. AIR 2002 SC 275; Mark Naukri.com Info Edge (India) Pvt. Ltd. v. Shailesh Gupta 2002 (24) PTC 355 (Delhi); Mark Masala Chili Societe Des Products Nestle S.A. v. Gopal Agencies 2002 (24) PTC 369 (Delhi); Mark Whole foods Ishi Khosla v. Anil Agarwal; Mark Aajtak Living Media India Ltd. v. J.V. Jain 2002 (25) PTC 61; Mark Absolut V and S Vin Spirit A.B. v. Kullu Valley Mineral Water Co. 2005 (30) PTC 47; Mark Alligator J.B. Stone and Co. Ltd. v. Steelace Manufacturing Ltd. (56) RPC 406; Mark Legal and General Legal and General Assurance Society Ltd. v. Denial and Ors. 1968 RPC 253; Pops Pickwick International Inc. (G.B.) Ltd. v. Multiple Sound Distributors Ltd. 1972 RPC 786; Mark Navratna Kaviraj Pandit v. Navratna Pharmaceuticals AIR 1965 SC 980 : PTC (Sup.) (680) (SC); Mark Ultra Indian Shaving Products Ltd. v. Gift Pack 1998 PTC 698 (Del.); Mark Double mint P Ohim v. WM Wrigley Jr. Co. [2004] R.P.C. 18; Mark Cellular Cellular Clothing Co. v. Maxton and Murray. Vol. 16 R.P.C. 397; Mark Oven Chips Mc Cain International v. Country Fair Foods 1981 RPC 16; Mark News Week Newsweek Inc. v. British Broadcasting Corporation [1979] RPC 441; Mark Mother Care/Other Care Mother Care U.K. Ltd. v. Penguin Books Ltd. [1988] R.P.C. 113; Marengo v. Daily Sketch [1992] F.S.R. 1, 2; Hodgkinson and Corby v. Wards [1994] 1 W.L.R. 1564; Parker-Knoll Limited v. Knoll International Limited [1962] R.P.C. 265 HL; Johnson and Johnson and Anr. v. Christine Hoden India (P) Ltd. 1988 PTC 39; Wander Ltd. and Anr. v. Antox India Pvt. Ltd. 1990 (Suppl.) SCC 727; In Re: Mark Sheen of an application by J and P Coats Ltd for registration of trade mark 1936 (53) RPC 355

Citing Reference:

Discussed		8
Mentioned		18

Case Note:

Intellectual Property Rights - Trade Marks - Infringement and Passing off - Usage of mark in descriptive sense - Suit for permanent injunction Along with interim relief - plaintiffs sought Defendants to be restrained from use of the expression "Sugar Free" in relation to products viz. frozen desserts and choc minis by claiming to have acquired exclusivity on the trade mark - Defendants challenged the suit on the ground that the expression used in descriptive sense describes attributes of the product - Whether plaintiff entitled to exclusive right over trade mark - Whether trade mark has acquired secondary meaning in consumer and trade parlance and has

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thereby assumed distinctiveness - Held, use of a descriptive expression as a trade mark by a trader, irrespective of the fact that the said trade mark has acquired a secondary meaning and distinctiveness, does not entitle such trader from precluding others from using the said expression for describing the characteristic features of their products - Confusion emanating from the conspicuous display of the expression "Sugar Free" on the packaging of the Defendant's product cannot be ignored - However blanket injunction on the use of a public Jurisdiction expression like "Sugar Free" would inequitably allow the plaintiff to monopolise the use of such expression leading to antithetical fair competition - Prima facie no imminent injury likely to be caused to the plaintiff if the Defendant allowed to use the expression - To balance equities, Defendant restrained from using the expression "Sugar Free" in the present manner which though prima facie does not appear deceptive, carries a certain tinge of appropriateness in it - Defendant, as clarified, free to use the expression "Sugar Free" in any other manner to describe special attributes of its product without leaving any scope for confusion - Application disposed of

Ratio Decidendi:

"Use of a descriptive expression as a trade mark by a trader, irrespective of the said trade mark having acquired a secondary meaning and distinctiveness in relation to the trader's products, does not entitle such trader from precluding other traders from using the said expression for the purposes of describing the characteristic features of their products."

JUDGMENT

G.S. Sistani, J.

I.A. No. 3847/2007

1. The plaintiff has filed the present suit, seeking, inter alia, a decree of permanent injunction for restraining the defendants from using in any manner, particularly in relation to their products, viz. frozen desserts and choc minis, the expression 'Sugar Free', which, the plaintiff claims has acquired exclusivity as a trade mark in relation to the various products manufactured by it. The said relief is being sought in order to prevent the defendants from passing off their products as those of the plaintiff as well as for rendition of accounts and damages.

2. Pending disposal of the present suit, the plaintiff filed an application being I.A. No. 3847/2007 under Order XXXIX, Rules 1 and 2 read with Section 151 of the Code of Civil Procedure, 1908 (hereinafter, "CPC") for seeking interim relief. This Court vide order dated 3.4.2007 granted an ex parte ad interim injunction against the defendants. Pursuant thereto, defendant Nos. 1 and 2 filed an appeal being F.A.O. (O.S.) No. 113/2007 for setting aside the ex parte order dated 3.4.2007. A Division Bench of this Court vide order dated 4.5.2007 directed that the appeal being F.A.O. (O.S.) No. 113/2007 shall be considered as an application under order XXXIX, Rule 4 of the CPC for vacation of the ex parte order dated 3.4.2007.

3. Accordingly, two applications have come up for disposal before this Court - one under order XXXIX, Rules 1 and 2 read with Section 151 of the CPC seeking temporary injunction, and the other under order XXXIX, Rule 4 of the CPC seeking vacation of the ex parte order dated 3.4.2007. I shall dispose of both these applications together as both of them are interlinked and the fate of one shall invariably decide the fate of the other.

4. First and foremost, it is essential to place on record a few incontrovertible facts which have led to the present applications and will provide us with a necessary prelude to effectively appreciate the substantive and technical aspects involved herein.

5. The plaintiff is engaged in the field of manufacturing and marketing of pharmaceuticals, medicinal preparations and health care products. The defendant No. 1 (hereinafter, the defendant), on the other hand, is engaged in the manufacturing, selling and marketing of various dairy products. The plaintiff and defendant have locked horns on the use of the expression 'Sugar Free' which apparently both parties are using in relation to their respective products. Whilst the plaintiff claims to be using the expression 'Sugar Free' as a trade mark in relation to its products, the defendant states to be using the said expression only in its descriptive sense to convey the special attributes of its product, namely, Pro Biotic Frozen Dessert.

6. The case, as set out by the plaintiff, is that the trade mark 'Sugar Free' was adopted in the year 1988 by the predecessor of the plaintiff company, namely, the Cadila Group, to launch a sugar substitute containing 'Aspartame', which is an artificial sweetener containing only 2% of the calories of sugar. Pursuant to the restructuring of the Cadila Group in the year 1995, part of its business along with its goodwill and the trade mark 'Sugar Free' were transferred to the plaintiff. The recent years have seen the plaintiff capitalising the trade mark 'Sugar Free' as an umbrella trade mark in relation to its various products, viz. 'Sugar Free Natura', 'Sugar Free Gold' and 'Sugar Free D'lite'. 'Sugar Free Natura', for instance, is a sugar substitute containing 'sucralose', which is a zero calorie artificial sweetener developed through a multi-step high technology manufacturing process.

7. The tablet dispensary container of 'Sugar Free' is stated to have obtained registration under the Designs

manupatra Act, 1911. It is further submitted by the plaintiff that it has already been successful in securing registration of the trade mark 'Sugar Free' in Russia and has also applied for registration in respect of the said trade mark in Myanmar. However, admittedly, none of the trade marks of the plaintiff, viz. 'Sugar Free', 'Sugar Free Natura', 'Sugar Free Gold' and 'Sugar Free D'lite' have yet obtained registration in India. Applications for registration of the said trade marks are stated to be pending disposal before the Registrar of Trade Marks. The necessary details regarding these applications, as provided in the plaint, are reproduced in the manner hereunder:

'Sugar Free' Class		
Trade Mark	Application No.	Date of Application
493060	1	11.6.1988
497629	1	12.9.1988
497630	1	12.9.1988
'Sugar Free Natura' Class		
Trade Mark	Application No.	Date of Application
1334439	5	25.1.2006
1457938	5	8.6.2006
1334438	30	25.1.2006
1457945	30	8.6.2006
'Sugar Free Gold' Class		
Trade Mark	Application No.	Date of Application
1369740	1	8.7.2005
1457940	1	8.6.2006
1369741	5	8.7.2005
1457939	5	8.6.2006
1369739	29	8.7.2005
1457941	29	8.6.2006
1369738	30	8.7.2005
1457943	30	8.6.2006
'Sugar Free D'lite' Class		
Trade Mark	Application No.	Date of Application
1175849	5	18.2.2003
1175850	29	18.2.2003
1175851	30	18.2.2003

8. Apart from making efforts towards securing registration of its trade marks, the plaintiff claims to have incurred huge expenses in promoting and popularising its products under the trade mark 'Sugar Free' both via electronic and print media. The plaintiff has placed on record certain statistics which reveal that till date there have been a total of 26,239 insertions on various television channels and a total of 1,136 insertions in newspapers, magazines, etc. for advertising and marketing the Sugar Free range of products.

9. It is claimed that the rigorous and innovative marketing of the Sugar Free range of products has made them extremely popular both in India as well as abroad. The products of the plaintiff are stated to be sold all over the country and exported to many foreign countries including the United Kingdom, Mauritius, Sri Lanka and South Africa. According to the plaintiff, the gross sales revenue of the plaintiff for the year ending 31.3.2006 were in excess of Rs. 1300 crore of which about Rs. 974 crore were from Domestic Sale of formulations, Rs. 116 crore from Export Sale of formulations, Rs. 154 crore from sale of Active Pharmaceutical Ingredients (API) in India and abroad and Rs. 65 crore from Consumer Business. It is further claimed that owing to the continuous and extensive sales, promotion and marketing of the Sugar Free range of products, the plaintiff has been successful in capturing 74% of the Indian market catering to artificial sweeteners/sugar substitutes.

10. The plaintiff claims that owing to their excellent quality and high degree of efficiency, the Sugar Free range of products enjoy immense goodwill and reputation amongst medical professionals, traders and the consuming public at large. It is further claimed that owing to the extensive marketing and promotion as well as long and continuous use of the plaintiff's products under the trade mark 'Sugar Free', the said trade mark has come to be exclusively and distinctively associated with that of the plaintiff.

11. The grievance of the plaintiff pertains to the manner in which the defendant has used the expression "Sugar Free" on the packaging of its product, namely, Pro Biotic Frozen Dessert. It is submitted that a visual perusal of the packaging on which the expressions "Amul-Sugar Free-Pro Biotic Frozen Dessert" are printed clearly gives an impression that the expression "Sugar Free" has been used on the packaging not in its descriptive sense but as part of the defendant's trade mark "Amul". It is further submitted that the unusually large font size adopted in the expression "Sugar Free" on the packaging of the defendant is likely to mislead potential consumers into believing that its product being Pro Biotic Frozen Dessert is related to the plaintiff's "Sugar Free" range of products or emanate from the same source as that of the plaintiff's products. It is thus the case of the plaintiff that the defendant, by deliberately using the expression 'Sugar Free' on the packaging of its product, has tried to pass off its product as that of the plaintiff. The plaintiff suspects that such attempt on the part of the defendant is rooted in dishonesty inasmuch as the defendant intends to rake in the goodwill and reputation associated with the plaintiff's products. To categorically establish its case, the plaintiff has submitted that the use of the expression 'Sugar Free' by the defendant, in particular, affects the plaintiff in the following ways:

i. It completely erodes the distinctiveness which is associated with the plaintiff's trade mark 'Sugar Free'.

ii. It also creates confusion that the plaintiff's product may be used in the manufacturing of the defendants' Pro Biotic Frozen Dessert.

iii. It also blocks future possibilities of the plaintiff's market expansion.

12. Before advertizing to the rival contentions of both parties put forth during the course of the proceedings herein, it would be an enriching exercise to throw light on the dynamics of the Law of Passing off, and in particular, the factors necessary for successfully instituting an action for passing off.

13. Imitation, they say, is regarded as the highest form of flattery. This popular adage, often used as a leitmotif in the world of art and culture where imitation is sometimes reckoned as inspiration, exists as a complete antithesis in realm of trade marks. The Doctrine of Passing Off absolutely despises any form of imitation, explicit or implicit, if calculated to deceive or cause confusion in relation to trade marks, which in strict business and marketing sense, are considered as repositories of the goodwill and reputation emanating from trade in goods and services.

14. According to eminent jurist Salmond, the gist of the conception of passing off is that the goods are in effect telling a falsehood about themselves, are saying some thing about themselves, which is calculated to mislead. The law on this matter is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices the benefit of the reputation already achieved by rival traders.

15. Lord Diplock in the celebrated case of Erven Warnink B.V. v. J. Townend Y Sons (Hull) Ltd. [1979] A.C. 731, famously known as the 'Avocaate's Case', has formulated five essential characteristics which must exist to sustain an action for passing off. Lord Diplock's formulation was as follows:

The essence of the tort of passing-off is a misrepresentation made by the defendant which is calculated to cause damage to the business or goodwill of the plaintiff:

My Lords, Spalding v. Gamage and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off : (1) a misrepresentation (2) made by a trader 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 foreseeable consequence) and (5) which causes actual damage to a business or goodwill of a trader by whom the action is brought (or in a quia timet action) will probably do so.

16. Closer home, this Court in Hindustan Radiators Co. v. Hindustan Radiators Ltd. reported at AIR 1987 Delhi, has laid down the following eight principles imperative for Constituting an action for passing-off:

i. that the plaintiff has been using its trading style and trade mark for quite a long period and continuously, whereas the defendant has entered into the said field only recently;

ii. that there has not been much delay in the filing of the suit for injunction by the plaintiff;

iii. that the goods of the plaintiff have acquired distinctiveness and are associated in the minds of the general public as goods of the plaintiff;

iv. that the nature of activity of the plaintiff and that of the defendant are the same or similar;

v. that the goods of the parties, with which the trade mark of the plaintiff is associated are the same or similar;

vi. that the user of the same trade mark or trade name by the defendant is likely to deceive and cause confusion in the public mind and injury to the business reputation of the plaintiff;

vii that the sphere of activity and the market of consumption of goods of the parties are the same;

viii. that the customers of the plaintiff inter alias include uneducated, illiterate and unwary customers who are capable of being deceived, confused or misled.

17. Any discussion on the Law of Passing off is incomplete without appreciating the distinction between an action for passing-off for infringement of trade marks. It is important to bear in mind that an action for infringement of trade marks is aimed at protecting the trade mark itself, whereas an action for passing-off is aimed at protecting the goodwill or reputation associated with the trade mark. This distinction has been very succinctly brought out in the case of Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories reported at (2) PTC (Suppl 680 (SC)), relevant portions whereof are reproduced thus:

27. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods. The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement.

No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Ex-pressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

18. Over the years, the Law of Passing off has gradually undergone a paradigm shift. Whilst the principles of the Law have not changed in principle, the judicial approach whilst adjudicating upon an action for passing off has gradually changed as the Courts have become more circumspective of those who complain of deception. This is primarily owing to the propensity of traders in adopting purely descriptive words as trade marks, which, in effect, has a direct bearing on other potential traders intending to use such descriptive words for highlighting the characteristic attributes of their products. Though there is no restraint on traders from using purely descriptive words as trade marks, any trader who adopts a trade mark of such nature is proscribed by the canon of fair competition to claim monopoly or exclusivity in respect of thereof. Even though an action for passing off, in essence, continues to protect the distinctiveness associated with trade marks, it has become a challenge for Courts of law to ensure that no passing off action results in creating monopoly rights in the use of trade marks which are inherently descriptive or public Jurisdiction in nature.

19. Coming to the present case, even as the plaintiff alleges that the defendant has tried to dilute the distinctiveness associated with its trade mark 'Sugar Free' in relation to its products, the defendant has questioned the exclusivity which the plaintiff is trying to claim in respect of its trade mark 'Sugar Free', which according to the defendant is a descriptive expression. The case of the defendant, as set out by Mr. Mihir H. Joshi, learned senior Counsel for the defendant, is outlined as under:

(1) That the expression 'Sugar Free', being a usual juxtaposition of two commonly known English words, cannot be considered to have been coined by the plaintiff and thus the plaintiff cannot claim any exclusive propriety right in respect thereof.

(2) That the expression 'Sugar Free' is essentially a descriptive expression used in relation to a particular category/class of foods viz., confectionery, biscuits, sweet meats, etc., which do not contain any sugar.

(3) That the expression 'Sugar Free', when used as a trade mark in relation to plaintiff's product which is a sugar substitute, describes in the usual and familiar manner the essential characteristic, quality and intended purpose of such product and thus cannot be considered as merely suggestive of its essential characteristic, quality and intended purpose.

(4) That the expression 'Sugar Free', being wholly descriptive of the characteristic quality and intended purpose and of the category/class of foods for which the same is used, is incapable of acquiring a secondary meaning in relation to the plaintiff's product different from its primary or natural meaning.

(5) That the expression 'Sugar Free', owing to its inability to acquire a secondary meaning in relation to the plaintiff's product, is incapable of acquiring distinctiveness in respect thereof irrespective of the extent of its use or the expenditure incurred by the plaintiff in adopting and popularizing the said expression as its trademark in relation to its product.

(6) That the use of the expression 'Sugar Free' by the defendant, not as a trademark but purely in descriptive sense, is sans any element of deception or malice and thus cannot be construed as a deliberate attempt on the part of the defendant to mis represent or pass off its goods as that of the plaintiff.

(7) That the expression 'Sugar Free', owing to its continuous and wide spread application in different context and situation in day to day life, the plaintiff, cannot be allowed, to monopolize or restrict the use of the expression 'Sugar Free' only in relation to its product thereby precluding the public at large from exercising their bona fide and valuable public right of using common descriptive English word.

(8) That the name of the defendant's product being Amul Sugar Free Pro Biotic Frozen Dessert' does not in any manner suggest that the said product is connected with the plaintiff or its product.

(9) That the placement of the defendant's trademarks' Amul before the Sugar Free Pro Biotic Frozen Dessert, clearly and explicitly indicates the origin of the product and that is absolutely no likelihood of deception or passing off the goods of the defendant as that of the plaintiff.

(10) That even if there is any confusion about the connection or ingredients as contended by the plaintiff, such confusion is a fall out of the plaintiff adopting a dangerous course of choosing a descriptive word for its product.

(11) That there is no common field of activity between the plaintiff and the defendant, in that the former's product are in the nature of sweeteners/Sugar substitute, whereas, the latter product is a 'ready to eat' eatable.

(12) That the use by the defendant of the expression 'Sugar Free' in its ordinary and primary descriptive sense does not result in dilution of the plaintiff's business or goodwill.

(13) That except for bald assertions, the plaintiff has not prima facie established likelihood of damage on account of the facets of passing off.

(14) The plaintiff has not issued any notice to the defendant prior to the suit nor taken any action for protection of its purported rights in the expression 'Sugar Free' against any other person despite its widespread use and thus the present suit is barred due to warranty of statutory notice under Section 167 of the Gujarat Co-operative Societies Act, 1967.

20. It is vehemently contended by learned senior Counsel for the defendant that the expression 'Sugar Free', being per se descriptive in nature, the plaintiff cannot claim exclusive propriety right in respect thereof.

21. Before delving at length on the contours of descriptiveness in relation to trade marks, it would be worthwhile to throw light on the following extracts from Christopher Wadlow's treatise 'The Law of Passing-Off':

(1) A mark which is prima facie descriptive will only be protected if it can be shown to have acquired secondary meaning that is to say, if it has become distinctive of the plaintiff. Of course, distinctiveness is an essential precondition for all marks, whether descriptive or "fancy", but the burden of proof is significantly higher for prima facie descriptive terms. So much so, that the decision to categorise a term as "descriptive" or "fancy" is often treated as virtually determinative of the whole action. It is arguable that the law is sometimes too ready to attribute distinctiveness to fancy terms on the strength of very slight user, and too slow to protest those which are descriptive in origin.

(2) As an entirely separate matter, a term may be descriptive in the sense that it is the name of the goods themselves. In other words, it is generic, although that word is not often used in the decided cases. Generic names are often also prima facie descriptive, but this is no more than a coincidence arising from the tendency of traders in many fields of business to favor descriptive or suggestive terms. If a term is the name of the goods as such, it cannot simultaneously denote any particular trade source. It may Therefore be used in respect of goods of that sort by any competing trader without there being passing-off.

(3) The defendant likewise cannot be prevented from using a descriptive term in its original descriptive sense, unless it has wholly lost that descriptive sense and become distinctive of the plaintiff in every context. More usually, some vestige of descriptive meaning remains even after the term has acquired enough secondary meaning to be protected as the plaintiff's trade mark. Equivocal or ambiguous use will be restrained and often indicates lack of good faith, but if the defendant's use of the term is clearly and accurately in a descriptive rather than a trade mark sense then there is no misrepresentation to restrain. Passing-off gives no monopoly rights to words or marks of any sort, and this is all the more important when the term is in common use outside its capacity as the plaintiff's trade mark.

(4) Even if the plaintiff succeeds in proving that a prima facie descriptive term has acquired some degree of secondary meaning, he will find that the scope of protection for his mark is narrower than for a wholly arbitrary term. There is a rule of law that relatively minor differences will suffice to distinguish the defendant's goods or services they provide. This applies even though the

defendant is using the closely similar term in a trade mark sense. Office Cleaning Association was sufficiently different to Office Clearing Services even though it was the trading name of the defendant. The plaintiff was free to choose a name of higher inherent distinctiveness, and the penalty for his failing to do so was that a degree of confusion would be tolerated as the only alternative to giving him an unfair monopoly.

22. Mr. Mihir Thakore, learned senior Counsel for the plaintiff has strenuously argued that the expression 'Sugar Free', being an ungrammatical combination of two English words, is a coined word. It is further contended that inasmuch as the plaintiff's product is a sweetener/sugar substitute, it cannot be described as sugar free. It is further submitted that anything which is used as a substitute to sugar in food and beverages cannot be termed free of sugar and only the food or beverage so made could be described as free of sugar.

23. To substantiate his contention, learned senior Counsel has relied upon the case of Proctor and Gamble v. Office For Harmonisation in the Internal Market (OHIM), famously known as "the Baby Dry case", reported at (2002) RPC 17. In the said case, the Court came to categorical finding that the expression 'Baby Dry', being an unusual juxtaposition of two independent English words, could not be described as being wholly descriptive in character. Relevant portions of the said judgment are reproduced as under:

45. As it is, the combination, whilst it does unquestionably allude to the function which the goods are supposed to fulfill, still does not satisfy the disqualifying criteria set forth in paragraphs 39 to 42 of this judgment. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.

46. Word combinations like 'BABY-DRY cannot Therefore be regarded as exhibiting, as a whole descriptive character; they are lexical inventions bestowing distinctive power on the mark so formed and may not be refused registration under Article 7(1)(c) of Regulation No. 40/94.

24. Prima facie, it is difficult for me to accept the plaintiff's claim of the expression "Sugar Free" being a coined word. "Sugar Free" cannot, in the least, be a coined word and neither does "Sugar Free" appear to me an unusual combination or juxtaposition of words. The receptive and pragmatic nature of English Language has always liberally allowed such syntactic usage of words and this is evident from the fact that the most trusted household dictionaries like the Oxford's Dictionary, the Longman's Dictionary, etc. recognize words with "free" as a suffix viz. lead free, stress free, hassle free, etc., to imply "without". In Parts of Speech, such expressions are known as "collocations" or "compounds" and often used in relation to nouns, adjectives and adverbs. "Sugar Free", for instance, is a compound adjective as it aptly describes the nature and characteristics of the noun, in this case being food and beverages, in relation to which it is used. It is thus difficult for this Court to believe the plaintiff's contention of the expression "Sugar Free" being a coined expression, when, ordinarily such expressions are commonly used both in written as well as spoken English.

25. Mr. Mihir Thakore has thus strenuously argued that the plaintiff's product being a sweetener/sugar substitute cannot technically be described as free of sugar, and thus, the expression "sugar free" is not descriptive of its product. This assertion of the learned senior Counsel also does not convince me. Ordinarily, when we describe a product, we seldom confine our description to its strict and literal meaning. Description of a product is often general, if not pedantic, an exercise that gives liberty to move beyond the literal and strict meaning of the product and take into account the other characteristics, quality and utility of the product. The thin and subtle distinction between "descriptive in meaning" and "descriptive in understanding" needs to be appreciated here. What a particular thing means and what it is generally understood to be are two different aspects altogether. The distinction between "descriptive in meaning" and "descriptive in understanding" emanates from the distinction between "meaning" and "connotation" in that a product may be ascribed a particular meaning but at the same time it may have varied connotations.

26. The distinction between "meaning" and "connotation", as proposed in the foregoing paragraph, is particularly relevant to present case. In the present case, the plaintiff's product is a sweetener/sugar substitute, and sweeteners are generally understood in their functional sense, that is, in terms of their utility when added to foods and beverages. I am doubtful if a sweetener really has an independent identity of its own inasmuch as its real worth, attributes and use surfaces only when it is added in food preparations as a substitute to sugar. To an average consumer, a sweetener is always understood in relation to the food products to which it is added in order to lessen the calories therein.

Inasmuch as a sweetener is known to exist only when added to foods and beverages, its identity in terms of its functional utility is quite "dissolved" or metamorphosed in the foods and beverages to which it is added. Thus, the expression "Sugar Free", when used in relation to a sweetener/sugar substitute, may not really describe a sweetener in the sense of its generic meaning, nevertheless, it connotes the specific nature and characteristic of the foods and beverages to which it is added. Thus, the expression "sugar free", when used in relation to a sweetener/sugar substitute, may not be "descriptive in meaning" but it is certainly "descriptive in understanding".

27. The reliance of learned Counsel for the plaintiff on the 'Baby Dry' case does not really help him in view of

manupatra the fact that unlike the expression 'Baby Dry', the expression 'Sugar Free' cannot still be considered as a coined word owing to its widespread usage and relevance in trade especially in relation to food and beverages.

28. Relying upon McCarthy on trade mark, learned senior Counsel for the plaintiff has vehemently contended that the plaintiff's trade mark 'Sugar Free' is not descriptive but at the most suggestive of the functional utility of the plaintiff's product. The underlying thrust in the learned Counsel's argument is that trade marks which are not descriptive but only suggestive of themselves are equally entitled to protection against passing-off.

29. It is further contended by Mr. Thakore that even if it is assumed that the word 'Sugar Free' is descriptive, it is nevertheless has acquired and has acquired a secondary meaning by virtue of continuous and extensive use and thus the consuming public at large identify the mark 'Sugar Free' only in relation to plaintiff's sugar substitute.

30. In support of the contention that a coined word, even if it has dictionary meaning, it has the potential of acquiring a secondary meaning and thereby become distinctive in relation to the product, Mr. Thakore has placed reliance on the following judgments:

I. In *Globe Super Parts v. Blue Super Flame* MANU/DE/0606/1985 : AIR 1986 Delhi 245, in which two words super and flame which are dictionary words were joined together were declared as coined words and protection was granted.

II. *Reddaway v. Banham* 1896 (13) RPC 218 here the trade mark was the Camel Hair used in relation to belts prepared from the Camel hairs. Though both the words have the dictionary meaning, still it was held that when the words which are descriptive of an article have come to denote the goods of a particular manufacturer, he is entitled to restrain others from using them as to deceive purchasers.

III. *Lakshmikant V. Patel v. Chetanbhat Shah and Anr.* MANU/SC/0763/2001 : AIR2002SC275 , the trade mark of the plaintiff was Mukta Jeevan Colour Lab whereas the defendant adopted the mark QSS Mukta Jeevan. Apart from the plea that it has dictionary meaning, the other plea taken was that QSS is an abbreviation and accordingly an adjective pre-fixed to the name. Though the defendant was carrying on business in the name of QSS Mukta Jeevan Studio but at the time of filing of the suit he was having the business in the name and style of Mukta Jeevan Colour Lab which was identical with the business of the plaintiff. The plea of the counsel for the plaintiff that QSS is an abbreviation and was merely an adjective pre-fixed to the name was accepted and it was held that it is the word Mukta Jeevan which makes distinctive the business name of the plaintiff and it is the continuous use of the plaintiff which has created a property therein linked with the plaintiff. The defendant was accordingly enjoined from using the said trade name in pursuance to the action for passing off.

31. On the same point, leaned senior Counsel has also relied on the following cases:

Mark Naukri.com Info Edge (India) Pvt. Ltd. v. Shailesh Gupta 2002 (24) PTC 355 (Delhi)

Mark Masala Chili Societe Des Products Nestle S.A. v. Gopal Agencies 2002 (24) PTC 369 (Delhi)

Mark Whole foods Ishi Khosla v. Anil Agarwal unreported decision of Delhi High Court, Hon'ble Justice Sikri dated 25.01.2007

Mark Aajtak Living Media India Ltd. v. J.V. Jain 2002 (25) PTC 61

Mark Absolut V and S Vin Spirit A.B. v. Kullu Valley Mineral Water Co. 2005 (30) PTC 47

Mark Alligator J.B. Stone and Co. Ltd. v. Steelace Manufacturing Ltd. (56) RPC 406.

Mark Legal and General Legal and General Assurance Society Ltd. v. Denial and Ors. 1968 RPC 253.

Mark Sheen In the matter of an application by J and P Coats Ltd for registration of trade mark 1936 (53) RPC 355.

Mark Top of the Pops Pickwick International Inc. (G.B.) Ltd. v. Multiple Sound Distributors Ltd. 1972 RPC 786.

Mark Navaratna Kaviraj Pandit v. Navratna Pharmaceuticals MANU/SC/0197/1964 : [1965]1SCR737 .

Mark Ultra Indian Shaving Products Ltd. v. Gift Pack 1998 PTC 698 (Delhi).

manupatra 32. It is, thus, the case of the plaintiff that even if the expression 'sugar free' is understood to be descriptive in relation to the plaintiff's products, nevertheless, owing to the widespread popularity and long and continuous usage of the sugar Free range of products amongst consumers, the expression 'Sugar Free' has acquired a secondary meaning and has consequently become distinctive of the plaintiff's products.

33. Per contra, Mr. Joshi, on behalf of the defendant has fervidly argued that the expression 'sugar free', owing to its widespread usage in day-to-day life as well as in trade as a public Jurisdiction, is unlikely to ever loose or forgo its primary meaning. It is contended that the expression 'sugar free' , being per se incapable of ever acquiring a secondary meaning, is unlikely to assume distinctiveness amongst traders and consumers. To buttress his argument, learned senior Counsel has relied upon the following judgments:

Mark Profit maker' Profit maker Trade Mark [1994] R.P.C. 613

Mark Double mint P Ohim v. WM Wrigley Jr. Co. [2004] R.P.C. 18

Mark Cellular Cellular Clothing Co. v. Maxton and Murray. 16 R.P.C. 397

Mark Oven Chips Mc Cain International v. Country Fair Foods 1981 RPC 16.

Mark News Week Newsweek Inc. v. British Broadcasting Corporation [1979] RPC 441.

Mark Mother Care/Other Care Mother Care U.K. Ltd. v. Penguin Books Ltd. [1988] R.P.C. 113.

34. The main thrust in Mr. Joshi's argument is that the expression 'sugar free', owing to its widespread usage in its primary sense, is unlikely to acquire a secondary meaning and thereby assume distinctiveness. It appears to me that the learned senior Counsel is trying to make a point that distinctiveness, in relation to trade marks and trade names, manifests only when the primary meaning, usage or signification of an expression is eclipsed or displaced by its secondary meaning. This contention of the learned senior Counsel is not acceptable to me. It is to be understood that the secondary meaning of a word or expression may have the potential to provide distinctiveness to such word or expression, but the existence of such secondary meaning does not ipso facto denude the word or expression of its primary meaning. There is all possibility or likelihood, and in fact it is usually the case, that words which in the course of time acquire secondary meanings as trade marks are also used and understood in linguistics in their primary sense. For instance, words like 'Catterpillar', 'Panther', etc. are famously known for their dual meanings, that is, both in their primary sense as generic words of animals as well as in their secondary sense as well known trade marks. Thus, simply because the usage of the expression 'sugar free' is more widespread in its primary sense does not lead to the conclusion that the expression 'sugar free' is unlikely to ever acquire a secondary meaning.

35. The question that now arises for consideration is whether or not the trade mark 'Sugar Free', as a matter of fact, has acquired a secondary meaning in consumer and trade parlance and thereby assumed distinctiveness in relation to the plaintiff's products.

36. Whilst ascertaining whether the expression 'Sugar Free' has acquired a secondary meaning and thus assumed distinctiveness as a trade mark of the plaintiff, an important aspect that has caught my attention is the specialised nature of the plaintiff's products. Being essentially sweeteners/sugar substitutes, having esoteric or specialised utility, the popularity of the 'Sugar Free' range of products will have to be necessarily measured within a specific or limited class of consumers. Consumers who will be inclined towards purchasing the 'sugar free' range of products will perforce be only those who are aware and informed about the characteristic utility of such products as zero calorie sugar substitutes. Such persons may include medical professionals viz. doctors, dieticians, etc., or persons suffering from diabetes, high cholestrol, etc., or simply those who are fashionably health conscious.

37. The factum of the specialized nature of the plaintiff's products vis-a-vis their limited consumer range, in fact, underscores the proposition that the distinctiveness associated with a trade mark is essentially relative in nature. That is to say, there may be a possibility where a particular mark comes to be distinctively associated as the trademark of a product only amongst a specific class of consumers, whilst the larger section of the consuming class may still continue to identify such mark in its primary or generic sense. Further, the distinctiveness associated with a trade mark being essentially relative in nature ex hypothesi gives rise to an important proposition that the distinctiveness of a trade mark can only be ascertained in relation to its consumer base. Thus, while ascertaining the distinctiveness of a trademark in relation to a product, it is paramount to first identify the range or circumference of the consuming class of such product, and measure the distinctiveness of the trademark only within such range or circumference.

38. Having identified the limited consumer base of the plaintiff's products, we shall now ascertain whether it is trade mark 'Sugar Free' has acquired a secondary meaning or distinctiveness in relation to its products within such limited consumer base. The usual approach followed by Courts of law, whilst ascertaining whether a particular trade mark has acquired a secondary meaning in relation to the product for which it is used, is to evaluate the trade mark on the anvil of various factors, viz. the extent of its use qua the product, the expenditure incurred by the plaintiff in marketing and promoting its product under the said trade mark, the profits and sales revenue revenue etc. These are valid parameters that objectively reflect the popularity,

manupatra usage, consumer recognition and market strength of a trademark and thus help in ascertaining whether the trade mark has acquired a secondary meaning or not.

39. In order to prima facie establish that the trade mark 'sugar free' has acquired a secondary meaning in relation to the plaintiff's products, learned senior Counsel for the plaintiff has placed on record sample invoices raised by the plaintiff since the year 1988 pertaining to the sale of its products under the trade mark 'sugar free'.

40. To further corroborate the popularity of its trade mark, the plaintiff has brought on record a copy of the Report of A.C. Neilson India, an independent research-based company whose Retail Audit Reports and other Market Research Services are famously endorsed in the pharmaceutical sector. As per the said Report, the plaintiff has topped in value sales for the period ending December 2006 and has acquired 74% of the market share in India catering to sugar substitutes.

41. The plaintiff has also placed on record certificates issued by Chartered Accountants certifying domestic and export sales for products sold under the trade mark 'sugar free' and the promotional expenses with respect thereto. For instance, as per the certificate dated 14.3.2007 issued by one M/s. R. Patel and Co., the Export Sales value of Sugar Free and Sugar Free range of products (Tablet/Powdeer/Granules) for the years 1999-00 to 2006-07 (up to 31.12.2006) are as under:

Year	Sales Value (Rs.)
1999-00	16,70,984
2000-01	41,79,663
2001-02	27,51,104
2002-03	25,25,146
2003-04	30,62,667
2004-05	34,06,094
2005-06	76,51,270
2006-07	1,42,33,653

42. A cursory perusal of the aforesaid statistical data placed on record by the plaintiff prima facie establishes the popularity of the Sugar Free range of products amongst traders and consumers thereby giving this Court a good reason to assume that the trade mark 'sugar free' has acquired a considerable degree of distinctiveness amongst traders and consumers. However, it is to be borne in mind that the acquisition of a secondary meaning by a trade mark or the distinctiveness associated with it are not ipso facto conclusive of an action for passing off. In order to successfully establish a case of passing off, it must be per force established before the Court that the defendant has, in fact, misrepresented his products as that of the plaintiff and thus caused damage to the distinctiveness associated with the trade mark used in relation to such products.

43. The various grounds establishing dishonest use of the plaintiff's trade mark 'Sugar Free' by the defendant, as set out by the plaintiff in its written submissions, are reproduced as under:

Adoption and used by the defendant of the words 'sugar free' on their packing is dishonest for the following reasons:

(1) The defendant knew that it is plaintiff's trade mark for sugar substitutes such as Aspartame and Sucralose.

(2) The defendant knew that plaintiff is marketing a drink under the trade mark 'Sugar Free Dlite' containing sugar substitute and is already in the Food and Beverage market.

(3) The manner of writing on the packaging clearly indicates use as trade mark and not merely to describe the characteristics of the product.

(4) If it was only to describe the product characteristics, it could have been used in any other manner. In fact the packet of Frozen Dessert already contains the following words NDIA'S FIRST SPECIALLY CREAED LOW FAT DIABETIC DELIGHT which is sufficient to describe the product and there was absolutely no need to use the word 'sugar free'.

(5) The Gujarati advertisement translates all other words including the word "INDIA'S FIRST SPECIALLY CREATED LOW FAT DIABETIC DELIGHT", but 'sugar free' continues to be stated as such in Gujarati clearly indicating use of these words as trade mark or in trade mark sense.

(6) The hoardings show use of 'sugar free' also in slogan'Sugar Free Guilt Free Worry Free' in addition to Sugar Free in large lettering clearly indicating use in trade mark sense and not in descriptive sense.

(7) There are innumerable ways to describe a Frozen Dessert/ice-cream which does not contain sugar. Illustrations, Therefore, have been filed in this Hon'ble Court. The object of using the plaintiff's trade mark and claiming such use as describing the product in the circumstances is clearly dishonest.

(8) If the only manner in which the defendant's product could be described is Sugar Free, it could be understood that the defendant has used Sugar Free to describe the product, but when product can be described in innumerable other ways such as 'Sugar Less', "no sugar", etc., use of distinctive trade mark of the plaintiff is dishonest.

(9) It was the duty of the defendant who was entering the market later not to anyway imitate the plaintiff's mark.

(10) It would be pertinent to highlight that the defendant had negotiated to purchase plaintiff's Sugar Free for the purpose of manufacturing and marketing diabetic ice-cream. In view of this, it became a bounden duty of the defendant not to use the plaintiff's trade mark while marketing its product, when it has not purchased the product of the plaintiff for use in marking such product, when it has not purchased the product of the plaintiff for use in making such product. Using the plaintiff's Trade Mark clearly amounts to taking advantage of the plaintiff's reputation and giving at least an impression to some members of the public that there is connection between the defendant's product and the plaintiff.

44. Per contra, learned Counsel for the defendants have vehemently denied any dishonest use of the expression 'Sugar Free' on the packaging of its product Pro Biotic Frozen Dessert by setting up the following defense:

(i) That 'Sugar Free', being a descriptive and laudatory expression, continues to be widely used in relation to foods and beverages. To bring out the descriptive nature of the plaintiff's trade mark which thus makes it extremely popular in usage, the defendants have placed on record sample packaging of various products wherein the expression 'Sugar Free' has been used by parties not in its trade mark sense but in a purely descriptive sense. For instance, the names of some of these products where the expression 'Sugar Free' has been used in its descriptive sense include 'Bagrry's Sugar Free Munchy Masala, Jell O - Sugar Free Gelatin Dessert Hershey's - Sugar Free-Dessert ,Handy Snacks-Sugar Free-Pudding, Joseph's -Sugar Free-Cookies, etc.

(ii) That the present manner of packaging of the defendant's is the usual manner in which the defendant has been packaging its goods. The defendants have placed on record samples of their products, viz. "Amul-Taaza-Homogenized Toned Milk" and "Amul-Shakti-Health Food Drink" to bring out the consistent manner in which they have been pre-imminently highlighting the characteristic attributes of their products.

(iii) That the defendant itself is a leading 'brand name' and enjoys tremendous good will amongst traders and consumers and is thus does not need to encash upon the good will of the plaintiff.

45. It is trite that the aforesaid rival contentions of both parties on whether the defendant has dishonestly used the expression 'Sugar Free' on the packaging of its product can be addressed more effectively once evidence is led. However, as of now, I am inclined to believe that the defendant's use of the said expression cannot be intended to deceive potential consumers into believing that the goods of the defendants are that of the plaintiff. It is the defendant's own good will and typical style of packaging its goods in the said manner coupled with the well-aware customer base that will be in a position to distinguish between the plaintiff's products with that of the defendant that has prompted me to hold that the possibility deception on the part of the defendant, at least at this stage, is completely ruled out.

46. The question whether the use by the defendant of the expression 'Sugar Free' is premised on deception or confusion can be more effectively addressed by a prima facie visual perusal of the impugned packaging of the defendant's product "Amul-Sugar Free-Pro Biotic Frozen Dessert". For felicity of reference, samples of the packaging of both the plaintiff's as well as the defendant's products bearing the expression 'sugar free' is reproduced thus:

Sample 'A'

Sample 'B'

47. A prima facie visual perusal of the defendant's sample demonstrates that the defendant has used 'Amul' as a trade mark before the expression 'sugar free'.

Even though, I see no perceptible similarity between the two different packaging in terms of colour scheme and get-up, what has really caught my attention is the manner in which the expression 'Sugar Free' has been

manupatra displayed on the packaging of the defendant's product. It is difficult to ignore that 'Amul', despite being the trade mark of the defendant, is written in comparatively much smaller font than the words 'sugar free' which are more conspicuous by their larger fonts. The expression 'Pro biotic Frozen Dessert' again has been written in a comparatively small size. The entire get up in the defendant's packaging is such that the focus is on the words 'sugar free' so much so that the defendant's trade mark 'Amul' is completely overshadowed.

48. What is important to be examined is how an average consumer, in this case being a consumer who is either a regular purchaser of the plaintiff's product or is well-informed about its functional utility, will perceive the defendant's product. The chances of deceiving such consumer are minimal inasmuch as he is well informed about the product he is intending to purchase and can ably distinguish between the plaintiff's product and the defendant's product. However, the possibility of confusion in the present case cannot be ruled out. It is important to note that the defendant's product contains Sucralose (see, sample B), which happens to be the chief ingredient of the plaintiff's product. There may be a possibility, though less likely, that such consumer may be misled into believing that the plaintiff's product being in the nature of an 'add on' has been used as an ingredient in the preparation of the defendant's Pro Biotic Frozen Dessert and, thus, may be gravitated to purchase the defendant's product.

49. The defendant has not satisfactorily explained this Court the reason behind the overwhelming impact of the expression 'Sugar Free' on the packaging of its product Pro Biotic Frozen Dessert. Moreover, if the defendant's plea that it has used the expression 'Sugar Free' only in a descriptive sense is to be believed, then there is no justification by the defendant as to why it has chosen to focus only on the expression 'Sugar Free' when the expression 'Pro biotic' can equally be used as a descriptive epithet in relation to its frozen dessert.

50. Mr. Joshi, learned Counsel for the defendant has vehemently argued that even if there is some scope for confusion in the pre-eminent display of the expression 'Sugar Free' on the packaging of the defendant's product, such confusion alone is not sufficient to constitute an action for passing off. To buttress his point, learned Counsel has quoted the following extracts from Kerly's Law of Trade Marks and Trade Names:

(1) Then it is said and again there is no disagreement 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. per Lord Oliver in Jif [1990] R.P.C. 341.

(2) 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 need to sale is not sufficient. Thus, if a customer asks for a tin o 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. per Lord Jauncey in Jif [1990] R.P.C. 341.

(3) No one is entitled to be protected against confusion as such. Confusion may result from the collision of two independent rights or liberties and where that is the case neither can complain; they must put up with the results of the confusion as one of the misfortunes which occur in life. The protection to which a man is entitled is protection against passing off, which is quite different thing from mere confusion. See Marengo v. Daily Sketch [1992] F.S.R. 1, CA per Lord Greene M.R.

(4) At the heart of passing off lies deception or its likelihood Never has the tort shown even a slight tendency to stray beyond cases of deception. Hodgkinson and Corby v. Wards [1994] 1 W.L.R. 1564, Jacob J. at 1570).

(5) Secondly, to deceive is one thing. To cause confusion is quite another.

The difference is this: when you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but you still do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguishing it from other pieces of truth known to him or because he may not even take the trouble to do so. Parker-Knoll Limited v. Knoll International Limited [1962] R.P.C. 265, Lord Denning at 274, lines 1-10.

51. It is noteworthy that throughout the course of the proceedings before this Court, the main plank of the plaintiff's contentions has been that the right to use a descriptive word even when it has acquired a secondary meaning would be permissible if and only if that is the only manner in which the product can be described and in no other. To make good its point, the plaintiff has proposed various similar permutations and combinations, viz. 'No Sugar', 'Without Sugar', 'Free of Sugar', etc., using which the defendant can convey the special attributes of its product Pro Biotic Frozen Dessert. This contention of the plaintiff per se does not impress me. Simply because a number of alternatives are available to defendant to describe its product Pro Biotic

manupatra Frozen Dessert does not imply that the plaintiff be allowed to itself the monopoly to use the expression 'Sugar Free', especially when the said expression being inherently descriptive in nature has become public Jurisdiction in relation to foods and beverages.

52. It is noteworthy that it is not for the first time that this Court, whilst adjudicating upon such matters, has been confronted with a purely descriptive trade mark seeking protection against passing off. I recall the stand taken by a Division Bench of this Court in Johnson and Johnson and Anr. v. Christine Hoden India (P) Ltd. reported at 1988 PTC 39. In this case, both the plaintiffs and defendants were manufacturers of sanitary napkins. Whilst the plaintiffs were using the expression 'Stay Free' as a trade mark in relation to their products, the defendants, on the other hand, were admittedly using the said expression merely to describe the characteristic nature of their product. The question that came up before this Court was whether the use of the expression 'Stay Free', in a purely descriptive sense, amounted to passing off. On a visual perusal of both products, that Court took a prima facie view that the defendant was entitled to use the expression 'Stay Free' insofar as it was using the same to describe its products in the descriptive sense but not in a trade mark sense.

53. Coming back to the present case, the plaintiff herein has sought for an absolute embargo on the defendant from using the expression 'Sugar Free' on the packaging of its product Pro Biotic Frozen Dessert purporting that such use is likely to confuse potential consumers in mistaking the defendant's product from being in some manner connected to its Sugar Free range of products. However, notwithstanding the confusion which the defendant's packaging is likely to create amongst potential consumers of the plaintiff, there are certain seminal questions that have been weighing heavily on my mind right from the beginning. Owing to the descriptive nature of the plaintiff's trade mark 'sugar free' which makes the expression extremely popular and much used especially in relation to foods products, can the defendant be absolutely restrained from using the expression 'sugar free' in relation to its products? To what extent will it be equitable to allow a blanket injunction on the defendant from using the expression 'sugar free', especially when the defendant pleads to use such expression only as descriptive epithet and not as a trade mark? Will not imposing a positive embargo on the use of the expression 'sugar free' by the defendant collaterally have the effect of allowing the plaintiff to monopolise the use of the said expression?

54. It is important to be borne in mind that use of a descriptive expression as a trade mark by a trader, irrespective of the said trade mark having acquired a secondary meaning and distinctiveness in relation to the trader's products, does not entitle such trader from precluding other traders from using the said expression for the purposes of describing the characteristic features of their products. I have no hesitation in stating, albeit without prejudice to the rights and interests of the plaintiff in the present suit, that by adopting such a purely descriptive and laudatory expression 'Sugar Free' as its trade mark, the plaintiff must be prepared to tolerate some degree of confusion which is inevitable owing to the wide spread use of such trade mark by fellow competitors. Simply because the plaintiff claims to be using the expression 'Sugar Free' as a trade mark much prior to the launch of the defendant's product Pro Biotic Frozen Dessert in the market does not give this Court a good ground for imposing a blanket injunction on the defendant from using the expression 'Sugar Free', especially when the defendant intends to use this expression only in its descriptive sense and not as a trade mark, and even otherwise, when the use of this expression is widespread in relation to foods and beverages.

55. To sum up, even though the petitioner has prima facie been successful in establishing the distinctiveness of its trade mark 'sugar free' in relation to its products, it has not been able to satisfy this Court why an embargo should be placed on the defendant from absolutely using the expression 'Sugar Free', especially when the defendant has prima facie satisfied this Court of its bona fide intention to use the said expression not as a trade mark but only in its descriptive or laudatory sense. However, even as any possibility of the defendant trying to dishonestly pass off its products as those of the plaintiff stands ruled out, I have a predilection that the overwhelming impact of the expression 'sugar free' on the packaging of the defendant's product may lead to some confusion. Such confusion, though not rooted in deception or malice on the part of the defendant, and further, such confusion, though less likely to manifest owing to the well-informed consumer base of the plaintiff's products, nevertheless, carries a fair risk of misleading the consumers of the plaintiff into believing that its sweetener has been added as an ingredient in the defendant's Pro Biotic Frozen Dessert.

56. This brings us to the last, nevertheless, most challenging part of the present case, and that being, what relief should this Court afford at this interlocutory stage so as to subserve the ends of justice. The following impact full observations made by the Apex Court in Wander Ltd. and Anr. v. Antox India Pvt. Ltd. reported at MANU/SC/0595/1990, have become a guiding light for Courts of law whilst deciding upon the relief to be afforded at an interlocutory stage when evidence is yet to be led:

The object of an interlocutory injunction is to protect the plaintiff against injury by violation of his rights for which he could not be adequately compensated in damages recoverable in the action if the uncertainty were resolved in his favor at the trial. The need for such protection must be weighed against the corresponding need of the defendant to be protected against injury resulting from his having been prevented from exercising his own legal rights for which he could not be adequately compensated. The Court must weigh one

57. No doubt that the confusion emanating from the conspicuous display of the expression 'sugar free' on the packaging of the defendant's product is hard to ignore. However, I am afraid that imposing a blanket injunction on the use of a public Jurisdiction expression like 'sugar free' will inequitably allow the plaintiff to monopolise the use of such expression, and this, in effect, will be antithetical to fair competition in trade and commerce. Thus, the challenge, in essence, before this Court is to provide such relief which would maintain the balance between the private right of the plaintiff to use the expression 'Sugar Free' as its trade mark and the larger public right of traders to use the said expression in its descriptive sense.

58. Although a conclusive decision in the present case can be made only after evidence is led and the case is adjudicated upon merits, as of now, I am of the prima facie view that no imminent injury is likely to be caused to the plaintiff if the defendant is allowed to use the expression 'sugar free' on the packaging of its product. To balance equities, the only solace which this Court can afford to the plaintiff at this stage is to restrain the defendant from using the expression 'sugar free' in the present manner, which, though prima facie does not appear deceptive, carries a certain tinge of appropriateness in it. Having said that, it is clarified that the defendant is free to use the expression 'Sugar Free' in any other manner which allows it to describe the special attributes of its product Pro Biotic Frozen Dessert without leaving any scope for confusion.

59. The ex parte order dated 3.4.2007 is accordingly varied to incorporate the following directions:

(i) The defendant is restrained from using the expression 'sugar free' in the present font size which is conspicuously bigger than its trade mark 'Amul'.

(ii) The defendant is free to use the expression 'sugar free' , as part of a sentence or as a catchy legend, so as to describe the characteristic feature of its product.

60. However, before disposing of the present applications, it is made clear that the observations and views expressed by me herein are only upon a prima facie perusal of the facts and documents on record. These observations and views are thus tentative and shall be subject to the final decision on merits which this Court subsequently takes whilst disposing of the present suit.

61. The applications stand disposed of.