



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

+ CS (OS) 589/2005 & IA No.11267/2006 (u/S 12 of Contempt of Court Act)

DART INDUSTRIES INC. & ANR. Plaintiffs

Through: Mr. Hemant Singh, Ms. Mamta R. Jha
and Ms. Shruttima Ehersa, Advs.

Versus

TECHNO PLAST & ORS. Defendants

Through: Mr. Sushant Singh and Mr. Ankit
Kaushal, Advs.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

ORDER

%

21.02.2017

14023/2016 (u/O VI R-17 CPC of the plaintiffs for amendment of the plaint)

1. The plaintiffs have sued for permanent injunction restraining the defendants from (i) committing acts of piracy; (ii) manufacturing, selling or offering for sale infringing products listed in the Table II of the plaint having shape and configuration identical to or resembling the plaintiffs' registered designs applied to the Tupperware Products and being infringing copies of the Tupperware Products thereby infringing the plaintiffs' copyright in the registered designs listed in Table I of the plaint as well as infringing the copyright in the artistic work owned by the plaintiffs listed in Table IV and for ancillary reliefs. The suit, as per the title thereof is "under Section 22 of the Designs Act, 2000 r/w Section 55 of the Copyright Act, 1957".
2. However the plaintiffs, in para 10 of the plaint, while giving the cause of action for the suit, divided the paragraphs under the heads "A. Design



Infringement”, “B. Copyright Infringement”, “C. Passing off of Trade Dress, Trade Names Etc., and “D. Unfair Competition and Unfair Trade Practices” and under the head “C. Passing off of Trade Dress and Trade Names Etc.”, *inter alia* pleaded:-

- “i. It is submitted that by virtue of the new and original designs of the Tupperware Products, the same have become extremely popular in the Indian market as well as in other countries worldwide and have acquired tremendous goodwill and reputation. The Plaintiff No. 1 has spent enormous amount of time, effort and money amounting to USD 120 million from 1994 through the end of 2004 on research and development. The wide recognition given to the designs created by Plaintiff No. 1 is detailed in paragraph 3 hereinabove. Amongst the honours won recently by Plaintiffs, it is pertinent to point out that the Guinness Book has listed Tupperware Products among the 10 greatest inventions of the 20th century. The Tupperware Products have won numerous design awards all over the world. Plaintiff No. 1 was one of the seven US companies to recently receive the ‘2004 Good Buy Award’ from the reputed Good Housekeeping Institute. Plaintiff No.1 has also received an award for one of the 25 Best Products of 2004 from the reputed Fortune Magazine. In a brand survey by HFN the Tupperware ® trademark are ranked second out of 150 companies that sell home products in terms of name recognition A list of Awards won by the Plaintiff No. 1 over the years is annexed hereto and marked as Annexure P3 hereinabove. The goodwill and reputation of Tupperware Products is also widely reported in newspapers and magazines as is evident from newspaper clippings annexed herewith and marked as Annexure P4 hereinabove. The diverse range of Tupperware Products is known worldwide for its unique designs, world-class quality, technical and functional superiority over similar kind of products produced by many other plastic product manufacturers. The trademark “Tupperware” has become a well known consumer goods brand in India and globally and this brand name is associated with unique designs, world-class quality, technical and functional superiority design, and high



quality.

- ii. The actual sales and the growth thereof of the Tupperware Products in India as reflected in paragraph 4 hereinabove and its sales in other countries tells a story of success of the Tupperware Products manufactured and sold by Plaintiff No. 2 in India and the increasing liking of the public at large for the Tupperware Products. The Plaintiff No. 2 has also spent crores of rupees on advertisement and publicity as reflected in the table given in paragraph 5 hereinabove. The Tupperware Products have captured a major part of the Indian market of sale of food grade plastic containers since its presence in India in 1996. The public at large patronizes the Tupperware Products not only in India but also worldwide. The sales in India have increased substantially as reported in the Annual Report of 2003 of the parent company namely Tupperware Corporation wherein region wise reporting is done.
- iii. It is submitted that by virtue of extensive registration, longstanding use, high quality and wide publicity, Plaintiff No. 2 has generated good will and reputation in India such that the Tupperware Products are identified by their design.
- iv. The Defendants who are in the business of *inter alia* making household plastic containers are making the Infringing Products which is advertised to be 'Microwavable Crockery' made from food grade plastic material meant to be sold to the same class of consumers as Tupperware Products. The Defendants have infringed the design and copyright of the Plaintiffs by manufacturing and selling Infringing Products shown in Table III which have a striking resemblance in shape, configuration and pattern of the Tupperware Products and which are goods used for household purposes being targeted to be sold to the same set of consumers as of the Tupperware Products. It is submitted that the Defendants are leaning on the reputation and goodwill painstakingly built by the Plaintiffs over many years.
- v. The first glance at the Infringing Products without going into the



minute details of size, capacity, design, material used, colour combinations, product finish and the logos and trade names, gives the impression as to deceptive or near similarities in the two designs. In view of the facts and circumstances stated hereinabove, it is submitted that the application of designs identical or similar to the Tupperware Product designs by the Defendants to the Infringing Products is clearly creating and is likely to further create confusion and misconception in the minds of the customers leading them to believe that the Infringing Products of the Defendants are the products emanating from Plaintiff No. 2 while in fact it is not so. The Defendants, it is submitted, has adopted the registered designs of the Plaintiffs and applied them to its products as stated above with a view to cash in on the reputation and good will enjoyed by the Plaintiffs and its products that is Tupperware Products manufactured with the registered designs. This is a case of confusion and amounts to the Defendants passing off its Infringing Products as those of the Plaintiff with a view to encash upon the good will and reputation of the latter. There has been conscious and substantial imitation of colour combination, get up and lay out of the Tupperware Products by the Defendants which bares the designs of the Defendants in causing confusion in the minds of customers.

- vi. The Infringing Products are not only a substantial and material imitation of the Tupperware Products as shown in Table III thereby appealing to the eye as being deceptively similar but even the trade dress of the Infringing Products causes confusion as to the identity of the said products resulting in the likelihood of the same being mistook to be Tupperware Products.
- vii. The confusingly similar designs of the Infringing Products namely the “4-in-1 Multipurpose Container”, the “Atta and Chapati Bowl” , “Multipurpose Containers”, “Tumbler” and “Slim Lunch Box” and the “Donga” have almost similar and identical colour combination, shape, configuration and design.
- viii. The Infringing Product namely the “Snack and Spare Box” being identical in design to the Tupperware Product namely “Freezer



Mate” (700 ml) is also illustrative of the passing off being done by the Defendants in as much as the fountain shaped symbol shown on the sidewall and bottom of the Tupperware Product to indicate its use in refrigerator and its utility in the Freezer, has been copied and placed at the same place in the Infringing Product which probably cannot be used in the refrigerator.

- ix. Another Infringing Product namely “4-in-1 Multipurpose Container” and the “Atta and Chapati Bowl” are not only an obvious imitation of the design of the Tupperware Product namely “Crystalwave Divided Bowl” but also have the identical colour combination and even the written instructions on the lid as also the placement of the written instructions and the languages in which this written instructions are given are identical.
- x. In the case of two of the Infringing Products namely “Executive Lunch” and “Classic Lunch Box”, the Defendants have not only made an obvious imitation of the registered designs of the corresponding Tupperware Products but have even used names matching those given to the identical Tupperware Products. Moreover the Defendants are actively trying to cash on the goodwill and reputation of the Plaintiffs by imitating and/ or advertising the design of “Executive Lunch” carry bag recently introduced in the market by the Plaintiff which product of the Defendants is identical in colour combination to the Plaintiffs’ product and was found being sold by the Defendants at the Trade Fair held in November, 2004. The brochure picked up from the India International Trade Fair shows a new design of the bag of the “Executive Lunch” which is identical in design, colour combination of green and black coloured check, shape and placement of the trade name, material and other configuration used in the bag recently launched by Plaintiffs. The time lag between the launch of the Infringing Product and the Tupperware Product, being short, is helping the Defendants in being successful in passing off the Infringing Products as Tupperware Products to take advantage of the reputation and goodwill acquired by the Tupperware Products. Such a practice is indicative of the intention of the Defendants to not only make material and substantial



imitation of the design of Tupperware Products but is also an attempt to pass off the Infringing Products as Tupperware Products.

- xi. By such blatant copying amounting to piracy, infringement as also passing off being carried out by the Defendants has actually caused and is there is every likelihood of the Defendants Infringing Products continuing to cause confusion and deceptiveness in the minds of unwary customers due to similarities in the trade dress, trade name(s), the fountain symbol, etc even though the corporate name and trade mark are not identical. This gets reflected even from the market survey report as well as the observations made during the visit to the Defendants' stall put up at the IITF. The Defendants have applied the registered designs of the Plaintiffs to the Infringing Products only for the purpose of promoting the sale of the Infringing Products. Such act of the Defendants is, it is submitted, fraudulent. It is further submitted that the Defendants have applied the registered designs to its own products knowing fully well that the designs of the Tupperware Products are registered and the Defendants have offered and are continuing to offer the offending products for sale knowing that they are pirated articles.
- xii. Apart from the overall shape of the Infringing Products being identical to the registered designs of the Tupperware Products as detailed in Table II hereinabove, one of the Infringing Products namely "Crazy Bowl" is identical in shape to the state of the art Tupperware Product namely "Serving Bowl " alongwith "Seal for Bowl" brought to India only for the purposes of being used as an incentive/ promotional product and not yet for sale but intended to be launched for sale in India in the near future.. It is submitted that the design of the said product duly registered by Plaintiff No. 1 in India is the state of art design using special moulding techniques and machinery to manufacture the said product. Though the Plaintiff No. 2 has only distributed the said product as a promotional item to its sales force and has not yet launched the said product for sale in India, the Defendants appeared to have obtained the said product either from a member of the sales force



of Plaintiff No. 2 or the Defendants may have purchased the said product abroad. In the case of the said product the Defendants appeared to have not only imitated the said high quality product but have also infringed the copyright in the design drawings annexed to the Registration Certificate placed on the record of this case. Moreover, the launch by the Defendants of the said product in the Indian Market prior to the launch of the Tupperware Product in India is also indicative of the Defendants actively trying to cash on the goodwill and reputation of the Plaintiffs by imitating the design of the “Serving Bowl” not yet sold in the Indian market but available with the sales force of Plaintiff No. 2. Similar is the case where the Defendants have advertised the design of “Executive Lunch” carry bag recently introduced in the market by the Plaintiff.

- xiii. It is therefore submitted that the Defendants are trying to cash in on the goodwill and reputation built painstakingly over the years by the Plaintiffs for which Plaintiff No.1 have spent enormous amounts on research and development aggregating to USD 120 million from 1994 through the end of 2004 as well as approximately an amount in the range of USD 200,000 to USD 1,000,000 for manufacture of each mould and additionally huge sums on purchase of moulds. Plaintiff No.2 has also spent crores of rupees every year on advertisement and publicity of Tupperware Products being offered for sale in India as indicated in paragraph 5 hereinabove and has achieved increasing sales as indicated in paragraph 4 hereinabove. In view of the above, it is submitted that the Defendants are, on account of passing off the Infringing Products as the Plaintiffs’ Tupperware Products, liable to *inter alia*, compensate the Plaintiffs for the damages suffered by it on this account.”

3. Though as aforesaid, neither in the title of the plaint nor in the prayer paragraph relief on the basis of passing off was claimed but in the *ex parte* order dated 5th May, 2005 when summons of the suit were issued and *ex parte ad interim* injunction restraining the defendants from manufacturing,



selling or exporting the products mentioned in Table A (sic for Table II) of the plaint was passed, it was *inter alia* recorded that the plaintiffs had filed the suit for injunction, also on the ground of “passing off”.

4. Separate written statements were filed by the defendants No. 1 and 4, defendant no.8 and by the defendant No.9 and in neither of the three written statements I find the plea, of the suit being not for the relief of passing off for the reason of the same having not been mentioned in the title of the plaint or in the prayer paragraph of the plaint. It is thus quiet evident that the defendants also understood the suit as also for the reliefs on the ground of ‘passing off’.

5. The *ex parte* injunction granted in favour of the plaintiffs was vacated by a detailed judgment dated 4th June, 2007 on the conditions mentioned therein. Paras 44 to 51 thereof deal with the claim in the suit on the ground of ‘passing off’; it was *inter alia* held that at the interim stage no case of ‘passing off’ also could be made out and doubts were also expressed that if the design is no more protected under the Designs Act, whether passing off action would at all be maintainable.

6. FAO(OS) No. 326/2007 was preferred by the plaintiffs against vacation of the *ex parte* order and which was entertained. Since there was no stay of proceedings in the suit, on 8th January, 2008 issues were framed in the suit with the issue No.4 being “*Whether the defendants are passing off their goods as those of the plaintiffs? OPP*” The plaintiffs filed affidavit by way of examination in chief of their witness and which was tendered in evidence on 4th March, 2014; however the cross-examination of the said witness was deferred on that date. The counsel for the defendants states that



the said witness was partly cross-examined on a subsequent date. FAO(OS) No.326/2007 supra preferred by the plaintiffs has been dismissed vide judgment dated 21st July, 2016 and in para 38 thereof, while dealing with the claim of the plaintiffs on the ground of passing off, it has been held as under:

“38. In the context of passing off, undoubtedly trade dress and the get up of the packaging, presentation of the product through label, etc constitute essential components of the goodwill and reputation of a commercial enterprise (Ref. Laxmikant Patel). William Grant & Sons Ltd v McDowell & Co Ltd 1994 FSR 690 (Del.) also supports such a proposition. Yet, for seeking even prima facie protection in the nature of interim injunction there should be material disclosing that the general public associates the shape in question (which is asserted by the plaintiff as their distinctive mark or get up) only with the plaintiff. Whilst in the case of trade dress in the form of label or mark, distinctiveness is easily discernable, in the case of shape based trade dress, the plaintiff has to necessarily show that the get up of the product or article (over which certain exclusivity or distinctiveness is claimed) has an integral association only with it. Unless this requirement is pleaded and established, (and for interim injunction purposes, at least prima facie) every product with a commonplace shape would “ride” on the reputation of an exclusive trademark, based on a distinctive name, label or color combination of the packaging or label, etc. In this case, the distinctiveness of the shape of the product- asserted to be unique or solely associated with the plaintiff has not been so pleaded and established.”

[emphasis added].



7. The observations aforesaid of the Division Bench led the plaintiffs to file this application for amendment, to elaborate the pleas in the plaint of distinctiveness of their products. The said amendments are claimed to be necessary to adjudicate the issue of passing off.

8. The counsel for the defendants has contested the application by contending:-

- i. that the trial in the suit has already commenced and no amendment can be claimed thereafter.
- ii. that the observations of the Division Bench in the judgment dated 21st July, 2016 do not entitle the plaintiff to amend the plaint.
- iii. ignorance of law and facts is no excuse and if the plaint suffers from defective pleadings, the plaintiffs cannot be permitted to fill up the said lacuna.
- iv. that the plaintiffs, by the amendments sought, are changing the nature of the case/cause of action.
- v. that the amendments cause prejudice to the defendants.
- vi. that the plaintiffs have not set out any reason for not moving the amendment application earlier.
- vii. that the amendments are not clarificatory as pleaded but change and alter the nature of the plaintiffs' case.

9. The counsel for the defendants, during the hearing, relying on ***Mohan Lal, Proprietor of Mourya Industries Vs. Sona Paint & Hardwares*** 2013(55) PTC 61 Delhi (Full Bench) has contended that though the Full Bench of this Court held that a suit for infringement of design does not exclude the plaintiffs from instituting an action of passing off in respect of a design used by plaintiff as a trademark, provided the action contains the



necessary ingredients to maintain such a proceedings and that such a suit can be instituted even during the period of registration of the design but has held that a composite suit for infringement of a registered design and a passing off action would not lie; though the separate suits filed in this regard could be tried together. Reference is also made to the order dated 4th October, 2016 in CS(COMM) 837/2016 titled ***Dart Industries Inc Vs. Vijay Kumar Bansal*** also filed by the plaintiffs against the defendants herein with respect to some other designs, asking the plaintiffs to elect whether the plaintiffs wanted to maintain that suit as one of infringement of design or one for passing off.

10. The counsel for the plaintiffs has stated that after the application for amendment of the plaint is decided, the plaintiffs are willing to continue with this suit as for infringement of design and to file a fresh suit on the ground of passing off.

11. The counsel for the defendants however states that since the period of registration of the design has lapsed and the claim made in the suit on the ground of infringement, of design is also only for damages for the period for which design was registered, the defendants have no objection to the plaintiffs continuing with this as a composite suit.

12. The counsel for the defendants has also referred to ***J. Samuel Vs. Gattu Mahesh*** (2012) 2 SCC 300 where amendments sought after conclusion of trial was denied observing that the mistakes sought to be corrected in the plaint could not be labeled as typographical mistake but were fatal to the suit and could not be permitted to be made up by way of amendment.



13. In my view the aforesaid judgment would have no application to the facts of the case. Not only has the trial concluded in that case as against this case where the deposition of the first witness also of the plaintiffs has not been completed but also because the plaint in the suit for specific performance of an agreement of sale of immovable property in that case did not contain the averment of the plaintiff having always been ready and willing to perform his part of the agreement to sell and which averment is mandatorily required to be made vide Section 16(c) of the Specific Relief Act, 1963. It was in the judgment supra in that context held that the defect in the pleading was fatal. We are here concerned with a claim for passing off and the counsel for the defendants inspite of prodding could not tell any statutory requirement equivalent to Section 16(c) supra qua suit on the ground of passing off.

14. The counsel for the defendants also relied on ***Revajeetu Builders and Developers Vs. Narayanaswamy and Sons*** (2009) 10 SCC 84 which in turn relied on ***Ganesh Trading Co. Vs. Moji Ram*** AIR 1961 SC 325, holding that if any essential fact is lacking of in the plaint, the cause of action will be defective and in that case an attempt to supply the omission could sometimes be viewed as equivalent to an introduction of a new cause of action.

15. It was however further held in ***Revajeetu Builders & Developers*** supra that it was not the only possible interpretation to be put on every defective state of pleadings and defective pleadings are generally curable if the cause of action sought to be brought out is not *ab initio* completely absent and that even very defective pleadings may be permitted to be cured,



so as to constitute cause of action where there was none, provided necessary conditions of payment of court fees are complied with.

16. The counsel for the plaintiffs of course argued that the amendments are only clarificatory in nature and that the relief on the ground of passing off is existing in the plaint as originally filed and by way of amendment is only being strengthened.

17. I may reiterate that the suit has always been treated as one on the ground of passing off also and it was never the plea of the defendants also that on the basis of the averments in the plaint the relief could not be said to have been claimed on the ground of passing off.

18. Undoubtedly with effect from the amendment on 1st July, 2002 of the Code of Civil Procedure, 1908 (CPC) no application for amendment is to be allowed after trial has commenced unless the court comes to the conclusion that inspite of due diligence the party could not have raised the matter before the commencement of trial. It is also not in dispute that as per the dicta in ***Link Engineers (P) Ltd. Vs. Asea Brown Boveri Ltd.*** 140 (2007) DLT 533 consistently followed, the trial commences when affidavit by way of examination-in-chief of the witness is tendered in evidence and which has been done in the present case.

19. Having considered the rival contentions, I came to the conclusion that the plaintiffs in the present case, inspite of due diligence could not have raised the matter as now sought to be raised by way of amendment, before the commencement of trial.

20. The matter sought to be raised by way of amendment, I agree with the counsel for the plaintiffs, is by way of clarification only. It is for this reason



only that I have hereinabove set out in entirety the relevant paragraphs of the plaint qua the relief of passing off.

21. I repeat that it was not a defence in the written statement that the essential ingredients of passing off were missing. At the time of framing of issues also it was not the plea of the defendants that the issue qua passing off ought not to be framed as essential ingredients for relief on the ground of passing off were missing. The amendment sought would thus not fall in the category of introduction of a new cause of action curing the shortcomings in the pleadings but would fall in the domain of clarificatory and curable. I say that the plaintiffs inspite of due diligence could not have claimed the amendment, also because of the aforesaid facts only. However once the Division Bench on 21st July, 2016, while dealing with the application for interim relief, observed that distinctiveness of the shape of the product associated to be unique or slightly associated with the plaintiffs had not been pleaded and established and which observation of the Division Bench, it is often the belief, influence the Single Judge at the time of final disposal also, the need therefor arose.

The application is accordingly allowed and disposed of.

CS(OS) 589/2005

22. Amended plaint be filed within one week.

23. Written statement to the amended plaint be filed within four weeks thereafter.

24. Replication thereto within further four weeks thereafter.

25. The parties to file affidavits of admission/denial of additional documents, if any, within further two weeks thereafter.



26. List on 20th July, 2017 for consideration of whether any additional issues are required to be framed.

27. The statement of the counsel for the defendants, as aforesaid recorded, that he has no objection to the composite suit on the ground of infringement and passing off is taken note of.

RAJIV SAHAI ENDLAW, J.

FEBRUARY 21, 2017

M

(Corrected & released on 10th March, 2017)