



## Delhi High Court takes a bite out of Britannia

The Delhi High Court has granted an interim injunction against Britannia for deceptively similar packaging. Lucy Rana and Bijit Das of SS Rana & Co report

In this case, ITC Limited took Britannia Industries to court over the violation of packaging/trade dress rights. ITC sought to permanently injunct Britannia from violating these rights.

ITC launched a new biscuit called 'Sunfeast Farmlite Digestive - All Good' in February 2016. The packaging consisted of a combination of the colours yellow and blue.

Britannia launched a similar biscuit under the name Nutri Choice Digestive Zero a few months later (July 2016).

The packaging of this product was also done in yellow and blue. The parties to this suit have previously been entangled in legal wrangles.

Britannia had filed a complaint against ITC before the Advertising Standards Council of India (ASCI).

In the present case, Britannia offered to replace the blue colour in its packaging with another shade of blue, but this was deemed unacceptable by ITC.

Britannia stated that the colour blue was an integral part of its packaging, as it supposedly reflects World Diabetes Day.

As there was no consensus between the parties regarding the issues at hand, the suit went to trial on 2 September 2016.

### Plaintiff's submissions

ITC asserted three unique and distinctive features of its packaging:

- The brand name 'Sunfeast' was written on the top-left hand side of the label on the yellow portion with the trademark 'Farmlite' underneath it, along with the mark 'Digestive - All Good' situated below 'Farmlite'.
- The colour scheme used in the trade dress was yellow and blue. The left part of the packaging was in a yellow background and the right side of the packaging was in blue, and both colours were separated by a curved line.
- The picture of the biscuits appeared on the right-front side of the label, which was depicted with a wheat spike/sheaf of wheat with grains lying at the bottom of an individual wheat biscuit with the words 'No Added Sugar/Maida' written on the biscuit in a bold white font. The words 'Sugar' and 'Maida' were separated by a white horizontal dividing line between the two words.

ITC averred that Britannia had copied various elements of its trade dress, including the colour combination.

ITC also submitted that the trade channels were identical and in furtherance to that also submitted sales, revenue and advertising figures to substantiate its claims.

*It was held that the defendant's packaging was deceptively similar to that of the plaintiff's product*



Lucy Rana, Managing associate advocate, SS Rana & Co



### Defendant's submissions

Britannia claimed that it held 66 percent of the market share, whereas ITC had a meagre 1.8 percent. Britannia also averred that the predominant colour of the packaging of its product was yellow, and that blue is merely a secondary colour used to indicate a connection to diabetes. Britannia stated that while there might have been a similarity between the two packagings, when viewed as a whole there was no case made for passing off. To that end, the defendant distinguished its packaging as follows:

- The word 'Britannia' itself appeared prominently against a red background in one corner of the impugned packaging.
- The words 'Nutri Choice' featured prominently in its packaging, and the same was not present in ITC's packaging.
- That the shades of blue and yellow used in the impugned packaging were different from that of the plaintiff's.

Britannia averred that a distinction had to be drawn between an action for infringement and an action for passing off. It claimed that the three essentials of passing off (establishing goodwill, demonstrating misrepresentation to the public, and establishing the loss suffered) were not demonstrated by ITC. Britannia further averred that colour per se was not an element of distinctiveness for identifying the source of the products. It was also averred that ITC failed to establish distinctiveness and secondary meaning with respect of its packaging.

### The difference between infringement and passing off

The court referred to the landmark judgement of Kaviraj Pandit Durga Dutt Sharma v Navaratna Pharmaceutical Laboratories to elucidate on this issue—the difference being that the use by the defendant of the trademark 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.

### The elements of passing off

With regard to this issue, the court referred to the landmark judgement of the House of Lords in Reckitt & Colman Products v Borden, in which the elements of passing off were definitively outlined as: establishing goodwill; demonstrating misrepresentation by the defendant to public; and establishing the loss suffered.

### The court's decision

The court observed that the sales and turnover figures submitted by ITC in support of its claims were a significant factor while examining the reputation of the plaintiff's product.

The court also opined that secondary meaning or distinctiveness can be acquired in a short span of time.

Even more so for eatables. It also observed that with respect to eatables such as biscuits, the colour scheme of the packaging plays an important role in the consumer making an initial choice and in enabling a discerning consumer to locate the particular brand of a manufacturer.

It was held that the defendant's packaging was deceptively similar to that of the plaintiff's product, and that the three elements of passing off are fulfilled in the present case.

As per the court's reasoning, the balance of convenience is in favour of ITC, and that granting an interim injunction would cause far less damage to Britannia as its product has been in the market for only two months. The court thereby granted an interim injunction, and restrained Britannia from using any variant of color blue in the packaging. But the court allowed Britannia to use any other distinctive colour instead, or to use the same packaging as used in the international markets for the same product. [IPPro](#)

*The balance of convenience is in favour of ITC, and granting an interim injunction would cause far less damage to Britannia*



**Bijit Das**, Associate advocate, SS Rana & Co